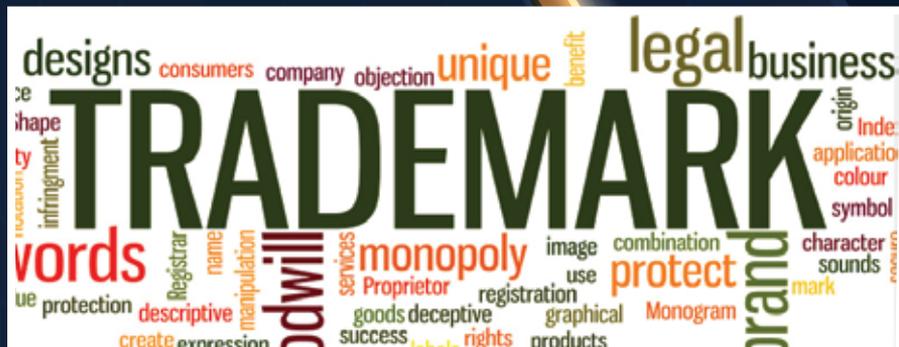
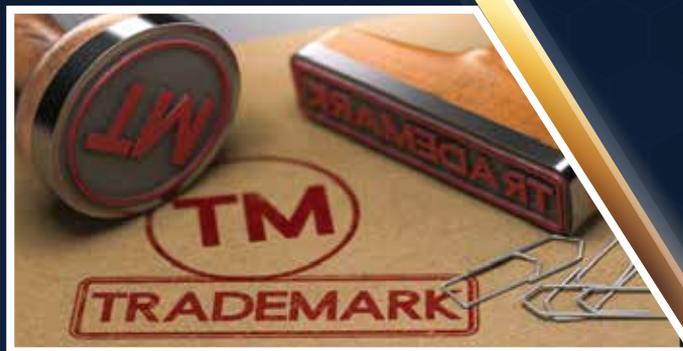




Government of the People's Republic of Bangladesh  
WTO Cell, Ministry of Commerce

**Bangladesh Regional Connectivity Project-1**  
Probashi Kollayan Bhaban  
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Policy Review/Policy Study/Policy Paper Preparation  
on  
The Trademarks Act, 2009



# Policy Review/Policy Study/Policy Paper Preparation

on

## The Trademarks Act, 2009

[Package no. BRCP-1/MOC/SD-26]

### Submitted to

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**First Draft Submission:** 02 June 2022

**Second Draft Submission:** 26 June 2022

**Third Draft Submission:** 22 August 2022

**Final Report Submission:** 24 October 2022

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## Preface

The review paper intends to respond to the requirement according to the provision of the contract agreement signed between Bangladesh Regional Connectivity Project-1 (BRCP 1) and the South Asian Network on Economic Modeling (SANEM) for conducting **“Policy Review/Policy Study/Policy Paper Preparation under the Bangladesh Regional Connectivity Project 1)”** in collaboration with International Development Association (IDA), The World Bank. The objective of this technical assistance project is to review the existing government policies related to trade to strengthen cooperation in trade, transport, and transit facilities and facilitate the economic empowerment of women traders. The ongoing context and challenges are compared with the existing policies. It has also analysed the best practices of regional comparators to promote and improve trade-related activities as well as the relevance of SHE trade with the existing policies. Finally, based on the findings, the recommendation for future policy has been identified.

Consultancy services for conducting the **“Policy Review/Policy Study/Policy Paper Preparation under the Bangladesh Regional Connectivity Project 1)”** was provided by the South Asian Network on Economic Modeling (SANEM), Bangladesh. The study team consists of four senior-level experts. The major objective of the study is to depict a clear picture of the current situation state of the implementation of the policies, and challenges for upcoming LDC graduation to provide the suggestion for future policies. Furthermore, Reviewing and identifying the gaps in the existing policies were also aimed to be found for this study.

Various issues have been identified upon the careful review of the Trademarks Act, 1911 which includes an overview of the current application system for Trademarks, enforcement ability, TRIPS issues and whether the Act is TRIPS compliant or not, post-graduation challenges, and the need to further amend some significant provisions of the Act.

We hope that the policy recommendations would be helpful for the policymakers and other relevant stakeholders for the further development of the Act.

**Md. Mijanur Rahman**

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Ministry of Commerce

## Acknowledgements

It is indeed a great pleasure that Bangladesh Regional Connectivity Project 1 (BRCP-1), Ministry of Commerce has entrusted International Development Association (IDA), and the World Bank to carry out “Policy Review/Policy Study/Policy Paper Preparation”. The report of the study has been prepared based on a mixed methodology. The studies are 1) SME Policy 2019 2) Trademark Act 2009, and 3) Geographical Indication of Goods (Registration & Protection) Act 2013.

The policy papers contain the objective, scope, and methodology for the studies, current context, and challenges, deviation from the international practices, and the relevance of the policies to the SHE trade. The consultants also described the best practices of regional countries adapted to facilitate trade-related activities. In the end, the findings from the analysis and recommendations for the upcoming policy papers are portrayed. The authors wish to thank Md Mijanur Rahman, Project Director, Bangladesh Regional Connectivity Project 1, and Md Munir Chowdhury, National trade expert, BRCP-1 for their valuable comments and continuous support in undertaking the study.

We are also thankful to all the officials and participants who took part in the consultation meetings, both online and in-person, for helping us with their constructive criticism and valuable suggestions during the study period.

This work would not have been possible without the participation of the relevant stakeholders in the Key Informant Interviews (KIIs). Thanks are also due to all respondents of interviews and KIIs who helped us by providing their information during the data collection period.

The contribution and support provided by everyone for the study are greatly appreciated.



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## List of acronyms

<i>4IR</i>	<i>4th Industrial Revolution</i>
<i>BIM</i>	<i>Bangladesh Institute of Management</i>
<i>BLPA</i>	<i>Bangladesh Land Port Authority</i>
<i>BRCP</i>	<i>Bangladesh Regional Connectivity Project</i>
<i>DPDT</i>	<i>Department of Patents, Designs and Trademarks</i>
<i>DFQF</i>	<i>Duty-free Quota-free</i>
<i>EU</i>	<i>European Union</i>
<i>FY</i>	<i>Fiscal Year</i>
<i>GI</i>	<i>Geographical Indications</i>
<i>GoB</i>	<i>Government of Bangladesh</i>
<i>GDP</i>	<i>Gross Domestic Product</i>
<i>ICT</i>	<i>Information and Communication Technology</i>
<i>IPR</i>	<i>Intellectual Property Right</i>
<i>IP</i>	<i>Intellectual Property</i>
<i>KII</i>	<i>Key Informant Interview</i>
<i>LDC</i>	<i>Least Developed Country</i>
<i>MoC</i>	<i>Ministry of Commerce</i>
<i>Mol</i>	<i>Ministry of Industries</i>
<i>MOPA</i>	<i>Ministry of Public Administration</i>
<i>NBR</i>	<i>National Board of Revenue</i>
<i>NGO</i>	<i>Non-Governmental Agency</i>
<i>STEM</i>	<i>Science, Technology, Engineering, and Mathematics</i>
<i>SME</i>	<i>Small and Medium Enterprise</i>
<i>SANEM</i>	<i>South Asian Network on Economic Modeling</i>
<i>TRIPS</i>	<i>Trade-Related Aspects of Intellectual Property Rights</i>
<i>UNCTAD</i>	<i>United Nations Conference on Trade and Development</i>
<i>UMIC</i>	<i>Upper Middle-Income Country</i>
<i>WIPO</i>	<i>World Intellectual Property Organization</i>
<i>WTO</i>	<i>World Trade Organization</i>

## Executive Summary

The Government of Bangladesh (GoB) has initiated the Bangladesh Regional Connectivity Project 1 (BRCP-1) in collaboration with the International Development Association (IDA) and the World Bank to improve regional connectivity and facilitate trade. The Ministry of Commerce (MoC) is responsible for the second phase of this umbrella project. The fundamental goal of this component of the technical assistance project is to review existing trade policies, the legislation related to trade, strengthen trade-related institutional capacity, ensure active and long-term cooperation among relevant stakeholders, and assist women entrepreneurs to achieve economic empowerment. Bangladesh is also on the verge of graduating from the LDC category in 2026, necessitating a review of present trade-related policies in order to ensure a smooth transition to post-graduation trade performance. Effective creation and execution of trade and trade-related policies are required during the preparatory phases of graduation.

As a part of this project, we have conducted a thorough review of the Trademarks Act, 2009 using a mixed methodology. This review paper has identified significant aspects of this Act, implementation challenges, compliance with the international treaty, and its relevance to the current global trade and business scenarios. This review has also compared the trademarks laws of Bangladesh with some of the significant success cases in formulating and implementing the trademarks laws of India, Malaysia and Indonesia.

