

People's Republic of Bangladesh
Trademarks Act, 2009

Act No. XIX of 2009 as amended in 24 March, 2009

TABLE OF CONTENTS

CHAPTER I PRELIMINARY

1. Short title and commencement.
2. Definitions.

CHAPTER II REGISTRAR, PATENT, DESIGN AND TRADEMARKS, TRADEMARKS REGISTRY AND CONDITIONS OF REGISTRATION

3. Registrar of Trademarks, Trademarks Registry, etc.
4. The Register of Trademarks.
5. Registration of certain class of goods or services.
6. Requisites for registration in the Register.
7. Limitation as to using colour.
8. Prohibition of registration of certain matters.
9. Prohibition of names of chemical materials.
10. Prohibition of registration of identical or deceptively similar trademark.
11. Use of names of living persons or dead persons.
12. Registration of parts of trademarks and of trademarks as a series.
13. Registration of trademarks as associated trademarks.
14. Registration of trademarks subject to disclaimer.

CHAPTER III PROCEDURE FOR, AND DURATION OR REGISTRATION

15. Application for registration.
16. Withdrawal of acceptance.
17. Advertisement of application.
18. Opposition to registration.
19. Correction.
20. Registration.
21. Jointly owned trademarks.
22. Duration, renewal and restoration of registration.
23. Effect of removal from registration for failure to pay fee for renewal.

CHAPTER IV EFFECT OF REGISTRATION

24. No action for infringement of unregistered trademark.
25. Rights conferred by registration.
26. Infringement of trademarks.
27. Acts not constituting infringement.
28. Registration to be prima facie evidence of validity.
29. Registration to be conclusive as to validity after a certain period.
30. Saving for vested rights
31. Savings for use of name, address, or description of goods or services.
32. Savings for words as name or description of an article or substance or services.

CHAPTER V ASSIGNMENT & TRANSMISSION

33. Power of registered proprietor to assign and give receipts
34. Assignability and transmissibility of registered trademarks
35. Assignability and transmissibility of unregistered trademarks
36. Restrictions on assignment or transmission where multiple exclusive rights would be created.
37. Restrictions on assignment or transmission when exclusive rights would be created in different parts of Bangladesh.
38. Conditions for assignment otherwise than in connection with the goodwill of a business.
39. Conditions for assignment and transmission of certification trademarks and associated trademarks.
40. Registration of assignments and transmissions.

CHAPTER VI USE OF TRADEMARKS AND REGISTERED USERS

41. Use of proposed trademarks by company to be formed.
42. Removal from Register and imposition of limitations on ground of non-use.
43. Defensive registration of well-known trademarks.
44. Registered Users.
45. Application for registration as registered user, etc.
46. Power of registered user to take proceedings against infringement.
47. Power of registered to vary or cancel of registration as registered user.
48. Registered user not to have right of assignment or transmission.
49. Use of one of associated or substantially identical trademarks

equivalent to use of another.

50. Use of trademark for export trade and use when form of trade connection changes

CHAPTER VII RECTIFICATION AND CORRECTION OF THE REGISTER, ETC.

51. Power to cancel or vary registration or to rectify the Register.

52. Correction of the Register.

53. Alteration of registered trademark.

54. Adaptation of entries in Register to amended or substituted classification of goods or services.

CHAPTER VIII CERTIFICATION TRADEMARKS

55. Certain provisions of the Act made inapplicable to certification trademarks.

56. Registration of certification trademarks.

57. Determination whether a mark is a certification trademarks.

58. Application for registration of certification trademark.

59. Consideration of application for registration by Government.

60. Opposition to registration of certification trademarks.

61. Deposit of regulations governing the use of a certification trademark.

62. Right conferred by registration of certification trademark.

63. Infringement of certification trademark.

64. Acts not constituting infringement of certification trademarks.

65. Cancellation or varying registration.

CHAPTER IX SPECIAL PROVISION FOR TEXTILE GOODS.

66. Textile Goods.

67. Restriction on registration of textile goods.

68. Stamping of length of piece goods, cotton yarn and thread

69. Declaration as piece goods.

70. Determination of Character of textile goods by sampling

CHAPTER X OFFENCES, PENALTIES AND PROCEDURE

71. Meaning of applying trademarks and trade descriptions.

72. Falsifying and falsely applying trademarks.

73. Penalty for applying false trademarks and false trade description, etc.

74. Penalty for selling goods to which a false trademark or trade description is applied.
75. Penalty for removal or piece-goods, etc.
76. Penalty for falsely representing a trademark as registered.
77. Penalty of improperly describing a place of business as connected with the Trademarks office.
78. Penalty for falsification of entries in the Register.
79. Forfeiture of goods.
80. Unintentional contravention of the law relating to marks and description.
81. Procedure where invalidity of registration is pleaded as a defence by an accused.
82. Offences by companies.
83. Cognizance of certain offences
84. Evidence of origin of goods imported by sea
85. Costs of defence or prosecution.
86. Limitation of prosecution.
87. Information as to commission of offence.
88. Punishment for Abetment of any offence committed out of Bangladesh.
89. Authority of the Government to issue instruction.

CHAPTER XI MISCELLANEOUS

90. Implied warranty on sale of marked goods.
91. Procedure and powers of Registrar.
92. Death of a party to a proceeding.
93. Extension of time.
94. Abandonment.
95. Procedure before the Government.
96. Suit for infringement, etc., to be instituted before District Court.
97. Relief's in suits for infringement or passing off.
98. Application for rectification of Register to be made to the High Court Division in certain case.
99. Procedure for application for rectification of the Register before the High Court Division.
100. Appeals.
101. Power of the High Court Division to make rules.
102. Stay of proceeding where the validity or registration of the trademark is questioned.
103. Right of appearance of Registrar in legal proceedings.

104. Costs of Registrar in proceedings before High Court Division.
105. Registered user to be impleaded in certain proceeding.
106. Evidence of entries in Register and things done by Registrar.
107. Registrar and other officers cannot be compelled to produce Register.
108. Power to require goods or services to show indication of origin.
109. Power to require information in respect of imported goods bearings false trademarks.
110. Certificate of validity.
111. Address for service of notice.
112. Trade usage, etc. to be taken into consideration.
113. Agent.
114. Documents not to be registered.
115. Indexes.
116. Documents open to public inspection.
117. Fees.
118. Exemption, etc.
119. Special Provision relating to Convention Countries.
120. Special Provision relating to Convention Application.
121. Provision as to reciprocity.
122. Provisions relating to collective marks.
123. Use and application of information and communication technology.
124. To make rules.
125. Reports regarding trade marks to be placed before parliament.
126. Publication of English Text.
127. Repeals and Savings.
128. Special provisions relating to savings.

CHAPTER I PRELIMINARY

1. Short title and commencement.

- (1) This Act may be called the Trademarks Act, 2009.
- (2) It shall be deemed to have come into force on 01 July, 2008.

2. Definitions.

In this Act, unless there is anything repugnant in the subject or context,

- (1) "Priority date" means the date of earlier application that has been accepted in the Paris Convention as the basis of priority of the right of trademarks for goods and services;
- (2) "Permitted use", in relation to a registered trademark, means the use of a trademark by a registered user of the trademark in relation to goods or services complying with any condition or restriction subject to which the trademark is registered;
- (3) "International Classification" means the classification adopted by the World Intellectual Property Organisation or International Classification according to NICE Agreement Concerning the International Classification of Goods and Services for the purposes of the Registration of Marks;
- (4) "District Court" means the Court of the District Judge and also includes the Court of an Additional District Judge or a Joint District Judge;
- (5) "False trade description" means—
 - (a) to use a trade description which is untrue or misleading in a material respect as regards the goods or services to which it is applied;
 - (b) to make such an addition, effacement or alteration to a trade description as regards the goods or services as are untrue or misleading;
 - (c) to indicate in a trade description that the accurate amount of the goods which are contained in the container is more than the amount of the standard yards or standard meters;
 - (d) to apply any marks or arrangement or combination thereof to any item of goods in such manner as to be likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose merchandise or manufacture they really are; or
 - (e) to use any false name or initials of a person to a trade description

of goods or services in such manner as if such name or initials were—

- (i) not a trademark or a part of a trademark; and
- (ii) identical with or deceptively similar to the name or initials of a person carrying on business in connection with goods or services of the same description and who has not authorised the use of such name or initials; and
- (iii) either the name or initials of a fictitious person or of some person not bona fide carrying on business in connection with such goods or services; and any trade description, though it is a trademark or a part of a trademark, shall be considered as 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 other direct or indirect indication as to—

- (a) the number, quantity, measure, gauge or weight of any goods or services; or
- (b) the standard of quality of any goods or services, according to a classification commonly used or recognized in the trade; or
- (c) the strength, performance or qualities of any goods, if it is 'drug' as defined in the Drugs Act, 1940 or "food" as defined in the Pure Food Ordinance, 1959; or
- (d) the place or country in which or the time at which any goods or services were made or produced; or
- (e) the name and address or other indication of the identity of the manufacturer or of the person for whom the goods or services are manufactured; or
- (f) the mode of the manufacture or producing any goods or services; or
- (g) the material of which any goods or services are composed; or
- (h) any existing patent, privilege or copyright relating to any goods or services and includes,—
 - (i) any description as to the use of any mark which according to the custom of the trade is commonly taken to be an indication of any of the matters referred to in clause (a) to (g) as trade description;
 - (ii) the description as to any imported goods contained in a bill of entry or shipping bill;
 - (iii) any other description which is likely to be misunderstood or mistaken for all or any of the said matters;

(8) "trademark" means—

(a) in relation to Chapter X of this Act, other than section 77—

(i) a registered trademark or a mark used in relation to goods for the purpose of indicating a connection in the course of trade between the goods and the person having the right as proprietor to use the mark;

(ii) a mark used in relation to a service so that it may be indicated that the person has the right as proprietor to use the mark in the course of trade;

(b) in relation to the other provisions of this Act, a mark used or proposed to be used in relation to any service or goods indicating a connection in the course of trade between the goods and the person having the right, either as proprietor or as registered user, to use the mark;

(c) certification trademark;

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

(10) "name" includes any abbreviation or initials of a name;

(11) "Registrar" means the Registrar referred to in section 3 of this Act;

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

(13) "Register" means the Register of Trademarks as referred to in section 4 of this Act;

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

(15) "registered trademark" means a trademark included in the Register;

(16) "registered user" means a registered user under section 44 of this Act;

(17) "registered proprietor" means the person whose name is recorded in the Register as proprietor of the trademark;

(18) "goods" means anything which is the subject of trade or manufacture including agricultural products and herbal plants;

(19) "Paris Convention" means the Paris Convention for the Protection of the Industrial Property of March 20, 1883, as last revised;

(20) "deceptively similar mark" means a mark which is likely to deceive or cause confusion and nearly resembles another mark registered under this Act;

(21) "regulation" means regulation relating to the use of trade mark which is registered as certification mark and approved by the Government;

(22) "rules" means the rules made under this Act;

(23) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, symbol, numeral, figurative elements, combination of colours or any combination thereof;

(24) "package" includes any case, box, container, covering, folder, receptacle, casket or bottle, wrapper, label, brand, ticket, reel frame, capsule cap, lid, stopper and cork;

(25) "collective mark" means any visible sign designated as such in the application for registration, which-

(a) is capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different enterprises;

(b) is used by different enterprises under the control of the registered owner of the collective mark; and

(c) is used in respect of goods or services by a group of individuals collectively engaged in the same business as one legal entity;

(26) "Government", in case of certification trademark, means the Secretary of the administrative Ministry or Division of the Trademarks Registry, and, in other cases, the administrative Ministry or Division;

(27) "Associated trademarks" means any trademark which is capable of being or required to be, registered as associated trademarks under this Act;

(28) "Certification trademark" means a mark adapted in relation to any goods or services which distinguishes, in the course of trade, the goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from the goods not so certified

and which is capable of being registered as such under the provisions of chapter VIII of this Act in respect of those goods or services in the name, as proprietor of certification trademark, of that person;

(29) "limitations" means any limitations of the exclusive right to the use of a trademark given by the registration of a person as proprietor thereof, and the limitations, as to the mode of use, shall include the marketing of goods or the sectors of providing services within or outside Bangladesh;

(30) "services" means services rendered for money or money's worth in the course of trade or business, but does not include goods; and

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

**CHAPTER II REGISTRAR, PATENT, DESIGN AND TRADEMARKS, TRADEMARKS
REGISTRY AND CONDITIONS OF REGISTRATION**

3. Registrar of Trademarks, Trademarks Registry, etc.

(1) For the purpose of this Act—

(a) the Trademarks Registry Wing of the Department of Patents, Designs and Trademarks, established under the Patents and Designs Act, 1911 (Act II of 1911) hereinafter referred to as the said Act in this section. shall be the Trademarks Registry under this Act;

(b) there shall be a Register in the Trademarks Registry who shall be called the Registrar of Trademarks, and the 'Registrar of Patents, Design and Trademarks appointed under the said Act shall be the Registrar of Trademarks.

