



MONTSERRAT

## CHAPTER 15.09

# MERCHANDISE MARKS ACT

### Revised Edition

showing the law as at 1 January 2013

This is a revised edition of the law, prepared by the Law Revision Commissioner under the authority of the Revised Edition of the Laws Act.

This edition contains a consolidation of the following laws—

### MERCHANDISE MARKS ACT

Act 12 of 1887 .. in force 31 December 1887

Amended by S.R.O. 15/1956

Amended by Acts: 4 of 2003

9 of 2011 .. in force 27 September 2011 (S.R.O. 40/2011)

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**CHAPTER 15.09**

**MERCHANDISE MARKS ACT**

**ARRANGEMENT OF SECTIONS**

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## CHAPTER 15.09

### MERCHANDISE MARKS ACT

(Act 12 of 1887, S.R.O. 15/1956 and Acts 4 of 2003 and 9 of 2011)

#### Commencement

[31 December 1887]

#### Short title

1. This Act may be cited as the Merchandise Marks Act.

#### Interpretation and application

2. (1) In this Act—

“**false trade description**” means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement or otherwise, where that alteration makes the description false in a material respect, and the fact that a trade description is a trade mark, or part of a trade mark, shall not prevent such trade description being a false trade description within the meaning of this Act;

“**goods**” means anything which is the subject of trade, manufacture or merchandise;

“**name**” includes any abbreviation of a name;

“**person**”, “**manufacturer, dealer, or trader**”, and “**proprietor**” include any body of persons corporate or unincorporate;

“**trade description**” means any description, statement, or other indication, direct or indirect—

- (a) as to the number, quantity, measure, gauge, or weight of any goods; or
- (b) as to the place or country in which any goods were made or produced; or
- (c) as to the mode of manufacturing or producing any goods; or
- (d) as to the material of which any goods are composed; or
- (e) as to any goods being the subject of an existing patent, privilege, or copyright,

and the use of any figure, word or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act;

“**trade mark**” means a trade mark registered in the Register of trade marks kept under the Trade Marks Act, and includes any trade mark which, either with or without registration, is protected by an Order in Cabinet under the said Act. (*Amended by Act 9 of 2011*)

(2) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to the goods of any such figures, words or marks, or arrangement or combination thereof whether including a trade mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.

(3) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description, and, for the purpose of this enactment, the expression “**false name or initials**” means, as applied to any goods, any name or initials of a person which—

- (a) are not a trade mark, or part of a trade mark; and
- (b) are identical with, or a colourable imitation of, the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of such name or initials; and
- (c) are either those of a fictitious person or of some person not *bona fide* carrying on business in connection with such goods.

### Offences as to trade marks and trade descriptions

3. (1) Every person who—

- (a) forges any trade mark; or
- (b) falsely applies to goods any trade mark, or any mark so nearly resembling a trade mark as to be calculated to deceive; or
- (c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging a trade mark; or
- (d) applies any false trade description to goods; or
- (e) disposes of, or has in his possession, any die, block, machine, or other instrument for the purpose of forging a trade mark; or
- (f) causes any of the things above in this section mentioned to be done,

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

(2) Every person who sells, or exposes, or has in his possession for sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false trade description is applied, or to which any trade mark, or mark so nearly resembling a trade mark as to be calculated to deceive, is falsely applied, as the case may be, shall, unless he proves—

- (a) that having taken all reasonable precautions against committing an offence against this Act, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and
- (b) that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or
- (c) that otherwise he had acted innocently,

be guilty of an offence against this Act.

(3) Every person guilty of an offence against this Act shall be liable—

- (a) on conviction on indictment to imprisonment for a term of two years, or to a fine, or to both imprisonment and fine; and
- (b) on summary conviction, to imprisonment for a term of four months, or to a fine of \$500, and in the case of a second or subsequent conviction, to imprisonment for a term of six months, or to a fine of \$1,000; and
- (c) in any case, to forfeit to Her Majesty every chattel, article, instrument or thing by means of or in relation to which the offence has been committed.

*(Amended by Act 4 of 2003)*

(4) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed, or otherwise disposed of, as the Court thinks fit.

(5) Any offence for which a person is, under this Act, liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a Magistrate may be forfeited, in manner provided by the Magistrate's Court Act:

Provided that, a person charged with an offence under this section before a Magistrate sitting under Part 4 of the said Act shall, on appearing before the Magistrate, and before the charge is gone into, be informed of his right to be tried on indictment, and, if he requires, be so tried accordingly.

### Forging trade mark

4. A person shall be deemed to forge a trade mark who either—

- (a) without the assent of the proprietor of the trade mark, makes that trade mark, or a mark so nearly resembling that trade mark, as to be calculated to deceive; or
- (b) falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise,

and any trade mark or mark so made or falsified is in this Act referred to as a forged trade mark:

Provided that, in any prosecution for forging a trade mark, the burden of proving the assent of the proprietor shall lie on the defendant.

### Applying marks and description

5. (1) A person shall be deemed to apply a trade mark, or mark, or trade description to goods, who—

- (a) applies it to the goods themselves; or
- (b) applies it to any covering, label, reel, or other thing in or with which the goods are sold, or exposed or had in possession for any purpose of sale, trade or manufacture; or
- (c) places, encloses, or annexes any goods which are sold, or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a trade mark or trade description has been applied; or
- (d) uses a trade mark, or mark, or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark, or mark, or trade description.

