



**BERMUDA
1889 : 17**

MERCHANDISE MARKS ACT 1889

ARRANGEMENT OF SECTIONS

- 1 Interpretation
- 2 Forgery of trade mark
- 3 Applying marks and descriptions
- 4 Offences
- 5 Defences
- 6 Watches and watch cases
- 7 What is sufficient description of trade mark in indictments and other documents
- 8 Accessory in Bermuda to act done outside Bermuda unlawful if done in Bermuda deemed to be principal
- 9 Search warrant
- 10 Private prosecution costs
- 11 Time limit for bringing prosecution
- 12 Prohibition on importations
- 13 Implied warranty on sale of marked goods
- 14 Trade descriptions in use on 14 August 1889
- 15 Savings

[14 August 1889]

[preamble and words of enactment omitted]

Interpretation

- 1 (1) For the purposes of this Act—

MERCHANDISE MARKS ACT 1889

"trade mark" means a trade mark registered in the register kept under the Trade Marks Act 1947, or kept under or preserved by the Trade Marks Act 1938 of the United Kingdom, and includes any trade mark which, either with or without registration, is protected by law in any British possession or foreign state to which section 91 of the Patents and Designs Act 1907 of the United Kingdom, and section 106 of the Patents Act 1949, of the United Kingdom, are, under Order in Council, for the time being applicable.

"trade description" means any description, statement, or other indication, direct or indirect—

- (i) as to the number, quantity, measure, gauge, or weight of any goods; or
- (ii) as to the place or country in which any goods were made or produced; or
- (iii) as to the mode of manufacturing or producing any goods; or
- (iv) as to the material of which any goods are composed; or
- (v) 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 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 the subject of trade, manufacture, or merchandise;

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

"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 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 purposes of this enactment "false name or initials" means, as applied to any goods, any name or initials of a person—

- (a) which are not a trade mark, or part of a trade mark; and
- (b) which 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) which are either those of a fictitious person or of some person not bona fide carrying on business in connection with such goods.

Forgery of trade mark

2 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.

Applying marks and descriptions

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

- (a) who applies it to the goods themselves; or

MERCHANDISE MARKS ACT 1889

- (b) who 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) who 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) who 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) In this section—
- (a) "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and
 - (b) "label" includes any band or ticket.
- (3) A trade mark, or mark, or trade description, shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed or affixed to, the goods, or to any covering, label, reel, or other thing.
- (4) A person shall be deemed falsely to apply to goods a trade mark, or mark, who without the consent 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.

Offences

- 4 (1) Subject to this Act, any 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,

commits an offence against this Act, unless he proves that he acted without intent to defraud.

(2) Any 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, commits an offence against this Act, 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
- (b) that on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the person from whom he obtained such goods or things; or
- (c) that otherwise he acted innocently;

commits an offence against this Act.

(3) Where a person commits an offence under this Act:

Punishment on conviction on indictment: imprisonment for 2 years or a fine of \$7,200 or both such imprisonment and fine;

Punishment on summary conviction: imprisonment for 4 months or a fine of \$1,440 and, in the case of a second or subsequent conviction, imprisonment for 6 months or a fine of \$2,280 and in any case shall be liable 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.

(5) A person charged with an offence under this section before a court of summary jurisdiction shall, on appearing before the court, and

MERCHANDISE MARKS ACT 1889

before the charge is gone into, be informed of his right to be tried on indictment; and, if he so requires, shall be so tried accordingly.

Defences

5 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 Bermuda 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 person on whose behalf the trade mark, mark, or trade description was applied,

then 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.

Watches and watch cases

6 (1) Where a watch case has thereon any words or marks which constitute or are by common repute considered as constituting a description of the country in which the watch was made, and the watch bears no description of the country where it was made, then 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 description, shall apply accordingly.

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

What is sufficient description of trade mark in indictments and other documents

7 In any indictment, pleading, proceedings, 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.

Accessory in Bermuda to act done outside Bermuda unlawful if done in Bermuda deemed to be principal

8 Notwithstanding anything in the Criminal Code [*title 8 item 31*], any person, who being in Bermuda, procures, counsels, aids, abets, or is accessory to the commission, outside Bermuda, of any act which if committed in Bermuda, would constitute an offence against this Act, shall be deemed to have committed that offence as a principal, and shall be liable to be indicted, proceeded against, tried, and convicted, in Bermuda as if the offence had been there committed.

Search warrant

9 (1) Where, upon information of an offence against the Act, a magistrate has issued either a summons requiring the defendant charged by such information to appear to answer to the information, or a warrant for the arrest of such defendant, and either that magistrate on or after issuing the summons or warrant, or any other magistrate, 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 magistrate may issue a warrant under his 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 therefor 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 goods or things 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 a court of summary jurisdiction may cause notice to be advertised stating that, unless cause

MERCHANDISE MARKS ACT 1889

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 goods or things 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.

[Section 9 subsection (1) amended by 2009:52 s.5 effective 4 January 2010]

Private prosecution costs

10 On any prosecution under this Act by any private prosecutor 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.

Time limit for bringing prosecution

11 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 importations

12 With respect to prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Act—

- (a) all such goods, and also all goods of foreign manufacture bearing any name or trade mark being or purporting to be the name or trade mark of any manufacturer, dealer, or trader in the United Kingdom, 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 Bermuda, and shall if imported be liable to forfeiture in like manner as goods laden or unladen contrary to section 9 of the Revenue Act 1898 [*title 14 item 10*];
- (b) before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof, the Accountant-General may require the informant to give such security for reimbursing to the Government of Bermuda and every or any public officer all expenses

and damages incurred in respect of any detention made on the information of such informant, and of any proceedings consequent on such detention, as the Accountant-General may see fit;

- (c) 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 situated, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom;
- (d) the Governor may from time to time make, revoke and vary, regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence;
- (e) such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods;
- (f) the regulations may provide for the informant reimbursing the Accountant-General all expenses and damages incurred in respect of any detention made on the information of such informant, and of any proceeding consequent on such detention;
- (g) the negative resolution procedure shall apply to regulations made under this section.

Implied warranty on sale of marked goods

13 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 purchaser.

MERCHANDISE MARKS ACT 1889

Trade descriptions in use on 14 August 1889

14 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 descriptions 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.

Savings

15 (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 Bermuda who bona fide acts in obedience to the instructions of his master, and on demand made by or on behalf of the prosecutor, has given full information as to his master.

[The Act, originally of limited duration, was continued in force indefinitely by Act No. 31 of 1912.]

[Amended by:

<i>1896 : 19</i>	<i>1969 : 666</i>
<i>1948 : 25</i>	<i>1974 : 93</i>
<i>1949 : 26</i>	<i>1977 : 35</i>
<i>1951 : 68</i>	<i>2009 : 52]</i>
<i>1951 : 78</i>	
<i>1952 : 3</i>	
<i>1952 : 11</i>	