

THE MERCHANDISE MARKS ACT

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THE MERCHANDISE MARKS ACT

[22nd May, 1888.]

Cap. 244.  
Law  
35 of 1958.  
Act  
12 of 1985  
Sch.

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

2.—(1) For the purposes of this Act, unless the context otherwise requires, the following expressions have the meanings hereby assigned to them respectively, that is to say— Interpretation.  
35/1958  
S 2.

“trade mark” has the meaning assigned to it by the Trade Marks Act;

“trade description” means the customs entry relating to imported goods, or any description, statement or any 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;

“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 trade description within the meaning of this Act;

“goods” means any thing which is the subject of trade, manufacture or merchandise;

“imported goods” does not include—

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

“indication of origin” means a definite indication of the country in which the goods were manufactured or produced; the indication being given conspicuously;

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

“name” includes any abbreviation of a name.

(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 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.

(4) Without prejudice to the generality of the definitions of "trade description" and "false trade description" contained in subsection (1), a trade description 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.

(5) Notwithstanding anything contained in the definition of "false trade description" in subsection (1) no trade mark, within the meaning of the Trade Marks Act, or part of such a trade mark, shall by virtue of paragraphs (b) and (c) of subsection (1) and subsection (4) 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 16th October, 1957, the trade mark either is registered under the Trade Marks Act, 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 a 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 30 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 16th October, 1957.

(6) Nothing contained in this section shall operate to extend the classes of goods which under section 14 are prohibited to be imported into this Island, as having a false trade description applied to them.

Offences as  
to trade  
marks and  
trade  
descriptions.

3.—(1) Every person who—

- (a) forges any trade mark; or
- (b) falsely applies to goods any trade mark, or any mark so nearly resembling a trade mark as to be calculated to deceive; or

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

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

(2) Every person who sells, or exposes 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, shall, unless he proves either—

35/1958  
S. 3 (a).

- (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, be guilty of an offence against this Act.

(3) Save as may otherwise be provided in this Act, every person guilty of an offence against this Act shall be liable—

35/1958  
S. 3 (b)

- (a) on conviction on indictment, to imprisonment with or without hard labour, for a term not exceeding

two years, or to fine, or to both imprisonment and fine; and

- (b) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding two hundred dollars, and in the case of a second or subsequent conviction, to imprisonment with or without hard labour, for a term not exceeding six months, or to a fine not exceeding five hundred dollars; 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.

35/1958  
S. 3 (c) (d).

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

(5) If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom in accordance with the provisions of the Justices of the Peace (Appeals) Act.

Forging  
trade mark.

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

- (a) without the assent of the proprietor of the trade mark makes that trade mark, or a mark so nearly resembling that trade mark as to be calculated to deceive; or
- (b) falsifies any genuine trade mark, whether by alteration, addition, effacement or otherwise,
- and any trade mark or mark so made or falsified is in this Act referred to as a forged trade mark :

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

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

Applying trade marks or descriptions to goods.

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

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

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

(3) 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.

35/1958  
S. 4.

(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; but in any prosecution for falsely applying a trade mark or mark to the goods the burden of proving the assent of the proprietor shall lie on the defendant.

Exemptions  
of certain  
persons  
employed in  
the ordinary  
course of  
business.

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

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

behalf the trade mark, mark, or description was applied,

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

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.

Application of this Act to watches.

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.

Trade mark, how described in pleading.

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

Rules as to evidence in prosecution under this Act.

10. Any person who being within this Island procures, counsels, aids, abets, or is accessory to the commission without this Island, of any act which, if committed in this

Punishment of accessories.

Island, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried and convicted, in any parish or place in this Island in which he may be, as if the misdemeanour had been there committed.

Search  
warrant and  
forfeiture  
of goods.

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

(2) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture; and a court of summary jurisdiction 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.

(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. 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.

Cost of prosecution or defence.

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.

Time limit of prosecution.

14.—(1) In order to make further provision for prohibiting the importation of goods which, if sold, or the exportation of goods prohibited to be exported which, if shipped, put off or water-borne to be shipped would be liable to forfeiture—

Prohibition on importation of certain goods. 35/1958 S. 5.

(a) all goods which, if sold, would be liable to forfeiture under this Act, and also all goods not manufactured within this Island, bearing any trade mark registered under the Trade Marks Act, as the trade mark of any manufacturer, dealer or trader in this Island, unless such 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 this Island and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were specified in paragraph (ii) of section 40 of the Customs Act;
- (b) all agricultural produce, the exportation of which is or shall be prohibited under or by virtue of any enactment relating to the protection of produce, or under or by virtue of any order made under any such enactment, shall be subject to the provision of this section;
- (c) before detaining any such goods, as hereinbefore mentioned, or taking any further proceedings with a view to the forfeiture thereof under the Act relating to the Customs, the Commissioner of Customs and Excise 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 to be imported or exported as the case may be;
- (d) the Minister may from time to time make, revoke and vary regulations either general or special, respecting the detention and forfeiture of goods, the importation or exportation of which is prohibited, 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;
- (e) where there is on any goods a name which is identical with or a colourable imitation of the name of a place in this Island, that name, unless

12/1985  
Sch.

accompanied by the name of the country in which such place is situated shall be treated for the purposes of this section as if it were the name of a place in this Island;

- (f) such regulations may apply to all goods the importation or exportation of which is prohibited, or different regulations may be made respecting different classes of such goods, or of offences in relation to such goods;
- (g) the Commissioner of Customs and Excise in 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; 12/1985 Sch.
- (h) the regulations may provide for the informant reimbursing the Commissioner of Customs and Excise all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention. 12/1985 Sch.