Legislation formulation and enactment is a time-consuming process that requires extensive research and continual contact with stakeholders. According to our major results, the provisions of the existing Act have been properly considered. However, the policy's effectiveness is hindered by a lack of coordination, enforcement capability, and monitoring. Furthermore, the existing Act fails to take into consideration the dynamic of trade and industry realities (COVID-19 recovery, 4IR, LDC graduation, 8th Five-Year plan, Perspective Plan 2021-2041). Given Bangladesh's anticipated graduation from the LDC bracket in 2026 and the requirement for a WTO and strong TRIPS-compliant trademark system, some crucial issues are not addressed in the Act.

Section two of this review paper gives an overview of the history and evaluation of the global as well as domestic formulation of trademarks, as well as the necessity of enacting a trademarks act. This section also summarizes the whole trademarks act, which was enacted in 2009. This section additionally includes an overview of the administrative authority (DPDT) and its current activities in terms of accepting or rejecting trademarks from both foreign and domestic applications, as well as application procedures and fee structure. This large section also covers specific bottlenecks in the existing act's implementation and enforcement, as well as limitations in the DPDT and the act's conformity with the international treaty, particularly TRIPS. This section contains the economic and social implications of trademarks, as well as the issues that the act may encounter as a result of the country's upcoming economic transition to a developing country. In this section, global best practices are discussed, as well as lessons that can be applied to improve and upgrade Bangladesh's trademarks legislation.

Section three of this review identifies the relationship of the Act with the SHE trade. Women's entrepreneurship and the building of a brand have expanded in Bangladesh; yet, women are

still denied access to the financial and social recognition necessary to establish themselves as entrepreneurs. In the framework of the country's socioeconomic system, women are discouraged from continuing with a new concept and market branding. Though the trademarks act is ostensibly gender-neutral, IP law has often put women at a disadvantage position.

Some specific recommendations have been suggested for a proper formulation and efficient implementation of future trademark laws in section four. The provisions of the existing Act must be revisited and tailor-made to be strong TRIPS compliant as Bangladesh is soon to be graduated from the LDC bracket. TRIPS Agreement requires members to comply with certain “minimum standards” for the protection of IPR Bangladesh has been able to comply with the TRIP agreement. However, in many cases, the principle of TRIPS compliance poses the question of whether Bangladesh is capable of protecting IPR as specified by the TRIPS, and the answer is no. The administrative capacity of DPDT and copyright office is very much vulnerable due to the manual system, and shortage of officers, staff, and experts on IP. For combating administrative weakness, the digitalization of the governing authority will help to provide better services within the shortest possible time. In order to become a WTO focal point after adopting the Madrid Protocol, the DPDT must reform in terms of filling scarce resources through coordination with international trade organizations.

IP in Bangladesh faces several challenges in ensuring its proper protection. Each IP has separate legislation to protect it, but there is no administrative body to coordinate all IP laws. Therefore ambiguities among the different IP laws are hindering IP implementation. By the same token, trademarks are one of the IP protection, but they have comparable inadequate enforcement and implementation, and many provisions are absent to put into effect. Further, there is no specialized court to deal with IP matters. Also, no uniform appellate authority is in operation. As Bangladesh moves away from being an LDC, it will be necessary to maintain strong IP enforcement in order to protect the rights holders. This will necessitate a special focus on enforcing IP violations. To improve the enforcement of IP, a special tribunal for IP-related matters must be developed.

DPDT offices are centralized which in turn impacts people's access to trademark protection. The prospect of decentralizing the existing trademark office must be studied. Establishing a number of IP offices in different regions of the country under the central trademarks office needs to take into account in order to facilitate the inclusive IP service. People are unaware of the importance of trademark registration and the consequences of violating it. In Bangladesh's socio-economic framework, copying is not deemed ethically reprehensible. A cooperation plan between the government and NGOs is required to minimize the public's reluctance to know about the trademarks. Mass awareness building initiatives regarding IPRs, e.g., seminars, symposiums, and workshops should be arranged regularly and the academic and training institutions should include trademarks and other IPRs in their curriculum.

# 1. Introduction

## 1.1 Background

A trademark is any sign, symbol, word, number, or phrase of a product that allows its owners the exclusive right to distinguish their goods and services from that of others (WIPO, 1993). In a country, trademark protection right is a common practice that is necessary for smooth industrial and economic development (Erixon et al., 2015). Trademarks, in a broader sense, encourage effort and entrepreneurship by rewarding trademark owners with recognition and financial benefit (DPDT, 2014). The Same source argues that trademark protection also prevents unfair rivals, such as counterfeiters, from using similar unique indications to promote inferior or different goods or services. The system enables skilled and enterprising individuals to manufacture and market goods and services under the most equitable circumstances possible, encouraging international commerce (WIPO, 1999). Hence, in Bangladesh trademark protection is ensured under the trademark act, 2009 which come into force in July 2008. However, the Trademark Rules 1963 is also operative along with the act which is very poor statutory support in case of ensuring trademark protection, therefore, the present act fails to fulfil the demands of the present digital-based society (Hossain, 2012).

In the context of the increasing growth of global trade, businesses require individual trademarks to retain goodwill among customers over time. Due to the relationship between trade and intellectual property rights (IPR), the Trade-Related Aspect of Intellectual Property Rights (TRIPS) under the World Trade Organization (WTO) agreement established a "global system of governing the ownership and flow of intellectual properties (Sayeed, 2016). Under the TRIPS agreement, the WTO member country is obliged to articulate the Intellectual Property (IP) regime for maintaining a comprehensible standard of the global IP regime including for trademarks. Bangladesh is the signatory country of the TRIPS agreement under the WTO since 1995, the World Intellectual Property Organization (WIPO) and the Paris Convention for the Protection of Intellectual Property Rights. The Trademarks act, 2009 is the harmonizing items that comply with TRIPS for ensuring the uniform IP law<sup>1</sup>. The reason to replace the trademarks act, 1940 with the new trademarks act, 2009 is to bring the trademarks arrangement of Bangladesh in compliance with the standard set by the TRIPS agreement and validate the revised provisions of the Paris Convention for the Protection of Industrial Property (Islam, 2009).

The new law is enacted to ensure the protection of entrepreneurs and comply with the TRIPS agreement for maintaining the uniform IP regime among the WTO member countries. However, this law is not free from the criticisms of IP experts and academicians, especially in terms of standard protection and enforcement measures provided for the owners of trademarks or service marks (Chowdhury et al., 2019). It is also pertinent to note that the Act is very silent regarding the digital-based business or e-commerce community (Shahabuddin, 2013). The amended Trademark Act 2015, was announced by a gazette notification on

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<sup>1</sup>[https://www.khuranaandkhurana.com/2017/05/15/trademark-law-bangladesh-an-abridgment/?utm\\_source=Mondaq&utm\\_medium=syndication&utm\\_campaign=LinkedIn-integration](https://www.khuranaandkhurana.com/2017/05/15/trademark-law-bangladesh-an-abridgment/?utm_source=Mondaq&utm_medium=syndication&utm_campaign=LinkedIn-integration)

November 21, 2015, to address the criticism. Yet, it made a few changes in section 19, most notably by substituting the Ordinance with the act.

As a part of the Government of Bangladesh's (GoB) attempt to liberalize trade, diversifying export items and export destinations, the Bangladesh Regional Connectivity Project 1 (BRCP-1) is initiated in cooperation with the International Development Association (IDA). The project is being jointly implemented by the Bangladesh Land Port Authority (BLPA), the National Board of Revenue (NBR), and the Ministry of Commerce (MoC). The Ministry of Commerce is responsible to implement component two of the umbrella project. The primary objective of this technical assistance project is to improve trade-related institutional capacity to ensure active and sustainable cooperation among stakeholders related to trade and facilitate the economic empowerment of women traders.

The South Asian Network on Economic Modeling (SANEM), has been assigned to provide consultancy services for the selected activities of the technical assistance project, which is to review the existing trade-related policies to strengthen cooperation in trade, transport, and transit facilities. The policy reviews will also address the barriers faced by women traders in becoming more integrated into the global supply chains and trading opportunities. As part of the project, SANEM will review 22 policy documents and critically analyse each of the policies to demonstrate the compatibility, objectives, challenges, future aspects, and possible recommendations for further improvement.

## ***1.2 Objective and research questions***

The research team has primarily dug into the following research questions:

1. Is the act ensuring efficient trademark certification concerning proper protection and registration?
2. Is the act compatible with the COVID-19 pandemic, 4<sup>th</sup> industrial revolution, LDC graduation, and 8<sup>th</sup> five-year plan?
3. What kind of revisions are needed to be done in this 12-year-old act to meet the emerging challenges?
4. What are international best practices in trademark registration that we can follow?
5. What are the bottlenecks of the act and what are the implementation challenges over there?
6. How this act can integrate the SHE trade to influence women entrepreneurs?
7. How to better maintain transparency among the relevant stakeholders including the government, firms, labours, and associations?

