

MERCHANDISE MARKS ACT**Principal Act****Act. No. 1888-04***Commencement*

6.7.1888

Assent

18.5.1888

Amending
enactment

Relevant current provisions

Commencement
date

Acts. 1935-08 s. 9

1948-18 ss. 2(1), 3(2), 5(3), 10 and 18

1956-13 ss. 2(1) and (2), 3(2) and (3) and 20

1983-12 –

English sources

Merchandise Marks Act 1887 (50 & 51 Vict. c.28)

ARRANGEMENT OF SECTIONS.

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AN ACT TO PREVENT THE IMPOSITION OF FRAUDULENT MARKS ON MERCHANDISE.

Short title.

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

Interpretation.

- 2.(1) In this Act, unless the context otherwise requires,—

“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 that trade description being a false trade description within the meaning of this Act;

“goods” mean 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 standard of quality of any goods, according to a classification 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 materials 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;

“trade mark” means a trade mark registered in England in the register of trade marks kept under the Trade Marks Act, 1938, and includes any trade mark which, either with or without registration, is protected by law in any British possession or foreign state to which the provisions of section 91 of the Patents and Designs Act, 1907, are, under Order in Council for the time being applicable.

(2) Without prejudice to the generality of the definitions of “false trade description” and “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.

(3) 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.

(4) 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 Act, “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

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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.

Offences as to trade marks and trade descriptions.

3.(1) A 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 abovementioned in this section to be done.

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

(2) A person who sells, or exposes for, 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, is, unless he proves either—

- (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 such goods or things; or
- (b) that otherwise he had acted innocently,

guilty of an offence against this Act.

- (3) A person guilty of an offence against this Act is 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 or to a fine of £100, and in the case of a second or subsequent conviction to imprisonment for six months, or to a fine of £250; 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.

(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.

Forging a trade mark.

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

- 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

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- (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 “label” includes any band or ticket.

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

(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 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 persons employed in ordinary 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 Gibraltar, 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 is 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 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.

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.

Evidence of place of production.

9. In any prosecution for an offence against this Act 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 or produced.

Punishment of accessories.

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10. Any person who, being in Gibraltar, procures, counsels, aids, abets or is accessory to the commission, out of Gibraltar, of any act which, if committed in Gibraltar, would under this Act be an offence, is guilty of that offence as a principal.

Search warrant.

11.(1) Where upon information of an offence against this Act, the magistrates' court 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 the court on or after issuing the summons or warrant 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 court may issue a warrant under its hand by virtue of which it shall be lawful for any police officer 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 the magistrates' court 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 the magistrates' court 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 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 realized 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.

12. *Repealed.*

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 the first 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, 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 Gibraltar.

(2) 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.

Rules to implement section 14.

15.(1) The Governor may make rules, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by section 14, and the conditions (if any) to be fulfilled before such detention and forfeiture, and may by such rules determine the information, notices and security to be given, and the evidence requisite for any of the purposes of that section, and the mode of verification of such evidence.

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

(3) The rules may provide for the informant reimbursing the Financial and Development Secretary all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

Implied warranty on sale of marked goods.

16. 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.

When provisions as to false description not to apply.

17. 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.

False representation as to Royal Warrant.

18. A 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 the Government of the United Kingdom or of Gibraltar, is liable on summary conviction to a fine of £100.

Savings.

19.(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 Gibraltar 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.

Saving as to false trade description.

20. Notwithstanding anything in the definition of “false trade description” no trade mark within the meaning of this Act or part of such trade mark

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shall be treated as a false trade description in relation to any goods to which the trade mark is applied, if the following conditions are satisfied, that is to say—

- (a) on the 3rd day of August, 1956, the trade mark either was registered under the Trade Marks Act (Act. 1948 No. 31) or was in use to indicate a connection in the course of trade between the goods and the proprietor of the trade mark; and
- (b) the trade mark as applied is used to indicate a connection in the course of trade between the goods and the person who is the proprietor of the trade mark or the goods and a person who is registered under section 13 of the Trade Marks Act 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 of, the proprietor on the 3rd day of August, 1956.