

MERCHANDISE MARKS ACT 1954

1954/43 (NZ) – 15 July 1955

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To consolidate and amend certain enactments relating to merchandise marks

1 Short title

This is the Merchandise Marks Act 1954.

2 Interpretation

- (1) In this Act and in any regulation made under this Act—
- “advertisement” means any words, whether written or spoken, or any picture, drawing, or figure –
- (a) Inserted in any newspaper or other periodical publication printed and published in Niue; or
- (b) Brought to the notice of members of public in Niue in other manner whatsoever;
- “certification trademark” includes any mark which is used or on in connection with goods for the purpose of indicating that they are the goods of the proprietor of the mark by virtue of certification;
- “covering” includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper;
- “dealer” includes any servant or employee of a dealer;
- “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 trade description, whether by way of addition, effacement, or otherwise where that alteration makes the description false or misleading in a material respect; and also includes a trade description (to whichever of the matters mentioned in the definition of that term in this section it relates) if it is likely to be misunderstood as, or mistaken for, an indication of 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 the fact that a trade description is a trade mark or part of a trade mark shall not prevent the trade description being a false trade description within the meaning of this Act; but no trade mark or part of a trade mark shall be treated as a false description in relation to any goods to which the trade mark or part of a trade mark is applied if the following conditions are satisfied –

- (a) On the day this Act is passed the trade mark either is registered under the Trade Marks Act 1953 (NZ) or is in use to indicate a connection in the course of trade between those goods and the proprietor of the trade mark; and
- (b) The trade mark as applied is used to indicate connection in the course of trade between the goods and the person who is the proprietor of the trade mark or between the goods and a person who is registered under section 37 of the Trade Marks Act 1953 (NZ) as a registered user of the trade mark; and
- (c) The person who is the proprietor of the trade mark is the same person as, or a successor in title to, the proprietor of the day this Act is passed;

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

“imported goods” does not include –

- (a) Goods which since the date of their importation have undergone in Niue any treatment or process resulting in a substantial change in the goods; or
- (b) Goods produced or manufactured in Niue which after exportation are brought back into Niue including any such goods which have undergone abroad any treatment or process not resulting in a substantial change in the goods;

“indication of origin” in relation to any goods, means a definite, clear, conspicuous indication in the English language of the country in which the goods were manufactured or produced;

“label” includes any band or ticket;

“manufacturer” includes any servant or employee of a manufacturer;

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof;

“name” includes any abbreviation of a name;

“person” includes any servant or employee of a person;

“proprietor” includes any servant or employee of a proprietor;

“sale” –

- (a) Includes, subject as hereinafter provided, sale wholesale as well as sale by retail:

Provided that references to exposure for sale in sections 4 and 7 of this Act or (unless the order expressly provides to the contrary) in any regulations made under this Act shall not include exposure for sale wholesale by a person being a wholesale dealer;

- (b) Does not include –
 - (i) a sale of goods for consignment by the vendor to a person outside Niue; or
 - (ii) a sale of second hand goods; or
 - (iii) the sale of any foodstuffs at any hotel or restaurant or other premises for consumption thereon or the sale of any foodstuffs which have undergone a process of cooking, curing, or preserving in Niue;

“trade description” –

- (a) Means any description, statement, or other indication, direct or indirect, –
 - (i) as to the number, quantity, measure, gauge, or weight of any goods; or

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- (ii) as to the standard of quality of any goods according to a classification commonly used or recognised in the trade; or
 - (iii) as to the place or country in which any goods and the material or substance of it were made or produced; or
 - (iv) as to the mode of manufacturing or producing any goods; or
 - (v) as to the material or substance of which any goods are composed; or
 - (vi) as to any goods being the subject of an existing patent, privilege, or copyright; and
- (b) Includes –
- (i) 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 those matters; and
 - (ii) anything likely to be misunderstood as or mistaken for an indication of any of those matters;

“trade mark” means any trade mark within the meaning of the Trade Marks Act 1953 (NZ); and includes a certification trade mark, and any mark which is used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of the mark by virtue of manufacture, selection, certification, dealing with, or offering for sale;

“trader” includes any servant or employee of a trader.

(2) For the purposes of this Act goods shall be deemed to be manufactured or made in any place if they have undergone in that place any treatment or process resulting in substantial change in the goods.