## ***1.3 Scope of the study***

Keeping in line with the rapid development of international trade and business and encouraging a harmonious trading system, the need to revise the existing law of the country is imperative. The global trade landscape has evolved dramatically over time, necessitating a reconsideration of the role of the department patent, design and trademarks (DPDT) office and the tasks of the Registrar. The evaluation of this act will assess the DPDT's work in the context of the current global trade landscape and provide possible recommendations to make

the organization more effective. This assessment will also look at the time it takes to deliver a trademark license, which can be reduced in comparison to worldwide best practices. Moreover, Bangladesh will lose the flexibility enjoyed under WTO rules and the TRIPS agreement in certain provisions after the LDC graduation. The act needs to revise to address the challenges that will arise after losing the flexibility in the TRIPS agreement. This Act is now being revised, and this evaluation will aid in conceptualizing categories for modifications so that the act can cope with domestic possible future challenges (8<sup>th</sup> Five-Year plan, UMIC graduation, and second perspective plan of Bangladesh). The constraints and implementation issues will be critically analysed in this policy review, as well as the analysing covers the provisions for promoting inclusive women entrepreneurs.

## **1.4 Methodology**

Intently deeming the aforementioned objectives and the key research questions of this study, the research team primarily used mixed methodologies to present the deliverables. In general, the methodology will be based on two significant tasks:

- (i) Rigorous desk research of all pertinent policy documents, literature, and secondary data will be carried on to understand the existing state of Trademark related works
- (ii) Primary data collection and analysis by managing Key Informant Interviews (KIIs) and Focus Group Discussions (FGDs) with stakeholders apt for the study. The interviews and discussions will be Transcribed and the research team will then go through the transcripts repeatedly and come up with a thematic analysis with findings.

Therefore, the research methodology can be categorised as follows:

### **1.4.1 Desk Research**

The research team has conducted in-depth desk research on the germane elements of the study. The task has comprised different activities. Chiefly, reviewing relevant documents and existing literature on the issues, examining and analysing the available secondary data, identifying potential policy gaps and differences related to Trademarks, and analysing the differences between Bangladesh and the prevailing universal best practices. The research team has focused on reviewing the following documents:

- The Trademark Act 2009 and Trademark Amendment Act 2015 of Bangladesh
- The Trademark Rules 2015 of Bangladesh
- International best practices including Malaysia Trademark Act 2019, India Trademark Act 1999, and Indonesia Trademarks act 2016
- WTO provisions on intellectual property rights, WIPO, and TRIPS documents
- Other relevant government documents

Relevant literature on the topic (Journal article, Newspaper article, Report, Research papers etc)

### **1.4.2 Primary Data collection**

In collecting primary data, the research team followed a qualitative approach. Qualitative data are expected to provide in-depth information on social dimensions and characteristics. As part of the qualitative data, the team has conducted some Key Informant Interviews (KIIs).

### ***Focus Group Discussion (FGD)***

For this study, the research team has conducted one FGD comprising 8-10 participants. The participants of the FGD have been from the Department of Patent, Design & Trademark (DPDT), Ministry of Industry (Mol). To smooth the discussion a semi-structured qualitative checklist for the FGD in line with the objectives of the study has been designed prior to take the FGD. The discussion lasted two hours and covered the entire scenario of trademark implementation, enforcement procedures, and the current state of the DPDT. The key information from the focus group was then analyzed and transcribed, with the key details being used in the study's findings and recommendations.

### ***Key Informant Interview (KII)***

The KIIs will be helpful for an in-depth understanding of the policies, assessment of projects, and identifying gaps. For this particular study, the research team will carry out a total of ten KIIs, with informants from the best possible diversified background. The informants will be comprised of as mentioned in Annexure A.

All KIIs have been conducted in person. Prior to conducting the KIIs, a KII checklist has been prepared, to smooth the interview with the key informants. The checklist will be customized based on the expertise of the target informant and his/her work areas related to the specific objective of the study.

### ***1.5 Organization of the paper***

The policy review paper follows the later-mentioned structure. The context and current challenges of the policy are discussed in Chapter Two. Moreover, the chapter includes the history of the trademarks and the significance of enacting the act, the scenario of the existing act, trade-related provisions, state, and challenges of existing provisions. The chapter also focuses on the trademarks act of different countries and how this act deviates from that. In Chapter Three, the relevance of this trademark act to the SHE trade is discussed. This chapter also illustrates whether the current provisions of the existing policy support gender inclusiveness in trade or not. Chapter Four suggests necessary recommendations and ways forwards to make it a compatible and strong policy considering several issues such as LDC graduation of Bangladesh, changing global trade patterns, WTO guidelines, etc. Finally, this paper marks its end with a concluding remark in Chapter Five.

## **2. Trademarks Act, 2009: Context and Challenges**

### ***2.1 History of Trademarks and Act***

A trademark is a distinguishing mark that identifies certain goods or services as being produced or offered by a specific person or organization. Its origins may be traced back to ancient times when the Roman blacksmiths were the first to utilize the mark as a means of distinguishing their swords<sup>2</sup>. Then subsequently in the middle age, craftsmen replicated their signatures, or "marks," on aesthetic or utilitarian objects. These marks developed over time into today's system of trademark registration and protection.

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<sup>2</sup> <https://www.tmlawworldwide.com/2012/01/03/brief-history-of-trademarks/>

After a long period in which only marks were used to distinguish items, the proclamation regarding the marks became a legal document. The proclamation 'nobody has any right to represent his goods as the goods of somebody else' and 'nobody has any right to pass off his goods as the goods of somebody else' was recognized in the case of *Southern v How*, 1617, where a clothier who had achieved a good reputation by placing his marks on clothes made by him was used by another to defraud and financial gains<sup>3</sup>. Following that, the courts made these principles the law.

## ***2.2 The history of the Trademarks Act of Bangladesh***

The need for a law governing trademark registration and preservation against contravention was recognized, paving the way for Britain's first statutory enactment in 1875. The British Trademark Act of 1875 established a formal registration of trademarks based upon whether the trademark characterised the trader's goods or not. As a result, Registration was regarded as clear evidence of trademark ownership. Subsequently, the Trademark Act of 1875 was abolished and replaced by the Patents, Designs, and Trademark Act of 1883. This Act was later overridden by the Trademark Act of 1905. The Trademark Act of 1938 was the next re-enactment. India adapted the British Trademark Act of 1938 and drafted the first Trademark Act of 1940.

Bangladesh inherited the legal framework on intellectual property (IP) dating back to British-India and the earliest legislation found to protect the trademarks in the penal code 1860. There is some provision in the Penal code 1860 where Trade, Property, and Other Marks” clearly define trademarks, property marks, and false use of these marks along with punishment for using a false trademark or property mark, punishment for counterfeiting a trademark property mark used by another, punishment for counterfeiting mark used by the public servant, and some other relevant offences thereof. However, the act was repealed subsequently and the Merchandise Mark Act, 1889, and the Trademarks Act, 1940 were enacted respectively. After the liberation from Pakistan, the three major law was operative to govern the affairs relating to trademarks. As a result, there was a requirement to bring the scatter act into a single act. Later in 2003. Department of Patents, Designs, and Trademarks (DPDT) was formed under the Ministry of Industry by amalgamating two independently operational offices- the Patent Office and the Trademark Registry Office. The Trademarks Ordinance was promulgated in 2008 and the Trademarks Act was enacted in 2009.

## ***2.3 Overview of the Trademarks act 2009***

The Trademarks Act, 2009 consists of ten chapters, and 128 sections. The act begins with various definitions related to the acts such as Trade definition, false Trade, Trademarks means, and the classification of Trade adopted by the WIPO. Chapter 2 of the act contains provisions concerning the registration of marks, elements needed for a “Trade” to fit with the registration process, and the assigned body for registration (Trademarks registry Unit under the Department of Patents, Design and Trademarks). Moreover, the mark is either allowed or

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<sup>3</sup> <https://www.bananaip.com/ip-news-center/history-and-evolution-of-trademark/>

prohibited to register in respect of a certain class of goods or services by complying with the requirements determined for the respective classes included in chapter 2.

The procedure from applying for Trademark registration by a claiming proprietor to the assessment of the application by the relevant authority and the duration of time is allocated if any correction needed is discussed in Chapter 3. Chapter 4 discusses the rights that a trademark owner enjoys after registration, which unregistered Marks do not, as well as when an act is infringed and when it is not, and the significance of registration. The act allows for the assignment and transmission of trademarks, and following restrictions and government consent are required to make the assignment and transmission to implicate, as described in Chapter 5 of the act. The regulations and restrictions for Trademark users in terms of using the Trademarks are set forth in Chapter 6. The flexibility of the register in Chapter 7 allows correction, revision, and modification in the application. Furthermore, the High Court is tasked with cancelling, verifying, or rectifying the application.