(2) For the purpose of facilitating the registration of trademarks, the Government may, by notification in the official Gazette, establish one or more branch offices of the Trademarks Registry.

(3) The Trademarks Registry or its branch offices shall perform all functions relating to trademarks including their registration.

(4) The Government may, by notification in the official Gazette, appoint required number of Deputy Registrars.

(5) A Deputy Registrar shall discharge his duties in respect of registration under this Act and under the control and supervision of the Registrar.

(6) The Registrar, with the prior approval of the Government, may, by general or special order delegate any of his functions or authority to a Deputy Registrar or any other sub-ordinate officer or officers.

4. The Register of Trademarks.

(1) For the purpose of this Act, a book or record to be called Register of Trademarks shall be kept at the Trademarks Registry wherein all registered trademarks with the names, addresses, and descriptions of the proprietors, notifications of assignments and transmission, the names, addresses and descriptions of registered user, disclaimers, conditions, limitation and such other matters relating to registered trademarks shall be recorded in writing in prescribed manner.

(2) Subject to the superintendence and direction of the Government, the Registrar shall maintain and preserve the Register.

(3) There shall be kept at the Trademarks Registry and at each branch office of the Department, a copy of the Register and such other documents mentioned in section 116 of this Act as the Government may, by notification in the official Gazette, direct.

(4) No notice of any trust, express or implied or constructive, shall be entered in the Register and no such notice shall be receivable by the Register.

5. Registration of certain class of goods or services.

(1) A trademark may be registered in respect of certain class of goods, or, service by complying the requirements determined for the respective class or classes.

(2) Any question arising as to the class of any goods or services shall be disposed of by the Registrar whose decision in the matter shall be final.

6. Requisites for registration in the Register.

A trademarks shall not be registered in the Register unless it contains or consists of at least one of the following essential particulars—

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

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

(c) one or more invented words;

(d) one or more words having no direct reference to the character or quality of the goods or services, as the case may be, and not being, according to its ordinary signification, a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in Bangladesh;

(e) any other distinctive mark.

(2) A name, signature or word which does not fall within the description in clauses (a), (b), (c) and (d) of sub-section (1) except in clause (e) of this sub-section shall not be registered in the Register except upon the evidence of its distinctiveness.

(3) For the purposes of this Act, the expression, "distinctive mark," in relation to the goods or services in respect of which a trademark is proposed to be registered, means a trademark which distinguishes the goods or services, as the case may be, of the proprietor from the goods or services, of the same kind in such trade and in the case of which no such connection subsists, either generally or, where the trademark is proposed to be registered, subject to limitations.

7. Limitation as to using colour.

(1) A trademark may be limited wholly or in part to one or more specified colours, and any such limitation shall be taken into consideration by the Tribunal to decide on the distinctive character of the trademark.

(2) So far as a trademark is registered without limitation of colour, it shall be deemed to be registered for all colours.

8. Prohibition of registration of certain matters.

-No mark or part of a mark shall be registered as a trademark-

(a) which comprises or consists of any scandalous or obscene matter; or
(b) the use of which would be contrary to any law for the time being in force; or

(c) the use of which would be likely to deceive or cause confusion; or
(d) which contains any matter likely to hurt the religious susceptibilities of any class of the citizens of Bangladesh;

(e) which is identical with, or is an imitation of, or contains as a element, an armorial bearing, flag or other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any state or international organization created by an international convention, charter or other instruments, unless authorized by the competent authority of that state or organization; or

(f) which would otherwise be disentitled to protection in a court;

(g) the application is made in bad intention and faith.

9. Prohibition of names of chemical materials.

-No word which is the commonly used and accepted name of any single chemical element or single chemical compound shall be registered as a trademark in respect of a chemical substance or preparation and any such registration shall, notwithstanding anything contained in section 29, be deemed, for the purposes of section 51, to be an entry made in the Register without sufficient cause or wrongly remaining on the register, as the circumstances may require : Provided that nothing in this section shall

apply to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trademark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

10. Prohibition of registration of identical or deceptively similar trademark.

(1) Save as provided in sub-section (2) no trademark shall be registered in respect of any goods or description of goods or in respect of any services or description of services which is identical with or deceptively similar to a trademark which is already registered in the name of a different proprietor in respect of the same goods or description of goods or in respect of the same services or description of services, as the case may be.

(2) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of trademarks which are identical or nearly resemble each other in respect of the same goods, or services or same description of goods or services subject to such limitations and conditions, if any, as the Registrar may think fit to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trademarks which are identical or nearly resemble each other in respect of the same goods or description of goods or in respect of same services or description of services, the Registrar may pending the applications bearing a later date until, the determination of the proceedings in respect of the earlier application, and dispose of the earlier applications in the light of the evidence tendered in relation to the application and the oppositions thereto.

(4) No trademark shall be registered in respect of any goods or services if it is identical with, or confusingly similar to, or constitutes a translation or a mark or trade description which is well-known in Bangladesh for identical or similar goods or services of another enterprise.

(5) No trademark shall be registered in respect of goods or services if it is well-known and registered in Bangladesh for goods or services which are not identical or similar to those in respect of which registration

is applied for, if-

(a) the trademark is used in such a way that may create a false conception that there is a connection between those goods or services and the owner of the registered trademark; and

(b) the interests of the registered trademark are likely to be damaged by such use.

(6) In determining whether a mark stating in sub-sections (4) and (5) is well known the knowledge of the mark in the relevant sector of the public, including knowledge which has been obtained in Bangladesh as a result of the promotions of the mark, shall be taken into account.

(7) Nothing in this section shall prevent the registration of a trademark where the proprietor of the earlier trademark or other earlier right consents to the registration.

Explanation: For the purposes of this section, "earlier trademark" means a registered trademark which has a date of application for registration earlier than that of the trademark in question, taking account, where appropriate, of the priorities claimed in respect of the trademark, and references in this section to an earlier trademark include a trademark in respect of which an application for registration has been made and which, if registered, would be an earlier trademark.

(8) A trademark whose registration expires shall continue to be taken into account in determining the capability of the said trademark to be registered for a period of 1(one) year after the expiry unless the Registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry.

11. Use of names of living persons or dead persons.

Where an application is made for the registration of a trademark which falsely suggests a connection with any living person. or a person whose death took place within 20 (twenty) years prior to the date of application for the registration of the trademark, the Registrar may, before he proceeds with the application, require the applicant to furnish him with the consent in writing of such living person or, as the case may be, of the legal representative of the deceased person to the connection appearing on the trademark, and may refuse to proceed with the application unless the applicant furnishes the Registrar with such consent.

12. Registration of parts of trademarks and of trademarks as a series.

(1) Where the proprietor of a trademark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trademarks.

(2) Each such separate trademark shall satisfy all the conditions applying to, and have all the incidents of, an independent trademark.

(3) Where a person who claims to be the proprietor of several trademarks in respect of the same goods or description of goods or in respect of the same services or description of services which resemble each other in the material particulars thereof, but differ in respect of-

(a) statements of the goods or services, as the case may be, in relation to which they are respectively used or proposed to be used; or

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

(c) other matter of a non-distinctive character which does not substantially affect the identity of the trademark; or

(d) colour; seeks to register those trademarks, they must be registered as a series in one registration.

13. Registration of trademarks as associated trademarks.

(1) Where a trademark which is registered, or is the subject of an application for registration, in respect of any goods or services is identical with another trademark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods or in respect of the same services or description of services, as the case may be, 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 trademarks shall be entered on the Register as associated trademarks.

(2) Where a trademark and any part thereof are registered as separate trademarks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trademarks.

(3) All trademarks registered under section 12(3) as a series in one registration shall be deemed to be, and shall be registered as, associated trademark.

(4) On application made in the prescribed manner by the registered

proprietor of two or more trademarks registered as associated trademarks, the Registrar may dissolve the association in respect of any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trademark were used by any other person in relation to any of the goods or any of services, as the case may be, in respect of which it is registered, and may amend the Register accordingly.

14. Registration of trademarks subject to disclaimer.

If a trademark contains

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

(b) any matter common to the trade, or otherwise of a nondistinctive character, the Tribunal, in deciding whether the trademark shall be entered or shall remain on the Register, may require, as a condition of its being on the Register, that the proprietor shall either disclaim any right to the exclusive use of such part or all or any portion of such matter, as the case may be, to the exclusive use of which the Tribunal holds him not to be entitled, or make such other disclaimer as the Tribunal may consider necessary for the purpose of defining the rights of the proprietor under the registration:

Provided that no disclaimer shall affect any rights of the proprietor of a trademark except such as arise out of the registration of the trademark in respect of which the disclaimer is made.

CHAPTER III PROCEDURE FOR, AND DURATION OR REGISTRATION

15. Application for registration.

(1) Any person claiming to be the proprietor of a trademark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trademark

(2) Separate applications shall be made in respect of every class of goods or services and the applications shall be considered according to the serial of receipt.

(3) Every application under sub-section (1) may be filed at the Head Office of the Department or in any branch office of the Trademarks Registry having territorial jurisdiction over 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, as having a place of business in Bangladesh is situated.

(4) Where the applicant or any of the joint applicants does not carry on business in Bangladesh, the application may be filed in the office of the Trademarks Registry having territorial jurisdiction over the place mentioned in the address for service in Bangladesh as disclosed in the first application, is situated.

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

- (a) accept an application absolutely,
- (b) refuse an application recording the grounds for such refusal,
- (c) accept an application subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.

16. Withdrawal of acceptance.

(1) Where, after the acceptance of an application for registration of a trademark the Registrar is satisfied, -

- (a) that the application has been accepted in error, or
- (b) that in the circumstances of the case the trademark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted, the Registrar may, after giving the applicant an opportunity of being heard,

withdraw the acceptance and proceed as if the application had not been accepted.

17. Advertisement of application.

(1) When an application for registration of a trademark has been accepted, whether absolutely or subject to conditions or limitation, the Registrar shall, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be advertised in the prescribed manner : Provided that the Registrar may cause the application to be advertised before acceptance if it relates to a trademark 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.

(2) Where 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 cause the application to be advertised again or, notify in the prescribed manner the correction or amendment made in the application.

18. Opposition to registration.

(1) Any person may, within 2 (two) months from the date of the advertisement of an application for registration, and on payment of the prescribed fee, give notice in writing in the prescribed manner to the Registrar, of opposition to registration.

(2) The Registrar shall, within 1 (one) month from the receipt of the notice of opposition by him, serve a copy of the notice on the applicant for registration in the prescribed manner and within 2 (two) months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and if he does not do so, he shall be deemed to have abandoned his application.

(3) If the applicant sends such counter-statement, the Registrar shall, within 1 (one) month from the receipt of such counter-statement, serve a copy thereof in the prescribed manner on the person giving notice of opposition.

(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed manner and within the prescribed time to the Registrar, and the Registrar shall give an opportunity to them to be heard, if they so desire.

(5) The Registrar shall, after hearing the parties, and considering the evidence, decide whether registration is to be permitted and whether such permission shall be or not subject to conditions or limitations.

(6) When the Registrar deems it necessary to permit registration subject to conditions or limitations under sub-section (5), he shall record his decision on such conditions or limitations.

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

(8) Notwithstanding anything contained in this section, all opposition relating activities for registration shall be concluded within 120 (one hundred and twenty) working days after giving notice under sub-section (1).

19. Correction.

(1) The Registrar may on such terms as he thinks fit, at any time, whether before or after acceptance of an application for registration under section 15 permit the correction of any error in or in connection with the application or permit correction of any error in a notice of opposition or a counter-statement under section 18.

20. Registration.

(1) Subject to the provisions of section 15 when-

(a) an application for registration of a trademark in the Register has been accepted,

(b) the application has not been opposed and the time for notice opposition has expired; and

(c) the application has been opposed and the opposition has been decided in favour of the applicant;

the Registrar shall register the said trademark in the Register, giving

effect of the trademark from the date of the making of the application for registration, and that date shall, subject to the provisions of section 120, be deemed for the purposes of this Act to be the date of registration.