Certain Goods to Bear Indication of Origin

3 Power to require indication of origin

(1) Cabinet may by regulation –

- (a) Direct that goods of any class or description specified in the order shall, in the case of goods intended for importation into Niue at the time of their importation or exposure for sale in Niue, or in the case of goods manufactured in Niue at the time of their manufacture or exposure for sale in Niue, bear an indication of origin;
- (b) Prohibit the sale or the exposure for sale in Niue of goods of any class or description specified in the regulation unless they bear an indication of origin;
- (c) Exclude specified items from any class or description of goods.

(2) A regulation under this section shall specify in every case –

- (a) The manner in which the indication of origin is to be applied to the goods; and
- (b) The date on which the regulation is to come into force (not being a date earlier than 3 months from the date of the making of the regulation, except in the case of a regulation revoking a previous regulation either entirely or as respects some of the goods to which that regulation relates, or a regulation made for amending a previous regulation in consequence of a direction having been given with respect to that regulation under this section relating to provisional exemptions); and
- (c) Whether the goods are to bear the indication of origin at the time of importation or of manufacture or of exposure for sale wholesale.

(3) If, where regulations have been made under this Act with respect to any goods, it is shown to the satisfaction of the Minister by persons appearing to him to have a substantial interest in the matter that the application of the provisions of the regulation or of some of those provisions, to any particular class or description of those goods has caused, or is likely to cause, injury or hardship to the said persons, or any of them, the Minister may, by notice in the *Gazette*, direct that the regulation, or any

particular provisions of the regulation shall cease to apply to goods of that class or description or shall apply to those goods subject only to such modifications and conditions as the Minister thinks fit, and the regulation shall, while the direction is in force, have effect subject to it.

4 Imported goods bearing name or trade mark of Niue manufacturer or trader not to be sold unless accompanied by indication of origin

(1) It shall not be lawful to sell, expose for sale, or (by way of advertising goods of some kind) distribute, in Niue any imported goods to which there is applied any name or trade mark or words, being or purporting to be the name or trade mark of any manufacturer, dealer, or trader in Niue or the name of any place or district in Niue or words which would be likely to associate the goods with Niue unless the name, mark, or words are accompanied by an indication of origin.

(2) If the Minister is satisfied, after considering such representations (if any) as may be made to him by any persons appearing to have a substantial interest in the matter, that having regard to the special circumstances of the trade, difficulties would arise if this section applied to goods of any class or description, or goods sold under any particular designation, and that public interests in Niue would not be materially prejudiced by exempting the goods from the operation of this section, he may, by notice in the *Gazette*, direct that this section shall not apply to those goods, or that goods shall not be treated as falling under this section by reason only that they are so designated.

(3) This section shall not have effect in respect of the application of a name or trade mark to articles used or to be used for any of the following purposes as coverings, labels, reels, or otherwise as articles in or with which goods manufactured or produced in Niue or are to be sold or exposed for sale, if –

- (a) The name or trade mark so applied is the name or trade mark of a manufacturer of or a dealer or a trader in those goods in Niue and the name or trade mark was applied with his consent;
- (b) The trade mark is a certification trade mark and it relates or is to relate to those goods, and was so applied by or with the consent of the proprietor of the certification trade mark or by another in accordance with his authorisation under the regulations relating to the certification trade mark.

5 [Repealed]

6 Penalty on removal of any required mark from goods

If any person removes, alters, or obliterates an indication of origin which, in compliance with the requirements of section 4 or a regulation made under section 3, was borne by the goods at the time of their importation or exposure for sale wholesale, he shall be deemed to have acted in contravention of that provision or regulation unless he proves to the satisfaction of the court dealing with the case that the removal, alteration, or obliteration was not for the purpose of concealing the origin of the goods at the time of their sale or exposure for sale.

7 Offences arising from failure to mark

(1) Subject to this section, every person who sells, exposes for sale, or distributes by way of advertisement, any goods in contravention of the foregoing provisions of this Act, or acts in contravention of or fails to comply with any such provision or any regulation made under section 3, commits an offence and shall be liable on conviction to a fine not exceeding 1 penalty unit; and the Court may in the case of a second or subsequent offence also order the goods in relation to which the offence has been committed to be forfeited.

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(2) (a) If any person advertises or offers for sale as being goods of a particular brand or make or otherwise under a specific designation, by means of an illustration or by means of any written matter, any goods of a class or description which are required by any regulation under section 3 to bear an indication of origin, he shall, if he does not include in the advertisement or offer an indication of the origin of the goods, and subject to this section, be deemed to have acted in contravention of a regulation made under that section.

(b) This subsection shall not apply in the case of any advertisement made, issued or published before the date on which the regulation was made.

