

THE TRADE MARKS ACT, 2009

(Act No. 19 of 2009 dated 24 March 2009)

An Act to repeal the existing law and to re-enact the same with amendments and to consolidate the laws relating to trade marks.

Whereas it is necessary and expedient to repeal the existing law and to re-enact the same with amendments and to consolidate the laws relating to trade marks.

It is hereby enacted as follows:

CHAPTER 1

PRELIMINARY

1. Short Title and commencement - (1) This Act shall be called the Trade Marks Act, 2009.

(2) It shall be deemed to have taken effect from the 1st of July, 2008.

2. Definitions - In this Act, unless there is anything repugnant to the subject or context-

(1) "date of priority" means the date of the previous application which is accepted by the Paris Convention as the basis of the right of priority in respect of trade mark of any goods or services,

(2) "permitted use" means the use of a registered trademark by its registered user complying with all conditions and restrictions to which the registration is subject;

(3) "international classification" means the classification accepted by the World Intellectual Property Organisation or the international classification in accordance with NICE Agreement Concerning the International Classification of Goods and Service for the purposes of the Registration of Marks;

(4) "District court" means the Court of the District Judge and includes the Court of an Additional District Judge or a Joint District Judge;

(5) "false trade description" means –

(a) use of an untrue or misleading trade description in respect of any goods or services;

(b) any addition or deletion or alteration in the trade description of any goods or services which is untrue or misleading;

(c) to indicate in the trade description of any goods that the actual quantity thereof as contained in its container represent more than standard yard or metre;

(d) use of any marks or arrangement or combination thereof for any goods in a manner likely to lead persons to believe that the goods belong to some person other than its real owner;

(e) use of any false name or initials in the trade description of any goods or services in such manner as if the name or initials of that person-

(i) is not a trade mark or part of a trade mark;

(ii) is identical with or deceptively similar to the name or initials of a person carrying on the business of the goods or services of the same description who has not authorised the use of such name or initials; and

(iii) is the name of a fictitious person or some person not carrying on the business of such goods or services;

and along with that a trade description or a trade mark or part of a trade mark shall be deemed to be a false trade description within the meaning of this Act;

(6) "tribunal" means the Registrar or, as the case may be, the Court before which any proceeding is pending;

(7) "trade description" means any description, statement or any other, direct or indirect, indication regarding any of the following matters, -

(a) the number, quantity, measure, gauge or weight of any goods or services;

(b) the standard of quality of any goods or services according to a classification commonly used or recognised in the trade;

(c) the strength, efficacy, quality of any goods, being "food" as defined in the Pure Food Ordinance, 1959, or "drug" as defined in the Drugs Act, 1940;

(d) the place, time or country in which any goods or services were manufactured or produced;

(e) the name and address or other indication as to the identity of the manufacturer or the person for whom the goods are produced or services are provided;

(f) the procedure of manufacture or production of any goods or providing any services;

(g) the description as to the ingredients for the manufacture of any goods or provision of any services; or

- (h) the existing patent, special advantage or copyright relating to any goods or services including the following -
- (i) the use of any number, word or mark relating to any matter mentioned in the trade description referred to in clauses (a) to (g) above and indicating that the same is generally acknowledged as the prevailing custom of the business or trade;
 - (ii) the description as to any imported goods contained in any bill of entry or shipping bill; and
 - (iii) any other description which is likely to be misunderstood or mistaken to relate to any of the said matters deemed to be included.

(8) "trade mark" means –

(a) in respect of the provisions of Chapter 10, excluding section 77, -

(i) a registered trade mark or a mark used in relation to any goods in the course of trade which shows that the user of the mark has the right as proprietor to use the mark;

(ii) a mark used in relation to any services in the course of trade which shows that the user of the mark has the right as proprietor to use the mark;

(b) in respect of the other provisions of the Act, a mark used or proposed to be used in relation to any goods or services which shows that the user has the right, either as a proprietor or as registered user, to use the mark;

(c) certification trade mark.

(9) "Civil Procedure Code" means the Code of Civil Procedure, 1908 (Act V of 1908)

(10) "name" means and includes its abbreviation or initial;

(11) "Registrar" means the Registrar of Trade Marks mentioned in section 3 of this Act;

(12) "prescribed" means prescribed by rules made by the Supreme Court, in relation to proceedings before the Supreme Court, and in other cases, by rules framed by the Government;

(13) "register" means the trade marks registration book or register mentioned in section 4.

(14) "registered" means registered under this Act;

- (15) "registered trade mark" means a trade mark which is included in the register;
- (16) "registered user" means a registered user under section 44;
- (17) "registered proprietor" means any person whose name is written in the trademarks registration book as proprietor of the trade mark;
- (18) "goods" means any article related to trade or production and shall include agricultural products and herbal plants;
- (19) "Paris Convention" means the Paris Convention for the Protection of the Industrial Property of Marks, 1883 as last amended on 20th March 1883.
- (20) "deceptive similar mark" means any mark which is likely to cause deception or confusion and which is similar to a mark registered under this Act;
- (21) "Regulations" means regulations related to registration as certification mark and use of the mark as approved by the Government;
- (22) "Rules" mean the Rules made under this Act;
- (23) "mark" means any device, brand, heading, label, ticket, name, signature, word, letter, symbol, number, numeric component or colour adjustment and includes any combination or adjustment thereof;
- (24) "package" means and includes any case, box, container, packet, bowl, folded cover, casket, bottle, wrapper, label, brand, ticket, reel frame, metal cap, lid, stopple, cork;
- (25) "collective mark" means a visible mark called by similar name in the application for registration which-
- (a) is capable of identifying separately the origin, quality and other general characteristics of the goods or services of different commercial establishment;
 - (b) is used by similar establishments under the control of the registered proprietor; and
 - (c) is used in relation to the goods or services of legal persons constituted under the control of persons engaged in the same business.
- (26) "Government" means, in case of certification trade mark, the Secretary of the Administrative Ministry or Division of the Trade Marks Registry, and in other cases, Administrative Ministry or Division;

(27) "associated trade mark" means a trade mark which is eligible to be, or required to be, registered as associated trade mark under this Act;

(28) "certification trade mark" means a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registrable as such under Chapter VIII in respect of those goods or services in the name, as proprietor of the certification trade mark, of that person;

(29) "limitations" means any limitation of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use of the goods or services within or without Bangladesh;

(30) "service" means any service provided in exchange of financial or similar consideration, but shall not include any goods;

(31) "transmission" means transmission under this Act, devolution on the representative of a deceased person and any other mode of transfer, not being assignment;

CHAPTER II

REGISTRAR, PATENT, DESIGN AND TRADEMARKS REGISTRY AND CONDITIONS FOR REGISTRATION

3. Registrar of Trademarks, Trademarks Registry, etc. (1) For carrying out the purposes of this Act –

- (a) The Trade Marks Registry Wing of the Department of Patents, Designs and Trade Marks established under the Patents and Designs Act, 1911 (Act II of 1911), hereafter in this section referred to as the 'said Act' shall be the Trade Marks Registry;
- (b) The Trade Marks Registry shall have a Registrar who shall be called the Registrar of Trade Marks. The Registrar of Patents, Designs and Trade Marks appointed under the said Act shall be the Registrar of Trade Marks.

(2) For ease of trade marks registration, the Government may, by gazette notification, establish one or more branch offices of the Trade Marks Registry.

(3) The Trade Marks Registry or its branch office shall carry out all activities in respect of trade marks including registration of trade marks.

(4) The Government may, by gazette notification, appoint necessary number of Deputy Registrars in the Trade Marks Registry.

(5) The Deputy Registrar shall carry out all the functions in relation to registration under this Act and under the supervision of the Registrar.

(6) With the prior approval of the Government, the Registrar may, by ordinary or special order, delegate any of his powers or responsibilities under specific conditions to any of his sub-ordinate officers including the Deputy Registrar.

4. The Register of Trade Marks – (1) For carrying out the purposes of this Act, a register or book of record called the Register of Trade Marks shall be kept at the Trade Marks Registry, wherein shall be entered all registered trade marks with the names, addresses and descriptions of the proprietors, notifications of assignment and transmission, the names, addresses and descriptions of registered users, and persons relinquishing their claims, and the conditions, limitations and other matters relating to registered trade marks in the prescribed manner.

(2) Subject to the supervision and direction of the Government, the Registrar shall control and maintain the Register of registration of trade marks.

(3) Every branch office of the Trade Marks Registry shall maintain and preserve a copy of the Register and all the documents prescribed by the Government by Gazette Notification from the list of documents referred to in section 116.

(4) No notice of any trust, direct, indirect or constructive, shall be entered in the Register and no such notice shall be entertained by the Registrar.

5. Registration of goods and services of specific class – (1) In the case of goods and services in a specific class, the trademark can be registered upon the satisfaction of the prescribed conditions for the specific class.

(2) If any question arises in respect of the class of any goods or services, the Registrar will resolve the question and his decision shall be final.

6. Pre-conditions for Registration in the Register – (1) A trade mark shall not be entered in the Register unless it definitely includes at least one description of the following subjects:

(a) the name of the representative company, individual, or firm, shown in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor of his business;

(c) one or more invented words;

(d) one or more words having no direct reference to the characteristics or qualities of the goods, and not being, in its ordinary meaning, the name of a geographical place, dynasty or an individual or an abbreviation of these names, or the name of a community, sect, or tribe in Bangladesh;

(e) any other distinctive mark,

(2) A name, signature or word, not falling within the scope of sub-section 1, excepting clause (e), and not being a distinctive mark shall not be entered in the Register.

(3) For the purpose of this Act, the expression "distinctive mark" of any trademark of any goods or services means a trademark which distinguishes the goods or services of any proprietor from similar goods or services in the same trade, and which bears no relation with the trade mark prepared for registration, either generally or, subject to limitations.

7. Limitation as to colour - (1) A trade mark may be limited, wholly or in part, to any colour or a combination of colours and any such limitation shall be taken into consideration by the tribunal while deciding upon the distinctive character of the trade mark.

(2) If a trade mark is not registered in any particular colour, it shall be deemed to be registered for all colours.

8. Restrictions on registration - A mark or a part of a mark shall not be reregistered as a trade mark if –

(a) it contains anything which is scandalous or obscene;

(b) it is contrary to any law for the time being in force;

(c) it is likely to deceive or to cause confusion;

(d) it contains anything to hurt the religious sentiments of any citizen of Bangladesh;

(e) without the permission of the relevant authority or person, it uses the name of any office or organisation, initials of such name, hallmark, monogram, map, flag, symbol, mark or part thereof or anything similar or partially similar to the name of such office or organization established under some national or international organization, or international agreement or convention.

(f) it is disentitled to protection of law for any other reason;

(g) any application is made mala fide or dishonestly.

9. Use of Names of Chemical elements barred - No word different from the commonly used and accepted as the name of any chemical element or any chemical compound shall be registered as a trade mark in respect of a chemical substance or its preparation, and any such registration shall, notwithstanding different provisions in section 29, be deemed for carrying out the purposes of section 51 to be an entry made in the Register without reasonable cause or an entry wrongly entered in the Register:

Provided that nothing in this section shall apply in the case of using a brand name or indicating the make to distinguish the element or compound as made by the proprietor or a registered user of the trade mark, from the element or compound as made by others, and in the case of intention to use in association with a suitable name or description.

10. Prohibition on registration of similar or deceptively similar trademarks – (1) Subject to sub-section (2), no trade mark shall be registered in respect of any goods or services or description of goods or services which is similar to or deceptively similar to a registered trade mark belonging to a different proprietor in respect of any goods or services or description of goods or services.

(2) For the purpose of honest concurrent use or for any other special reason the Registrar, may consider it necessary and permit the registration of trade mark of goods and services or trade description thereof in the names of more than one proprietor of the trade marks subject to appropriate conditions and restrictions even though the goods or services or description thereof are same or similar.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or nearly resemble each other, in respect of the same goods or description of goods, the Registrar may adjourn the acceptance of the later application until the disposal of the earlier application and decide upon the later application in the light of the evidence and opposition of the earlier application.