(2) On the registration of a trademark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof, impressed with the seal of the Trademarks Registry.

(3) Subject to the compliance with the conditions by the applicant for registration, the registration certificate of the concerned application shall be provided under sub-section (2) within 150 (one hundred and fifty) working days from the date of filing the application, if there is no defects, or objection or any opposition against the application for trademark.

(4) When the registration of the trademark is not completed within 1 (one) year from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

(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 trademarks.

(1) Nothing in this Act shall authorize the registration of two or more persons who use a trademark independently, or propose so to use it, as joint proprietors thereof.

(2) Notwithstanding anything contained in sub-section (1), where there are inter relation between two or more persons interested in the use of the same trademark relating to an article or service, those persons may be registered as joint proprietors of the trademark, and the effect in relation to any rights to the use of the trademark vested in those persons shall be if those rights had been vested in a single person.

22. Duration, renewal and restoration of registration.

(1) The registration of a trademark shall be for a period of seven years, but may be renewed from time to time in accordance with the provisions of this section.

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

(3) At the prescribed time before the expiration of the last registration of a trademark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with the Registrar may remove the trademark from the Register.

(4) Where a trademark has been removed from the Register for non-payment of the prescribed fee, the Registrar may, within 1 (one) year from the expiration of the last registration of the trademarks, on receipt of an application in the prescribed form, if satisfied that it is just so to do, restore the trademark to the Register and renew the registration of the trademark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of 10 (ten) years from the expiration of the last registration.

23. Effect of removal from registration for failure to pay fee for renewal .

Where a trademark has been removed from the Register for failure to pay the fee for renewal, it shall nevertheless, for the purpose of any application for the registration of another trademark during 1 (one) year next after the date of the removal, be deemed to be a trademark already on the Register, unless the Tribunal is satisfied-

(a) that there has been no bona fide trade use of the trademark which has been removed during the 2 (two) years immediately preceding its removal; and

(b) that no deception or confusion would be likely to arise from the use of the trademark which is the subject of the application for registration by reason of any previous use of the trademark which has been removed.

CHAPTER IV EFFECT OF REGISTRATION

24. No action for infringement of unregistered trademark.

(1) No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trademark.

(2) Nothing in this Act shall be deemed to affect rights of action against any person for passing of goods or services as the goods or services, as the case may be, of another person or the remedies in respect thereof.

25. Rights conferred by registration.

(1) Subject to the other provisions of this Act, the registration of a person in the Register as proprietor of a trademark in respect of any goods or services shall, if valid give to that person the exclusive right to the use of the trademark in relation to those goods or services, as the case may be, and to obtain relief in respect of infringement of the trademark in the manner provided by this Act.

(2) No person other than the registered owner of a trademark in relation to any goods or services, as the case may be, shall use that trademark without the consent of the registered owner.

(3) The exclusive right to the use of a trademark given under subsection (1) shall be subject to any conditions or limitations entered on the Register.

(4) Where two or more persons are registered proprietors of trademarks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trademarks shall not except so far their respective rights are subject to any conditions or limitations entered on the Register, be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trademarks but each of those persons has otherwise the same rights as against other persons not being registered users using by way of permitted use as he would have if he were the sole registered proprietor.

26. Infringement of trademarks.

(1) A registered trademark is deemed to be infringed by any person who, not being the registered proprietor of the trademark or a registered user thereof a trademark which is identical with, or deceptively similar to, any trademark, in relation to goods or services of his own trade.

(2) A registered trademark is infringed by any person who, not being the registered proprietor of the trademark or a registered user thereof uses in the course of trade a mark where the mark is-

(a) identical with the trademark and is used in relation to goods or services similar to those for which the trademark is registered;

(b) the mark is similar to the trademark and is used in relation to goods or services identical with or similar to those for which the trademark is registered; or

(c) identical with the registered trademark and is used in relation to goods or services which are identical with those for which the trademark is registered; and for this reason there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trademark.

(3) A registered trademark is infringed or is deemed to be infringed by any person who, not being the registered proprietor of the trademark or a registered user thereof uses in the course of trade a mark where the mark is-

(a) identical with or similar to the trademark;

(b) used in relation to goods or services which are not similar to those for which the trademark is registered; and

(c) where the trademark has a reputation in Bangladesh and the use of the mark, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.

(4) For the purposes of this section, a person uses "a registered trademark" means-

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the mark, or offers or supplies services under the mark;

(c) imports or exports goods under the mark;

(d) uses the mark on business papers or in advertising.

(5) A person who applies a registered trademark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as infringer of the trademark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorized by the proprietor or a registered user or any other person having the right to use it under this Act.

(6) Nothing in the provisions of this section shall be construed as preventing the use of the registered trademark by any person for the purpose of identifying goods or services as those of the proprietor or a registered user or any other person having the right to use it under this Act, but such use otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trademark if the use without due cause taken unfair advantage of, or is detrimental to, the distinctive character or repute of the trademark.

(7) A well-known mark which is registered is infringed or is deemed to be infringed by a person who, not being the registered proprietor of the well-known mark or a registered user thereof using by way of permitted use,

(a) uses the mark in relation to goods or services identical with or similar to the goods or services for which the well-known mark has been registered; or

(b) uses such a mark in relation to goods or services which not being identical with or similar to those in respect of which the well-known mark has been registered, by using of the mark in relation to those goods or services, would indicate a connection between those goods or services and the owner of the registered well-known mark and that the interests of the owner of the registered well-known mark are likely to be damaged by such use.

Explanation: For the purposes of this section, a "well-known mark" has the same meaning as in section 10.

(8) In an action for infringement of a trademark registered in the Register an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that-

(a) the use of the mark of which the plaintiff complains is not likely to deceive or cause confusion; or

(b) the use is not to be taken as indicating a connection in the course of trade between the goods or services in respect of which the trademark is registered and some person having the right, either as registered proprietor or as registered user, to the trademark.

27. Acts not constituting infringement.

(1) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of the right to the use of a registered

trademark-

(a) where a trademark is registered subject to any conditions or limitations, the use of the trademark in any manner in relation to goods or services, as the case may be, to be sold or otherwise traded in, in any place, or in relation to goods or services to be exported to any market, or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;

(b) by being permitted to use those goods or a bulk of which they form part or services, or a bulk of which they form part by the proprietor of the trademark or any person related to the trade of goods or services in relation with the registered user or to use within the limit of permitted use of the registered proprietor or user, the use of such trademark, unless the registered proprietor or the user subsequently has removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trademark;

(c) by registration under this Act-

(i) the use of a trademark is within established right by a person in relation to goods or services adapted to form part of, or to be accessory to, other goods or services;

(ii) the use of a registered trademark, being one of two or more trademarks registered under this Act which are identical or nearly resemble each other, is in exercise of the right to the use of the trademarks given by registration under this Act.

(2) Where the goods of services bearing a registered trademark are lawfully acquired by a person, the sale of or other dealings in those goods or services by that person or by a person claiming under or through him is not an infringement of the trademark by reason only of the trademark having been assigned by the registered proprietor to some other persons after the acquisition of those goods or services, as the case may be.

28. Registration to be prima facie evidence of validity.

(1) In all legal proceedings relating to a trademark registered under this Act, including application under section 51, the original registration of the trademark and of all subsequent assignments and transmissions of the trademark shall be prima facie evidence of the validity thereof.

(2) In all legal proceedings as aforesaid a trademark registered in the Register shall not be held to be invalid on the ground that it was not a trademark to be registered under section 6 except upon evidence of

distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trademark had been so used by the registered proprietor or his predecessor-in-title as to have become distinctive at the date of registration.

29. Registration to be conclusive as to validity after a certain period.

Subject to the provisions of sections 32 and 42, in all legal proceedings relating to a trademark registered in the Register including application under section 51, the original registration of the trademark shall, after the expiration of 7 (seven) years from the date of such original registration, be taken to be valid in all respects unless it is proved.

- (a) that such registration was obtained by fraud or in bad faith;
- (b) that the trademark was registered in contravention of, or offends against, the provisions of section 8;
- (c) the trademark was not, at the commencement of the proceedings, distinctive of the goods or services, of the registered proprietor.

30. Saving for vested rights

Nothing in this Act shall entitle the proprietor of a registered trademark or well-known mark or a registered user to interfere with or restrain any person or his predecessor from using a trademark identical with or nearly resembling it in relation to goods or services if it has continuously been used by them from a date prior to the use of the first-mentioned trademark or well-known mark in relation to those goods or services by the proprietor or a predecessor-in-title of his, and the Registrar shall not refuse to register the second-mentioned trademark by reason only of the registration of the first-mentioned trademark.

31. Savings for use of name, address, or description of goods or services.

Nothing in this Act shall entitle the proprietor or a registered user of a registered trademark or a registered 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, or of the name of the place of business, of any of his predecessors' business, or the use by any person of any bona-fide description of the character or quality of his goods or services.

32. Savings for words as name or description of an article or substance or services.

(1) The registration of a trademark shall not be deemed to have become invalid by reason only of any use after the date of the registration of

any word or words which the trademark contains or of which it consists of the name or description of an article or substance or services:

Provided that, if it is proved either-

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

(b) that the article or substance or service was manufactured under a patent and that a period of two years or more has passed after the patent has elapsed, and that the said word or words are the only practicable name or description of the article or substance or service- the provisions of sub-section (2) shall apply.

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

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

(i) if the trademark consists solely of such word or words, the registration of the trademark, so far as regards registration in respect of the article or substance or service in question or any goods or services of the same description, shall be deemed to be an entry wrongly remaining in the Register;

(ii) if the trademark contains such word or words and other matter, the Tribunal, in deciding whether the trademark shall remain on the Register, so far as regards registration in respect of the article or substance or service in question of any goods or services of the same description, may, in case of a decision in favour of its remaining on the Register, require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance or service and any goods or services of the same description, of such word or words : Provided that no disclaimer shall affect any rights of the proprietor of a trade except such as arise out of the registration of the trademark in respect of which the disclaimer is made :

(b) for the purposes of any other legal proceedings relating to the trademarks-

(i) if the trademark consists solely of such word or words, all rights of the proprietor under this Act or any other law to the exclusive use of the trademark in relation to the article or substance or service in question or to any goods or services of the same description, or

(ii) if the trademark contains such word or words and other matters, all such rights of the proprietor to the exclusive use of such word or words, in such relation as aforesaid, shall be deemed to have ceased on the date at which the use mentioned in clause (a) of sub-section (1) first become well-known and established, or at the expiration of the period of 2 (two) years mentioned in clause (b) of sub-section (1).

CHAPTER V ASSIGNMENT & TRANSMISSION

33. Power of registered proprietor to assign and give receipts

The person for the time being entered in the Register as proprietor of a trademark shall, subject to the provisions of this Act and to any rights appearing from the Register to be vested in any other person, have power to assign the trademark, and to give effectual receipts for any consideration for such assignment.

34. Assignability and transmissibility of registered trademarks

Notwithstanding anything in any other law to the contrary, a registered trademark shall, subject to the provisions of this Chapter, be assignable and transmissible whether with or without the goodwill of the business concerned, and in respect either of all of the goods or services in respect of which it is registered or of some only of those goods or services.

35. Assignability and transmissibility of unregistered trademarks

(1) An unregistered trademark shall not be assignable or transmissible except along with the goodwill of the business concerned.

(2) Notwithstanding anything contained in sub-section (1) an unregistered trademark may be assigned or transmitted otherwise than along with the goodwill of the business concerned if—

(a) at the time of assignment or transmission of the unregistered trademark, it is used in the same business as a registered trademark;

(b) the registered trademark is assigned or transmitted at the same time and to the same person as the unregistered trademark; and

(c) the unregistered trademark relates to goods or services in respect of which the registered trademark is assigned or transmitted.

36. Restrictions on assignment or transmission where multiple exclusive rights would be created.

(1) Notwithstanding anything contained in sections 34 and 35 where as a result of the assignment or transmission there would subsist, whether under this Act or any other law, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or and the trademarks be nearly same or resemble each other and for this reason people may be deceived or confused, then a trademark shall not be assignable or transmissible : Provided that an assignment or transmission shall not be deemed to be invalid if the persons assigned to sell the goods or services of a trademark within Bangladesh or to export the goods

or services to the same market outside Bangladesh can not exercise their rights for the limitations imposed upon the exclusive rights.

