

CHAPTER 192

AN ACT to provide against fraudulent marks on merchandise Cap.189-1958

[22nd May, 1889]

1. This Act may be cited as the

Short title

MERCHANDISE MARKS ACT.

2. (1) In this Act—

Interpretation

“false trade description” means a trade description which is false or misleading 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 or misleading 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 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;

“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 standard of quality of any goods, according to a classification commonly used or recognized in the trade; or

(c) as to the fitness for purpose, strength, performance or behaviour of any goods; or

(d) as to the place or country in which any goods were made or produced; or

(e) as to the mode of manufacturing or producing any goods; or

(f) as to the material of which any goods are composed; or

(g) 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;

46 and 47
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“trade mark” means a trade mark registered in the register of trade marks kept under the Patents, Designs and Trade Marks Act, 1883, or any Act or Acts replacing the same, of the Parliament of the United Kingdom, and includes any trade mark which, either with or without registration, is protected by law in Grenada or in any other British possession or in any foreign state to which the provisions of section 103 of the said Act are, under any Order of Her Majesty in Council, for the time being applicable;

the expressions “person”, “manufacturer”, “dealer or trader” and “proprietor” include any body of persons corporate or unincorporate.

(2) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to 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 authorized 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.

3. Without prejudice to the generality of the definitions of “trade description” and “false trade description”, a trade description (to whichever of the matters mentioned in the definition of “trade description” it relates) shall be deemed for the purposes of this Act to be a false trade description if it is calculated to be misunderstood as, or mistaken for, an indication as to the same or some other such matter which would be false or misleading in a material respect as regards the goods to which the description is applied, and anything calculated to be misunderstood as, or mistaken for, an indication of any of those matters shall be deemed for those purposes to be a trade description.

Clarification
of definition
of trade
description,
etc.

OFFENCES AND PENALTIES FOR FALSE TRADE MARKS
AND TRADE DESCRIPTIONS

4. (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 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,

Offences
concerning
trade marks
and trade
descriptions

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

(2) A person is guilty of an offence who sells, or exposes or has in his possession for sale, or for 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, unless he proves either—

- (a) that, having taken all reasonable precautions against committing an offence, 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 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
- (b) that otherwise he had acted innocently.

Penalties for
offences

5. (1) Every person who is guilty of an offence under section 4 shall be liable—

- (a) on conviction on indictment, to imprisonment for two years and to a fine; and
- (b) on summary conviction, to imprisonment for four months and to a fine of five thousand dollars, and, in the case of a second or any subsequent conviction, to imprisonment for six months and to a fine of twelve thousand dollars; and
- (c) in any case, to forfeit every chattel, article, instrument or thing by means of or in relation to which the offence has been committed.

Disposal of
forfeited
articles

(2) The court before which any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the court thinks fit, and the court may, out of any proceeds which may be realized by the disposal 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 the goods.

(3) Any person charged with an offence under this section before a magistrate shall, on appearing before the court, and before the charge is gone into, be informed of his right to be tried on indictment, and, if he requires it, he shall be so tried accordingly.

6. A person shall be deemed to forge a trade mark who either— Forgery of
trade mark

- (a) without the assent of the proprietor of the trade mark, makes that trade mark, or a mark so nearly resembling it 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.

For the purposes of paragraph (a) the burden of proving the assent of the proprietor shall lie on the defendant.

7. (1) A person shall be deemed to apply a trade mark, or mark, or trade description to goods who— Applying
marks and
descriptions

- (a) applies it to the goods themselves; or
- (b) applies it to any covering, label, reel or 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 word “covering” includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame or wrapper; and the word “label” includes any band or ticket.

(3) 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.

(4) 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, and 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

8. 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 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 any other person, 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 Grenada 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 trade 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.

9. (1) 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 for any purpose of trade or manufacture, goods with a false trade description shall apply accordingly.

Application of Act to watches

(2) For the purposes of this section, the expression “watch” means all that portion of a watch which is not the watch case.

PROCEDURE

10. In the 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 the trade mark or forged trade mark to be a trade mark or forged trade mark.

Trade mark,
how
described in
pleading

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

Rules as to
evidence

12. (1) 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 or made 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 court, 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.

Proceedings
for forfeiture
where owner
cannot be
found

(2) Any goods or things forfeited under this section may be destroyed or otherwise disposed of in such manner as the court by which they are forfeited may direct, and the court may, out

Destruction
of things
forfeited

of any proceeds which may be realized by the disposal 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 the goods.

Costs

13. 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

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

MISCELLANEOUS

Prohibition
on import-
ation of
goods which,
if sold, are
liable to
forfeiture

15. Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Act, be it therefore enacted as follows—

- (a) all such goods, 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 in Grenada, 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 and, subject to the provisions of this section, shall be included among goods prohibited to be imported as under section 78 of the Customs Act, or any other Act for the time being in force prohibiting goods to be imported;
- (b) before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to customs, the Permanent Secretary (Finance) 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 the section to be imported;
- (c) the Permanent Secretary (Finance) may from time to time make regulations, either general or special, respecting the detention and 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;
- (d) 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, that name, unless accompanied by 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;
- (e) 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;
- (f) the Permanent Secretary (Finance) in making and administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion or otherwise, shall act under the control of the Minister for the time being responsible for finance;

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- (g) the regulations may provide for the informant reimbursing the Permanent Secretary (Finance) all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention;
- (h) this section shall have effect as if it were a part of the Customs Act.

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16. On the sale or in the contract for the sale of any goods to which a trade mark, 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.

Implied warranty on sale of marked goods

False representation as to Royal Warrant, etc.

17. Every person who falsely represents that any goods are made by a person holding a Royal Warrant, or for the service of Her Majesty, or any of the Royal Family, or any Government Ministry or Department, shall be guilty of an offence and liable, on summary conviction, to a fine of one thousand dollars.

Provisions of Act as to false descriptions not to apply in certain cases

18. If on the 22nd May, 1889, a trade description was being 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 and 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 the name, the name of the place or country in which the goods were actually made or produced, and a statement that they were made or produced there.

Saving provisions

19. (1) This Act shall not exempt any person from any action 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 the person making it 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 employee of an employer resident in Grenada who *bona fide* acts in obedience to the instructions of his employer, and, on demand made by or on behalf of the prosecutor, has given full information as to his employer.