(4) A trade mark cannot be registered in respect of any goods or services if the trade mark is similar to or confusingly similar to any well-known trade mark in Bangladesh in respect of similar goods or services or made with translation of any similar trade mark or trade description.

(5) A trade mark cannot be registered for any goods or services if the trade mark is similar to any well-known trade mark in Bangladesh for the same goods or services, if –

(a) the said trade mark is used in such a way as to create the wrong impression that the goods or services have a relationship with the registered proprietor; or

(b) there is a risk that such use is likely to prejudice the interest of the registered trade mark.

(6) In determining whether a mark described under sub-section (4) and (5) is well-known, the general knowledge or impression of the consuming public about that trade mark together with the result of advertisement of the trade mark in Bangladesh, must be considered.

(7) Nothing in this section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or any other person having an earlier right consents to the registration.

Explanation – For carrying out the purposes of this section, ‘earlier trade mark’ means a trade mark registered before the application for the trade mark in question and has prior claim over the trademark, and for which application for registration has been filed before and if it were registered on the basis of such application, it would have been considered as an earlier trade mark

(8) If the Registrar is satisfied that, a trade mark has been used honestly for 2 (two) years after expiry of the registration then while determining the qualification for registration of the said trade mark subsequently, it shall be deemed that despite the expiry the registration was valid for 1 (one) year after the expiry.

11. Use of name of a person, living or dead - If an application for the registration of a trade mark appears to have connection with any living person, or a person whose death took place within 20 (twenty) years prior to the date of application for registration of the trade mark, the Registrar may, before he considers the application, require the applicant to furnish him with the consent in writing of such living person or, as the case may be, the written consent of the legal representative of the deceased person, and may refuse to consider the application if the said consent is not submitted.

12. Registration of parts of trade marks and trade marks as a series - (1) Where the proprietor of a trade mark claims to be entitled to use of any part thereof separately, he may apply to the Registrar for the registration of that part of the trademark as a separate trade mark.

(2) Each such separate trade mark described in sub-section (1) shall require to satisfy all the conditions applicable to, and have all the characteristics of, an independent trade mark.

(3) Where a person claims to be the proprietor of several trade marks for the same or similar goods or services or description of goods or services, and the trade marks, while resembling each other in the material particulars thereof, yet differ in respect of the following, they shall be registered as a series of trade marks –

(a) statement of the goods or services for which the trade mark is used or proposed to be used; or

(b) statement of number, price, quality or names of places; or

(c) other matters of a non-distinctive character which does not substantially prejudice the identity of the trade mark; or

(d) colour.

13. Registration as Associated Trade Marks – (1) Where a trade mark which is registered, or is the subject of an application for registration, for any goods or services is identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor for the same goods or services, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the Register as associated trade marks.

(2) Where a trade mark or any part thereof is registered separately in the name of the same proprietor, they shall be registered as associated trade marks.

(3) Any trade mark registered separately as a series in accordance with the provisions of section 12 (3), shall be deemed to be, and may be registered as, associated trade marks.

(4) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by any other person for the goods or services for which it is registered, and may amend the register accordingly.

14. Registration of trade marks subject to disclaimer - If a trade mark contains -

(a) any part not separately registered as a trade mark in the name of the proprietor, or for the separate registration of which no application has been made, or

(b) any characteristic generally, or otherwise non-distinctive to the trade,

the tribunal, while considering whether the trade mark shall be entered or shall remain on the register, and in deciding to include the said part or characteristic in the Register, may impose a condition that the proprietor shall not claim any exclusive right to the use of such part in whole or in part, or direct the proprietor to make such disclaimer as the tribunal may consider appropriate for the purpose of limiting the right or title of the proprietor under the registration:

Provided that no disclaimer shall affect any right of the proprietor of a trade mark which does not arise out of the registration of the trade mark in respect of which the disclaimer is made.

CHAPTER III

PROCEDURE FOR AND DURATION OF REGISTRATION

15. Application for registration - (1) Any person using or proposing to use a trade mark, being desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of the trade mark.

(2) Separate applications shall be made for registration for different classes of goods or services and the above applications shall be considered chronologically from receipt.

(3) Every application under sub-section (1) shall be filed in the Trade Marks Registry within whose territorial limits the principal place of business in Bangladesh of the applicant, or in the case of joint applicants the principal place of business in Bangladesh of the applicant whose name is first mentioned in the application, is situated.

(4) Where the applicant or the joint applicants do not carry on business in Bangladesh, the application shall be filed in the Trade Marks Registry within whose territorial limits the communication address of the applicant or the joint applicant whose name is first mentioned in the application, is situated.

(5) Subject to the provisions of this Act, the Registrar may –

- (a) accept the application absolutely,
- (b) reject the application after recording reasonable grounds, or
- (c) accept the application subject to such amendments, modifications, conditions or limitations as he may think fit.

16. Rejection of accepted application - Where, after the acceptance of an application for registration of a trade mark, the Registrar is satisfied that –

- (a) the application has been accepted in error; or
- (b) in the circumstances of the case the trade mark should not be registered or should be registered subject to conditions or limitations additional to or different from the conditions or limitations subject to which the application has been accepted,

the Registrar may, after giving the applicant reasonable opportunity of being heard, so reject the application as if the same had not been accepted.

17. Notice of acceptance of application - (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, immediately after acceptance, issue notice of acceptance of the application mentioning the conditions or limitations, in the prescribed manner:

PROVIDED that the Registrar may cause the application to be notified before acceptance if it relates to a trade mark to which section 6(2) applies, or in any other case where it

appears to him that it is expedient by reason of any exceptional circumstances so to do, he may issue notice of the application before its acceptance.

(2) If an application under sub-section (1) -

(a) has been advertised before acceptance; or

(b) after advertisement of an application an error in the application has been corrected; or the application has been permitted to be amended under section 19,

the Registrar may, in the prescribed manner, again issue notice of the correction or amendment .

18. Opposition to registration - (1) Any person may, within 2 (two) months from the date of publication of the notice/advertisement of an application, after payment of the prescribed fee, give notice in writing in the prescribed manner to the Registrar opposing the advertised application.

(2) The Registrar shall, within 1 (one month) of receipt of notice of opposition under sub-section (1), serve in the prescribed manner a copy of the notice on the applicant, and within 2 (two) months of receipt of such notice the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies in support of his application, otherwise the applicant shall be deemed to have abandoned his application.

(3) If the applicant submits the counter-statement, the Registrar shall serve, in the prescribed manner, a copy thereof on the person giving the notice of opposition within one month of receipt of the counter-statement.

(4) The opponent and the applicant shall submit all evidences relied upon by them to the Registrar in the prescribed time and manner, and on the basis of their applications, the Registrar shall give to both parties an opportunity of being heard.

(5) The Registrar shall, after hearing the parties and considering the evidence, decide about the permission for registration with or without conditions or limitations.

(6) If, under sub-section (5), the Registrar deems it expedient to allow registration, subject to any condition or limitation, he will decide on such conditions or limitations.

(7) Where the person giving notice of opposition or the applicant giving counter-statement, neither resides nor carries on business in Bangladesh, after receipt of notice, the Registrar may require him to give security for the costs of proceedings before him, and in default of such security being duly given, may treat the opposition or the application, as the case may be, as abandoned.

(8) Notwithstanding anything contained in this section, all proceedings relating to the opposition of the registration must be completed within 120 (one hundred twenty) working days of sending notice under sub-section (1).

19. Correction of error - The Registrar may permit correction, on such terms as he deems appropriate, of any error in the application for registration before or after accepting the application under section 15, or in the notice of opposition or the counter statement submitted under section 18 .

20. Registration. – (1) Subject to the provisions of section 15, if –

- (a) an application for registration of trademark has been accepted in the register;
- (b) the application has not been opposed or the time for giving notice of opposition has expired; and
- (c) the application has been opposed and the decision in opposition has been taken in favour of the applicant,

the Registrar shall register the said trade mark in the register with effect from the date of application and that date shall, subject to the provisions of section 120, be deemed to be the date of registration.

(2) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate of registration in the prescribed form, sealed with the seal of the Trade Marks Registry.

(3) If there is no defect in the application for registration of trademark, or there is no opposition to the registration, and, subject to the fulfillment of the conditions of registration by the applicant, the registration certificate referred to in sub-section (2) must be provided within 150 (one hundred fifty) working days of the submission of the application.

(4) Where the certificate of registration of a trade mark cannot be issued within 1 (one) year from the date of submission of the application for registration of trademark by reason of default on the part of the applicant, the Registrar shall give notice thereof to the applicant in the prescribed manner, and if the default is not corrected within the time specified in the notice, the application shall be deemed to be abandoned.

(5) The Registrar may amend the register or a certificate of registration for the purpose of correcting a clerical error or an obvious mistake.

21. Jointly owned trade marks. - (1) Nothing in this Act shall authorise the registration of two or more persons who use or propose to use a trade mark independently as joint proprietors hereof.

(2) Notwithstanding anything contained in sub-section (1), where two or more interested persons associated in running the business of the goods or services of a trade mark, those persons may be registered as joint proprietors of the trade mark, and their right to the use

of the trade mark shall be effective in such a way as if the right has been vested in a single person.

22. Duration, renewal and restoration of registration – (1) The registration of a trade mark shall be for a period of 7 (seven) years, but the said registration is renewable in accordance with the provisions of this section.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of 10 (ten) years from the date of expiration of original registration or last renewal of registration, as the case may be.

(3) Within the prescribed time before the expiry of the last registration of a trade mark, the Registrar shall send in the prescribed manner to the registered proprietor notice of the date of expiry and the conditions as to payment of fees and obtaining renewal of registration, and if before expiry of the prescribed time the conditions are not duly fulfilled, the Registrar may remove the trade mark from the register.

(4) Where registration of a trade mark is removed from the register for non-payment of the prescribed fee, the Registrar shall, within one year from the expiration of the registration of the trade mark, on receipt of an application in the prescribed form, if satisfied that it is just so to do, restore the trade mark in the register, and the registration of such trademark may be renewed either generally or subject to such conditions or limitations, for a period of ten years from the expiry of the last registration.

23. Effect of removal from register for failure to pay fee for renewal. - Where a trade mark has been removed from the register for failure to pay the fee for renewal, it shall nevertheless, for the purpose of considering the application for registration of any other trade mark be deemed to be a trade mark maintained on the register, during 1 (one) year next after the date of the removal, unless the tribunal is satisfied as to-

(a) that there has been no proper commercial use of the trade mark during the 2 (two) years immediately preceding its removal; or

(b) that no deception or confusion would be likely to arise from the use of the trade mark applied for registration by reason of any previous use of the removed trade mark .

CHAPTER IV

EFFECT OF REGISTRATION

24. No action for infringement of unregistered trade mark - (1) No person shall be entitled to institute any proceeding to remedy, or to recover damages for, the infringement of an unregistered trade mark.

(2) Nothing in this Act shall be deemed to affect right of remedial action against any person for passing off the goods or services of another person as his own.

25. Right conferred by registration - (1) Subject to the other provisions of this Act, the registration of a trade mark shall entitle its registered proprietor to the exclusive right to use the trade mark for the related goods or services and to obtain relief for infringement of his proprietary right to the trade mark in the manner provided by this Act.

(2) No person other than the registered proprietor of the trade mark for any goods or services, shall use the trademark without the approval of the registered proprietor.

(3) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to the conditions and limitations written in the register.

(4) Where two or more persons are registered proprietors of identical or almost identical trade marks one shall not be deemed to have acquired over the other(s), the exclusive right to the use of the trade marks merely by reason of registration of the trade marks unless their respective rights, the conditions or limitations are recorded in the register, and each of such registered proprietors shall enjoy the exclusive right to use as sole registered proprietor as against any person not registered as approved user.