(2) The proprietor of a registered trademark who proposes to assign it may submit to the Registrar in the prescribed manner a statement of cases stating out the circumstances and the Registrar may issue to him a certificate setting whether, having regard to the similarity of the goods or services, and of the trademarks referred to in the case, the proposed assignment would or would not be invalid under sub-section (1) of this section.

(3) A certificate issued under sub-section (2) shall, subject to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under sub-section (1) of this section, of the assignment in so far as such validity or invalidity depends upon the facts set out in the case : Provided that a certificate in favour of validity shall not be treated as conclusive, if application for the registration under section 40 if the title of the person becoming entitled is not made within 6(six) months from the date on which the certificate is issued.

37. Restrictions on assignment or transmission when exclusive rights would be created in different parts of Bangladesh.

(1) Notwithstanding anything in sections 34 and 36, a trademark shall not be assignable or transmissible in a case in which as a result of the assignment or transmission there would in the circumstances subsist, whether under this Act or any other law, exclusive rights in more than one of the persons concerned to the use, in relation to goods or services, as the case may be, of trademarks to be sold, or otherwise traded in, in any place in Bangladesh and an exclusive right in another or these persons to the use of a trademark nearly resembling the first mentioned trademark or of an identical trademark in relation to the same goods or description of goods or services or description of services, as the case may be, limited to use in relation to goods or services, as the case may be, to be the sold, or otherwise traded in, in any other place in Bangladesh.

(2) In case of an application in the prescribed manner where the proprietor of a trademark who proposes to assign it, or a person who claims that a registered trademark has been transmitted to him or to a predecessor-in-title of his since the commencement of this Act, the

Registrar is satisfied that in all the circumstances the assignment or transmission in exercise of the said rights under sub-section (1) of the trademark would not be contrary to the public interest, may, approve the assignment or transmission, and assignment or transmission so approved shall not, be deemed to be invalid under this Section or section 36 of this Act.

(3) In a case where an assignment or transmission has not been declared invalid under sub-section (2) and if application for the registration under section 40 of this Act of the title of the person becoming entitled is made within 6 (six) months from the date on which the approval is given, and it is shown that the approval was not obtained by fraud or misrepresentation, the assignment or transmission shall not be deemed to be invalid under this Section or section 36 of this Act.

38. Conditions for assignment otherwise than in connection with the goodwill of a business.

(1) Where an assignment of a trademark, whether registered or unregistered, is made otherwise than in connection with the goodwill of the business in which the mark has been or is used, the assignment shall not take effect unless

(a) the assignee, not later than the expiration of 6 (six) months from the date on which the assignment is made or within such extended period, if any, not exceeding 3 (three) months in the aggregate, as the Registrar may allow, applies to the Registrar for directions with respect to the advertisement of the assignment; and

(b) advertises it in such form and manner and within such period as the Registrar may direct.

(2) For the purposes of this section an assignment of a trademark of the following description shall not be deemed to be an assignment made otherwise than in connection with the goodwill of the business in which the mark is used, namely: -

(a) an assignment of a trademark in respect of only of some of the goods or services, as the case may be, for which the trademark is registered accompanied by the transfer of the goodwill of the business concerned in those goods or services only; or

(b) an assignment of a trademark which is used in relation to goods or services, as the case may be, exported from Bangladesh if the assignment is accompanied by the transfer of the goodwill of the export business only.

39. Conditions for assignment and transmission of certification trademarks and associated trademarks.

(1) A certification trademark may be assignable or transmissible
(a) with the prior consent of the Government in that behalf; and
(b) if application made in the prescribed manner through the Registrar.

(2) Associated trademarks shall be assignable and transmissible only as a whole and not separately, but, subject to the provisions of this Act, they shall, for all other purposes, be deemed to have been registered as separate trademarks.

40. Registration of assignments and transmissions.

(1) where a person becomes entitled by assignment or transmission to a registered trademark, he shall apply in the prescribed manner to the Registrar to register his title, and the Registrar shall on receipt of the application and on proof of the title to his satisfaction, register him as the proprietor of the trademark in respect of the goods or services in respect of which the assignment or transmission has effect and shall cause particulars of the assignment or transmission to be entered on 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 such dispute is settled by a competent court.

(2) Except for the purposes of an application before the Registrar under sub-section (1) of this section or an appeal from an order thereon, or an application under section 51 of this Act or an appeal from an order thereon, a document or instrument in respect of which no entry has been made in the Register in accordance with sub-section (1) of this section, shall not be admitted in evidence by the Registrar or any Court in proof of title to the trademark by assignment or transmission unless the Registrar or the Court, as the case may be, otherwise directs.

CHAPTER VI USE OF TRADEMARKS AND REGISTERED USERS

41. Use of proposed trademarks by company to be formed.

(1) No application for the registration of a trademark in respect of any goods or services shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trademark, if the Registrar is satisfied that a company is about to be formed and registered under the Companies Act, 1994 (Act XVIII of 1994) and that the applicant intends to assign the trademark to that company with a view to the use thereof in relation to those goods or services as the case may be, by the company.

(2) The Tribunal may, in a case to which sub-section (1) applies, require the applicant to give security for the costs of any proceedings relative to any opposition or appeal, and in default of such security being duly given may treat the application as abandoned.

(3) If any trademark in respect of any goods or services is assigned to any company under sub-section (1) an application shall be made to the Registrar within the time specified for registration as the proprietor of the trademark in respect of those goods, or services.

(4) If any application is made under sub-section (3), the Registrar may register the company as the proprietor of the assigned trademark in respect of those goods or services and if no application is made within the time, the registration shall cease to have effect and the Registrar shall amend the register accordingly.

42. Removal from Register and imposition of limitations on ground of non-use.

(1) A registered trademark may be taken off the Register in respect of any of the goods or services, in respect of which it is registered on application made in the prescribed manner by any person aggrieved to the High Court Division or the Registrar, on the ground either-

(a) that the trademark was registered without any bona-fide intention on the part of the applicant for registration that it should be used in relation to those goods or services, as the case may be, by him or, in a case to which the provisions of section 41 apply, by the company concerned, and that there has in fact, been no bona-fide use of the trademark, in relation to those goods or services by any proprietor thereof for the time being up to a date one month before the date of the

application; or

(b) that up to a date one month before the date of the application, a continuous period of 5 (five) years or longer elapsed during which the trademark was registered and during which there was no bona-fide use thereof in relation to those goods or services by any proprietor thereof for the time being

(2) The Tribunal shall not refuse an application submitted under sub-section (1) except where—

(a) the applicant has been permitted under section 10 to register an identical or nearly resembling trademark in respect of the goods or services; or

(b) where the Tribunal is of opinion that there has been, before the relevant date or during the relevant period, bona-fide use of the trademark by any proprietor thereof for the time being in relation to goods or services.

(3) On an application by an aggrieved person in the prescribed manner to the High Court Division or the Registrar, the Tribunal may impose on the registration such limitations as it thinks proper for securing that registration shall cease to extend to such use in cases where—

(a) circumstances exist in relation to goods or services, as the case may be, to be sold, or otherwise traded in, in a particular place in Bangladesh, or in relation to goods or services, as the case may be, to be exported to a particular market outside Bangladesh, that there has been no bona fide use of the trademark for 5 (five) years or more after registration by any proprietor thereof; or

(b) more than one person have been permitted under section 10 to register an identical or nearly resembling trademark in respect of identical goods or services, as the case may be, to be sold, or otherwise traded in, or to be exported.

(4) For the purpose of clause (b) of sub-section (1) or sub-section (2), an applicant shall not be entitled to rely on any non-use of a trademark, which—

(a) is shown to have been due to special circumstances; and

(b) is not to any intention to abandon the business or not to use the trademarks.

43. Defensive registration of well-known trademarks.

(1) Where a trademark consisting of any invented word has become so

well-known as respects of any goods or services in relation to which it is registered and has been used, that the use thereof in relation to other goods or services, as the case may be, would be likely to be taken as indicating a connection in the course of trade between those goods or services and a person entitled to use the trademark in relation to the first-mentioned goods or services, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods or services does not use or propose to use the trademark in relation to those other goods or services and notwithstanding anything in section 42, the trademark may on application in the prescribed manner by such proprietor be registered in his name in respect of those other goods or services, as the case may be, as defensive trademark and, while so registered, shall not be liable to be taken off the Register in respect of those goods or services under the said Section.

(2) The registered proprietor of a trademark may apply for the registration thereof in respect of any goods or services as a defensive trademark notwithstanding that it is already registered in his name in respect of those goods or services, otherwise than as a defensive trademark.

(3) A trademark registered as a defensive trademark and that trademark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods or services, as the case may be, be deemed to be and shall be registered as associated trademarks.

(4) On application made in the prescribed manner by any person aggrieved to the High Court Division or to the Registrar, the registrations of a trademark as a defensive trademark may be cancelled on the ground that—
(a) the requirements of sub-section (1) of this section are no longer satisfied in respect of any goods or services in relation to which the trademark is registered in the name of the same proprietor otherwise than as a defensive trademark, or
(b) as respects any goods or services, as the case may be, in relation to which it is registered as a defensive trademark, there is no longer any likelihood that the use of the trademark in relation to those goods or services would be taken as giving the indication mentioned in sub-section (1).

(5) The Registrar may at any time cancel the registration as a defensive trademark of a trademark of which there is no longer any registration

in the name of the same proprietor otherwise than as a defensive trademark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trademarks as defensive trademarks and of trademarks so registered as they apply in other cases.

44. Registered Users.

(1) Subject to the provisions of section 45 of this Act, a person other than the registered proprietor of a trademark may be registered as the registered user thereof in respect of all or any of the goods or services in respect of which it is registered otherwise than as a defensive trademark and either with or without conditions: Provided that the Government may, by rules in this behalf, provide that no application for registration as such shall be entertained unless the agreement between the parties complies with the conditions laid down in the rules for preventing trafficking in trademarks.

(2) The permitted use of a trademark under sub-section (1), shall be deemed to be used 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 trademark, the registered proprietor and the proposed registered users shall jointly apply in writing to the registrar in the prescribed manner, and every such application shall be accompanied by-

(a) the agreement in writing 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 trademark; and

(b) an affidavit made by the registered proprietor or by some person authorized to act on his behalf, which shall include-

(i) particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer;

(ii) whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registrations as Registered user application may be made;

(iii) stating the goods or services in respect of which registration is proposed;

(iv) stating the conditions or restrictions, if any, proposed with respect to the characteristics of the goods or services, as the case may be, to the mode or place of permitted use, or to any other matter;

(v) stating whether the permitted use is to be for a period, or without limit of period, and, if for a period, the duration thereof; and

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

(2) Any registered user may, subject to prescribed conditions, be registered, if-

(a) the requirements of sub-section (1) have been complied with, and

(b) the use of trademark in respect of goods or services by the proposed registered user would be against public interest.

(3) The Registrar may, subject to other provisions of this Act, refuse any application under this section including the said application if it appears to him that grant thereof would tend to facilitate trafficking any goods or services by the name of the said trademark.

(4) No application under this section shall be refused or conditionally accepted by the Registrar without giving the applicant an opportunity of being heard.

(5) The Registrar shall, if so requested by an applicant, take steps for securing that information given for the purposes of an application under this section (other than matters entered in the Register) is not disclosed to rivals in trade.

(6) The Registrar shall issues notice in the prescribed manner of the registration of a person as a registered user, to other registered users of the trademark, if any.

46. Power of registered user to take proceedings against infringement.

(1) Subject to any agreement subsisting between the parties, a registered user of a trademark 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) Notwithstanding anything contained in any other law, a proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

47. Power of Registrar to vary or cancel of registration as registered user.

(1) Without prejudice to the provision of section 51 of this Act. the registration of a person as a registered user-

(a) may be varied by Registrar as regards the goods or services in respect of which, or any conditions or restrictions subject to which, if has effect, on the application in writing in the prescribed manner of the registered proprietor of the trademark;

(b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trademark;

(c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, namely :-

(i) that the Registered user has used the trademark otherwise than by way of the permitted use, or in such a way 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, some fact material to the application for the registration, which if accurately represented or disclosed would have justified the refusal of the application for registration of the Registered user;

(iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested;

(iv) that the circumstances have changed since the date of registration in such a way that at the date of such application for cancellation they would have justified the refusal of an application for registration of the registered user;

(d) may be cancelled by the Registrar in respect of any goods or services, as the case may be, in relation to which the trademark is no longer Registered;

(e) may be cancelled by the Registrar of his own motion or on the application in writing in the prescribed manner of any person, on the ground that any stipulation in the agreement between the Registered proprietor and the registered user regarding the quality of the goods or services in relation to which the trademark is to be used is either not being enforced or is not being complied with.