(3) Where any person sells, or exposes for sale, any goods, of which some (being goods to which a regulation under section 3 applies) form a distinguishable part, and that part is reasonably capable of having applied to it an indication of origin in manner required by the regulation he shall, for the purposes of this section, be deemed to have sold, or exposed for sale, that part, and the provisions of this section shall apply accordingly.

(4) It shall not within Niue be lawful to sell or offer for sale by sample goods of a class or description to which a regulation under section 3 applies unless the required indication of origin is applied to the samples or unless particulars corresponding to the particulars which would be contained in such an indication are communicated in writing to the person whom the samples are submitted, and if any person acts in contravention of this subsection he shall, subject to this section, be deemed to have acted in contravention of a regulation made under section 3.

(5) A person shall not be guilty of an offence if he proves –

- (a) That having taken all reasonable precautions against committing such an offence he had at the time of the commission of the alleged offence no reason to suspect that the goods were goods to which the foregoing provisions of this Act or regulation made under section 3 applied, and that on a 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 the goods; or
- (b) That otherwise he had acted innocently.

8 Special provisions in respect of blends and mixtures

(1) Section 4 shall not extend to blends or mixtures, and regulations made under section 3 with respect to goods of any class or description shall not extend to blends or mixtures consisting of or containing those goods unless the regulation expressly so provides, and, where any regulation so provides, the indication of origin to be given in respect of the blends or mixtures shall, notwithstanding anything in this Act, be an indication in such form as the regulation prescribes.

(2) The provisions of this section shall not apply to any blend or mixture produced by a process of manufacture from materials of different kinds.

False Trade Descriptions

9 Offences as to trade marks and trade descriptions

(1) Subject to this Act, and unless he proves that he acted without intent to defraud, every person commits an offence 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 likely to deceive; or
- (c) Makes any dye, 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 dye, block, machine, or other instrument for the purpose of forging a trade mark; or
- (f) Falsely represents that goods offered for sale were manufactured or made in Niue; or
- (g) Uses any word, mark, or sign likely to mislead any person as to the real or actual manufacturer or maker of goods, or the place where the goods were made or manufactured; or
- (h) Causes any of the things specified in this subsection to be done.

(2) Every person commits an offence who sells, or exposes, or has in his possession 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 likely to deceive is falsely applied 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 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 the goods or things; or
- (b) That otherwise he acted innocently.

10 Application of false trade description

(1) The provisions of this Act relating to 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 of it, whether including a trade mark or not as are likely 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.

(2) The provisions of this Act relating to the application of false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application of 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 the 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 who carries on business in connection with goods of the same description, and who has not authorised the use of the name or initials; and
- (c) Are either those of a fictitious person or of some person not carrying on business in connection with the goods.

11 Forging trade mark

(1) A person shall be deemed to forge a trade mark who –

- (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 likely to deceive; or
- (b) Falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise.

(2) Any trade mark or mark so made or falsified is in this Act referred to as a forged trade mark.

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(3) In any prosecution for forging a trade mark the burden of proving the assent of the proprietor shall lie on the defendant.

12 Advertisements and other applications of marks and descriptions

(1) A person shall be deemed to apply a trade mark, 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 that trade mark, mark or trade description has been applied; or
- (d) Uses a trade mark, or mark, or trade description in any manner likely to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark, mark, or trade description.

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

(3) A person shall be deemed falsely to apply to goods a trade mark or mark who, without the assent of the proprietor, applies that trade mark or mark, or one so nearly resembling it as to be likely 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.

(4) For the purposes of subsection (1)(d) goods delivered under a request made by reference to a trade mark or mark or trade description appearing in any sign, advertisement, invoice, wine list, business letter, business paper, or other commercial communication shall be deemed to be goods in connection with which the trade mark, mark or trade description is used.

General

13 Exemption of employees in certain cases

(1) Where a defendant is charged with making any dye, 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 likely 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 dyes, blocks, machines, or other instruments for making or being used in making trade marks, or for applying 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 Niue, and was not interested in the goods by way of profit or commission dependent on the sale of 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.

(2) Nothing in this Act shall be construed so as to render liable to any prosecution of punishment any servant of a master resident in Niue who acts in good faith in obedience to the instructions of that master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

14 Power of employer to exempt himself from penalty on conviction of actual offender

(1) Where an employer or principal is charged with the offence of having acted in contravention of, or of having failed to comply with any provision of this Act or any regulation made under this Act he shall be entitled on information duly laid by him and on giving not less than 3 days' notice of his intention to the prosecution to have any other person whom he charges as the actual offender brought before the court at the time appointed for hearing the charge, and if, after the commission of the offence has been proved, the employer or principal proves to the satisfaction of the court that he has used due diligence to enforce compliance with this Act or of the regulation, and that the said other person had committed the offence in question without his consent, connivance, or wilful default, the said other person shall, subject to section 7 (5), be convicted of the offence, and the employer or principal shall be exempt from any penalty.