26. Infringement of registered trade marks. - (1) A person will be deemed to have infringed a registered trade mark, if the person, not being a registered proprietor or registered user, uses in the course of his trade, a deceptively similar trade mark for any goods or services.

(2) A registered trade mark shall be infringed, if any person, not being a registered proprietor or registered user, uses in the course of his trade, a mark which -

- (a) is identical to the trademark and the goods or services for which it is used are similar to the goods or services covered by the registered trade mark;
 - (b) is similar to the trademark, and the goods or services for which it is used are identical to the goods or services covered by the registered trade mark; or
 - (c) is identical to the registered trademark, and the goods or services for which it is used are identical to the goods or services covered by the registered trade mark;
- and

which results in the apprehension that the public may be confused or may get the wrong impression that the mark has an association with the registered trade mark.

(3) A registered trade mark shall be deemed to have been infringed by a person who, not being a registered proprietor or registered user, uses in the course of his trade, a mark which-

- (a) is identical with or similar to the registered trade mark;
- (b) is used for any other goods or services which are similar to those goods or services for which the trade mark is registered; and

(c) is well reputed in Bangladesh as a registered trade mark and the use of the mark, without proper cause, and with intent to take undue advantage causes detriment to, the distinctive character or reputation of the registered trade mark.

(4) For the purposes of this section, the “use of registered trade mark” by a person means-

- (a) affixing the mark on the goods or its package;
- (b) displaying the goods with the mark, supplying the goods to the market for sale, rendering or proposing to render service under the mark, or storing the goods;
- (c) importing or exporting the goods with the mark;
- (d) using the mark on business papers or advertisements.

(5) A registered trade mark shall be deemed to be infringed by a person who, not being empowered by the registered proprietor or user or a person empowered to use the mark or knowing or having reason to believe that the use of the mark would be unlawful, uses the registered trade mark for his goods or services, its package, on business papers, or its advertisements.

(6) Nothing in this section shall be interpreted to obstruct the use of a registered trade mark by a registered proprietor or user or a person empowered to use or the use of a registered trade mark to identify their goods or services; provided that any such use of a registered trade mark in industry and commerce with dishonest intention to take undue advantage, or where it prejudices the distinctiveness or reputation of a registered trade mark, shall be deemed to be an infringement of the registered trade mark.

(7) Any person, not being its registered proprietor or registered user, shall be deemed to infringe a well-known mark for the following uses thereof, if the person –

- (a) uses a mark for any goods or services which are identical with or similar to the goods or services covered by registered well-known mark; or
- (b) uses for his goods or services a mark which, although not identical with or similar to the registered well-known mark, makes an indication from such use of some association with the registered proprietor of the well-known mark and as a result it appears to affect the interest of the proprietor of the registered well known trademark.

Explanation – For the purposes of this section, “well-known mark” shall have the meaning described in section 10.

(8) If the defendant, in a suit filed for the infringement of a registered trademark included in the register, is able to satisfy the court that –

- (a) there is no possibility of the public being confused or deceived by the use of such mark, or

(b) it does not give any indication that the defendant's goods or services has any trade relation with the registered proprietor or registered user of the registered trademark,

then the court shall not grant any injunction or any other relief in favour of the plaintiff.

28. Registration to be prima facie evidence of validity. - (1) In all legal proceedings relating to a trade mark registered under this Act including applications submitted under section 51 and all subsequent assignments and transfers of the trade mark, the original registration of the trade mark shall be prima facie evidence of the validity thereof.

(2) If it is proved that the registered proprietor or his predecessor in title had used the mark in such a way that the said mark had acquired distinctive characteristic on the date of registration, then in any legal proceedings referred to in sub-section (1), no registered trademark shall be declared to be invalid merely on the ground that it was not a registrable trade mark under section 6 without the evidence of distinctiveness and that such evidence was not submitted to the Registrar.

29. Registration to be conclusive as to validity after specified period. - Subject to the provisions of sections 32 and 42, in all legal proceedings relating to a trade mark registered in the register, including applications made under section 51, the original registration of the trade mark shall, after expiry of seven years from the date thereof, be taken to be valid in all respects, unless it is proved that such registration –

(a) was obtained by deception or for a dishonest purpose;

(b) has been done in contravention of section 8 or is inconsistent with the provision of the said section; or

(c) from the date of commencement of the legal proceedings, the above trademark was not distinctive in respect of goods or services of registered proprietor.

30. Saving for vested rights. - Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark or well-known mark to interfere with or obstruct continuous use by any person or his predecessor in title of an identical or nearly identical trade mark for any goods or services, if such use has been from a date prior to the registration of the registered trade mark or use of the well-known mark, and in such a case, the Registrar shall not refuse to register the second mentioned trade mark due to the only reason that the first-mentioned trade mark has been registered in the meanwhile.

31. Saving for use of name, address, or description of goods and services. – Nothing in this Act shall entitle the registered proprietor or registered user of a registered trade mark or well-known mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name of his predecessor, or of the name of the predecessor's place of business, or bonafide use by any person of the characteristics or qualities of his goods or services.

32. Saving of name or description of an article, substance or service.

(1) The registration of a trade mark shall not be deemed to have become invalid by reason of use, after the date of the registration, of the name or description of an article, substance/ ingredients, or service, or any word(s) being a combination of the name and description;

Provided that, the provisions of sub-section (2) shall apply in the following cases, if it is proved –

(a) that there is a well known and well-established use of the word or words as the name or description of the article, substance or service by a person or persons carrying on trade therein, and such word or words are not being used in relation to goods or services of the proprietor or a registered user of the trade mark or in the case of a certification trade mark in relation to goods or services certified by the proprietor; or

(b) that the article, substance or service was previously produced or provided under a patent, and that a period of two years or more has elapsed after the duration of the patent and that the said word or words have been established as the identification of the article, substance or service.

(2) If the facts mentioned in clause (a) or (b) of the proviso to sub-section (1) are proved with respect to any word or words, then -

(a) for the purposes of any proceedings under section 51 –

(i) if the trade mark consists solely of such word or words, the entry in the register for the registration of the trade mark along with the description of the relevant article, substance or service or of any goods or services shall be deemed to have been made erroneously;

(ii) if the trade mark consists of other matters including such word or words, the tribunal, in deciding whether the related article, substance or service or any goods or service shall remain on the register, may give direction requiring submission of a disclaimer as to any right to the exclusive use of the questionable word or words in relation to similar article or substance or any goods or services of the similar description:

Provided that the disclaimer shall not affect any rights arising out of registration of the trade mark other than the disclaimed portion;

(b) for the purposes of any other legal proceedings relating to the trade mark, -

(i) if the trade mark consists solely of such word or words, in case of the disputed article or substance or goods or services of the same description,

all rights of the proprietor as to use of the trademark under this Act or any other law, or

(ii) if the trade mark contains other matters including such word or words, all the rights of the proprietor as to the exclusive use of such word or words relating to the disputed article or substance or service or goods and services of the same description,

shall be deemed to have ceased on the date at which the use of such word or words as mentioned in clause (a) of the proviso to sub-section (1) first became well-known or established, or at the expiration of the period of (2) two years as mentioned in clause (b) of the proviso to sub-section (1).

CHAPTER V

ASSIGNMENT AND TRANSMISSION

33. Power of assignment by registered proprietor. - Subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, the proprietor of a trade mark shall have power to assign the trade mark and to give receipts for the consideration received for such assignment.

34. Assignment and transmission of registered trade marks. Notwithstanding anything contained in any other law, and subject to the provisions of this chapter, a registered trade mark shall be assignable and transferable, whether with or without the goodwill of the business concerned, and the goods or services for which the trade mark is registered shall be assignable and transferable.

35. Assignment and transmission of unregistered trade marks. (1) Except with the goodwill of the business, an unregistered trademark cannot be assigned or transmitted.

(2) Notwithstanding anything contained in sub-section (1), except in connection with the goodwill of the business, an unregistered trademark may be assigned or transmitted, if -

(a) at the time of assignment or transmission, it is used as a registered trade mark in the same type of business,

(b) a registered trade mark is assigned and transmitted at the same time and to the same person as unregistered trade mark, and

(c) the unregistered trade mark relates to the goods or services for which the registered trade mark has been assigned and transmitted.

36. Restriction on assignment and transmission creating exclusive rights for many persons.

(1) Notwithstanding anything contained in sections 34 and 35, a trade mark shall not be assignable or transmissible when the assignment and transmission creates exclusive rights in more than one persons for the same goods or services and the trademarks being identical or similar results in the apprehension that the public may be confused or deceived:

Provided that an assignment or transmission shall not be deemed illegal when the limitation on the exclusive rights prevent the persons entitled from exercising their right to sell within Bangladesh or in the export market without Bangladesh.

(2) The proprietor of a registered trade mark proposing to assign it shall submit to the Registrar, in the prescribed manner, a written statement of the case whereupon the Registrar shall decide as to the legality or illegality of the assignment considering the identity of the goods or services and the trade mark and issue to the proprietor a certificate to that effect.

(3) If it transpires that the certificate issued under sub-section (2) was not obtained by fraud or false description, then, subject to appeal, the same shall be deemed final.

Provided that, if the proprietor does not submit his application for registration under section 40 within 6 (six) months of issuance of the certificate, then the certificate shall not be deemed conclusive or final..

37. Restrictions on assignment and transmission creating exclusive rights in different regions of Bangladesh.

(1) Notwithstanding anything contained in sections 34 and 35, a trade mark shall not be assignable or transmissible if the assignment and transmission creates exclusive rights in more than one persons under this Act or any other law in relation to the same goods or services and the trademarks are identical or similar to each other and are used in different regions of Bangladesh as a result of imposition of limitations on the use of the trademarks.

(2) On application, in the prescribed manner, by the proprietor of a registered trade mark proposing to assign it or by a person who claims that a registered trade mark has been assigned to him or to his predecessor in title since enforcement of this Act, the Registrar shall not, if it transpires to him that the assignment or transmission under sub-section (1) shall not be contrary to the public interest, declare the assignment or transmission of the trademark to be illegal under the provisions of this section or section 36.

(3) Where after the Registrar does not declare the assignment or transmission of the trademark to be illegal under sub-section (2), an application for registration is made to the Registrar under the provisions of section 40 and it is proved that it has not been obtained by fraud or false description, then the above assignment and its transmission shall not be deemed to be illegal under this section or section 36.

38. Conditions for assignment without the goodwill of a business. (1) Where an assignment of a registered or unregistered trade mark is made without the goodwill of the business, then –

- (a) if the assignee does not make an application for issuing notice or advertisement of the assignment within 6 (six) months from the date of assignment or within the additional period of maximum 3 (three) months approved by the Registrar; and
- (b) if the advertisement is not published by the Registrar in the prescribed manner and time, the above assignment shall not be effective.

(2) For the purposes of this section, an assignment of a trade mark, without the goodwill of the business, shall not be deemed to have been made in the following cases -

- (a) an assignment of a trade mark for some of the goods or services for which the trade mark is registered together with the goodwill of the business; or
- (b) an assignment of a trade mark for goods or services exported from Bangladesh together with the goodwill of the business.

39. Conditions for assignment of certification trademarks and associated trade marks. (1) A certification trademark may be transferred subject to the following conditions –

- (a) with the approval of the Government, and
- (b) with a written application made in the prescribed manner to the Registrar

(2) Associated trade marks shall be assignable only in whole and not partially, but subject to the provisions of this Act, such associated trademarks shall be deemed to be registered separately for any other purpose.

40. Registration of assignment and transmission - (1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make an application in the prescribed manner to the Registrar to register his title, and the Registrar shall, on getting satisfactory proof of title, register him as the proprietor of the trade mark for the goods or services for which the assignment or transmission has taken effect, and shall cause particulars of the assignment or transmission together with his name as the proprietor to be entered in the register:

PROVIDED that where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent court.