(2) The Registrar shall issue notice in the prescribed manner of every application under this section to the registered proprietor and each registered user (not being the applicant) of the trademark.

48. Registered user not to have right of assignment or transmission.

Nothing in this Act shall confer on a registered user of a trademark any assignable or transmissible right to the use thereof.

Explanation: The right of a registered user of a trade shall not be deemed to have been assigned or transmitted within the meaning of this section in the following cases, namely:-

(a) Where the registered user being an individual enters into a ownership with any other person for carrying on the business concerned; but in any such case the firm may use the trademark, if otherwise in force, only for so long as the registered user is a member of the firm;

(b) Where the registered user being a firm subsequently undergoes a change in its constitution; but in any such case the reconstituted firm may use the trademark, if otherwise in force, only for so long as any partner of the original firm at the time of its registration as registered user, continues to be a partner of the reconstituted firm.

(c) For the purposes of this section, "firm" has the same meaning as in the Partnership Act. 1932 (Act IX of 1932).

49. Use of one of associated or substantially identical trademarks equivalent to use of another.

(1) Where under the provisions of this Act. the use a registered trademark is required to be proved for any purpose, the Tribunal may, if and so far as it shall think right, accept the use of a registered associated trademark, or the trademark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trademark shall for the purposes of this Act be deemed to be also a use of any trademark being a part thereof and registered in accordance with sub-section (1) of section 12 of this Act in the name of the same proprietor.

50. Use of trademark for export trade and use when form of trade connection changes:

(1) The application in Bangladesh of a trademark to goods or services to be exported from Bangladesh and any other law done in Bangladesh in

relation to goods or services, to be so exported which, if done in relation to goods or services, as the case may be, to be sold or otherwise trade in within Bangladesh would constitute use of a trademark therein, shall be deemed to constitute use of the trademark in relation to those goods or services, as the case may be, for any purpose for which such use is metrical under this Act or any other Law.

(2) The use of registered trademark in relation to goods or services between which and the person using the mark any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the mark has been or is used in relation to goods or services, as the case may be, between which and the person using the mark or any predecessor in his business a different form of connection in the course of trade subsisted or subsists.

CHAPTER VII RECTIFICATION AND CORRECTION OF THE REGISTER, ETC.

51. Power to cancel or vary registration or to rectify the Register.

(1) On application made in the prescribed manner by any person aggrieved to the High Court Division or to the Registrar, the Tribunal may make such order as it may think fit for cancelling or varying the registration of a trademark on the ground of any contravention of, or failure to observe a condition entered on the Register in relation thereto.

(2) Any person aggrieved by the absence or omission from the Register of any entry, or by any entry made in the Register without sufficient cause, or by any entry wrongly remaining on the Register, or by any error or defect in any entry in the Register, may apply in the prescribed manner to the High Court Division or to the Registrar, and the Tribunal may make such order for making, expunging or varying the entry as it may think fit.

(3) The Tribunal may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the Register.

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

(5) Any order of the High Court Division rectifying Register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the Register accordingly.

52. Correction of the Register.

(1) The Register may, on application made in the prescribed manner by the registered proprietor—

(a) correct any error in the name, address or description of the registered proprietor of a trademark;

(b) enter any change in the name, address or description of the person who is registered as proprietor of a trademark;

(c) cancel the entry of a trademark on the Register;

(d) strike out any goods or classes of goods or services or classes or services from those in respect of which a trademark is Registered;

(e) entry a disclaimer or memorandum relating to a trademark which does not in any way extend the rights given by the existing registration of the trademark;

(f) make any consequential amendment or alteration in the certificate of registration, and for that purpose, may require the certificate of registration to be produced to him.

(2) The Registrar may, on application made in the prescribed manner by a registered user of a trademark, correct any error, or enter any change, in the names, address or description of the registered user.

53. Alteration of registered trademark.

(1) The registered proprietor of a trademark may apply in the prescribed manner to the Registrar for leave to add to or alter the trademark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, dispose of the matter.

(3) Where leave is granted under this section, the trademark as altered shall be advertised in the prescribed manner, unless the application has already been advertised under sub-section (2) of this section.

54. Adaptation of entries in Register to amended or substituted classification of goods or services.

(1) The Registrar shall not make any amendment of the Register which would have the effect of adding any goods or classes of goods or services or classes of services, to those in respect of which a trademark is Registered immediately before the amendment is to be made or of antedating the registration of a trademark in respect of any goods or services;

(2) Sub-section (1) shall not apply when Registrar is satisfied that compliance therewith would involve undue complexity and that the addition or antedating would not affect any substantial quantity of goods or

services and would not substantially prejudice the rights of any person.

(3) A proposal so to amend the Register shall be notified to the registered proprietor of the trademark affected and advertised in the prescribed manner, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes the provisions of sub-section (1).

CHAPTER VIII CERTIFICATION TRADEMARKS

55. Certain provisions of the Act made inapplicable to certification trademarks.

-The following provisions of this Act shall not apply to certification trademarks, namely:-

- (a) Section 5;
- (b) Section 15, 17 and 18 except as expressly applied by this Chapter;
- (c) Section 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 except section 76.

56. Registration of certification trademarks.

-A mark shall not be eligible to be registered as a certification trademark in the name of a person who carries on a trade in goods or service of the kind certified.

57. Determination whether a mark is a certification trademarks.

In determination whether a mark is adapted to distinguish in accordance with the provision of sub-sections (28) of section 2, the Tribunal may have regard to the extent to which

- (a) the mark is inherently so adapted to distinguish in relation to the goods or services in question; and
- (b) by reason of the use of the mark or of any other circumstance, the mark is in fact so adapted to distinguish in relation to the goods or services in question.

58. Application for registration of certification trademark.

(1) An application for the registration of a mark as a certification trademark shall be made to the Register in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof, and accompanied by a draft of the regulations to be deposited under section 61 of this Act.

(2) Subject to the provisions of section 56 and 57, the provisions of sub-section (1), (2), (3), (4) and (6) of section 15 and the provisions of section 16 and 19 shall apply in relation to an application under this Section as they apply in relation to an application under Section 15: Provided that the references in this sub-section to acceptance of an application shall not be construed as references to authorization to proceed with an application.

(3) In dealing under the said provisions with an application under this section, the Tribunal shall have regard to the like considerations, so far as relevant, as if the application were an application under section 15 and to any other consideration, not being matters within the competence of the Government under section 59 relevant to applications under this section, including the desirability of securing that a certification trademark shall comprise some indication that it is a certification trademark.

59. Consideration of application for registration by 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 with regard to the following matters, namely:

- (a) whether the applicant is competent to certify the goods or services in respect of which the mark is to be registered;
- (b) whether the draft of the regulations to be deposited under section 61 is satisfactory;
- (c) whether in all the circumstances the registration applied for would be to the public advantage.

(2) After considering any application according to sub-section-(1), the Government may-

- (a) direct that the application shall not accepted; or
- (b) direct the Registrar to accept the application and approve the said draft of the regulations either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modification of the application or of the regulations, which if thinks requisite having regard to any of said matters: Provided that in the case of a direction for acceptance and approval without modification and unconditionally, the Government shall not decide the matter without giving to the applicant and opportunity of being heard :

Provided further that the Government may, at the request of the application made through the Registrar, reconsider any of the said matter on which if has given a decision under this clause before the authorisation to proceed with the application is given if any amendment or modification is thereafter made in the application or in the draft of the regulation.

60. Opposition to registration of certification trademarks.

(1) When an application is accepted, the Registrar shall, as soon as may be thereafter, cause the application as accepted to be advertised in the

prescribed, manner, and the provisions of section 18 of this Act shall apply in relation to the registration of the mark as they apply in relation to an application under section 15.

(2) When notice of opposition is given relating to an application for registration, the Government shall, after hearing the parties, if so required by them, and considering any evidence and having regard to the matters aforesaid, direct the Registrar-

(a) to refuse registration; or

(b) to Register the mark either absolutely or subject to such conditions or limitation, or amendments or modifications as the Government may think proper to impose or make.

(3) The Register shall dispose of the matter in accordance with the directions issued by the Government under sub-section (2).

61. Deposit of regulations governing the use of a certification trademark.

(1) There shall be deposited at the Trademarks Registry in respect of every mark registered as a certification trademark regulations approved by the Government for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorise the use of the certification trademark, and may contain any other provisions which the Government may, by general or special order, require or permit to be inserted therein.

(2) Registrations deposited under sub-section (1) shall be open to inspection in like manner as the Register.

(3) The regulations so deposited may on the application of the registered proprietor be altered by the Register with the consent of the Government.

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

62. Right conferred by registration of certification trademark.

(1) Subject to the provisions of section 30, 31 and 64, the registration of a person as proprietor of a certification trademark in respect of any goods or services, as the case may be, shall, if valid, give to the person

the exclusive right to the use of the trademark in relation to those goods or services.

(2) The exclusive right to the use of a certification trademark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

63. Infringement of certification trademark.

The right conferred by section 62 shall be deemed to be infringed by any person who uses in the course of trade a mark which is identical with, or deceptively similar to, the certification trademark in relation to any goods or services in respect of which it is registered and in such manner as to render the use of the mark likely to be taken as being used as a trademark.

64. Acts not constituting infringement of certification trademarks.

(1) Notwithstanding anything contained in this Act, the following acts shall not constitute an infringement of the right to the use of a registered certification trademark-

(a) where a certification trademark is registered subject to any conditions or limitation, to which having regard to any such limitations, the registration does not extend;

(b) the use of the certification trademark in relation to goods or services certified by the proprietor of the mark;

(c) where-

(i) the use of the certification trademark in relation to goods or services adapted to form part of or to be accessory to, other goods or services, as the case may be, in relation to which the mark has been used without infringement of right given as aforesaid or might for the being so used; and

(ii) if the use of the mark is reasonably necessary in order to indicate that the goods or services are so adapted and neither the purpose nor the effect of the mark is to indicate otherwise than in accordance with the fact that the goods or services are certified by the proprietor.

(2) Clause (b) of sub-section (1) shall not apply to the case of use consisting of the application of a certification trademark to any goods or services, notwithstanding that they are such goods or services as are mentioned in that clause if such application is contrary to the regulations referred to in that clause.

(3) Where a certification trademark is identical or nearly resemble to

two or more trademarks registered under this Act, the use of any of those trademarks in exercise of the right to the use of that trademark given by registration, shall not be deemed to be an infringement of the right so given to the use of any other of those trademarks.

65. Cancellation or varying registration.

(1) The Government may, on the application in the prescribed manner of any person aggrieved or on the recommendation of the Registrar, and after giving the proprietor an opportunity of opposing the application or recommendation, make such order as it thinks fit for expunging or varying any entry in the Register relating to a certification trademark, or for varying the deposited regulations, on any of the following grounds namely—
(a) that the proprietor is no longer competent, in the case of any of the goods or service in respect of which the mark is registered, to certify those goods or services;

(b) that the proprietor has failed to observe any provision of the deposited regulations to be observed on his part;

(c) that it is no longer to the public advantage that the mark should be registered; and

(d) that it is requisite for the public advantage that the regulations should be varied.

(2) The High Court Division and the Registrar shall nor have any jurisdiction to make an order under section 51 on any of the grounds under sub-section (1).

(3) The Registrar shall rectify the Register and the deposited regulations in such manner as may be requisite for giving effect to an order made under sub-section (1) of this section.

CHAPTER IX SPECIAL PROVISION FOR TEXTILE GOODS.

66. Textile Goods.

The Government shall prescribe classes of goods under the International Classification, hereinafter referred to as textile goods in this Chapter, to the trademarks used in relation to which the provisions of this Chapter shall apply; and subject to the said provisions, the other provisions of this Act shall apply to such trademarks as they apply to trademarks used in relation to order classes of goods.

67. Restriction on registration of textile goods.

(1) In respect of textile goods being piece goods-

- (a) no mark consisting of a line heading alone shall be capable of being registered as a trademark;
- (b) a line heading shall not be deemed to be adapted to distinguish;
- (c) the registration of a trademark shall not give any exclusive right to the use of a line head.

