

THE MERCHANDISE MARKS ACT

Date of commencement: 30th April, 1937.

An Act to make provision against the use of false trade descriptions and forged trade marks.

Short title.

1. This Act may be cited as the Merchandise Marks Act, 1937.

Interpretation.

2. For the purposes of 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 subject of trade, manufacture or merchandise;

“magistrate’s court” means a court established under the Subordinate Courts Proclamation (*Cap.* 20);

“Minister” means the Deputy Prime Minister;

“name” includes an abbreviation of a name;

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

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

- (a) the number, quantity, measure, gauge or weight of any goods; or
- (b) the place or country in which any goods were made or produced; or
- (c) the mode of manufacturing or producing any goods; or
- (d) the material of which any goods are composed; or
- (e) any goods being the subject of an existing patent, privilege or copyright; or
- (f) the standard of quality of any goods according to a classification commonly used or recognised in the trade; or
- (g) the fitness for purpose, strength, performance or behaviour of any goods;

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 Registration Proclamation, 1902, of the Transvaal, as formerly in force in Swaziland, or under Part VII of the Patents, Designs and Trade Marks Act, and includes any trade mark which, either with or without registration, is protected by law in the United Kingdom or in any part of the British Commonwealth or a foreign state, to which section 103 of the Patents, Designs and Trade Marks Act, 1883, of the United Kingdom, are under Order in Council for the time being applicable (which section is set forth in the Schedule).

(2) 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 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 relating to the application of a false trade description to goods or relating to 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 and 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.

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) manufactures, imports or has in his possession any labels for the purpose of applying them contrary to the provisions of this Act; or
- (g) 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.

(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 be guilty of an offence, unless he proves that —

- (a) 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 or trade description; and
- (b) on demand made by or on behalf of the complainant he gave all the information in his power with respect to persons from whom he obtained such goods or things; or
- (c) otherwise he had acted innocently.

(3) Any person convicted of any of the offences mentioned in sub-section (1) or (2) shall be liable to —

- (a) a fine not exceeding four hundred rand, or, in default of payment thereof to imprisonment not exceeding two years, or to both such fine and imprisonment; and
- (b) forfeiture at the discretion of the court of every article, instrument or thing by means of which or in relation to which the offence has been committed.

Presumptions.

4. (1) 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 referred to in this Act 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 accused.

(2) A person shall be deemed to apply a trade mark or mark or trade description to goods who —

- (a) applies it to 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.

(3) 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.

(4) 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.

(5) A person shall be deemed falsely to 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 accused.

Defences.

5. If a person 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 Swaziland 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, or mark or trade description; and
- (d) that he gave the complainant all the information in his power with respect to the persons on whose behalf the die, block, machine or other instrument was made or 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 complainant unless he has given due notice to him that he will rely on the above defence.

Country of origin of watches.

6. If a watch case has thereon any words or marks which constitute or are by common repute considered as constituting a description of the country where it 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 for 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.

Necessary allegation.

7. In any indictment, charge, 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.

Proof of origin.

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

Accessory to crime.

9. Any person who being within Swaziland procures, counsels, aids, abets or is accessory to the commission outside Swaziland of an act which if committed in Swaziland would under this Act be an offence shall be guilty of that offence as a principal, and shall be liable to be indicted, proceeded against, tried and convicted in any place in Swaziland in which he may be as if the offence had been there committed.

Power of entry and search.

10. (1) If upon information of an offence against this Act there has been issued in due form of law either a summons requiring the person charged by such information to appear to answer to the same or a warrant for the arrest of such person, and either the person issuing such summons or warrant or any other officer of the law, empowered to issue criminal process, 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 person charged or arrested or otherwise in his possession or under his control in any place, the person issuing such summons or warrant or other such officer as aforesaid as the case may be, may issue a warrant under his hand by virtue of which any police officer named or referred to in the warrant may enter such house, premises or place at any reasonable time by day and search there for and seize and take away those goods or things.

(2) Any goods or things seized under such warrant shall be brought before a magistrate's court having jurisdiction in respect of such offence for the purpose of its being determined whether the same are or are not liable to forfeiture under this Act.

Forfeiture.

(3) 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 the clerk to a magistrate's court of the district in which such goods or things shall be found may cause notice to be advertised in the Gazette 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 may, unless the owner or any person on his behalf or other person interested in the goods or things show cause to the contrary, order such goods or things or any one of them to be forfeited.