(2) Except in the case of an appeal arising out of an application before the Registrar under subsection (1) or a similar application, or an application under section 51 or a similar application, a document or instrument not recorded in the register under sub-section (1),

shall not be admitted in evidence by the Registrar or any court in proof of title to the trade mark by assignment or transmission, unless the Registrar or the court directs otherwise.

CHAPTER VI

USE OF TRADE MARK AND REGISTERED USER

41. Proposed use of trade mark by company under incorporation. (1) If the Registrar is satisfied that an applicant for registration of a trade mark for any goods or services is desirous of assigning the trade mark to a company under incorporation under the Companies Act, 1994, he shall not refuse the application for registration of the trade mark only on the ground that the applicant has not used nor proposed to use the goods or services.

(2) In a case to which sub-section (1) applies, the tribunal may require the applicant to give security for the costs of any opposition to the application or appeal therefrom, and if the applicant fails to give such security the application shall be deemed to have been refused.

(3) If a trademark for any goods or services is assigned to a company under sub-section (1), then an application has to be made to the Registrar, within the prescribed time, for registration as registered proprietor of the trademark for the goods or services.

(4) If an application is made under sub-section (3) the Registrar may register the company as the proprietor of the assigned trade mark and if no application is made within the prescribed time, the registration shall cease and the Registrar shall amend the register accordingly.

42. Removal from Register for non-use of the trademark and imposition of limitations

(1) A registered trade mark for any goods or services may be struck off the register on the application in the prescribed manner to the High Court Division or to the Registrar, by any person aggrieved, on any of the following grounds -

(a) that the trade mark for the goods or services was registered although the applicant for registration or the company under incorporation referred to under section 41 had no bonafide intention and that there has in fact been no bona fide use of the trade mark by the applicant or the above company for 1 (one) month prior to the filing of the application; or

(b) that there was no bona fide use of the trademark by the applicant or the company for a period of five years or more after the registration..

(2) Except for the following cases, the tribunal shall not reject an application made under sub-section (1), if –

- (a) the applicant has been permitted under section 10 to register the trade mark for identical or similar goods or services; or
- (b) it appears to the tribunal that the trademark in relation to the goods or services has been used with bona fide intention within the specified date or duration.

(3) If any aggrieved person makes an application in the prescribed manner to the High Court Division or the Registrar on any of the grounds set out below, then the Tribunal may impose limitations for securing the discontinuance of the use of the registered trademark in relation to the goods or services –

- (a) that the trademark for the goods or services was registered for the purpose of sale or use otherwise in trade in a specific place in Bangladesh or for export to a specific market outside Bangladesh, but after registration, there was no bona fide use of the trademark by the applicant or the company for a period of five years or more after the registration; or
- (b) where more than one persons have been given the permission for registration of the trademark for identical or similar goods or services under section 10, and the trade mark is used for sale or otherwise for export.

(4) For the purposes of clause (b) of sub-section (1) or of sub-section (2), the applicant shall not, for the non-use of the trademark, raise such grounds, that –

- (a) it happened due to special circumstances, and
- (b) it was not caused due to any intention to abandon the business or not to use the trade mark.

43. Defensive registration of well known trade marks. (1) Where a trade mark consisting of any invented word for any goods or services has become well known by its use and was registered, but subsequently the said trademark was used for some other goods or services, creating confusion that it has some connection with the first-mentioned person, then, if the proprietor of the first-mentioned goods or services does not use or proposes not to use the trade mark and notwithstanding anything contained in section 42, on an application in the prescribed manner by the said proprietor, the Registrar may register him as the proprietor of the well-known trade mark, and the trademark in respect of identical goods or services shall not be taken off the register under section 42.

(2) The registered proprietor of a trade mark may apply for the registration of the said trademark as a defensive trade mark notwithstanding that it is already registered in his name since before in some other way.

(3) If a registered defensive trade mark is otherwise registered in the name of the same proprietor for different goods and services, then they shall be deemed to be associated trade marks.

(4) On application in prescribed manner to the High Court Division or to the Registrar, by an aggrieved person, the registration of a trade mark as a defensive trade mark may be cancelled if –

(a) except for defensive trade mark, the conditions of sub-section (1) are not presently satisfied in respect of any goods or services in relation to which the trade mark is registered in the name of the same proprietor; or

(b) there is no possibility that the conditions of sub-section (1) will be infringed, if the trademark is used for the goods or services in relation to which the defensive trademark was registered.

(5) The Registrar may, at any time, cancel the registration of a trade mark for which no defensive trade mark is registered in the name of the same proprietor.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply to defensive trade marks in the same way they apply to other trademarks.

44. Registered user. (1) Subject to the provisions of section 45, a person other than the registered proprietor of a trade mark, except for goods or services for which a defensive trademark has been registered, may be registered, conditionally or unconditionally, as a registered user thereof for all or any of the goods or services.

Provided that, the Government may make Rules in respect of rejecting or not accepting any application for registration, if the contract executed between the parties does not include the condition that rules relating to the prevention of trafficking of trademarks is to be followed.

(2) The use of a trade mark registered under sub-section (1) shall be deemed to be done by the proprietor thereof.

45. Application for registration as registered user, etc. (1) Where it is proposed that a person should be registered as a registered user of a trade mark, the registered proprietor and the proposed registered user shall jointly apply in writing to the Registrar in the prescribed manner, and every such application shall be accompanied by the following information and description –

(a) the signed agreement or a duly authenticated copy thereof, entered into between the registered proprietor and the proposed registered user with respect to the permitted use of the trade mark;

(b) an affidavit sworn by the registered proprietor or by a person authorised to act on his behalf, which shall include the following matters-

- (i) the statement giving particulars of and information about the existing relationship between the registered proprietor and the proposed registered user, including the degree of control the proprietor shall have over the permitted use;
- (ii) detailed statement about whether the proposed registered user shall be entitled to apply as the sole registered user or whether there shall be any other restriction on him;
- (iii) description of the goods or services under the proposed registration;
- (iv) description of the conditions and restrictions with respect to the mode or place of permitted use relating to the characteristics and qualities of the goods or services;
- (v) statement as to whether the permitted use is for a specified period or for an unlimited period, and, if for a specified period, the duration thereof; and

(c) such other documents, information or evidence as may be prescribed or required by the Registrar.

(2) Subject to the prescribed conditions, a registered user may be registered, if –

- (a) the conditions of sub-section (1) have been complied with; and
- (b) the use of the trademark for the goods or services by the proposed registered user is not contrary to public interest.

(3) If it appears to the Registrar that, allowing an application under this section would increase the smuggling of the goods or services under the cover of the trade mark, then he may, subject to the other provisions of this Act, reject any application under this section including the above application.

(4) The Registrar shall not reject or conditionally accept an application under this section without giving the applicant an opportunity of being heard.

(5) The Registrar shall, if so requested by the applicant, ensure that any information given along with an application under this section, other than matters entered in the register, is not disclosed to his rivals in trade.

(6) When a person is registered as a registered user, the Registrar shall, in the prescribed manner inform the other registered users, if any, of the trade mark about the matters of registration.

46. Power of registered users to take proceedings against infringement. (1) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement

thereof, and if the proprietor refuses or neglects to do so within 3 (three) months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

(2) A proprietor sued as defendant in the above manner shall not be liable for any costs arising from the proceedings if he takes part in the proceedings.

47. Power of Registrar to vary or cancel registration of registered user. (1) Without prejudice to the provisions of section 51, the Registrar -

(a) may vary the conditions or restrictions applicable to the registration of a registered user for any goods or services, pursuant to an application in writing, in the prescribed manner, made by the registered proprietor of the trade mark;

(b) may cancel the registration of the registered user pursuant to an application in writing, in the prescribed manner, made by registered proprietor or the registered user of the trade mark;

(c) may cancel the registration of the registered user on an application in writing in the prescribed manner by any person on any of the following grounds –

(i) that the registered user used the trade mark otherwise than permitted so as to cause or to be likely to cause, deception or confusion;

(ii) that the proprietor or the registered user misrepresented, or failed to disclose, in the application some fact material for registration which if accurately represented or disclosed would have given the Registrar sufficient reasons to reject the application;

(iii) that considering the rights conferred by the Contract which the applicant is eager to execute, the Registrar deems it inappropriate to effectuate the registration;

(iv) that the circumstances in which the application for registration was made changed in such a way that at the date of the application for cancellation, it was reasonable to reject the application for registration of the registered user;

(d) may cancel the registration of the trademark for any goods or services if the registration is no longer effective.

(e) may cancel the above registration on his own motion or on the application in writing in the prescribed manner, on the ground that the stipulations in the agreement between the registered proprietor and the registered user regarding the quality of the concerned goods or services are neither being enforced nor being complied with;

(2) The Registrar shall not take any decision on any application submitted under this section without issuing notice in the prescribed manner to the registered proprietor and each registered user of the trade mark.

48. Assignment or transmission of trademark by the registered user. - Nothing in this Act shall confer on a registered user of a trade mark the right to assign or transmit the right to use the trademark.

Explanation – In the following cases it will be deemed that the registered user of trademark has not assigned the use of trademarks under this section:-

- (a) For the purposes of carrying out his trade, if a registered user of a trademark enters into a partnership with another person, the partnership firm may use the trademark as long as the registered user is a member of the firm;
- (b) If the registered user is a firm and subsequently there is a change in the constitution of the firm, then the reconstituted firm may use the trademark if the above trademark remains in force in other ways and any registered user of the former firm continues as a member of the re-constituted firm.
- (c) For the purposes of this section, “firm” means a firm as defined in the Partnership Act, 1932 (At IX of 1932).

49. Use of one of associated or substantially identical trade marks equivalent to use of another. (1) Where under the provisions of this Act complete use of a registered trade mark is required to be proved for any other purpose, the tribunal may, if it thinks fit, accept use of a registered associated trade mark, or use of the trade mark with additions or alterations but without harming its basic identity, as an equivalent of registered trade mark.

(2) The use of the whole of a trade mark registered under this Act shall also mean and include use of some other trade mark registered in the name of the same proprietor under section 12(1), which is a part of the first mentioned trademark.

50. Use of trademark in case of change of export trade relationship. (1) If a trade mark is applied to goods or services to be exported from Bangladesh or if any such act is done relating to a similarly exportable goods or services, as would be deemed to be used of the trade mark for sale or for any other use in trade within Bangladesh, then the use of the trade mark to the goods or services for any of the aforesaid purposes shall be deemed to constitute use of the trade mark under this Act or any other law.

(2) If there is any relation between the use of the trade mark for any goods or services and the user of the mark, then the said use shall not be deemed to cause deception or confusion just for the reason that a different relation was or is there between those goods or services and the user of the mark or his predecessor in business.

Chapter VII

RECTIFICATION OF THE REGISTER

51. Power to cancel, change or amend registration. (1) On application by an aggrieved person in the prescribed manner made to the High Court Division or to the Registrar, the Tribunal may, on the ground of violation or failure to observe any condition entered in the Register of registration, may give appropriate orders for cancellation or amendment of the registration of the registered trade mark.

(2) On the application, in the prescribed manner, of a person aggrieved due to absence of any information in the registration Book/Register, or inclusion of an entry without sufficient cause, or by mistake, or any other reason, the tribunal may give appropriate orders for entering necessary information, or to delete or change any entry, as the case may be.

(3) In any proceeding under this section the tribunal may settle any dispute or question relating to necessary and expedient amendment to the Register of Registration.

(4) The High Court Division or the Registrar, of his own motion, may give any order under sub-section (1) or sub-section (2) after issuing notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard.

(5) Any order of the High Court Division for amendment of Register of Registration shall contain a direction to the effect that the notice of amendment shall be served upon the Registrar in the prescribed manner and thereupon the Registrar shall amend the Register as per direction contained in the notice.