(2) In respect of any textile goods, the registration of letters or numerals. or any combination thereof, shall be subject to such conditions and restrictions as may be prescribed.

68. Stamping of length of piece goods, cotton yarn and thread

(1) Piece goods, such as are ordinarily sold by length or by the piece, which have been manufactured, bleached, dyed, printed or finished in premises which is a factory as defined in the Bangladesh Labour Act, 2006 (Act. XLII of 2006) shall not be removed for sale from the last of such premises in which they underwent any of the said processes without having conspicuously stamped in Bengali numerals as well as in English numerals on each piece the length thereof in standard meters and a fraction of such a meters, according to the real length of the piece, and except when the goods are sold from the factory for export from Bangladesh, without being conspicuously marked on each piece with the name of the manufacturer or of the occupier of the premises in which the piece was finally processed or of the wholesale purchaser in Bangladesh of the piece.

(2) Cotton yarn such as is ordinarily sold in bundles, and cotton threads, namely, sewing, darning, crochet or handicraft thread, which have been manufactured, bleached, dyed, or finished in any premises not exempted by the rules framed under Section 70 of this Act shall not be removed for sale from those premises unless, in accordance with the said rules

in the case of yarn-

(a) the bundles are conspicuously marked with an indication of the weight of yarn in the metric system in each bundle;

(b) the count of the yarn contained in the bundle and in the case of thread each unit is conspicuously marked with the length or weight of thread in the unit and in such other manner as may be required by the said rules; and

(c) except where the goods are sold from premises for export from Bangladesh, unless each bundle or unit is conspicuously marked with the name of the manufacturer or of the wholesale purchaser in Bangladesh of the goods:

Provided that all premises where the work is done by members of the family with or without the assistance of not more than ten other employees, and all premises controlled by a co-operative society where not more than twenty workers are employed in the premises shall be exempted from the operation of the rules made under section 70 of this Act.

69. Declaration as piece goods.

For the purpose of section 68 and the clause (1) of section 15 of the Customs Act, 1969 (Act IV of 1969) the Government may, by notification on the Official Gazette, declare what classes of goods are included in the expression "piece goods" such as are ordinarily sold by length or by the piece.

70. Determination of Character of textile goods by sampling:

(1) For the purposes of this Act, the Government may make rules-

(a) to provide, with respect to any goods which purport or are alleged to be of uniform number, quantity, measure, gauge or weight, for the number of samples to be selected and tested and for the selection of the samples; and

(b) to provide for the manner in which, for the purpose of Section 68 of this Act, yarn and thread shall be marked with the particulars required by that section, and for the exemption of certain premises used for the manufacture, bleaching, dyeing or finishing of yarn or thread from the provisions of that section.

(2) With respect to any goods for the selection and testing of samples of which provision is not made in any rules for the time being in force under sub-section (1) the Court or officer of customs, as the case may be, having occasion to ascertain the number, quantity, measure, gauge or weight or the goods, shall, 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 made under sub-section (1) or of an order passed 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, or in relation to, any goods of which samples have been selected and tested in pursuance of rules made under sub-section (1) or of an order passed under sub-section (2) desires that any further samples of the goods be selected and tested, such further samples shall, on his written application and on the payment in advance by him to the Court or officer of customs, as the case may be, of such sums for defraying the cost of the further selection and testing as the Court or officer may from time to time require, be selected and tested to such extent as may be permitted by with respect to which provision is not made in such rules, the Court or officer of customs may determine in the circumstances to be reasonable, the samples being selected in the manner prescribed under sub-section (1) or in sub-section (2), as the case may be.

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

CHAPTER X OFFENCES, PENALTIES AND PROCEDURE

71. Meaning of applying trademarks and trade descriptions.

(1) A person shall be deemed to apply a trademark, mark or trade description to goods or service, as the case may be, who-

(a) applies it to the goods themselves or services themselves, as the case may be; or

(b) applies it to any package in or with which the goods or services, as the case may be, are sold, or exposed for sale, or had possession for sale or for any purpose of trade or manufacture; or

(c) places, encloses or annexes any goods or services, as the case may be, which are sold, or are exposed for sale, or had in possession for sale or for any purpose of trademark on manufacture, in or with any package or other things to which a trademarks or mark or trade description has been applied; or

(d) applies a trademark or mark trade description any manner reasonable likely to lead to the belief that the goods or services, as the case may be, in connection with which it is used are designated or described by that trademark or mark or trade description; or

(e) in relation to the goods or services, as the case may be, uses a trademark or trade description in any sign, advertisement, invoice, catalogue, business letter, business paper, price list, or other commercial document, and goods or services, as the case may be, are delivered to a person in pursuance of a request or order made by reference of the trademark or trade description as so used.

(2) A trademark or mark or trade description shall be deemed to be applied to goods or services as the case may be, whether it is woven in, impressed on, or otherwise worked into, or annexed or affixed to, the goods or services, as the case may be, or to any package or other thing.

72. Falsifying and falsely applying trademarks.

(1) A person shall be deemed to falsify a trademarks who, either-

(a) without the assent of the proprietor of the trademark, makes that trademark, or a deceptively similar mark; or

(b) falsifies any genuine trademark, whether by alteration, addition, effacement or otherwise.

(2) A person shall be deemed to falsely apply to goods or services, as the case may be, a trademark who, without the assent of the proprietor of the trademark-

(a) applies such trademark or a deceptively similar mark to goods or services, as the case may be, or any package containing goods;

(b) uses any package bearing a mark which is identical with or deceptively similar to the trademark of such proprietor, for the purpose of packing, filling, or wrapping therein any goods of the proprietor of the trademark.

(3) Any trademark falsified as mentioned in sub-section (1) of this section or falsely applied as mentioned in sub-section (2) of this section, shall be deemed to be a false trademark,

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

73. Penalty for applying false trademarks and false trade description, etc.

-If a person-

(a) falsifies any trademark,

(b) falsely applies for any trademark or to goods or services,

(c) makes, disposes of, or has in his possession, any die, block, machine, plate or other instrument of the purpose of falsifying, or of being used for falsifying a trademark,

(d) applies any false trade description to goods or services,

(e) applies to any goods to which an indication of the country or place in which they were made or produced or the name and address of the manufacturer or producer or supplier, as the case may be, or person for whom the goods or services are manufactured, produced or supplied is required to be applied under section 108 of this Act, a false indication of such country, place, name or address,

(f) tampers with, alters or effaces an indication of origin which has been applied to any goods or services to which it is required to be applied under section 108, or

(g) causes any of the things mentioned from clause (a) to (f) to be done. he shall, subject to the provisions of this Act be punished with imprisonment for a term which may extend 2 (two) years but not less than 6 (six) months or with fine which may extend to taka 2 (two) lac but not less than 50 (fifty) thousand or with both and for a second or subsequent conviction, with imprisonment for a term which may extend to 3 (three) years but not less than 1 (one) year, or with fine which may extend to taka 3 (three) lac but not less than 1 (one) lac, or with both.

74. Penalty for selling goods to which a false trademark or trade description is applied.

If a person sells, or exposes for sale, or has in his possession for sale or for any purpose of trade or manufacturer any goods or things to which a false trademark or a false trade description is applied or which, being required under section 108 to have applied to them an indication of the country or place in which they were made or produced or the name and address of the manufacturer or producer or the person for whom the goods are manufactured or produced are without the indication so require, he shall, unless the proves

(a) that, having taken all reasonable precautions against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trademark or trade description or that any offence had been committed in respect of the goods; and

(b) that, on demand by or on behalf of the prosecutor he gave all the information in his power with respect to the person from whom he obtained such goods or things; or

(c) that otherwise he acted innocently,
be punished with imprisonment of either description for a term which may extend to 2 (two) years, or with fine, or with both, and in case of a second or subsequent conviction, with imprisonment of either description for a term which may extend to 3 (three) years, or with fine, or with both.

75. Penalty for removal of piece-goods, etc.

If any person removes or attempts to remove or causes or attempts to cause to be removed for sale from any premises referred to in section 68 of this Act, or sells or exposes of sale or has in his possession for sale or for any purpose of trade or manufacture piece goods or cotton yarn or cotton thread which is not marked as required by that section, every such piece and every such bundle of yarn and all such thread and everything used for the packing thereof shall be forfeited to the Government and such person shall be punished with fine which may extend to five thousand taka.

76. Penalty for falsely representing a trademark as registered.

(1) If any person makes any representation-

(a) with respect to a mark not being a registered trademark, to the effect that it is a registered trademark; or

(b) with respect to a part of a registered trademark not being a part

separately registered as trademark, to the effect that it is separately registered as a trademark; or

(c) to the effect that a registered trademark is registered in respect of any goods or services in respect of which it is not in fact registered; or

(d) to the effect that the registration of a trademark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the Register, the registration does not in fact give that right; he shall be punished with imprisonment for a term which may extend to 1 (one) year but not less than 6 (six) months, or with fine which may extend to taka 1 (one) lac but not less than 50 (fifty) thousand, or with both.

(2) For the purposes of this section, the use in Bangladesh in relation to a trademark of the word "registered", or of any other expression referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the Register, except-

(a) where that word or other expression is used in direct association with other words delineated in characters at least as large as those in which that word or other expression is delineated and indicating that the reference is to registration as a trademark under the law of a country outside Bangladesh being a country under the Act of which the registration referred to is in fact in force; or

(b) where that other expression is of itself such as to indicate that the reference is to such registration as is mentioned in clause (a) of this sub-section; or

(c) where that word is used in relation to a mark registered as a trademark under the law of a country outside Bangladesh and in relation solely to goods or services, to be exported to that country.

77. Penalty of improperly describing a place of business as connected with the Trademarks office.

If any person uses on his place of business, or on any document issued by him, or otherwise, words which would reasonably lead to the belief that his place of business is, or is officially connected with, the Trademark Office, he shall be punished with imprisonment of either description for a term which may extend to one year but not less than 6 (six) months, or with fine which may extend to taka 1 (one) lac but not less than 50 (fifty) thousand, or with both.

78. Penalty for falsification of entries in the Register.

If any person makes, or causes to be made, a false entry in the Register, or a writing falsely purporting to be a copy of an entry in the Register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be punished with imprisonment for a term which may extend to 1 (one) year but not less than 6 (six) months, or with fine, which may extend to taka 1 (one) lac but not less than 50 (fifty) thousand taka, or with both.

79. Forfeiture of goods.

(1) Where a person is convicted of an offence under section 73 or section 74 of this Act, or is acquitted of an offence under section 73 of this Act on proof that he acted without intent to defraud, or under section 76 of this Act on proof of the matters specified in clauses (a), (b) and (c) of that section, the court convicting or acquitting him may direct the forfeiture to Government of all goods and things by means of, or in relation to, which the offence has been committed, or but for such proof as aforesaid would have been committed.

(2) When forfeiture is directed on a conviction, and an appeal lies against the conviction, an appeal shall lie against the forfeiture also.

(3) When a forfeiture is directed on an acquittal and the goods or things to which the direction relates are of value exceeding five hundred taka, an appeal against the forfeiture may be preferred, within thirty days from the date of the direction, to the Court to which in appealable cases appeals lie from sentences of the Court which directed the forfeiture.

(4) When forfeiture is directed on a conviction the Court, before whom the person convicted, may order any forfeited article to be destroyed or otherwise disposed of as the Court thinks fit.

80. Unintentional contravention of the law relating to marks and description.

Where a person is accused of an offence under section 73 of this Act and proves.

(a) that in the ordinary course of his business he is employed on behalf of other persons to apply trademarks or trade descriptions, or, as the case may be, to make dies, blocks, machines, plates, or other instruments for making, or being used in making, trademarks;

(b) that in the case which is the subject of the charge he was so employed,

and was not interested in the goods or service or other thing by way of profit or commission dependent on the sale of such goods or services or other things, as the case may be;

(c) that the took reasonable precautions against committing the offence charged;

(d) that he had, at the time of the commission of the alleged offence, on reason to suspect the genuineness of the trademark or trade description; and

(e) that on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons on whose behalf the mark or description was applied; the Court may discharge the person from the complaint.

81. Procedure where invalidity of registration is pleaded as a defence by an accused.

(1) When an accused charge with an offence under section 73 or section 74 of this Act in relation to a registered trademark pleads that the registration of the trademarks is invalid, the following procedures shall be followed—

(a) if the Magistrate is satisfied that such defence is prima facie tenable, he shall not proceed with the charge but shall 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 on the ground that the registration is invalid.