Chapter 8 expanded on the provisions of Chapter 3, describing in general the requirements for becoming a certificated trademark, the procedure for applying for trademarks, and trademark infringement. The act preserves the provision for special consideration of textile goods in an entire chapter (chapter 9) of the act. Chapter 10 essentially comprises the provision to determine the offence based on the categories of infringement, and the penalty is provided dependent on the degree of the offence stated in the act. The miscellaneous provision, which includes the various specific provision for the act, application fees, exemption of the act, the registrar's and government's duties, appeals, and repeals and savings, is included in the final chapter (chapter 11) of the act. Some significant provisions of the Act are summarized in Table 1.

**Table 1: Summary of the Trademarks Act, 2009**

Chapter Number	Title of the chapter	Section	Related provisions
Chapter I	Preliminary	Section 1	Short title, extent, and commencement
	Definitions	Section 2	Definitions of various terms used in the act such as “false trade”, “trade description”, “trade mark”, “deceptive similar mark”, “associated & certificate trade mark”, service and transmission
Chapter II	Trademarks Registry and conditions of the Registration	Section 3	Trademarks Registry wing of the Department of Patents, Designs and Trademarks, established under the Patents and Designs Act, 1911. There shall be a Registrar of trademarks in this department
		Section 4	The register to record all registered trademarks wherein all registered trademarks with the names, addresses, and descriptions of the proprietors, notifications of assignments and transmission, the names, addresses and descriptions of the registered user shall be recorded
		Section 5	Registration of a certain class of goods or services- A trademark may be registered in respect of the certain class of goods, or, service by complying with the requirements determined for the respective class or classes.

Chapter Number	Title of the chapter	Section	Related provisions
		Section 6	Requisites feature of “Trade” for registration in the Register- A trademark 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.
		Section 7	Limitation of using colour decided by Tribunal-A trademark may be limited wholly or in part to one or more specified colours, and the Tribunal will consider any such limitation when determining the trademark's distinctive character.
		Section 8	Prohibition of giving registration of certain matters – Any Trade that is scandalous, contrary to law, anti-religious, imitation, or cause of confusion is prohibited
		Section 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
		Section 12	Opportunity to have Registration of parts of trademarks and trademarks as a series- When the proprietor of a trademark asserts that a certain portion thereof is entitled to exclusive use on its own, he may submit an application to register both the entirety and the particular portion as separate trademarks
		Section 13	Registration of trademarks as associated trademarks- Where a trademark which is registered, or is the the subject of an application for registration, in respect of any goods or services, is identical to another trademark which is registered
		Section 14	Registration of trademarks subject to the disclaimer- 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 any matter common to the trade, or otherwise of a non-distinctive character.
Chapter III	Procedure and Duration of Registration	Section 15	Application for the Registration- Anyone who wants to register their trademark and claims ownership of a mark that they have used or intend to use must submit a written application in the required format to the Registrar.
		Section 15(5)	Application may be either accepted or rejected or accepted subject to amendments and modifications required
		Section 16	Withdraw of acceptance- If registration is accepted with an error
		Section 17	Advertisement of application- The registrar must announce the applicant's approval along with any limits or conditions, if any, in the manner prescribed as soon as is reasonably practical after a trademark registration application is

Chapter Number	Title of the chapter	Section	Related provisions
			authorized, whether unconditionally or with restrictions or conditions
		Section 18	Opposition to registration - Anyone may oppose registration by notifying the Registrar in writing in the prescribed manner within two months of the date the application for registration was advertised
		Section 19	The registrar is obliged to permit the correction of any error
		Section 20	Registration completed subject to application accepted, not opposition claim, and opposition is in favour of the applicant.
		Section 21	The act doesn't permit two-person to use the same trademarks independently but rather permits jointly owned trademarks
		Section 22	Duration, renewal and restoration of registration- duration of the registered trademarks is 7 years, the duration of the renewable registration is for 10 years,
		Section 23	Effect of removal from registration for failure to pay the fee for renewal, renew the registration for the period
Chapter IV	Effect of Registration	Section 24	The act doesn't ensure the protection of any infringement of unregistered Trademarks- No one should have the right to bring a lawsuit to stop or seek compensation for the infringement of an unregistered trademark.
		Section 25	The right conferred by Registration-Exclusive right enjoyed by the proprietor after the registration
		Section 26	Infringement of Trademarks (Identical to registered trademarks, harm reputation of the mark)- Any individual using a trademark that is identical to, deceptively similar to, or used in connection with products or services of his trade but who is not its registered holder or registered user is presumed to be infringing the trademark
		Section 27	Acts not constituting infringement
		Section 28	Registration to be prima facie evidence of validity- The original registration of the trademark and any future assignments and transmissions of the trademark must be prima facie proof of the validity in all legal proceedings relating to a trademark registered under this Act
		Section 29	The registration is valid for the specified time as long as it is not used for any dishonest or deceptive purposes, or in violation of section 8 of the law.
		Section 31	Act gives the owner or registered user of a registered trademark or registered well-known mark the right to prevent anyone from using their name, the name of their place of business
		Section 32	Savings for words such as the name or description of an article or substance or service.
Chapter V	Assignment and	Section 33	Power of registered proprietor to assign and give receipts to any other person

Chapter Number	Title of the chapter	Section	Related provisions
	Transmission	Section 36	Restrictions on assignment or transmission where multiple exclusive rights would be created
		Section 37	Restrictions on assignment or transmission when exclusive rights would be created in different parts of Bangladesh
		Section 39	With government prior consent and application made to Registrar, the assignment and transmission of certification trademarks are permissible
		Section 40	The procedure of Registration of assignments and transmissions- provided that the dispute between the parties is settled by the court
Chapter VI	Use of Trademarks and Registered users	Section 41	Under the act registered trademarks are used to form the company- the registration for the company is entitled under the Companies act 1994
		Section 43	Defensive registration of well-known trademarks- if a mark creates confusion with the well-known marks, the well-known marks shall be under the defensive mark
		Section 45	Join application of proprietor and proposed register users for registration as registered users- this provision includes the degree of control by a proprietor, duration of the permitted use
		Section 46	Power of registered user to take proceedings against infringement. However, if the proprietor refuses
		Section 47	Power of registrar to vary or cancel the registration of registered user- Registrar cancel the registration of the registered users if the trademark is deceptive and make confusion –or may cancel the registration if the registration is no longer effective
		Section 48	Registered users don't have the right of assignment and transmission in many cases such as partnership firm may use the trademarks as long as the registered user is a member of the firm
Chapter VII	Rectification	Section 51	The acts have given the power to the High Court division and Registrar to cancel and vary or rectify the Register on the ground of contravention
	Correction of the Register, etc	Section 52	Correction of the register if any error occurs or any amendment is required in the application. This provision includes deleting the entry of any trademarks from the Register
		Section 53	The registered proprietor is allowed to alter the trademarks by not substantially affecting the identity and the Registrar has a right to reject and conditionally accept the application
Chapter VIII	Certification of the Trademarks	Section 55	Several sections are inapplicable to the certification trademarks
		Section 56	A mark is ineligible to be a certification trademark in the name of a person who carries on a trade-in good or service of the kind certified
		Section 57	Determine whether a mark is fitted to be a certified trademark- the characteristic to be a marks the section

Chapter Number	Title of the chapter	Section	Related provisions
			2(28) must be followed and marks must bear the identification of the different goods and services
		Section 58	Application for registration of certification trademark- in the process of the application- there are some sections applicable mentioned in the act for the certification trademarks
		Section 59	The application for registration is under consideration by the government- the registrar forwards the application to the government and the government considers the application based on some pre-condition mentioned in this section
		Section 60	Opposition to registration of certification trademarks- when the application is accepted then the registrar advertises the marks in a prescribed manner. If the opposition is recorded then the government may fix the hearing date
		Section 60(2)	Government can either refuse or accept subject to amendment or modification required
		Section 62	The right conferred by registration of certification trademark- An exclusive right conferred by the sub-section (1) shall be effective
		Section 63	Infringement of certification trademark- Infringement occurs when the right conferred in section 62 is violated by using marks which identical and deceptively similar to the certification trade
		Section 64	Cases not constituting infringement of certification trademarks- certain cases such as a mark is identical or similar to two or more trademarks
		Section 65	Cancellation or varying the entry in the register of registration- Government may oppose the application or recommend, order cancellation or the variation of any entry in the register relating to a certification trade mark
Chapter IX	Special Provision for Textile Goods	Section 66	Provision is applied for textile goods under the International classification
		Section 67	Restriction on registration of textile goods- piece goods may be registered marks if the marks consist of “no marks consisting of only a line heading”
		Section 68	Stamping of the length of piece goods, cotton yarn and thread- the definition of the piece goods is adapted from the Labour act 2006
		Section 69	“Piece goods” declaration- Government adds the definition of the goods with section 68 by declaring a Gazette
		Section 70	Government definition to determine the textile goods- Government may make rules to select and test samples of the goods having uniform number, quantity, measures, gauge or weight
Chapter X	Utility of Trademarks	Section 71	Meaning of applying the trademarks and trade description- a person can apply trademarks for the goods and services,