52. Correction of mistake in the Register. (1) On the application made in the prescribed manner by the registered proprietor, direction may be given by the Registrar -

- (a) to correct any error relating to the name, address or description of the registered proprietor of the trade mark;
- (b) to change the name, address and description of the registered proprietor of the trade mark in the Register;
- (c) to delete any the entry of any trade mark from the Register;
- (d) to delete any goods or services from any goods or class of goods, or services or class of services included in the registration of trade mark;
- (e) to record any disclaimer or memorandum relating to any registered trade mark the registration whereof does not confer any right; and

(f) to submit to him the certificate of registration for any incidental amendment or change.

(2) On the application in the prescribed manner by any registered user of a trade mark, the Registrar can amend or change any defect in the name, address or description of the registered user as recorded in the Register,

53. Alteration of registered trade mark. (1) A registered proprietor, without making any change in the trademark, may apply to the Registrar in the prescribed manner to add to or alter the trade mark, and the Registrar may reject or conditionally accept the said application.

(2) If he deems proper or expedient, the Registrar may issue notice/ advertisement in the prescribed manner about any application filed under this section, and upon issuance of such notice, if any person serves notice of opposition upon the concerned parties in prescribed manner within the prescribed time, the Registrar may dispose of the matter after giving the parties a hearing.

(3) Upon granting any application under this section and if the changed trade mark has not meanwhile been advertised under sub-section (2) the Registrar may, in the prescribed manner, issue notice/advertisement.

54. Amendment of entries in Register not to change the classification of goods or services of the registered trade mark. (1) The Registrar shall not make any such amendment of entries in the Register as would have the effect of adding some other goods or services or classes of goods or services to those of the trade mark registered immediately before the amendment or of antedating the registration of a trade mark for any goods or services.

(2) The provisions of sub-section (1) shall not apply if it transpires to the Registrar that the addition or antedating pursuant to the aforesaid amendment would not create undue complexity nor cause harm to substantial quantity of goods or services nor prejudice the rights of any person.

(3) A proposal to amend the register shall be notified in the prescribed manner to the registered proprietor of the trade mark so affected or likely to be affected, and any person aggrieved may, by application to the Registrar, oppose the proposed amendment if it contravenes the provisions of sub-section (1).

CHAPTER VIII

CERTIFICATION TRADEMARK

55. Certain provisions of this Act not applicable to certification trade marks. - The following provisions of this Act shall not apply to certification trade marks, that is to say,-

(a) Section 5;

(b) if not specifically made applicable by this Chapter, sections 15, 17 and 18;

(c) Sections 25, 26, 27, 36, 37, 38, 41, 42, 43, 44, 45, 46, 47, 48 and sub-section (2) of Section 50; and

(d) Chapter X excluding section 76

56. Registration of certification trade marks. - A mark shall not be registrable as a certification trade mark in the name of a person who carries on a trade in goods or services of the kind certified.

57. Determination of whether a mark would be considered as a certification trade mark. In determining whether a mark has characteristics different from certification trademark defined under section 2(28), the tribunal shall keep in view the following:-

(a) the above mark can easily make the goods or services in question appear to have different characteristics; and

(b) by reason of the use of the mark or in any other circumstances, the mark is capable of making the goods or services in question as having different characteristics.

58. Applications for registration of certification trade marks. (1) An application for registration as proprietor of a certification trade mark shall be made to the Registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof, accompanied by a draft of the regulations described under section 61 of this Act.

(2) The provisions sub-section (1), (2), (3), (4) and (6) of section 15 and sections 16 and 19 shall, subject to the provisions of sections 56 and 57, be applicable while considering an application under this section in the same way as they apply to an application made under section 15:

Provided that in case of acceptance of any application, the provisions referred to in sub-section (2) shall not be interpreted as empowering to take any proceeding about an application under this section.

(3) While considering an application under this section under the provisions referred to in sub-section (2), the tribunal shall, in applicable cases, have regard to the like considerations, as for an application under section 15, and to any other relevant considerations, not within the jurisdiction of the Government under section 59, including the question of ensuring the distinctiveness of the trade mark.

59. Consideration of application for registration by the Government. (1) When authorisation to proceed with an application under section 58 has been given, the Registrar shall forward the application to the Government who shall consider the application on the basis of the following matters -

- (a) whether the applicant is competent to certify the goods or services for which the mark is to be registered;
- (b) whether the draft of regulations in relation to the use of certification trademark to be filed under section 61 is satisfactory;
- (c) whether the goods or services for which the mark is to be registered are suitable for the public;

(2) After consideration of the application in light of the matters set out in sub-section (1) the Government may -

- (i) direct that the application shall not be accepted; or
- (ii) direct the Registrar to accept the application and approve the said draft regulations without modification, unconditionally or subject to any conditions or limitations, or to any necessary amendments or modification, having regard to the said matters:

Provided that, except in the case of a direction for acceptance and approval without modification or unconditionally, the Government shall not decide upon the matter without giving to the applicant an opportunity of being heard:

Provided further that the Government may, at the request of the applicant made through the Registrar in the event of any subsequent amendment or modification in the application or the draft regulations, reconsider any decision it had previously given under this item on any of the said matters before giving authorisation to the Registrar to proceed with the application.

60. Opposition to registration of certification trade marks. (1) When an application for certification trademark has been accepted, the Registrar shall, as soon as possible, cause the above application to be advertised in the prescribed manner, and the provisions of section 18 shall be applicable in a manner as if the application had been an application under section 15.

(2) When notice of opposition is given relating to the application for registration, the Government shall, after hearing the parties and considering the evidence, if any, give the Registrar –

(a) an order to reject the same, or

(b) a direction to register the relevant mark unconditionally or subject to any conditions, limitations or modifications considered appropriate by the Government.

(3) Where the Government provides any direction under sub-section (2), the Registrar shall dispose of the matter in accordance with the direction.

61. Filing of regulations governing the use of a certification trade mark. – (1) There shall be filed at the Trade Marks Registry in respect of every mark registered as a certification trade mark all matters relating to the use of the trademark and regulations approved by the Government, which shall include description of goods or services for which the registered proprietor grants the right to use the certification trade mark, and such other provisions as the Government may, by general or special order, require to be included in the regulations.

(2) The regulations filed under sub-section (1) shall be open to inspection in the same manner as the Register of Registration.

(3) The regulations so filed may, on the application of the registered proprietor, be altered by the Registrar subject to the approval of the Government.

(4) The Government may cause the said application to be advertised in any case where it appears to it expedient so to do, and if within the time specified in the advertisement any person gives notice of opposition to the application, the Government shall not dispose of the application without giving the concerned parties an opportunity of being heard.

62. Right conferred by registration of certification trademark. (1) Subject to the provisions of sections 30, 31 and 64, the registration of a person as proprietor of a certification trade mark for any goods or services shall give to that person the exclusive right to the use of the certification trade mark for those goods or services.

(2) The exclusive right conferred by sub-section (1) shall be effective subject to the conditions and limitations, upon which the certification trademark has been registered.

63. Infringement of certification trade marks. - The right conferred by section 62 shall be deemed to be infringed by any person who, not being the registered proprietor of the certification trade mark or a person authorised by him in that behalf, uses in the course of his trade, a mark, which is identical with, or deceptively similar to the certification trade mark resulting in confusing the mark as a valid trade mark for goods reasons.

64. Cases where certification trademarks are not infringed. (1) Notwithstanding anything contained in this Act, the following shall not constitute an infringement of the right to use of registered certification trade mark-

(a) where the conditions or limitations under which a certification trade mark is registered do not apply;

(b) the use of a certification trade mark for goods or services certified by the proprietor of the mark;

(c) where –

(i) the certification trade mark is adapted for use in relation to goods or services which form part of other goods or services and the trade mark has been used or being used for similar goods or services without infringement of the right; and

(ii) use of the mark is reasonably considered necessary for the reason that the goods or services are so adapted as to indicate that the goods are certified by the proprietor.

(2) Notwithstanding its similarity to the goods or services referred to in Clause (b) of sub-section (1), the provisions of the above sub-section shall not be applicable for the goods or services, whose application for registration of certification trademark is contrary to the provisions of the above clause (b).

(3) Where a certification trade mark is identical or similar to two or more trade marks registered under this Act, the right to the use of any of those trade marks shall not be deemed to be infringed because of the said certification trade mark.

65. Cancellation or variation of entry in the Register of registration. (1) The Government may, on the application in the prescribed manner of any aggrieved person or on the recommendation of the Registrar, and after giving the proprietor a reasonable opportunity of opposing the application or recommendation, order cancellation or variation of any entry in the register relating to a certification trade mark, or for varying the filed regulations, on any of the following grounds -

(a) that the proprietor is not competent to certify the goods or services for which the mark is registered;

(b) that the proprietor has failed to observe any provision of the filed regulations;

(c) that the registration of the relevant mark is no longer required in public interest; and

(d) that the said regulations are required to change in public interest.

(2) Neither the High Court nor the Registrar can make an order under section 51 on any of the grounds described in sub-section (1).

(3) The Registrar shall be able to rectify the Register and the filed regulations for giving effect to an order made under sub-section (1).

CHAPTER IX

SPECIAL PROVISIONS FOR TEXTILE GOODS

66. Textile goods. The provisions of this Chapter shall apply to trade marks for the goods the Government shall prescribe under the International classification, hereinafter in this Chapter referred to as “textile goods”, and the other provisions of this Act shall also apply to such trade marks as they apply to trade marks for other classes of goods.

67. Restrictions on registration of textile goods. (1) In respect of textile goods being piece goods -

(a) no mark consisting of only a line heading shall be registrable as a trade mark;

(b) a line heading shall not be deemed to be adapted for distinguishing the goods;

(c) the registration of a trade mark shall not give any exclusive right to the use of a line heading.

(2) The registration of letters or numerals, or any adjustment or combination thereof for any textile goods, shall be subject to prescribed conditions and restrictions.

68. Long stamping of piece goods, cotton fibre or thread. (1) Piece goods, ordinarily sold by length or by the piece, manufactured, bleached, dyed, printed or finished under the provisions of the Labour Act, 2006 (Act No. 42 of 2006) in the premises of a factory, shall not be removed from such premises in which they underwent any of the said processes without conspicuous stamping in Bangla or English numerals the length of each piece in standard metres, but no such stamping shall be required when the goods are sold direct from the factory for export from Bangladesh, without stamping thereon the name of the manufacturer or the proprietor of the premises in which the piece was finally processed or the name of the wholesale purchaser in Bangladesh of the said goods.

(2) Cotton yarn which is ordinarily sold in bundles, and cotton thread used in sewing, darning, crochet or handicraft, which have been manufactured, bleached, dyed or finished in factory premises and are not exempted by the rules made under section 70, shall not be removed for sale from the premises unless in compliance with the said rules -

(a) each bundle of yarn is conspicuously marked with the weight of yarn in the metric system;

(b) the count of the yarn in each bundle and in the case of other threads the length or weight of thread in each unit are conspicuously marked; and

(c) when the goods are sold directly from the premises for export from Bangladesh, name of the manufacturer or of the wholesale purchaser in Bangladesh is printed on each bundle or unit:

PROVIDED that any premises where the work is done by the members of one family with or without the assistance of not more than ten employees, and any premises controlled by a co-operative society employing a 'maximum' of twenty workers shall be exempted from the operation of the said rules.

69. Declaration of piece goods. For carrying out the purposes of section 68 and Clause (I) of section 15 of the Customs Act (Act IV of 1969), the Government may, by Gazette Notification, declare as "piece goods" the goods which are sold by length or piece.