(b) if the accused proves to the Magistrate that he has made such application within the time so limited or such further time as the Magistrate may for sufficient cause allow, the further proceedings in the prosecution shall be stayed by the Magistrate till the disposal of such application for rectification and of the appeal, if any, there from.

(c) if within a period of three months or within such extended time as may be allowed by the Magistrate, the accused fails to apply to the High Court Division for rectification of the Register, the Magistrate shall proceed with the case as if the registration were valid.

(2) Where before the institution of a complaint of an offence referred to in section 73 or 74, any application for the rectification of the Register concerning the trademark in question on the ground of invalidity of the registration thereof has already been properly made to and is pending before the Tribunal, the Magistrate shall stay the further proceedings in the prosecution pending the disposal of the application

aforesaid and shall determine the charge against the accused in conformity with the result of the application for rectification in so far as the complainant relies upon the registration of his mark.

82. Offences by companies.

(1) If the person committing an offence under this Act is a company, the company as well as every person in charge of and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly.

(2) Notwithstanding any things contained in sub-section (1) if the person conducting the business of the company proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence, no measurers shall be taken against him.

(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 consent or connivance of, or that the commission of the offence is attributable to any neglect on the part of, any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer of the company shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation: For the purposes of this section, -

(a) "company" means any body corporate and includes a firm or other association of individual; and

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

83. Cognizance of certain offences-

(1) No court shall take cognizance of an offence under section 76 or section 77, or section 78 of this Act except on a complaint in writing made by the Registrar or any officer authorised by him in this behalf.

(2) No Court inferior to that of, 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), in imposing any fine to any person under this Act,

the Metropolitan Magistrate, or the Magistrate of the first class shall impose any fine mentioned in this Act.

84. Evidence of origin of goods imported by sea

In the case of goods brought into Bangladesh by sea, evidence of the port of shipment shall, in a prosecution for an offence under this Act or section 15 of the Customs Act, 1969 (Act IV of 1969), be prima facie evidence of the place or country in which the goods were made or produced.

85. Costs of defence or prosecution.

(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 all the circumstances of the case and the conduct of the parties.

(2) Such costs shall, on application to the Court, be recoverable as if they were a fine recoverable under section 386 of the Code of Criminal Procedure, 1898 (Act V of 1898).

86. Limitation of prosecution.

No prosecution for an offence under this Act shall be commenced after the expiration of three years next following the commission of the offence charged or two years the discovery thereof by the prosecutor, whichever expiration first happens.

87. Information as to commission of offence.

An officer of the Government whose duty it is to take part in the enforcement of this Act shall not be compelled in any Court to say whence he got any information as to the commission of any offence under this Act.

88. Punishment for Abetment of any offence committed out of Bangladesh.

If any person, being within Bangladesh, abets the commission of any act out side Bangladesh, which, if committed in Bangladesh, would, be an offence under this Act, he may be tried for such abetment in any place in Bangladesh in which he may be found, and be punished therefore with the punishment to which he would be liable if he had himself committed in that place the act which he abetted.

89. Authority of the Government to issue instruction.

(1) The Government may, by notification in the official Gazette, issue

instructions for observance by Criminal Courts in giving effect to any of the provisions of this Act.

(2) Instructions under sub-section (1) may provide, among other matters, for the limits of variation, as regards number, quantity, measure, gauge or weight, which are to be recognized by Criminal Courts as permissible in the case of any goods or services.

CHAPTER XI MISCELLANEOUS

90. Implied warranty on sale of marked goods.

-If-

- (a) a trademark or mark or trade description is applied on the sale or in the contract for the sale of any goods or services, and
- (b) anything contrary is expressed in some writing signed by or on behalf of the seller at the time of the sale or contract for the sale, the seller shall be deemed to warrant that the mark is a genuine mark, not counterfeit mark or the trade description is not a false trade description within the meaning of section 2(8).

Explanation: For the purposes of this section "Counterfeit mark" means a trademark without authorization-

- (a) which-
 - (i) is used on any goods, packaging or any service,
 - (ii) is identical to the trademark validly registered in respect of such goods or services, or
 - (iii) can not be distinguished in its essential aspects from such trademark; and
- (b) which thereby infringes the rights of the owner of the trademark under this Act.

91. Procedure and powers of Registrar.

(1) In all proceedings under this Act before the Registrar, the Registrar shall have all the powers of a Civil Court for the purposes of receiving evidence, administering oaths, enforcing the attendance of witnesses, compelling the discovery and production of documents and issuing commissions for the examination of witnesses.

(2) Evidence shall be given by affidavit, provided that the Registrar may, if he thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit.

(3) Subject to the provisions of section 93, the Registrar shall not exercise any power vested in him by this Act or the rules made there under without giving such party an opportunity of being heard and if required, a written notice in this regard shall be send within the time prescribed by him.

(4) The Registrar may, save as otherwise expressly provided in this Act,

and any rule made in this behalf make such orders as he considers reasonable, and any such order shall be executable as decree of a Civil Court.

(5) The Registrar may on any application made to him in the prescribed manner, or, of his own motion, review his own decision on the ground of discovery of new and important matter of evidence which, after the exercise of due diligence, was not within the knowledge of or could not be produced by, the applicant, at the time when the order was made, or on account of some mistake or error apparent on the face of the record.

92. Death of a party to a proceeding.

If a person, who is a party to a proceeding under this Act, dies pending the proceeding, the Registrar may, on request, And on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceeding 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 successor-in-interest.

93. Extension of time.

(1) If the Registrar is satisfied on application made to him in the prescribed manner that there is sufficient cause for extending the time he may subject to such condition as to costs or otherwise as he may think fit to impose, extend the time and notify the parties accordingly: Provided that no extension of time shall be granted where time is expressly provided in this Act or the rules made there under.

(2) Nothing in sub-section (1) shall be deemed to require the Registrar to hear the parties before disposing of an application for extension of time.

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

94. Abandonment.

-Where an applicant is in default in the prosecution of an application made under this Act, the Registrar may, by notice, require the applicant to remedy the default within a time specified any after giving his, if so desired, an opportunity of being heard, treat the application as abandoned, unless the default is remedied within the time specified in

the notice.

95. Procedure before the Government.

-In all proceedings under this Act before the Government, evidence shall be given by affidavit, provided that the Government may, if it thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit, and shall for that purpose have all the powers of a Civil Court.

96. Suit for in infringement, etc., to be instituted before District Court.

-No suit-

- (a) for the infringement of a registered trademark;
- (b) relating to any right in a registered trademark;
- (c) relating to any corrected right in registered trademark; and
- (d) for passing off arising out of the use by the defendant of any trademark which is identical with, or, deceptively similar to, the plaintiff's trademark, whether registered or unregistered; shall be instituted in any court inferior to a District Court having jurisdiction to try the suit.

97. Relief's in suits for infringement or passing off.

(1) The relief which a Court may grant in a suit for infringement or passing off referred to in section 96 of this Act includes an injunction and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

(2) Notwithstanding anything contained in sub-section (1), the Court shall not grant relief by way of damage or an account of profits in any case-

- (a) where in a suit for infringement of a trademark, the infringement complained of is in relation to a certification trademark; or
- (b) where in a suit for infringement the defendant satisfies the court-
 - (i) that at the time he commenced to use the trademark complained of in the suit he was unaware and had no reasonable ground for believing that the trademark of the plaintiff was on the Register or that the plaintiff was a registered user using by way of permitted use; and
 - (ii) that when he became aware of the existence and nature of the plaintiff's right in the trademark, he forthwith ceased to use the trademark in relation to goods or services in respect of which it was registered; or

(c) where in a suit for passing off the defendant satisfies the Court,-
(i) that at the time he commenced to use the trademark complained of in the suit he was unaware and had no reasonable ground for believing that the trademark, of the plaintiff was in use; and
(ii) that when he became aware of the existence and nature of the plaintiffs trademark, he forthwith ceased to use the trademark complained of.

98. Application for rectification of Register to be made to the High Court Division in certain case.

(1) Where in a suit for infringement of registered trademark the validity of the registration of the plaintiff's trademark is questioned by the defendant and the plaintiff questions the validity of the registration of the defendant's trademark, the issue as the validity of the registration of the trademark concerned shall be determined only 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 made to 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 section 51, the Registrar may, refer the application to the High Court Division.

99. Procedure for application for rectification of the Register before the High Court Division.

(1) An application for rectification of the Register made to the High Court Division shall be in such form and shall contain such particulars as may be prescribed.

(2) The provisions of the Code of Civil Procedure shall apply to applications and appeals to the High Court Division under this section.

(3) A certified copy of every order or judgement of the High Court Division or of the Appellate Division, as the case may be, relating to a registered trademark under this section shall be communicated to the Registrar, by that Court and the Registrar shall give effect to the order of the court and shall, when so directed amend the entries in, or rectify, the Register in accordance with such order.

100. Appeals.

(1) No appeal shall lie from any decision, order or direction made or issued under this Act by the Government or from any law or order of the Registrar for the purpose of giving effect to any such decision, order or direction.

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

(3) Every such appeal shall be preferred in the prescribed manner.

(4) The High Court Division in disposing of an appeal under this section shall have the power to make an order which the Registrar could make under this Act.

(5) In an appeal by an applicant for registration against a decision of the Registrar under section 14 or section 15 or section 18, 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 without being liable to pay the costs of the Registrar or the parties opposing his application.

(6) The provisions of the Code of Civil Procedure shall, subject to the provisions of this Act and of the rules made there under, apply to appeals before the High Court Division.

Explanation: "Order" or "decision" of the Registrar under subsection (2) means order or decision which finally determines the rights of the parties and is not merely procedural.

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 all proceedings under this Act.

102. Stay of proceeding where the validity or registration of the trademark is questioned.

(1) Where in any suit for the infringement of a trademark, the defendant pleads that the registration of the plaintiff's trademark is invalid; or the plaintiff pleads the invalidity of the registration of the defendant's trademark, the Court trying the suit hereinafter referred to as the Court, shall-

(a) if any proceedings for rectification of the Register in relation to the plaintiff's or defendant's trademark are pending before the Registrar or the High Court Division, stay the suit pending the final disposal of such proceedings.

(b) if no such proceedings are pending and the Registrar is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trademark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of 3 (three) months from the date of 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 proves to the Court that he has made any such application as is referred to in clause (b) of sub-section (1) within the time specified therein or within such extended time as the Court may, for sufficient cause, allow, the trial of the suit shall be stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the Court may allow, the issue as to the validity of the registration of the trademark concerned shall be deemed to have been abandoned and the Court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceeding referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the Court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trademark.

(5) The stay of a suit for the infringement of a trademark under this section shall not preclude the Court making any interlocutory order including any order granting an injunction, directing accounts to be kept, appointing a receiver or attaching any property, during the period of

the stay of the suit.

103. Right of appearance of Registrar in legal proceedings.

(1) The Registrar shall have the right to appear and be heard in any suit or other legal proceedings in which the relief sought includes alteration or rectification of the Register or in which any question relating to the practice of the Trademarks Registry is raised.

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

(a) where the appeal is not opposed, and the application is either refused by the Registrar or is accepted by him 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 for the public interest.

(3) Unless the High Court Division otherwise directs, the Registrar may, in lieu of appearing, submit a statement in writing, signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue, or of the grounds of a decision given by him affecting it, or of the practice of the Trademarks Registry in like cases, or of other matters relevant to the issues and within his knowledge as Registrar, and such statement shall be evidence in the proceeding.

104. Costs of Registrar in proceedings before High Court Division.

In all proceedings under this Act before the High Court Division the costs of the Registrar shall be in the discretion of the High Court Division, but the Registrar shall not be ordered to pay the costs of any of the parties.

105. Registered user to be impleaded in certain proceeding.

(1) In every proceeding under Chapter VII or under section 100 of this Act, every registered user of a trademark using by way of permissive use, who is not himself an applicant in respect of any proceeding under that Chapter or section shall be made a party to the proceeding.

(2) Notwithstanding anything contained in any other law, a Registered user so made a party to the preceding shall not be liable for any costs unless he enters an appearance and takes part in the proceeding.

106. Evidence of entries in Register and things done by Registrar.

(1) A printed or written copy of any entry in the Register or of any document referred to in section 116(1) purporting to be certified by the Registrar and impressed with the seal of the Trademarks Registry, shall be admitted in evidence in all Courts and in all proceedings without further proof or production of the original.

(2) Any entry or matter certified by the Registrar being authorised under this Act or rules made there under shall be the final evidence of having been contents thereof.