(2) Where any goods which, if sold, would be liable to forfeiture under this Act, are imported into this Island, 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 this Island, and the Commissioner of Customs and Excise is, upon representations made to him, satisfied that the use of the name or trade mark is fraudulent, he 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 this Island, and the name and address of the person to whom the goods were sent in this Island; 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 dollars.

Power to require information in respect of imported goods bearing fraudulent marks. 12/1985 Sch.

(3) Any information obtained from the importer of the goods or his agent under subsection (2), or from any other source, may be communicated by the Commissioner of Customs and Excise to any person whose name or trade mark is alleged to have been used or infringed.

(4) This section shall have effect as if it were part of the Customs Act.

12/1985  
Sch.

Imported  
goods  
bearing  
name or  
trade mark  
of Jamaican  
manufac-  
turer or  
trader not  
to be sold  
unless  
accom-  
panied  
by indica-  
tion of  
origin.  
35/1958  
S. 6.

**15.**—(1) It shall not be lawful to sell, expose for sale, or, by way of advertising goods of some other kind, distribute in the Island, any imported goods to which there is applied any name or trade mark being, or purporting to be, the name or trade mark of any manufacturer, dealer or trader or the name of any place or district in the Island, unless the name or trade mark is accompanied by an indication of origin.

(2) For the purposes of this section—

- (a) a name or trade mark shall be deemed to be applied to goods if it is applied either to the goods themselves or to any covering, label, reel or other thing in or with which the goods are sold or exposed for sale; and
- (b) the expression “trade mark” means a 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.

(3) If the Minister is satisfied, after considering such representations (if any) as may be made to him by any persons appearing to the Minister 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 the Island would not be materially prejudiced by exempting such goods from the operation of this section, he may direct that this section shall not apply to such goods, or that the goods shall not be treated as falling under this section by reason only that they are so designated.

Every such direction shall be published in the *Gazette*, and in such other manner as the Minister may deem suitable.

(4) 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, that is to say, as coverings, labels, reels, or otherwise as articles in or with which goods manufactured or produced in the Island are or are to be sold or exposed for sale if the name or mark so applied is the name or trade mark of a manufacturer of or of a dealer or trader in those goods in the Island and the name or mark was applied with his consent.

16. If any person sells, exposes for sale or distributes by way of advertisement, any goods in contravention of the provisions of section 15 such person shall be guilty of an offence against this Act and shall be liable on summary conviction to a fine not exceeding ten dollars and in the case of a second or subsequent offence to a fine not exceeding forty dollars and the court may in the case of a second or subsequent offence order the goods in relation to which the offence has been committed to be forfeited:

Contra-  
vention of  
section 15  
constitutes  
an offence  
against this  
Act.  
35/1958  
S. 6.

Provided that—

- (i) in the case of the sale wholesale of any goods, it shall be a good defence to proceedings under this section if the person charged with the offence satisfies the court that the goods were sold to the purchaser on an undertaking in writing that they would be exported or sold for exportation to a place outside the Island and any such undertaking in writing, if it purports to be signed by the purchaser

and specifies the usual business address of the purchaser, shall be admissible as evidence of the facts appearing therein;

(ii) a person shall not be treated as being guilty by virtue of this section of an offence against this Act 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 this Act 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.

Imported  
goods  
bearing  
Jamaican  
certification  
trade mark.  
35/1958  
S. 6.

17.—(1) The provisions of paragraph (a) of subsection (1) and subsection (2) of section 14 and (subject to subsection (2) of this section), subsection (1) of section 15 shall apply to a mark being or purporting to be a certification trade mark registered or deemed to be registered under section 39 of the Trade Marks Act, in the name as proprietor thereof of a person in Jamaica, as they apply to a trade mark of a manufacturer, dealer or trader in Jamaica.

(2) Subsection (1) of section 15 shall not have effect in respect of the application of a certification trade mark to articles used or to be used for any of the following purposes, that is to say, as coverings, labels, reels, or otherwise as articles in or with which goods manufactured or produced in Jamaica are or are to be sold or exposed for sale if the mark relates or is to relate to those goods, and was so applied by or with the consent of the proprietor of the mark or by another in accordance with his authorization under the regulations relating to the mark.

**18.** 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.

Implied warranty on sale of marked goods.

**19.** 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 :

Cases in which the provisions of this Act as to false descriptions are not to apply.

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.

**20.—(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.

Saving provisions.

(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 this Island, 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.

False  
representa-  
tion as to  
Royal  
Warrant.  
35/1958  
S. 7.

21. Any 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 Department, shall be liable on summary conviction to a penalty not exceeding forty dollars.