70. Determination of character of textile goods by sampling.

(1) For the purposes of this Act, the Government may, by Gazette Notification, make rules on the following matters -

(a) to select and test samples of goods having uniform number, quantity, measure, gauge or weight;

(b) to provide for the procedure for marking cotton yarn or thread with the necessary description under section 68, and for the exemption of some factories or premises used for the manufacture, bleaching, dyeing or finishing of similar cotton yarn from the provisions of that section.

(2) With respect to any goods for the selection and testing of samples of which no provision is made in the rules under sub-section (1), the Court or the customs officer, having arranged for ascertaining the number, quantity, measure, gauge or weight of the goods, may, by order in writing, determine the number of samples to be selected and tested and the manner in which the samples are to be selected.

(3) The average of the results of the testing in pursuance of rules under subsection (1) or of an order under sub-section (2) shall be prima facie evidence of the number, quantity, measure, gauge or weight of the goods.

(4) If a person having any claim to any goods of which samples have been selected and tested in pursuance of rules under sub-section (1), or of an order under sub-section (2), desires that any further samples of the goods be selected and tested, may in writing apply, to the Court or the customs officer, in the prescribed manner after paying in advance the cost of the further selection and testing as the court or customs officer may from time to time determine, and thereupon the Government or Customs officer shall select and test the goods according to the rules or in the case of goods with respect to which provision is not made in such rules, the court or officer of customs may prescribe the procedure he would deem reasonable in the circumstances and give decision for selection of samples under sub-section (1), or sub-section (2) according to the procedure prescribed by him.

(5) The average of the results of the testing of samples referred to in sub-section (3) and of the further testing under sub-section (4) shall be conclusive proof of the number, quantity, measure, gauge or weight of the goods.

CHAPTER X

OFFENCES AND PUNISHMENTS

71. Meaning of applying trade marks and trade descriptions.

(1) A person shall be deemed to apply a trade mark or mark or trade description to goods or services if he -

(a) applies it to the goods or services;

(b) applies it to any package in which the goods or services are sold, or exposed for sale, or kept in possession for the purposes of sale, trade or manufacture;

(c) places, encloses or attaches any goods or services which are sold, or exposed for sale, or kept in possession for sale or for the purpose of trade in or with any package to which a trade mark or mark or trade description has been applied;

(d) uses a trade mark or mark for any goods or services in a manner from which it reasonably transpires that the goods or services for which it is used are identified or described by that trade mark or mark or trade description; or

(e) uses for any goods or services a trade mark or trade description in any sign, advertisement, invoice, catalogue, business letter, business paper, price list or any other commercial document, and goods or services are transferred to another person on the basis of a request or order by reference to the trade mark or trade description used as aforesaid.

(2) A trade mark or mark or trade description shall be deemed to have been applied to goods or services if it is woven in, impressed on, or otherwise added to, or annexed or affixed to it.

72. Falsifying and falsely applying trade marks. (1) A person shall be deemed to falsify a trade mark who, without the consent of the proprietor of the trade mark -

- (a) makes that trademark or a deceptively similar mark; or
- (b) copies or counterfeits any genuine trade mark, whether by alteration, addition, effacement or otherwise.

(2) A person shall be deemed to falsely apply a trademark who, without the consent of the proprietor of the trademark-

- (a) applies a mark, which is identical or deceptively similar to the proprietor's trademark, to goods or services or any package of goods; or
- (b) uses any cover or package bearing a mark which is identical with or deceptively similar to the trade mark of the proprietor, for the purpose of binding, filling or wrapping therein any goods.

(3) Any trade mark falsified as mentioned in sub-section (1) or falsely applied trade mark as mentioned in sub-section (2) is in this Act referred to as a false trade mark.

(4) In any prosecution for falsifying a trade mark or falsely applying a trademark to goods or services, the burden of proving the consent of the proprietor shall lie on the accused.

73. Penalty for applying false trade marks, trade descriptions, etc. If any person-

- (a) falsifies any trade mark,
- (b) falsely applies any trade mark to goods or services,
- (c) makes, hands over, or keeps in his possession, or uses any die, block, machine, plate or other instrument for the purpose of falsifying a trade mark,
- (d) applies any false trade description to goods or services,
- (e) applies false identity, name and address to any goods instead of the identity of the country or place in which they were made or produced or the name and address of the manufacturer or the person for whom the goods were manufactured as required under section 108,
- (f) effaces, alters or erases a correct mark or indication regarding production of any goods as required under section 108, or
- (g) causes or organizes any of the activities described in Clauses (a) to (f),

then, subject to the provisions of this Act, he shall be punishable with imprisonment for a maximum term of 2 (two) years but not less than 6 (six) months, or a maximum fine of 2 (two) lakhs but not less than 50 (fifty) thousand taka, or both; and if he is convicted a second time or next time for the same offence, imprisonment for a maximum term of three years but not less than 1 (one) year or a maximum fine of 3 (three) lakhs but not less than taka 1 (one) lakh, or both.

74. Penalty for selling goods with false trade mark or false trade description. Any person who, in contravention of the provisions of section 108, does not use the name of the institution, country or place of manufacture of the goods or keeps on display any goods or substance for sale, or keeps in possession for trade or production, then he shall be punishable with imprisonment for a maximum term of 2 (two) years but not less than 6 (six) months, or a maximum fine of 2 (two) lakhs but not less than 50 (fifty) thousand taka, or both; and if he is convicted a second time or next time for the same offence, imprisonment for a maximum term of three years but not less than 1 (one) year, or a maximum fine of 3 (three) lakhs but not less than taka 1 (one) lakh, or both; unless he proves -

(a) that he took all reasonable precautions against committing an offence under this section and there was no reason to suspect the genuineness of the trade mark or trade description;

(b) that on demand by the complainant, he gave all the information he knew about the person from whom he obtained such goods or things; or

(c) that otherwise he had acted in good faith.

75. Penalty for removing piece goods. If any person removes or assists in removing or attempts to remove from any premises referred to in section 68 or sells, displays for sale or keeps in his possession for trade or manufacture piece goods or cotton yarn or thread which is not marked as required by that section, then every such piece and every such bundle of yarn and all such thread or cotton and everything used for the packing thereof shall be forfeited by Government and such person shall be punishable with fine not exceeding 5 (five) thousand taka.

76. Penalty for representing an unregistered trade mark as registered

(1) If any person –

(a) represents an unregistered trade mark as a registered trademark;

(b) represents part of a registered trade mark as separately registered as a trade mark although it is not so registered;

(c) represents that a trade mark is registered for any goods or services although it is not in fact so registered; or

(d) gives the false notion that registration of a trade mark gives an exclusive right to use thereof in any circumstances although it is registered with limitations;

then, he shall be punishable with imprisonment for a maximum term of 1 (one) year but not less than 6 (six) months, or a maximum fine of 1 (one) lakh taka but not less than 50 (fifty) thousand taka, or both;

(2) For the purposes of this section, the use in Bangladesh in relation to a trade mark of the word "registered", or of any other expression referring directly or indirectly to that word, shall be deemed to import a reference to registration in the register, except-

(a) where that word or any other expression or indication of that word is used to refer to registration of trade mark under the law relating to trade marks registration of a country outside Bangladesh; or

(b) where the above word or other expression thereof indicates that the reference is to the registration mentioned in clause (a); or

(c) where that word is registered as a trade mark under the law of a country outside Bangladesh and is used for goods or services exportable to that country.

77. Penalty for untruly describing a place of business as connected with the Trade Marks Office. If any person uses in his place of business, or on any document issued by him, or otherwise, words which reasonably lead to the belief that his place of business is connected with the Trade Marks Registry, he shall be punishable with imprisonment for a maximum term of one year but not less than 6 (six) months, or a maximum fine of 1 (one) lakh taka but not less than 50 (fifty) thousand taka, or both.

78. Penalty for false entries in Register. - If any person makes, or causes to be made, a false entry in the Register, or writes or causes to write something false purporting to show it as a copy of an entry in the Register, or produces or causes to produce any such writing or entry in evidence, knowing the same to be false, he shall be punishable with imprisonment for a term which may extend to one year but not less than (six) months or a maximum fine of 1 (one) lakh taka but not less than 50 (fifty) thousand taka or both.

79. Forfeiture of goods. (1) Where a person is convicted of an offence under section 73 or section 74, or is acquitted of an offence under section 73 on proof that he acted without intent to defraud, or is acquitted under section 74 on proof of the matters specified in clauses (a), (b) and (c) of that section, then the relevant court may order the forfeiture, to Government, of all goods and things in relation to which the offence has been committed.

(2) An appeal shall lie against an order for forfeiture of any goods or substance.

(3) When a forfeiture is ordered on acquittal and the goods or substance to which the order relates are of value exceeding 5 (five) thousand taka, an appeal against the forfeiture may be preferred within thirty days from the date of the order.

(4) When a forfeiture is directed on a conviction, the relevant court may order any forfeited articles to be destroyed or otherwise disposed of.

80. Involuntary infringement of provisions relating to mark and trade description. If a person accused of any offence under section 73, can prove that –

(a) in the ordinary course of his professional work, being employed by some other person, he used the trade marks or trade descriptions on behalf of his employer or made moulds, blocks, machines, plates, or other instruments for making, or being used in making, trade marks;

(b) he was associated with the subject matter of the charge only as an employee and did not have any interest in the goods or services or any profit or commission earned on the sale of such goods or services;

(c) he took all reasonable precautions against committing the offence;

(d) 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

(e) he informed the prosecutor of all the information he knew about the user of the trade mark or trade description,

then, the court may acquit the above person from the above charges.

81. Procedure for pleading invalidity of registration in defence of the accused. - (1) Where an accused charged with an offence under section 73 or section 74 pleads in his defence that the registration of the trade mark is invalid, the following procedure shall be followed:-

(a) If the court is satisfied that such defence is prima facie tenable, it may, without proceeding with the charge, adjourn the proceeding for three months from the date on which the plea of the accused is recorded to enable the accused to file an application before the High Court Division under this Act, for the rectification of the Register.

(b) If the accused can prove to the court that he has made such application within the specified time or within such time as the court has prescribed, then the court may stay the further proceedings till the disposal of the application for rectification of Register, or if an appeal has been preferred, until the disposal of the appeal.

(c) If within a period of 3 (three) months or within such extended time as may be allowed by the court the accused fails to apply to the High Court Division for

rectification of the Register, the court shall proceed with the case as if the registration was valid.

(2) Where before the institution of a complaint of an offence under section 73 or 74, any application for the rectification of the Register on the ground of invalidity of the registration of the trade mark has already been made to and is pending before the tribunal, the court may stay the further proceedings in the prosecution till disposal of the application aforesaid and shall determine the charge against the accused in conformity with the result of the application for rectification.

82. Offences committed by companies. (1) If the person responsible for the running of the company, commits an offence under this Act in course of running the business of the company, then the above offence shall be deemed to have been committed by the company and legal proceedings may be initiated against the persons responsible for the running of the company and they may be punished accordingly.

(2) Notwithstanding anything contained in sub-section (1), a person responsible for the running of the company shall not be liable to any punishment if he proves that the offence was committed without his knowledge and that he exercised all due diligence to prevent the commission of such offence.

(3) Notwithstanding anything contained in sub-section (1), where an offence under this Act has been committed by a company and it is proved that the offence has been committed with direct or indirect consent of, or due to any neglect on the part of, any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation: For the purpose of this section-

(a) "company" means and includes any body corporate, commercial establishment and association or organisation; and

(b) "director", in relation to a firm, means a partner in the firm.

83. Cognizance of certain offences. - (1) No court shall take cognizance of an offence under section 76, 77 or 78 except on complaint in writing made by the Registrar or any officer authorised by him.

(2) No court other than the Metropolitan Magistrate or Magistrate of the first class shall try an offence under this Act.

(3) Notwithstanding anything contained in the Code of Criminal Procedure, 1898 (Act V of 1898), when imposing any fine on any person under this Act, the Metropolitan Magistrate or Magistrate of the first class shall have the power to impose the fine mentioned in this Act.