Chapter Number	Title of the chapter	Section	Related provisions
			sign, advertisement, invoice, catalogue, business letter, and price list any other commercial elements
	Offence	Section 72	Falsifying and falsely applying for trademarks- identical or deceptively similar to the proprietor's marks
	Penalty	Section 73	Due to applying false trademarks and false trade descriptions, applying false identity, name and address- the penalty is kept a maximum of 2 years to a minimum of 6 months or fine
		Section 74	Due to selling goods to which a false trademark or trade description is applied- the penalty is kept a maximum of 2 years to a minimum of 6 months or fine
		Section 75	Due to removal or attempts to remove or cause to remove of piece goods- the fine is not less than BDT 5 thousand are kept in this case
		Section 76	Due to falsely representing a trademark as registered- any person representing unregistered trademarks or part of a registered trademark- the penalty is kept a maximum of 1 year to a minimum of 6 months
		Section 77	Due to improperly describing a place of business as connected with the Trademarks office- maximum 1 year to minimum 6 months or fine
		Section 78	Due to falsification of entries in the Register- punishment is kept more than 1 year but not less than 6 month
		Offence	Section 79
	Section 80		Unintentional contravention of the law relating to marks and description
	Section 82		The offence committed by the company- however, the company proves that the offence was committed without his knowledge therefore the offence against the company would not be proved
	Section 83		Cognizance of certain offences- No court less than a Metropolitan Magistrate or a Magistrate of the First Class shall try an offence under this Act
	The procedure of implementing legal proceedings	Section 85	Costs of defence or prosecution- the court may order such costs to be paid by the accused to the complainant or by the complainant to the accused
		Section 86	No accusation never be commenced after 3 years expiry date then no case may be lodged
		Section 87	Government officer is not compelled to any court regarding the information as to the commission of office
		Section 88	Punishment for Abatement of any offence committed outside of Bangladesh
		Section 89	Authority of the Government to issue the instruction by notifying an official Gazette
Chapter XI	Miscellaneous	Section 90	Warranty is provided under the act on the sale of marked goods

Chapter Number	Title of the chapter	Section	Related provisions
	procedure if a certain case arises	Section 91	The procedure and powers of the Registrar-Registrar possess the same power as the Civil Court in certain cases
		Section 92	The procedure of registering marks in case of death of register during the proceeding of the marks
	Other procedures of application	Section 93	Extension of application time subject to the logical cause- No appeal shall lie from any order of the Registrar under this section
		Section 94	Abandonment of application- Registrar permits to remedy the application error within a time specified, if no such remedied then the registrar can reject the application
		Section 95	Submission of the affidavit and oral evidence before the government
	Suit	Section 96	Suit for the infringement before a district court- case could be filed in case of infringement, amended right, passing off similar or deceptively similar marks
		Section 97	Relief's in suits for infringement or passing off. Moreover, the reason for not granting the relief from the suit. The suit for passing off is discussed in this section
	Rectification	Section 98	Application procedure for rectification of Register to be made to the High Court Division in certain case
		Section 99	Application procedure for application for rectification of the Register before the High Court Division- the provision of this act and rules, and the provision of the Civil procedure code shall be applicable in the court
	Appeals and rule of the High Court	Section 100	Appeals- There is no right of appeal from any government decision, order, or direction made or issued under this Act, or from any law or order made by the Registrar to give effect to any such decision.
		Section 101	Power of the High Court Division to make rules- the rules requires to be consistent with the act
		Section 102	Procedure where the validity of registration of the trademarks is questioned
	Power and duty of the registrar	Section 103	Right to appear and be heard in any suit by the registrar- In any lawsuit or other legal actions where relief includes changing or rectifying the Register, the Registrar shall be entitled to present and be heard.
		Section 104	Costs of Registrar in proceedings before High Court Division
		Section 106	Evidence of entries in the Register and things done by Registrar- printed or written copy of any entry in the Register or any document referred to in section 116(1) are the evidence of the Registrar
	Power and rule of government	Section 108	Power to direct submission of the necessary information to prove the original places of production of goods and services (Imported goods case)
Section 109		Power to prohibit the imported goods bearing false trademarks- Customs are liable to implement the provision of the act, customs can seize or confiscate	

Chapter Number	Title of the chapter	Section	Related provisions
		Section 112	Trade usage is taken into account during the trial- the tribunal should admit in the evidence the prevailing custom of the relevant trade
		Section 114	The document that not be registered- the documents requires to maintain the Registration act 1908
		Section 115	Keeping the index of the registered trademarks under the supervision of the Registrar
		Section 116	Document open to the public inquiry- regular publication of the register of registration, index, affidavit and any other documents
		Section 117	Prescribed government fee- registrar cannot initiate the task before the payment of the fee, the fee is payable for filing any documents, the document deemed not filed until payment of the fee
	Exemption	Section 118	Exemption from the act- if a person provides the information about the employers or employee in the good faith, he shall not be punished in any case of proceeding
	Special provision	Section 119	Relating to Convention Countries- Member of the Paris Convention or World Trade Organization outside of Bangladesh that grants Bangladeshi nationals the same rights as those accorded to its residents in regard to trademark registration and protection
		Section 120	Relating to Convention Application- the mark registered in Bangladesh requires to file an application to the member state of the Paris Convention and WTO within 6 months of the registration accepted in Bangladesh
		Section 121	Relating to reciprocity- if a member does not permit the same protection and registration of Bangladeshi applicants in their nation, Bangladesh may treat that country in reciprocity to how they treat Bangladesh.
		Section 122	Relating to collective marks
	Government rule for the act	Section 123	The electronic Gazette may be used to publish all notices, ads, orders, and other issues, including usage instructions, as well as all records that must be made available to the public through the online platform
		Section 125	Report regarding trademarks to parliament- Government requires to arrange a parliamentary session about the activities relating to the trademarks
	Repeal and saving	Section 127	Repeal and saving- The Merchandise Marks Act, 1889 and the Trademarks Act, 1940 are repealed
		Section 128	Special provisions relating to savings- any action done or action taken under the Trademark Ordinance, 2008 (and the Trademark Ordinance, 2009

Source: Trademarks Act, 2009

## 2.4 Overview of the Department of Patent, Design and Trademarks (DPDT)

The Department of Patents, Designs and Trademarks, (DPDT) led by the Ministry of Industries, regulates intellectual property matters. The DPDT is affiliated with the World Intellectual Property Organization (WIPO). The DPDT is supported by the government of Bangladesh, and the revenue it generates through application fees and other fees is considered government revenue, which the DPDT cannot use for its regular expense. The government pays for all of the DPDT's expenses and then takes back the earnings of the revenue. As a result, it has no operational surplus. The Patent and Design Wing and the Trademarks Wing are the two main wings of the DPDT. The following are the task and obligation trademarks wing:

#### **Trademarks Wing-**

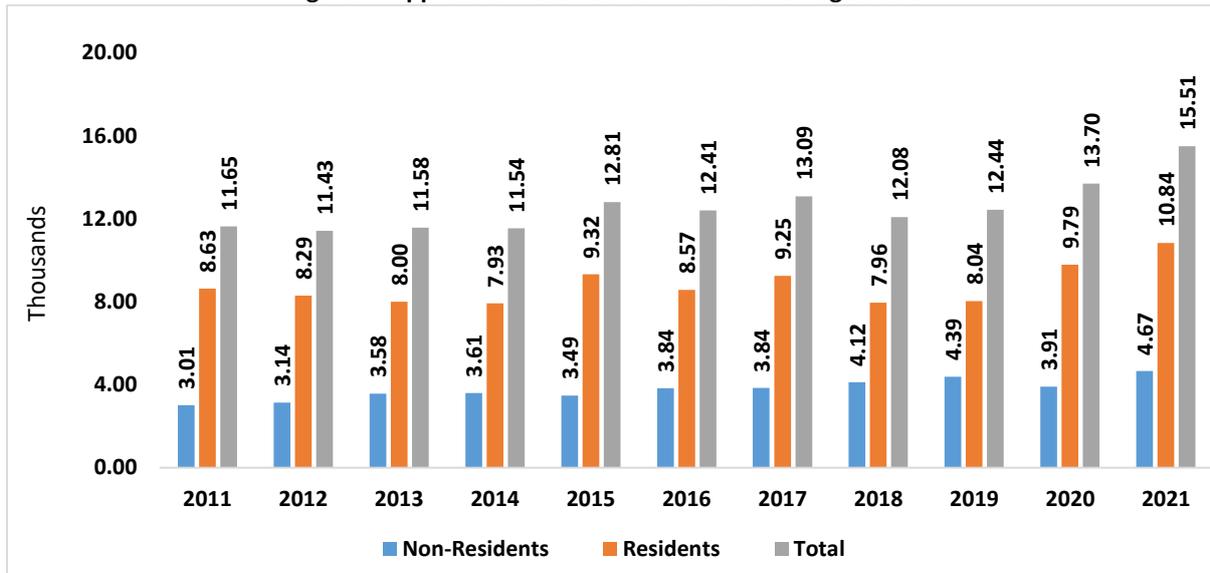
- Processes trademark registration applications from both domestic and international sources
- Ensures proper ownership and protection
- Evaluates trademark applications, looking for similar and distinct marks.
- determines whether to accept or refuse the registration of trademarks
- Amends the trademark application and the registration after hearing
- Retains an index card with the product's class listed alphabetically
- Holds track of activities such as assignment transmission and change of ownership description after registration
- Provides trademark registration and renewal certificates
- Performs opposition and correction proceedings for contentious marks, as well as their solution

#### **2.4.1 Present Activities of Trademarks by DPDT**

From 1971 to 2021, Bangladesh has 65,031 certified trademarks, 17,641 of them are residents and 44,075 are non-residents. The highest number of trademarks have been certified in the year 2015 (4,522). Department of Patent, Design and Trademarks has received 2, 93,160 trademark applications till 2021, 2, 07,873 of the applications are residents and 85,287 are non-residents. Although a majority of the applications are from residents, the majority of the certificate issued is from non-residents. The scenario of certified trademarks and applications for registration in DPDT can be compressively summarized with distinct figures and graphs.