107. Registrar and other officers cannot be compelled to produce Register.

The Registrar or any other officer of the Trademarks Registry shall not, in any legal proceeding to which he is not a party, be compellable to produce the Register or any other document in his custody, the contents of which can be proved by the production of a certified copy issued under this Act or to appear as a witness to prove the matters therein recorded unless ordered by the Court for special cause.

108. Power to require goods or services to show indication of origin.

(1) The Government may by notification in the official Gazette, require that-

(a) an indication of goods or services which are supplied or imported into Bangladesh and produced and manufactured beyond the limits of Bangladesh, or

(b) an indication of goods or services which are produced or manufactured within the limits of Bangladesh or,

(c) an indication of the name of country or place of the manufacture, producer or supplier or the persons for whom the goods or services were manufactured or produced. shall be applied to the goods or services from such date as may be appointed by the notification not being less than 3 (three) months from its issue.

(2) The notification may specify the manner, time occasions or necessity of the indication mentioned in sub-section (1).

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

(a) any application is made for its issue by persons or associations, suppliers or users of the goods or services concerned, or

(b) the Government is otherwise convinced that it is necessary in the

public interest to issue the notification, with or without such inquiry as the Government may consider necessary.

(4) No notification under this section shall be issued without complying with the provisions of section 23 of the General Clauses Act. 1897 (Act X of 1897).

(5) A notification under this section shall not apply to goods made or produced, or, to services supplied from beyond the limits of Bangladesh and imported into Bangladesh, if in respect of those goods or services, as the case may be, the Commissioner of Customs exercising jurisdiction at the port of entry of the goods or services, is satisfied at the time of importation that they are intended for exportation whether after transshipment in or transit through Bangladesh or otherwise.

109. Power to require information in respect of imported goods bearings false trademarks.

(1) Where goods, which are prohibited to be re-imported into Bangladesh under clause (d), clause (e) or clause (f), of section 15 of the Customs Act 1969 (Act IV of 1969), and are liable to detention and confiscation on importation under that Act, are imported into Bangladesh, the Commissioner of Customs exercising jurisdiction at the port of entry of the goods, if, upon representation made to him, has reason to believe that the trademark complained of is used as a false trademark, may require the importer of the goods, or his agent, to produce any documents in his possession relating to the goods and to furnish information as to the name and address of the person by whom the goods were consigned to Bangladesh and the name and address of the person to whom the goods were sent in Bangladesh.

(2) The importer or his agent shall, within 14 (fourteen) days from the date of receipt of the order of the Commissioner under sub-section (1) of his section, comply with the requirement as aforesaid and if he fails to do so, he shall be punished with fine which may extend to 5 (five) thousand taka.

(3) Any information obtained from the importer of the goods or his agent under this section may be communicated by the Commissioner of Customs to the registered proprietor or registered user of the trademark which is alleged to have been used as a false trademark.

110. Certificate of validity.

If in any legal proceeding in which the validity of the registration of a trademark comes into question, a decision is given in favour of the proprietor of the trademark, the Tribunal may grant a certificate to that effect, and if such a certificate is granted, then in any subsequent legal proceeding in which the said validity comes into question, the said proprietor on obtaining a final order or judgement in his favour shall, unless the said final order or judgement for sufficient reason directs otherwise, be entitled to his full cost, charges and expenses as between legal practitioner and client.

111. Address for service of notice.

– An address for service stated in an application, or notice of opposition shall, for the purposes of the application or notice of opposition, be deemed to be the address of the applicant or opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at or sending by post to the address for service of the applicant or opponent.

112. Trade usage, etc. to be taken into consideration.

– In any suit or other proceeding relating to a trademark, the Tribunal shall admit evidence of the usage of the trade concerned and of any relevant trademark or trade name or get-up legitimately used by other persons.

113. Agent.

Where any act, other than the making of an affidavit, is required to be done by any person, by or under this Act, the said act may, subject to the rules made in this behalf, be done, in lieu of by that person himself, by duly authorized agent, being either a legal practitioner, or a person registered in the prescribed manner as a trademarks agent, or a person in the sole and regular employment of the principal.

114. Documents not to be registered.

Notwithstanding any thing contained in the Registration Act, 1908. (Act no XVI of 1908) no document declaring or purporting to declare the ownership or title of a person to a trademark other than a registered trademark shall be registered under that Act.

115. Indexes.

There shall be kept under the direction and supervision of the Registrar.–

- (a) an index of registered trademark;
- (b) an index of trademarks in respect of which applications for registration are pending;
- (c) an index of the names of the proprietors of registered trademarks; and
- (d) an index of the names of registered users.

116. Documents open to public inspection.

(1) Save as otherwise provided in sub-section (6) of section 45, the following documents shall, subject to such conditions as may be prescribed, be open to public inspection at the Trademarks Registry—

- (a) the Register, and any document upon which any entry in the Register is based;
- (b) every notice of opposition to the registration of a trademark, application for rectification before the Registrar, counter-statement thereto, and any affidavit or document filed by the parties in any proceedings before the Registrar;
- (c) all regulations deposited under section 61 and all applications under section 65 for varying such regulations;
- (d) the indexes mentioned in section 115; and
- (e) such other documents as the Government may, by notification in the official Gazette, specify.

(2) Any person may, on application to the Registrar and on payment of such fees as may be prescribed, obtain a certified copy of entry in the Register or any document referred to in sub-section (1) of this section.

117. Fees.

(1) There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed by the Government.

(2) When a fee is payable in respect of the doing of an act by the Registrar, the Registrar shall not do that act until the fee has been paid.

(3) Where a fee is payable in respect of the filing of a document at the Trademarks Registry, the document shall be deemed not to have been filed at the Registry until the fee has been paid.

118. Exemption, etc.

(1) Nothing in this Act shall be construed so as to render liable to any

prosecution or punishment any servant of a master resident in Bangladesh who in good faith obeys in obedience to the instruction of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master and as to the instructions which he has received from his master.

(2) Nothing in this Act shall exempt any person from any suit or other proceeding which might have been brought against him if this Act had not been made.

(3) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any suit or other proceeding, but such discovery or answer shall not be admissible in evidence against such person in any such prosecution for an offence under Chapter X of this Act or clause (d), (e) and (f) of section 15 of the Customs Act, 1969 (Act, IV of 1969).

119. Special Provision relating to Convention Countries.

With a view to the fulfillment of a treaty, convention or arrangement with any country which is a member of Paris Convention or World Trade Organization outside Bangladesh which affords to citizens of Bangladesh similar privileges as granted to its own citizens in respect of registration and protection of trademarks, the Government may, by notification in the official Gazette declare such country to be a Convention Country for the purposes of this Act.

120. Special Provision relating to Convention Application.

(1) Where a person has made an application for the registration of a trademark in a Convention Country which is a member of Paris Convention or a member of World Trade Organization and that person, or his legal representative or assignee, make an application for the registration of a trademark in Bangladesh within 6 (six) months after the date in which the application was made in Convention Country together with the full particulars and certified copy of the priority application, the trademark shall, if registered under this Act, be registered as of the date on which the application was made in the Convention Country and that date shall be deemed for the purposes of this Act to be the date of registration.

(2) Where applications have been made for the registration of a trademark in two or more Convention Countries, the period of 6 (six) months referred to in sub-section (1) shall be reckoned from the date on which the earliest

of those applications was made.

(3) Nothing in this Act shall entitle the proprietor of a trademark to recover damages for infringement which took place prior to the date of application for registration under this Act.

121. Provision as to reciprocity.

Where any country specified by the Government in this behalf by notification in the official Gazette does not accord to citizens of Bangladesh the same rights in respect of the registration and protection of the trademarks as it accords to its own nationals no national of such country shall be entitled, either solely or jointly with any other person

(a) to apply for the registration of, or be registered as the proprietor of a trademark in the Register; or

(b) to be registered as the assignee of the proprietor of a registered trademark; or

(c) to apply for registration or be registered as a registered user of a trademark under section 45 of this Act.

122. Provisions relating to collective marks.

Except as otherwise expressly provided for by this Act or any other law for the time being in force, the provisions of this Act shall as far as may be made applicable apply to a collective mark.

123. Use and application of information and communication technology.

(1) All notices, advertisements, order and other matters including instructions to be used may be published in the electronic Gazette, and all the records which shall be made available to the public through electronic circulation, may be made available through electronic circulation and the Registrar shall take necessary steps to do so with prior approval of the Government.

(2) The manner and procedure in respect of publishing the electronic Gazette or of using electronic circulation method shall be prescribed by the Government.

Explanation: for the purposes of this Act, "electronic circulation" means on line processing of data and information directly on website through the internet.

(3) Matters described in this section shall be regulated, as far as

practicable, by the Information and Communication Technology Act, 2006 (Act XXXIX of 2006) and rules and regulations issued there under.

124. To make rules.

(1) The Government may by notification in the official Gazette, make rules to carry out the purposes of this Act.

(2) In particular, and without prejudice to the generality of the forgoing power, such rules may—

(a) prescribe the classification of goods or services according to international classification for the purpose of the registration of trademarks, and empower to amend the Register so far as may be necessary for the purpose of adapting the entries therein;

(b) require the making of duplicated trademarks and other documents connects therewith;

(c) provide for securing and regulating the publication, sale or distribution of copies of trademarks and other documents connected there with;

(d) make arrangement to amend the entries in the Register;

(e) prescribe the conditions and restrictions subject to which the Register may be inspected;

(f) prescribe the form of certificates of registration;

(g) make provisions regarding not to accept any application under section 44(1);

(h) prescribe the further documents, information or evidence to accompany an application under sub-section (1) of section 45(1);

(i) prescribe classes of goods as textile goods for the purpose of section 66;

(j) regulate the awarding of costs by the Registrar under section 91;

(k) prescribe the conditions subject to which an agent referred to in section 113 may act;

(l) prescribe all the fees to be paid under this Act;

(m) provide for the establishment of branches of the Trademark Registry when expedient for facilitating the working of this Act, and for preparing copies of the Register to be kept at such breach offices;

(n) prescribe the manner in which, in proceedings under this Act, before the Government on the Registrar, applications shall be made, notice given and matters advertised;

(o) prescribe the times or periods required by this Act to be prescribed;

(p) provide for regulating the business of the Trademarks Registry and its branches and for regulating all things by this Act placed under the

direction or control of the Government or the Registrar;

(q) provide for the number of samples to be selected for the purpose of section 70;

(r) provide for the manner in which cotton yarn and cotton thread shall be marked and the exemption of certain premises from the provisions of that section;

(s) prescribe the classes of goods included in the expression piece-goods, such as are ordinarily sold by length or by the piece for the purposes of section 69;

(t) provide for the use of public communication and information technology for the fulfillment of the purpose of section 23;

(u) provide for any other matter which is required to be or may be prescribe.

125. Reports regarding trade marks to be placed before parliament.

The Government shall cause to be placed before parliament on or before the 31 day of March every year a report respecting the services of the Trademark Registry for the previous year ending on the 31 day of December of that year.

126. Publication of English Text.

The Government shall, after the commencement of this Act, by notification in the official Gazette, publish the English version of the Bengali Text of this Act which shall be called the Authentic English Text of this Act : Provided that, in the event of conflict between the Bengali and English Text, the Bengali text shall prevail.

127. Repeals and Savings.

(1) The Merchandise Marks Act, 1889 (Act IV of 1889) and the Trademarks Act, 1940 (Act V of 1940) here-in-after referred to as repealed Acts are hereby repealed.

(2) Notwithstanding such repeal any act done or any rule made or any order, notice, notification or advertisement issued or any application in respect of registration or any trademark pending, or registration issued or any other measures or proceedings taken or commenced under the repealed Acts, subject to consistence with the provisions of this Act shall have effect until repealed or amended and shall be deemed to be done, made, issued or commenced under the corresponding provisions of this Act.

128. Special provisions relating to savings.

(1) Any act done or action taken under the Trademark Ordinance, 2008 (Ordinance No. 2 of 2008) and the Trademark Ordinance, 2009 (Ordinance No. 5 of 2009), here-in-after referred to as the two Ordinances shall be deemed to have done or taken under this Act.

(2) Notwithstanding ceasing to have effect of the two Ordinances in pursuance of clause (2) of Article 93 of the Constitution of the People's Republic of Bangladesh, if after such ceasing any act is done or action taken in continuity of those Ordinances or in the continuity to be construed shall be deemed to have done or taken under this Act.