84. Evidence of origin of goods imported by sea. - In the case of goods brought into Bangladesh by sea or where a complaint is lodged for an offence committed under section 15 of the Customs Act, 1969 (Act IV of 1969) in respect of such goods, shipment documents provided by the port of shipment shall be admitted as prima facie evidence of the country or place in which the goods were produced.

85. Costs of the case. (1) In any prosecution under this Act, the court may order such costs to be paid by the accused to the complainant, or by the complainant to the accused, as the court deems reasonable having regard to the circumstances of the case and the conduct of the parties.

(2) The above costs shall be recoverable as if they were a fine recoverable under section 380 of the Code of Criminal Procedure, 1898 (Act V of 1898).

86. Limitation of prosecution. No case may be lodged for an offence under this Act, if the complaint is not made within 3 (three) years after the commission of the offence charged, or two years after the discovery of the information relating to the case by the complainant, whichever shall first-happen.

87. Information as to commission of offence. - An officer of the Government entrusted with the responsibility of enforcement of the provisions of this Act shall not be compelled by the court to say whence he got any information as to the commission of any offence under this Act.

88. Punishment for abetment of acts done out of Bangladesh. If any person, being within Bangladesh, abets the commission, outside Bangladesh, of any act which, if committed in Bangladesh, would, under this Act, be deemed to be an offence, he may be tried for such abetment in any place in Bangladesh where he may be found, and be sentenced to the punishment to which he would be liable for that offence.

89. Power of the Government to give direction. (1) The Government may, by notification in the Official Gazette, issue necessary directions for the purpose of bringing into effect any provision of this Act by the Criminal Court.

(2) The direction issued under sub-section (1) may include, amongst others, the limits of variation as regards the number, quantity, length, gauge and weight recognised by criminal courts in respect of any goods or services.

CHAPTER XI

MISCELLANEOUS

90. Implied warranty on sale of marked goods. If –

(a) a trade mark or mark or trade description is used to any goods or services for sale or in the contract for sale of any goods or services, and

(b) nothing contrary in writing is expressed at the time of sale or execution of the contract for sale by the seller or any person acting on his behalf,

then, the seller shall be deemed to warrant that the mark is a genuine mark and not a false one, or that the trade description is not a false trade description as defined in section 2(8).

Explanation – For the purposes of this section, “false trademark” means a trademark having no authority –

(a) which –

- (i) is used in case of goods, package or service,
- (ii) is similar to a validly registered trademark used for any goods or services, or
- (iii) cannot be separated from the very necessary characteristic shape of the registered trademark; and

(b) which violates the rights of the proprietor of the trademark under this Act.

91. Procedure and powers of Registrar. (1) In all proceedings under this Act, the Registrar shall have the powers of a civil court for the purposes of taking evidence, administering oaths, enforcing the attendance of witnesses, compelling the discovery and production of documents and issuing commissions for the examination of witnesses.

(2) In all proceedings under this Act before the Registrar, evidences shall be given by affidavit, but if the Registrar thinks fit, instead of taking evidence by affidavit or in addition to the evidence admitted, accept oral evidence.

(3) Subject to the provisions of section 93, the Registrar shall not exercise the powers conferred by this Act and Rules thereunder without giving the parties an opportunity of being heard, and in appropriate cases, give notice in writing within the prescribed period.

(4) Unless there is anything contrary in this Act or in the Rules expressly and clearly stated, the Registrar may make such order as he thinks reasonable and such order shall be effective as a decree of the civil court.

(5) If it transpires to the Registrar that while giving orders in a proceedings under this section, some new and important matters in respect of the evidences have been revealed or there has been some fault in proofs and the evidences, then, the Registrar may, in the prescribed manner review his own decision on the basis of an application filed or on his own motion.

92. Death of a party to the proceeding. If a party to a proceeding under this Act dies pending the proceeding, the Registrar may, on the application of any concerned party, and on being satisfied as to the transmission of the interest of the deceased person to someone else, substitute his successor in interest in his place, or, if the Registrar is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceeding to continue without the substitution of his successor in interest.

93. Extension of time. (1) If the Registrar is satisfied, on application made to him by any party in the prescribed manner, that there is sufficient cause for extending the time for the disposal of the proceedings, he may, subject to costs or any such conditions as he may think fit to impose, extend the time and if the time is extended, the relevant party or parties must be notified.

Provided that, if there is any time prescribed in this Act or Rules for the disposal of the proceedings, that time shall not be extended.

(2) Notwithstanding anything contained in sub-section (1), the Registrar may review his decision on the application in the prescribed manner of any aggrieved party.

(3) No appeal shall lie from any order of the Registrar under this section.

94. Rejection of application. If there is any fault in an application filed under this section, the Registrar may direct the applicant to remedy the default within a time specified and if even after the direction, such default is not remedied within the above time, the Registrar may give an order to reject the application.

95. Procedure for governing the proceedings by the Government. - In all proceedings under this Act before the Government, evidence shall be given by affidavit; however, if the Government thinks fit, it can take oral evidence in lieu of, or in addition to, evidence by affidavit.

96. Filing of case in the District Court for matters relating to infringement. - In the following cases, no case shall be instituted in any court inferior to a District Court -

- (a) infringement of any registered trade mark;
- (b) any right relating to a registered trade mark;
- (c) any amended right of a registered trademark; and
- (d) passing off a similar or deceptively similar trade mark, as a registered or unregistered trademark.

97. Relief in suits for infringement of trademark etc. (1) In a suit for infringement or passing off referred to in section 96, a court may grant injunction as relief and at the option of the plaintiff, give an order for payment of either damages or part of profits, and such order shall also include order for destruction or erasing or removal or non-removal of the labels and marks used for infringements.

(2) Notwithstanding anything contained in sub-section (1), the court shall not order payment of damages or part of profits in the following cases -

(a) where the infringement complained of is in relation to a certification trade mark; or

(b) where in a suit for infringement of trademark, the defendant satisfies the court to the effect that -

(i) at the time he commenced to use the trade mark complained of in the suit, he was unaware or had no reasonable ground for believing that the trade mark of the plaintiff was included in the register or that the plaintiff was a registered user; or

(ii) when he became aware of the existence and nature of the plaintiff's right in the trade mark, he forthwith ceased to use the trade mark;

(c) where in a suit for passing off, the defendant satisfies the court to the effect that -

(i) at the time he commenced to use the trade mark complained of in the suit he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was in use; and

(ii) when he became aware of the existence and nature of the plaintiff's trade mark he forthwith ceased to use the trade mark complained of.

98. Filing of application for rectification of register in the High Court Division in certain cases. (1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where the validity of the registration of the defendant's trade mark is questioned by the plaintiff, then the issue as to the validity of the registration of the trade mark concerned shall be determined on an application for the rectification of the register.

(2) Notwithstanding anything contained in section 42, 43(4) or 51, every application under sub-section (1) shall be filed in the High Court Division.

(3) Subject to the provisions of sub-section (1) and (2), where an application for rectification of the register is made to the Registrar under section 42, 43(4) or 51, the Registrar may refer the application to the High Court Division.

99. Procedure for filing of application for rectification of register in the High Court Division. (1) The application for rectification of register has to be made in the prescribed form, with the relevant descriptions, in the High Court Division.

(2) Subject to the provisions of this Act and Rules, the provisions of the Civil Procedure Code shall be applicable to the application filed in the High Court Division under this section and any appeal therefrom.

(3) The certified copy of the order of the High Court Division or Appellate Division in respect of the registered trademark under this section shall be sent to the Registrar, and the Registrar shall execute the above order by making amendment of any entry in the register.

100. Appeal. – (1) No appeal shall lie against any decision, order or direction given by the Government under this Act and any work done or order given by the Registrar in order to give effect to the said decision, order or direction.

(2) Save as otherwise expressly provided in sub-section (1) or this Act, an appeal shall lie, within the prescribed period, from any decision or order of the Registrar under this Act or the rules made thereunder to the High Court Division.

(3) The above appeal shall be filed in the prescribed procedure,

(4) For disposal of an appeal under this section, the High Court Division can give the same orders as the Registrar could give.

(5) In an appeal under section 14, 15 or 18 by an applicant against a decision of the Registrar in relation to registration, it shall not be open, save with the express permission of the Court, to the Registrar or any party opposing the appeal to advance grounds other than those recorded in the said decision or advanced by the party in the proceedings before the Registrar, as the case may be; and where any such additional grounds are advanced, the applicant for registration may, on giving notice in the prescribed manner, withdraw his application for registration without being liable to pay any costs to any party.

(6) Subject to the provisions of this Act and the Rules made thereunder, the provisions of the Code of Civil Procedure, 1908, shall apply to appeals before the High Court Division under this Act.

Explanation – “Order” or “decision” of the Registrar under sub-section (2) means such order or decision which conclusively determines the rights of the parties.

101. Power of the High Court Division to make rules. - The High Court Division may make rules consistent with this Act as to the conduct and procedure of proceedings under this Act.

102. Stay of proceedings where the validity of trademark or registration is questioned. (1) Where in any suit for infringement of a trade mark the defendant pleads that registration of the plaintiff's trade mark is invalid, or the plaintiff pleads the invalidity of registration of the defendant's trade mark, then the court trying the suit, hereinafter referred to as the above court –

(a) may stay the suit pending the final disposal of any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark pending before the High Court Division or the Registrar;

(b) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiffs or defendant's trade mark is prima facie tenable, then the above Court will frame issues regarding the same and adjourn the case for a period of 3 (three) months from the date of the framing of the issue in order to enable the party concerned to apply to the High Court Division for rectification of the register.

(2) If the party concerned can prove to the court that he has made the application referred to in sub-section (1)(b) within the time specified therein or within such extended time as the court might allow, the above court may stay the trial of the suit until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the prescribed time, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the above court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings under subsection (1) or (2) shall be binding upon the parties and the above court shall dispose of the suit conformably to such order.

(5) In any suit for infringement of trade mark under this Act the Court shall not be precluded from making any order of stay, granting an injunction, directing account to be kept, appointing a receiver or attaching any property.

103. Right of the Registrar to appear in legal proceedings. (1) The Registrar shall have the right to appear in court and be heard in legal proceedings claiming reliefs including alteration or rectification of the register or in proceedings relating to registration of trademark.

(2) In any appeal to the High Court Division from an order of the Registrar on an application for registration of a trade mark, the Registrar shall have the right to appear in court and be heard in the following cases-

(a) where the appeal is not opposed, and the application is either refused or accepted by the Registrar subject to any amendments, modifications, conditions or limitations, and

(b) where the appeal has been opposed and the Registrar considers that his appearance is necessary in the public interest.

(3) Unless the High Court Division otherwise directs, the Registrar may, in lieu of appearing before the Court, submit thereto a statement containing specific information relating to the matters in issue which he came to know as the Registrar or the grounds of any decision given by him on the issues or the practice of registration of trade marks or information about other matters relevant to the issues and within his knowledge as Registrar which shall be admitted in evidence in the proceeding.

104. Cost to Registrar in proceedings before the High Court Division - The High Court Division shall have the authority to determine the cost expended by the Registrar in conducting the proceeding under this Act before the High Court Division, but the Registrar shall not be ordered to pay the cost to any party to the proceeding.

105. Joining registered user as party to the case - (1) The registered user of a trade mark, if not joined as a party to any case or appeal under chapter VII or section 100 of this Act, shall be made a party to the case or appeal.

(2) Notwithstanding anything contained in any other law for the time being in force, if a registered user is made a party to the case or appeal under subsection (1), he shall not be bound to pay costs of the case, if he enters appearance or participates in the said case or appeal.

106. Entries in Register and action of Registrar to be admitted in evidence - (1) Printed or written copy of any entry in the register of registration mentioned in Section 116(1) or in any document, attested by the Registrar and sealed by the Trade Marks Registry, shall be admitted in evidence in all cases or proceedings filed or accepted under this Act.