Figure 1 depicts the number of trademark registration applications filed by both residents and non-residents from 2011 to 2021. The overall number of applications in 2021 is more than in any preceding year, indicating that there is a positive trend across the year, with the number of applications increasing as the year progresses. The number of resident and non-resident applications has increased over time, with resident applications outnumbering non-resident applications for all years.

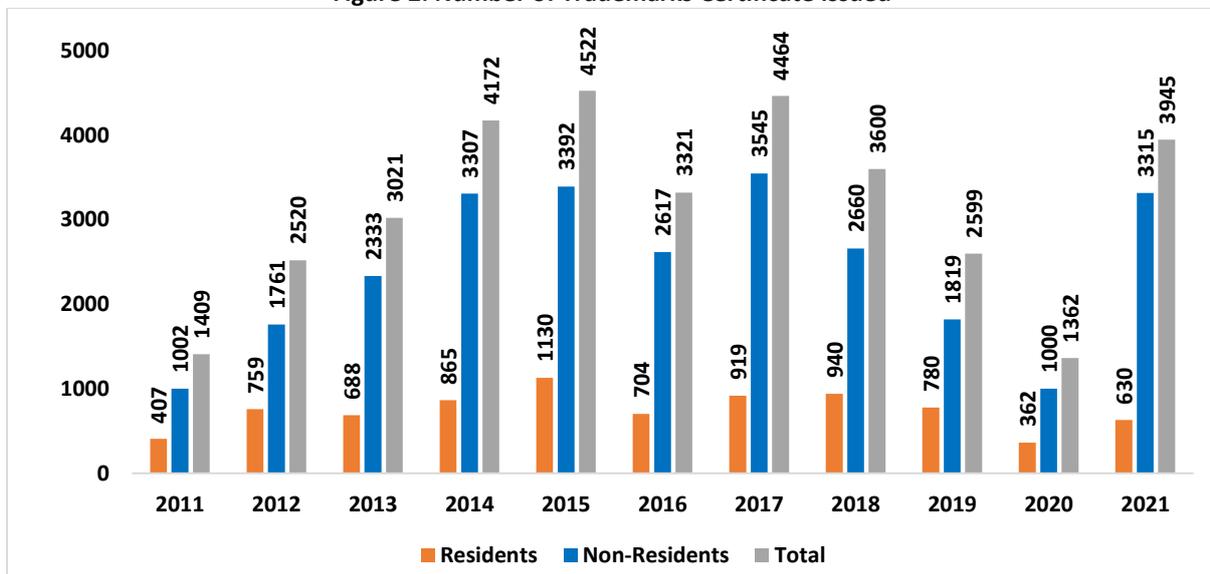
Figure 1: Application received for Trademarks Registration



Source: Department of Patent, Design, and Trademarks, 2022

Figure 2 shows that while the number of marks applied for registration is higher for residents, the certificate issued for trademarks is higher for non-residents. This contradiction arises because non-residents apply for trademark protection in Bangladesh after receiving protection in their home country. The protocol that the DPDP must follow is less stringent than the procedure that a resident must follow. In 2021, for example, the total number of trademark certificates issued was 3945, with 630 issued to residents and 3315 issued to non-residents.

Figure 2: Number of Trademarks Certificate Issued



Source: Department of Patent, Design, and Trademarks, 2022

#### 2.4.1 Registration process of Trademarks

The Trademarks Act allows for the registration of different types of marks: Trademarks for Goods, Trademarks for Services, Collective marks, Certification marks, Associated marks, Protective marks etc. The collective mark is owned by an organization (such as an association),

and it can be used by all members of the association. Certification marks, on the other hand, are owned by individuals who only have the right to use them.

There are various steps in the entire procedure of trademark registration. Each step needs a significant amount of time to register. In the smooth case, trademark registration in Bangladesh takes 5 months to 7 or 8 months if the application receives no complaints. In a smooth process, if complaints are received, trademark registration in Bangladesh takes around 24-36 months<sup>4</sup>. Solving the problem of complaints in the DPDT tribunal takes a larger time than any other step in the registration process. Table 2 contains the steps that have to be maintained during the whole registration of marks.

**Table 2: Workflow of Trademarks registration**

Number of Steps	Steps name	Section	Requirements	Fee
Step 1	Filing the application	15	<ul style="list-style-type: none"> <li>Name of the Applicant(s)</li> <li>Address and Nationality</li> <li>Specification of goods</li> </ul>	3500 plus 15 per cent VAT
Step 2	Acceptance	15	NA	NA
Step 3	Advertisement	17	<ul style="list-style-type: none"> <li>Corrections in the application under Section 19 and the advertisement is given again</li> </ul>	1000 plus 15 per cent VAT
Step 4	Opposition	18	<ul style="list-style-type: none"> <li>Opponent serving the notice to the Registrar</li> <li>Applicant file a counter</li> <li>The registrar serves a copy of such counter to the opponent.</li> </ul>	Opponent: 3000 plus 15 per cent VAT Applicant: 2500 plus 15 per cent VAT
Step 5	Registration	20	<ul style="list-style-type: none"> <li>The applicant is issued a certificate of registration with the seal of the trademark registrar</li> </ul>	15,000 plus 15 per cent VAT

*Source: Authors' compilation from various sources*

## **2.6 Current state and challenges of the trademarks act**

Individual nation-states have developed their intellectual property rights (IP) reflecting their domestic needs and priorities, although each country has acceded to several IP-related conventions and treaties (CRS, 2020). However, the inclusion of the TRIPS agreement in many bilateral and multilateral trade agreements has generated several initiatives to unify and strengthen intellectual property rights protection at the national and international levels (Rafiqzaman, 2002). Trademarks are registered and protected in almost every country on the planet. Each national or regional office keeps a Trademark Register office, which contains complete application information on all registrations and renewals, making verification, search, and potential opposition by third parties. The effect of such registration limits the protection for each country and complicates international trade in using the trademarks, particularly in export. Despite the fact that Bangladesh's IP law was created to meet

<sup>4</sup> <https://ssrana.in/global-ip/international-trademark-filing-registration/trademark-in-bangladesh/>

worldwide IP practice, there is a significant flaw in the present act that makes it difficult to sustain the international practice of protecting IP rights.

### **2.6.1 Institutional barriers to applying the act**

The DPDT was formed in 2003 by integrating the patent office and the trademarks registry office which is functioning under the Ministry of Industries. The Government of Bangladesh (GoB) has put greater emphasis on modernizing and upgrading IP law for keeping it in conformity with the TRIPS agreement. Thus, DPDT is assigned for playing a greater role to protect IP rights and conformity with the TRIPS. However, DPDT has been confronted with several institutional hurdles that have limited its ability to carry out the work in a full swing. The scarcity the manpower is the main barrier to operating. Currently, the examiner has been working in the trademarks wing 6 while the available position for examiners is 12 (DPDT, 2022). Moreover, the examiner does not stay long and sometimes vacancy for the examiner arises. As a general rule, the Public Service Commission (PSC) will hire examiners at the department's entry-level. Gradually, those examiners will be promoted to higher-ranking positions, and one of them will eventually become the Registrar. However, the head of the department and other senior employees at present are appointed by the Ministry of Public Administration (MOPA), who may have limited experience with intellectual property. The government send a different official to abroad for developing the skills of manpower and some officials are trained at the Bangladesh Institute of Management (BIM). Yet, this is not enough to meet up the need for officials with specialized knowledge of different branches of science, especially to check the Trademark application (Khondoker et al., 2013).