(2) The expression “**covering**” includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame or wrapper; and the expression “**label**” includes any band or ticket.

A trade mark, or mark, or trade description, shall be deemed to be applied whether it is woven, impressed or otherwise worked into, or annexed or affixed to, the goods, or to any covering, label, reel or other thing.

(3) A person shall be deemed to falsely apply to goods a trade mark or mark, who, without the assent of the proprietor of a trade mark, applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive; but in any prosecution for falsely applying a trade mark or mark to goods, the burden of proving the assent of the proprietor shall lie on the defendant.

### Exemption of certain persons employed in ordinary course of business

6. Where a defendant is charged with making any die, block, machine or other instrument for the purpose of forging, or being used for forging a trade mark, or with falsely applying to goods any trade mark, or any mark so nearly resembling a trade mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves—

- (a) that in the ordinary course of his business, he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade marks, or, as the case may be, to apply marks or descriptions to goods, and that, in the case which is the subject of the charge, he was so employed by some person resident in Montserrat, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and
- (b) that he took reasonable precautions against committing the offence charged; and
- (c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and
- (d) that he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade mark, mark, or description was applied,

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence.

### Application, of act to watches

7. Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *prima facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied, and with respect to selling, or exposing, or having in possession, for sale or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly; and, for the purposes of this section, the expression “**watch**” means all that portion of a watch which is not the watch case.

### Trade mark, how described in pleading

8. In any indictment, pleading, proceeding or document, in which any trade mark or forged trade mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to

state that trade mark or forged trade mark to be a trade mark or forged trade mark.

### **Rule as to evidence**

9. In any prosecution for an offence against this Act, evidence of the port of shipment shall, in the case of imported goods, be *prima facie* evidence of the place or country in which the goods were made or produced.

### **Punishment of accessory**

10. Any person who, being within Montserrat, procures, counsels, aids, abets or is accessory to the commission, without Montserrat, of any act, which, if committed in Montserrat would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried and convicted in any district or place in Montserrat in which he may be, as if the misdemeanour had been there committed.

### **Search warrant and forfeiture**

11. (1) Where, upon information of an offence against this Act, a Magistrate has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said Magistrate, on or after issuing the summons or warrant, or any other Magistrate, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things, by means of or in relation to which such offence has been committed, are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such Magistrate may issue a warrant under his hand, by virtue of which it shall be lawful for any constable named or referred to in the warrant to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a Magistrate for the purpose of its being determined whether the same are or are not liable to forfeiture under this Act.

(2) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a Magistrate may cause notice to be advertised, stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and, at such time and place, the Magistrate, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

(3) Any goods or things forfeited under this section, or under any other provision of this Act, may be destroyed, or otherwise disposed of, in such manner as the court by which the same are forfeited may direct, and the court may, out of any proceeds which may be realised by the disposition of such goods (all trade marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.

### **Costs of defence or prosecution**

12. On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information given by, and the conduct of, the defendant and prosecutor respectively.

### **Limitation of prosecution**

13. No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after discovery thereof by the prosecutor, whichever expiration first happens.

### **Prohibition on importation**

14. (1) All goods which, if sold, would be liable to forfeiture under this Act, and also all goods of foreign manufacture bearing any name or trade mark being, or purporting to be, the name or trade mark of any manufacturer, dealer, or trader in the United Kingdom, or Montserrat, or any British possession, unless such name or trade mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into Montserrat, and, subject to the provisions of this section, shall be included among the goods prohibited to be imported, as if they were so specified in the customs laws in force in Montserrat, and if any such goods as aforesaid shall be imported or brought into Montserrat, such goods shall be forfeited, and may be destroyed or otherwise disposed of as the Governor may direct.

(2) Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the customs, the Governor may require the regulations under this section, whether as to information, security, conditions or other matters, to be complied with, and may satisfy himself in accordance with those regulations that the goods are such as are prohibited by this section to be imported.

(3) The Governor acting on the advice of Cabinet may from time to time make, revoke, and vary regulations, either general or special, respecting the detention or forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture; and may, by such regulations, determine the information, notices, and security to be given, and the evidence requisite

for any of the purposes of this section, and the mode of verification of such evidence. (*Amended by Act 9 of 2011*)

(4) Where there is on any goods a name which is identical with, or a colourable imitation of, the name of a place in the United Kingdom, or Montserrat, or any British possession, that name, unless accompanied with the name of the country in which such place is situate, shall be treated, for the purposes of this section, as if it were the name of a place in the United Kingdom, or Montserrat, or such British possession, respectively.

(5) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods, or of offences in relation to such goods.

(6) The regulations may provide for the informant reimbursing the Treasury all expenses and damages incurred in respect to any detention made on his information, and of any proceedings consequent on such detention.

(7) All regulations under this section shall be published in the *Gazette*.

(8) This section shall have effect as if it were part of the Customs law for the time being in force in Montserrat.

### **Implied warranty on sale of marked goods**

15. On the sale, or in the contract for the sale, of any goods to which the trade mark, or mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine trade mark, and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor, and delivered, at the time of the sale or contract, to and accepted by the vendee.

### **Provisions as to false description not to apply in certain cases**

16. Where, at the passing of this Act, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied:

Provided that, where such trade description includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply, unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.

## Savings

**17. (1)** This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

**(2)** Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act.

**(3)** Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in Montserrat, who *bona fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

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