(2) Any entry or matter certified by the Registrar in exercise of his powers under this Act or the rules shall be conclusive evidence of the matter included therein.

107. Registrar and other officers not obliged to submit Register of Registration – The Registrar or any other officer of the Trade Marks Registry shall not be compelled to submit the Register of Registration or any other document in his custody the subject matter of which can be proved by certified copy issued under this Act in any case or proceeding where he is not a party or unless ordered by the Court for any special reason he cannot be compelled to appear as a witness to prove the subject matter of the document.

108. Power to direct submission of necessary information to prove the original place of production of goods or services- (1) The government may by notification published in the official gazette, issue directions to the following effect :-

- (a) direction about the goods or services manufactured or produced outside Bangladesh which are supplied or imported into Bangladesh;
- (b) direction about the goods or services manufactured or produced in Bangladesh; or
- (c) direction about the name of the Country or place of the manufacturer or producer or supplier of goods or services or of those for whom the goods or services were manufactured or produced;

and the above direction is to be used on the goods or services on the date prescribed by the notification which date shall not be less than three months from the issue date of the notification.

(2) The above notification may specify the manner, time, and occasion of the use of the directions mentioned in sub-section (1) and matters relating to its necessity.

(3) No notification shall be issued under this section in the following cases if-

- (a) no application is made by persons or association representing the interests of trader, manufacturer, producer, supplier or user; or
- (b) in some other way the Government becomes sanguine to this effect that no such notification is necessary in public interest.

(4) No notification shall be issued under this section without following the provisions of section 23 of the General Clauses Act, 1987 (Act X of 1897)

(5) No notification under this section shall be applicable to the goods or services manufactured or produced outside Bangladesh or imported into Bangladesh, if the Customs Commissioner having jurisdiction over the port of entry of those goods or services into Bangladesh becomes certain at the time of export that the said goods or services are earmarked for export by reshipment after clearance in Bangladesh or by transportation through Bangladesh.

109. Power to call for information regarding goods imported with false trademarks -

(1) Where under clauses (d), (e) and (f) of section 15 of the Customs Act, 1969 (Act IV of 1969) the re-import of any goods into Bangladesh is prohibited and the goods are liable to be seized and confiscated, the Customs Commissioner having jurisdiction over the port of entry of those goods into Bangladesh may direct the importer or his representative to submit the documents and the names and addresses of the sender and the receiver of the goods when he has reasonable grounds to believe, upon receiving an application from any person, that the said trade mark has been used as a false trade mark.

(2) The importer or his representative shall be liable to a fine not exceeding Taka 5000 (Taka Five Thousand) if he fails to comply with the Commissioner's order under subsection (1) within 14 (fourteen) days of receipt thereof.

(3) The Customs Commissioner may inform the proprietor of the registered trade mark or its registered user of the information relating to use of false trade mark received from the importer or his representative

110. Validity Certificate - Where a question as to the validity of the registration of trade mark arises and the question is decided in favour of the proprietor of the trade mark, the tribunal could issue a certificate in favour of the proprietor, and on such certificate being issued the proprietor shall be entitled to the cost of the lawyer and other costs in any subsequent proceeding decided in favour of the proprietor.

111. Address for serving notice - The address mentioned in the application or notice of opposition shall be deemed to be address of the applicant or the opponent, and all documents relating to the application or opposition thereof could be served by sending it personally or by registered post to the address of the applicant or the opponent.

112. Consideration of trade customs, etc. - In any case or other proceeding related to trade mark, the tribunal may admit in evidence the prevailing customs of the relevant trade and any relevant trade mark or outfit legally used by other persons.

113. Agent - When a person is to perform any act other than swearing an affidavit under this Act, the same could be done instead by another person authorized by that person, subject to the rules made in this behalf, and such authorized person could be a lawyer, or a person registered in the prescribed manner as a trade mark representative or a regular employee of the registered proprietor.

114. Documents disqualified for registration- Notwithstanding anything contained in the Registration Act, 1908 (Act 16 of 1908), no document declaring the proprietorship of any person over any trade mark other than a registered trade mark shall be registered under this Act.

115. Index - An index of the following matters shall be maintained at the direction and under the supervision of the Registrar:-

- (a) registered trade mark
- (b) pending applications for registration of trade marks;
- (c) the names of the proprietors of registered trade marks; and
- (d) the names of the registered users.

116. Documents open to public inspection - (1) In the absence of anything to the contrary in Section 45(6) the following documents shall be open to public inspection subject to the prescribed conditions-

- (a) Register of registration and the basis of every entry therein;

(b) Every notice of opposition to registration of trade mark, amendment application submitted to the Registrar, any counter statement thereto, and any affidavit or any other document filed by the parties to any proceeding before the Registrar;

(c) All Regulations filed under Section 61 and any application for amendment thereto filed under Section 65;

(d) Index mentioned in Section 115;

(e) Any other document prescribed by the Government by notification in the official gazette.

(2) On an application made to the Registrar in the prescribed manner and on payment of prescribed fee any person may get certified copy of any entry in the Register, or any document mentioned in sub-section(1)

117. Fees - (1) The Government may realize in the prescribed manner fees for any application, registration and other matters under this Act.

(2) When any fee is payable for any function by the Registrar, he shall not do the task before payment of such fee.

(3) If any fee is payable for filing any document in the Trade Marks Registry, that document shall be deemed not filed until payment of the fee.

118. Indemnity, etc - (1) Notwithstanding anything contained in this Act, if an employee of a resident Bangladeshi in compliance with his employer's order and in good faith does any work, and gives any information about his employer or his orders as demanded by the plaintiff or the person acting on his behalf, he shall not be punished in any case or proceeding.

(2) This Act shall not grant to any person indemnity from any case or proceeding which could be instituted against him had this Act not been passed.

(3) Nothing in this Act shall grant any right to any person to refrain from answering any question relating to any fact finding investigation, case or other proceeding but such information or answer shall not be used as evidence against that person in any proceeding under chapter (X) of this Act or under clauses (d), (e), and (f) of section 15 of the Customs Act, 1969 (Act IV of 1969).

119. Special Provision for Convention Countries - When a member-country of the Paris Convention or the World Trade Organisation extends the same facilities to a Bangladeshi citizen as are available to its own citizens with regard to registration and protection of trade marks, then for the purpose of implementation of the Agreement, Convention or Memorandum of Understanding that state shall be deemed a Convention State.

120. Special Provision for Convention Application - (1) If an applicant for registration of trade mark in a member-country of the Paris Convention or the World Trade Organisation or his legal representative, within six months of the application, applies for the registration of that trade mark in Bangladesh submitting therewith the full description and certified copy of the preferential application and if that trade mark is registered under this Act, then such registration shall be deemed to take effect from the date of application in the Convention State.

(2) If applications are made for registration of trade mark in two or more Convention States, then the six month period mentioned in sub-section (1) shall be counted from the date of the first application.

(3) Notwithstanding anything contained in this Act, no proprietor of trade mark shall be entitled to claim compensation for violation of his right before filing an application for registration under this Act.

121. Relationship between Convention Countries - If a state regarded under Section 119 as a Convention State does not grant to Bangladesh citizens the same facilities regarding trade mark registration and protection as are granted to its citizens, then no citizen of that state shall individually or collectively with any Bangladesh citizen be entitled -

- (a) to apply for registration in the register of any trade mark or to be registered proprietor of any trade mark;
- (b) to be the legal representative of the proprietor of any registered trade mark; or
- (c) to apply for registration or to be registered user of a trade mark.

122. Provision relating to classification mark- In the absence of contrary provisions in this Act or any other law for the time being in force, the provisions of this Act shall, as far as possible, apply to classification marks.

123. Application and use of Information and Communication Technology- (1) All notices, advertisements, orders, directions and other matters required to be issued under this Act may be published in electronic gazette, and the documents that are required to be open for public inspection under section 116 may be kept open under electronic operation system, and the Registrar, with prior approval of the Government, may take necessary steps for introducing electronic operation system.

(2) The Government will prescribe the principles and rules relating to electronic gazette and electronic operation system.

Explanation- For the purposes of this section “electronic operation system” means processing data/information online to website.

124. Framing Rules. – (1) The Government may, by notification published in the official gazette, make rules for carrying out the purposes of this Act.

(2) Without prejudice to the generality of subsection (1), the said rules may particularly provide for the following matters –

- (a) to prescribe classification of goods or services in accordance with international classification for the purpose of registration of trade mark, and to authorize amendment of the register of registration keeping consistency with the said classification;
- (b) to direct preparation of copies of trade mark and other documents in relation thereto;
- (c) to control and secure the publication, sale or distribution of copies of trade mark and other related documents;
- (d) to arrange for amendment of entries in the register of registration;
- (e) to prescribe necessary conditions and restrictions on inspection of the register of registration;
- (f) to prescribe the form of Certificate of Registration;
- (g) to provide for refusing or not accepting the application made under section 44 (1);
- (h) to prescribe for the additional documents, information and evidence to be attached with the application under section 45 (1);
- (i) to determine the classification of textile goods to carry out the purpose of Section 66;
- (j) to control matters relating to cost prescribed by the Registrar under Section 91;
- (k) to determine the conditions under which the representative mentioned in Section 113 can work;
- (l) to proscribe all kinds of fees payable under this Act;
- (m) establishing the branch offices of the Trade Marks Registry and making copies of the register of registration maintained in the branch;
- (n) prescribing rules relating to issuance of notice about filing application, giving notice and other matters in proceedings instituted before the Government or the Registrar under this Act;
- (o) determining prescribed time or duration under this Act;
- (p) controlling the functions of the Trade Marks Registry and its branch offices, and the powers conferred on the Government and the Registrar under this Act;
- (q) rules relating to selection of samples for carrying out the purpose of Section 70;
- (r) procedures for making cotton yarn and cotton thread and for exempting some factories and premises from the provisions of the said section;
- (s) rules relating to classification of goods which are sold generally by measure of length or by piece, for carrying out the purpose of section 69;
- (t) rules relating to use of mass communication and information technology, for carrying out the purpose of section 123; and
- (u) rules relating to other necessary matters.

125. Trade Marks Report to Parliament. – The Government shall arrange to place before the Parliament every year before 31st March a report made up to 31st December of last year about the activities relating to trade marks.

126. Publication of Authentic English Text. – After the commencement of this Act, the Government shall, by notification in the official gazette, publish an English version of this Act, which shall be called the Authentic English Text of this Act.

Provided that in the event of conflict between the Bangla version of the Act and the Authentic English Text, the Bangla Version shall prevail.

127. Repeal and savings. – (1) The Merchandise Marks Act, 1889 (Act IV of 1889) and the Trade Marks Act, 1940 (Act V of 1940) hereinafter called “the repealed Acts”, are thereby repealed.

(2) Notwithstanding the repeal aforesaid any activity done, or rules framed, or any other order, notice, advertisement, or notification issued, or any pending application for registration of trade mark, or approved registration, or any measure or proceeding taken or commenced under the repealed Acts, shall, subject to being consistent with the provisions of this Act, and until repealed or amended, remain in force, and shall be deemed to have been taken, framed or issued or registration, proceedings or applications approved, accepted or commenced under the relevant provisions of this Act.

128. Special provisions for savings. – (1) Anything done or any measure taken under the Trade Marks Ordinance, 2008 (Ordinance No. 2 of 2008) and the Trade Marks Ordinance, 2009 (Ordinance No. 5 of 2009), hereinafter called “the said two Ordinances” shall be deemed to have been done or taken under this Act.

(2) Notwithstanding the expiry of the effectiveness of the said two Ordinances in accordance with the provisions of Article 93 (2) of the Constitution of the People’s Republic of Bangladesh, anything done or any measure taken in continuation or constructive continuation of the said two Ordinances, shall also be deemed to have been done or taken under this Act.