### **2.6.2 Weakness of civil and criminal enforcement procedure**

Infringement of trademark registration is addressed in section (26) of the trademarks act. If a trademark registration is violated, the Trademarks Provision authorizes the judiciary to apply punishments. Moreover, the act provides protection to non-registered trademarks, though not to the same extent as registered trademarks. The act permits the filing of a suit against the trademark infringement only in the district court or higher. Section 96 of the act refers to “no case shall be instituted in any court inferior to the District court”. The administrative authorities (DPDT) have no direct jurisdiction over counterfeiters or confiscation of the infringing goods. Law enforcement agency such as the police, the Bangladesh Rifles and the Rapid Action Battalion (RAB) takes the action on any matter relating to the infringement of a trademark only after being directed by the Chief Judicial Magistrate’s Court<sup>5</sup>. However, all the processes in the protection of the mark would begin only if registered mark holders complain about the violation. If the holders of the rights do not go to court to file a lawsuit against the violation, the court will not take the case. Due to the lengthy procedure and lack of judicial weak infrastructure, taking prompt action in the case of a violation is rare under this act (Somrat, 2019). As there is no special tribunal for dealing with trademark infringement, courts treat trademark infringement cases in the same way they do other cases. To emphasize the importance of paying special attention to the preservation of intellectual property rights, there is a need for a special tribunal that can solely deal with the suit involving intellectual property rights. The act could provide the administrative body (DPDT) the right to take action against any trademark violations. Furthermore, the DPDP officer may be given the authority to conduct raids on counterfeit and pirated items, as well as execute legal action under special

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<sup>5</sup> <https://www.kashishipr.com/blog/enforcement-and-protection-of-trademark-rights-in-bangladesh/>

executive power. This review of the Trademark Act 2009 emphasizes the transfer of some extent of power from the judiciary to the trademarks registered authority (DPDT) to take legal action against any infringement of trademark registration.

### **2.6.3 Trademarks and TFA**

The purpose of a trade facilitation agreement (TFA) is to make it easier to transfer, release, and clear commodities, including those in transit. It also lays out guidelines for effective collaboration between customs and other relevant authorities on trade facilitation and customs compliance issues<sup>6</sup>. Since September 27, 2016, Bangladesh has been a TFA signatory country. WTO began implementing the TFA for WTO member countries because "red tape" is a problem that prevents goods from moving freely across borders (Hossian, 2018). As a result, several reforms in customs and other related authorities have been implemented to facilitate trade. Increased trade has, however, intensified the issue of counterfeit goods and services being exported and imported. This trend of parallel and counterfeit importation and exportation of branded goods results in the infringement of the IPR of brand owners, who are mostly foreign investors or multinational companies operating in Bangladesh. Such a scenario is having a negative and damaging impact on Bangladesh's economy and GDP growth by discouraging or slowing foreign investment and denying the government of Bangladesh the ability to earn the appropriate amount of duty or revenue (Mishbah, 2022). The Customs Act of 1969 allowed the customs authority the power to prohibit the entry and exit of counterfeit goods during the customs clearance procedure, and the NBR recently passed the IPR Enforcement (Export and Import) Rules 2019 to strengthen these measures. Under the policy, without the permission of the rights holders, products with IPR issues, such as copyright, trademark, patent, design, and geographical indication, could not be exported from or imported into Bangladesh.

To receive trademark protection, trademark owners must file an application with the appropriate customs body, specifying the characteristics that can differentiate genuine from infringing goods. However, if the brand owner does not file for protection in customs, this approach may cause the protection to be delayed. In addition, the policy's approach is strict in that the trademark owner may follow a procedure that discourages filing a complaint against infringement. Thus, the customs authority, NBR, and DPDT can coordinate and implement the protection of infringement of commodities during the export and import to fully utilize TFA and prevent counterfeit items during the trade.

### **2.6.4 Trademarks Act and Madrid protocol**

The Madrid System states that a trademark registered in one country does not need to apply for registration in any other country where it requires protection. One single application to the World Intellectual Property Organization's (WIPO) local central point allows the protection of all countries of the Madrid Union. The Madrid system was established as a result of the Madrid Agreement and Madrid Protocol. A signatory country's registered trademarks are protected for all signatory countries under the agreement of the Madrid protocol; A person with a connection to a country party to one or both of these treaties (via nationality, residency, or establishment) may obtain an international registration through the trademark

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<sup>6</sup> [https://www.wto.org/english/tratop\\_e/tradfa\\_e/tradfa\\_e.htm](https://www.wto.org/english/tratop_e/tradfa_e/tradfa_e.htm)

office of that country, which will be valid in some or all of the other nations of the Madrid Union (WIPO, 2014). The reason for establishing the Madrid Union is to avoid registering the marks separately with each national and regional office.

Bangladesh has not yet joined the Madrid Protocol but is expected to join. For Bangladesh to join the Madrid Protocol, the existing provisions of the trademarks act must be reviewed or replaced with new provisions that comply with the Madrid Protocol and make trademark registration easier for all countries through the DPDT, which serves as WIPO's focal point. The principal provision of the trademarks act, 2009 does not allow Bangladesh and foreign nationals to register trademarks simultaneously in other countries. For examination, if a person wants to register his trademark in other countries he has to make a separate application and pay fees in the respective country.

### **2.6.5 Trademarks act and NICE Classification**

The NICE classification is an international standard for classifying goods and services that are applied for trademark registration (WIPO, 2006). The categorization is unanimously adopted during the NICE agreement (1957) by signatory countries of the Paris Convention for the Protection of Industrial Property. Despite the fact that Bangladesh is not a signatory country to the NICE agreement, the trademarks office (DPDT) of Bangladesh follows the 9th edition of NICE classification and the DPDT's list of goods and services. Bangladesh recognizes the international categorization adopted by the NICE agreement for trade registration of products and services under provision 2 (3) in the trademarks act 2009.

The goods and services are divided into 45 categories in the NICE classification, with goods 1 to 34 and services 35 to 45. In the NICE classification, yarns and threads in textile use are listed as class 22 and textile goods are listed as class 24. Under the NICE agreement, textile good is classified. In Bangladesh, the Trademarks Act of 2009 includes a separate provision and an entire chapter for textile goods, which is not required because Bangladesh currently follow the NICE agreement for identifying goods and services. The distinct provision of textiles goods has been kept in the Trademarks Act 2009, which was derived from the Trademarks Act 1940. Bangladesh does not require a distinct chapter of textile goods to register trademarks. The NICE agreement for trademark registration classifies textile goods which are comprehensive to identify the source of the textile goods for the trademark registration. Moreover, The Trademarks Act, 2009 is given protection to class 34 under the International Classification of goods. No visible and effective measure has been initiated to expand the protection of services (beyond class 34). Therefore, effective visible action is required for providing the trademark registration for the 11 service class.

### **2.6.6 Trademarks acts and TRIPS agreement**

Bangladesh is a signatory country of the TRIPS agreement and Paris convention for the protection of industrial property. Under Section 119 of the Trademarks Act, 2009; Bangladesh ensures the same protection system to the members of the Paris Convention and the TRIPS Agreement for complying with the agreement. As a result, if any trademark is registered in a member state other than Bangladesh of the Paris Convention or WTO, it can enjoy protection from the same date within the territory of Bangladesh provided the owner makes an application for registration in Bangladesh within six months from the date of primary registration of the member state. Article 19 of the TRIPS includes a full definition of

trademarks as well as a description of the rights given by registered trademarks, as well as rules on restrictions and exceptions and the length of protection.

Members of the TRIPS Agreement must comply with a set of minimum standards for the protection of the intellectual property rights covered by the agreement. However, Members may decide to enact legislation that provides greater protection than what is required under the agreement, provided that the additional protection does not conflict with the terms of the agreement. For this reason, the TRIPS Agreement is occasionally referred to as a "minimum standards" agreement.

The nature and scope of a trademark holder's rights under the existing trademark regime also comply with the TRIPS Agreement's rules, with a special emphasis on the 'distinctiveness' character. However, Bangladesh's trademark law does not include a need for visual perceptibility; rather, the Provision states that "non-visually perceptible subject matter" is registerable under the existing trademark regime (Chowdhury et al., 2017). Moreover, regarding trademark infringement, Section-26(2) of the Act, which protects unauthorized use of a mark, has addressed a broader line of "likely confusion," which has introduced a slightly higher requirement beyond the minimum TRIPS compliance rules.