(2) The person so convicted shall, in the discretion of the court, be also liable to pay any costs incidental to proceedings.

(3) The prosecution shall in any such case have the right to cross-examine the employer or principal if he gives evidence, and any witnesses called by him in support of his charge, and to call rebutting evidence.

15 Description of trade mark in pleading

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

16 Punishment of accessories

Every person who being in Niue procures, counsels, aids, abets, or is accessory to the commission out of Niue of any act which if committed in Niue would under this Act be an offence punishable on indictment shall be guilty of that offence as a principal, and be liable to be indicted, proceeded against, tried, and convicted in Niue as if the offence had been committed there.

17 Limitation of prosecution

No prosecution for an offence against this Act shall be commenced after the expiration of 3 years from the date of the commission of the offence, or after the expiration of one year from the first discovery of it by the prosecutor, whichever first happens.

18 General penalty for offences

Every person who commits an offence against this Act for which no penalty is provided elsewhere than in this section shall be liable on conviction –

- (a) To imprisonment for a term not exceeding 2 years, or to a fine not exceeding 10 penalty units, or to both such imprisonment and such fine; and

- (b) If the court so directs, to forfeit to the Government every chattel, article, instrument, or thing, by means of or in relation to which the offence was committed.

19 Forfeiture

(1) Where any articles (including goods, chattels, instruments, and things) would be liable to forfeiture under section 7 if the owner was convicted of a second offence against this Act, or under section 18 if the owner was convicted of an offence against this Act, and the owner is unknown or cannot be found, an application to the Court may be made for the purpose only of enforcing the forfeiture, and any Judge may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place specified in the notice, the articles will be forfeited; and at that time and place any Judge, unless the owner or any person on his behalf or other person interested in the articles shows cause to the contrary, may order the articles or any of them to be forfeited.

(2) Subject to this section and to any directions of the Court which orders the forfeiture, any such articles which are forfeited under this Act may be sold, destroyed, or otherwise disposed of as the Minister may direct.

(3) Subject to subsection (4)(6), where any such articles which are forfeited under this Act are sold, the proceeds of sale shall be applied in the like manner as if the proceeds were a fine incurred under this Act.

(4) Where any such articles are forfeited under this Act, or under the Customs Act 1966 in consequence of the operation of section 22 of this Act –

- (a) If the articles are not destroyed, all trade marks or trade descriptions which are on the articles in contravention of this Act or of any regulation made under section 3 shall be obliterated before the articles are sold or otherwise disposed of;
- (b) If the Court which orders the forfeiture or any Judge so directs, any innocent party may be reimbursed out of the proceeds of any such sale or disposition any loss he may have innocently sustained in dealing with the articles.

(5) Any such direction may be given by the court which order the forfeiture at the time when it is ordering the forfeiture, or by any Judge on an application made to the High Court in that behalf by any interested person.

20 Implied warranty on sale of marked goods

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 trade mark or mark is a genuine one and not forged or falsely applied, and 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 purchaser.

21 Provisions as to false description not to apply in certain cases

(1) Where on the coming into operation of this Act a trade description was 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 the goods, the provisions of this Act with respect to false trade descriptions shall not apply to that trade description when so applied.

(2) Where the 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 were 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 and the material or substance of it were actually made or produced, with a statement that they were made or produced there.

22 Importation of certain goods prohibited

All goods which if exposed for sale in Niue would be liable to forfeiture under section 18(1)(b) are hereby prohibited to be imported into Niue, and shall be deemed to be included among goods prohibited to be imported under section 48 of the Customs Act 1966, subject to the following provisions, that is to say:

- (a) Before detaining any such goods, or taking any further proceeding with a view to their forfeiture under the Customs Act 1966, the Minister of Customs 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;
- (b) Section 19(4) shall apply in connection with any such goods which are forfeited under the Customs Act 1966;
- (c) Cabinet may make regulations, either general or special, respecting the detention and forfeiture of goods that importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by any 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 verifying any such evidence;
- (d) Regulations so made may apply to all goods the importation of which is prohibited by this section, or to any class or classes of those goods or of offences in relation to those goods;
- (e) Regulations so made may provide that the informant shall reimburse the Minister of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

23 [Spent]

24 Savings in respect of liabilities

(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 that person in any prosecution of an offence against this Act.

25 [Spent]