(4) Any goods or things forfeited under 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.

11. On any prosecution under this Act the court may order costs to be paid to the accused by the complainant or to the complainant by the accused having regard to the information given by and the conduct of the accused and complainant respectively.

Limitation of action.

12. No prosecution for an offence against this Act shall be commenced after the expiry of three years after the commission of the offence or one year after the first discovery thereof by the complainant whichever first occurs.

Prohibition of importation.

13. (1) All goods 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 Swaziland 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 if any such goods are imported contrary to the provisions hereof they shall be forfeited.

(2) The words "goods of foreign manufacture" in sub-section (1) shall mean all goods manufactured, made or produced at any place outside Swaziland.

(3) Before detaining any such goods or taking any further proceedings with a view to the forfeiture thereof under the law relating to customs, the officers 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 themselves in accordance with these regulations that the goods are prohibited by this section to be imported.

(4) The Minister may by notice in the Gazette make regulations either general or special relating to 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.

(5) If on any goods there is a name which is identical with or a colourable imitation of the name of a place in Swaziland 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 Swaziland.

(6) If any goods which if sold would be liable to forfeiture under this Act are imported into Swaziland, and the goods bear any name or trade mark being or purporting to be the name or trade mark of any manufacturer dealer or trader in Swaziland, and the director of customs and excise is upon representations made to him satisfied that the use of the name

or trade mark is fraudulent, the proper officer of customs and excise may require the importer of the goods or his agent to produce any documents in his possession relating to the goods and to furnish information as to the name and address of the person by whom the goods were consigned to Swaziland and the name and address of the person to whom the goods were sent in Swaziland; and if the importer or his agent fails within fourteen days to comply with any such requirement he shall for each offence forfeit the sum of two hundred rand.

(7) Any information obtained from the importer of the goods or his agent under this section or from any other source may be communicated by the director of customs to any person whose name or trade mark is alleged to have been used or infringed.

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

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

Warranty.

14. On the sale or in the contract for the sale of any goods to which a 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.

Saving of existing rights.

15. If at the commencement of this Act a trade description is lawfully and generally applied to goods of a particular class or method of manufacture of such goods the provisions of this Act relating 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.

Exemption.

16. The Minister may, by notice in the Gazette at the request of the government of any other country exempt under such regulations as he may approve any goods or things imported directly into such country while in transit through Swaziland:

Provided that goods or things so exempted shall in case of re-importation into Swaziland become subject to this Act.

Miscellaneous savings.

17. (1) This Act shall not exempt any person from any action, suit or other proceeding which might but for 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 Swaziland who *bona fide* acts in obedience to instructions of such master and on demand made by or on behalf of the prosecutor has given full information as to his master.

Allegation of Royal Warrant.

18. Any person who falsely represents that any goods are made by a person holding a Royal Warrant or for the service of His Majesty or of the Ngwenyama or of the Ndhlovukati or any of the Royal Family or of the Government shall be liable on summary conviction to a penalty not exceeding forty rand or, in default of payment, to imprisonment for a period not exceeding four months.

SCHEDULE

[*Being section 103 of the Patents, Designs and Trade Marks Act, 1883 of the United Kingdom.*]

If Her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, designs and trade marks or any of them, then any person who has applied for protection for any invention, design or trade mark in any such State shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act in priority to other applicants; and such patent or registration shall have the same date as the date of the protection obtained in such foreign State: Provided that his application is made in the case of a patent within seven months and in the case of a design or trade mark within four months from his applying for protection in the foreign State with which the arrangement is in force: Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification or the actual registration of his design or trade mark in this country as the case may be.

The publication in the United Kingdom or the Isle of Man during the respective periods aforesaid of any description of the invention or the use therein during such periods of the invention or the exhibition or use therein during such periods of the design or the publication therein during such periods of a description or representation of the design or the use therein during such periods of the trade mark shall not invalidate the patent which may be granted for the invention or the registration of the design or trade mark.

The application for the grant of a patent or the registration of a design or the registration of a trade mark under this section must be made in the same manner as an ordinary application under this Act: Provided that in the case of trade marks any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act.

The provisions of this section shall apply only in the case of those foreign States in respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable and so long only in the case of each State as the Order in Council shall continue in force with respect to that State.