TRIPS has permitted members to narrow down the scope of registrable marks by requiring prior use or visual perceptibility in order for them to qualify for registration. Thus, if a WTO member exploited the leeway of recognizing the additional requirements permitted under this Article, the particular member may not, therefore, be obliged to register a sign that is distinctive, yet non-visual. In Bangladesh, Section 6 of the Trademarks Act 2009 provides for the requisite distinctiveness in detail. According to Section 6, any distinctive mark shall be registered as a trademark subject to the limitations as provided in the Act. It also clarifies that a mark that does not fall within the description in Clauses (a) to (d) shall not be registered except upon the evidence of its distinctiveness. However, Section 6 does not directly provide for the requirement of visual perceptibility. Interestingly, the use of the words "visible sign" in the definition of the term "collective marks" in Section 2(25) may signify that the omission of these words in other definitions is deliberate, and calculated. Moreover, the definition of the term "marks" in Section 2(23) also signifies the fact that visual perceptibility is not a requirement for registration. Seen in this light, the Trademarks Act of 2009 can be found to comply with both the mandatory and directory parts of Article 15(1), which provides for the requirement of distinctiveness as well as visual perceptibility. Thus, it can be argued that the Act of 2009 has introduced a TRIPS-plus feature by expanding the protection to the "non-visually perceptible matters" as trademarks. In effect, this expansion of the scope of registrable trademarks to include non-visually perceptible subject matter can, however, be taken as unwise exploitation of the flexibilities offered by the TRIPS (Sayeed, 2016)

## ***2.7 Changing nature of world trade and relevance of the Trademarks act 2009***

At present, World trade has been faster due to the development of the modern transportation and communication system. The country produces and trades goods and services based on its comparative advantages. This time, trade is more than just about trading goods and services; it's also trading about innovation, creativity, and branding. Thus, businesses of all countries require individual trademarks on their product to retain goodwill

among customers over time. Bangladesh has gone through some changes during the last decade to stay up with changing global trade patterns, political economies, industrialization, and technological use.

According to the World Bank classification, Bangladesh has already graduated from a low-income country to a lower-middle-income country. The country has set a target of becoming a high-income country by 2031 and a developed country by 2041. Meanwhile, Bangladesh has met all three criteria for graduation from the least developed country (LDC), and will officially graduate in 2026. The challenge for Bangladesh as a lower-middle-income country is to avoid falling into the middle-income trap, while challenges arising from LDC graduation are more diverse, including losing access to soft loans, losing duty-free and quota-free (DFQF) market access in the European market, and losing the special exemption on pharmaceuticals and agricultural products in the TRIPS agreement. For keeping compliance with the TRIPS agreement, a strong IPR regime must be ensured in the country after LDC graduation. The TRIPS agreement plays a significant role in facilitating trade in knowledge and creativity, resolving trade disputes over intellectual property, and in assuring WTO members the latitude to achieve their domestic objectives. This agreement is legal recognition of the significance of links between intellectual property and trade. In the context of the changing nature of world trade, there may have some challenges.

### **2.7.1 LDC graduation challenges**

Bangladesh has been given the final approval to graduate from the LDC status after satisfying all three criteria: per capita GNI, human assets index (HAI), and economic vulnerability index (EVI). In the triennials of 2018 and 2021, Bangladesh met all three criteria. Graduation from the LDC category is an important step toward a country's long-term development. Bangladesh is scheduled to exit the LDC status in 2026. Graduation from the LDC status will have a mixed set of impacts. Bangladesh will lose all of the flexibility it has had under WTO and TRIPS standards once it graduates. Under the TRIPS agreement, LDCs currently benefit from two types of transition periods: a general transition period and a special transition period specifically designed for the pharmaceutical industry. The WTO council meeting held in 2019 has extended the general transition period for 13 years (July 1, 2034) and a special transition period for the pharmaceuticals industry remains valid until 1 January 2033<sup>77</sup>.

After the LDC graduation, Bangladesh has to be ensured the IP law more structurally, Bangladesh needs to provide protection for all types of patents, copyrights, trademarks and undisclosed information. Challenges may arise in implementing the IP law due to Bangladesh will no longer be eligible for a 90 per cent discount on international filing fees under the Patent Cooperation Treaty (PCT) system, as well as a similar fee reduction under the Madrid System for international trademark protection. Bangladesh also lacks the necessary infrastructure for enforcing IP enforcement measures, including civil and administrative remedies, criminal procedures, border controls, and so on. Therefore for ensuring the strong IP right after LDC graduation, Bangladesh should address concerns about Intellectual Property (IP) rights. A team of experts under the National Task Force should embed IP dimensions in

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<sup>77</sup><https://thefinancialexpress.com.bd/views/intellectual-property-rights-issues-must-be-embedded-in-bangladeshs-ldc-graduation-strategy-1627315096>

the transition strategy and request targeted capacity building for development partners so that the country can enjoy the maximum benefits of the LDC graduation.

### **2.7.2 Covid-19 Pandemic**

The impacts of the Covid-19 pandemic have been seen globally and throughout all sectors, posing a serious threat to every country's economy, particularly in the public health sector. The race for Covid 19 related terms has raised important intellectual property rights issues. Different countries are adopting various methods to contain Covid 19. The phrases that have been used for Covid 19 containment are purely related to the country's marks. The Covid-19 pandemic has generated a rush of trademark applications for names like "Covid-19," "Coronavirus," newly mutated virus, and other medical and pandemic-management phrases (Caiboli, 2020). Bangladesh has been attempting to develop the Covid vaccine since the beginning of Covid 19 and has made multiple attempts, with one vaccine, "Bangavax," currently undergoing human trials. The term "Bangavax" will be Bangladesh's trademark. In addition, the number of trademark applications for medical and pandemic-related management has increased worldwide. Therefore, there will be increased challenges by the DPDT that if any drug applies for trademark registration, the DPDT checks with the Director General of Drug Administration (DGDA) to see if these medicines (used for Covid-19) are authorized or not. The proper management and scrutiny of trademark applications relating to Covid 19 medicine and related products are significant issues that DPDT may face in managing Covid 19.

### **2.7.3 4<sup>th</sup> Industrial Revolution**

The 4th Industrial Revolution marked significant changes in how people lived, work, and interact with one another. It introduces a new stage in human progress, made possible by incredible technological advancements comparable to those of the first, second, and third industrial revolutions. It combines breakthroughs in artificial intelligence (AI), robots, the internet of things (IoT), 3D printing, genetic engineering, quantum computing, and other advanced technology. As a result of artificial intelligence replacing repeated jobs mostly performed by low and semi-skilled labour, many developing countries, such as Bangladesh, may lose their comparative advantage in low-skilled labour-intensive production processes. The 4IR will result in employment losses as Bangladesh's labour-intensive industrial industry is automated.

IP-intensive goods and services have now become increasingly a significant part of global trade exports and imports. Intangible capital (technology, hardware and software, and branding) now contribute twice as much to the overall value of manufactured goods as tangible capital (CPD, 2021). As a result, there is a growing interest in IP issues among IT start-ups and IT entrepreneurs in Bangladesh. Bangladesh needs to develop an integrated IP governance structure by reviewing the copyright and trademark offices' responsibilities, as well as including emerging challenges such as intangible and IT-based products in domestic use and foreign trade (Bhattacharya, 2021).

### **2.7.4 8<sup>th</sup> Five-Year plan and the 2<sup>nd</sup> perspective plan**

Bangladesh's 8th Five-Year Plan and Perspective Plan are important in becoming a knowledge-based, innovative nation. A variety of programs and activities focused on overcoming the gap between industry, academia, and government have been introduced. By adding digital

technology-based features to products and processes, industries are being urged to focus more on the innovation and redesign of items they are currently manufacturing. Researchers and academicians, on the other hand, are praised for their discoveries and research efforts.

According to the 8<sup>th</sup> Five-Year plan, programs to invest in technological research and development are being implemented, and Bangladeshi businesses have begun to improve their value-addition potential by harnessing new ideas. Therefore proper management of trademarks application and ensuring the right are the challenges that will come ahead for the country.

## ***2.8 Comparison with the international best practice***

In this section, we'll look at the trademarks act of a few comparisons that have had a great deal of success in terms of protecting trademarks. As Bangladesh is about to transition from LDC status and has a target of becoming a UMIC by 2031, and a developed country by 2041 a timely Trademarks Act is essential to the country's economic success and achieving the target. Amending a law necessitates various legal procedures while also being time-consuming. On the other hand, well-crafted legislation can have a significant impact on the regulatory process. A critical assessment of trademark legislation in similar countries to Bangladesh, such as India, Malaysia, and Indonesia will be useful in drawing lessons from them.

### **2.8.1 India**

The Indian Trademark Act of 1940 was based on the British Trademark Act of 1938. The Trade and Merchandise Mark Act, 1958, was shaped by independent India. This Act is currently known as the Trademark Act of 1999, and it comes into force on December 30, 1999. Trademark laws in India are governed by the Act and the Trademark Rules of 2002. The Madrid Protocol has been incorporated by the Trademarks (Amendment) Act of 2010. This facilitates trademark registration by allowing applicants to submit only one application to WIPO, which will offer them protection in several countries around the world once the first step of basic registration in the national country is completed. An overview of the Indian trademarks act is given in Table 3.

**Table 3: Overview of India's Trademarks Act**

Title of the chapter	Highlights	Weaknesses	Takeaways
Chapter I: Preliminary	<ul style="list-style-type: none"> <li>Includes various combinations of colour under the definition of mark</li> <li>Registration of service mark is permitted</li> <li>A single application for filing under a different class of good</li> <li>Imitation of well-known trademarks cannot be registered</li> <li>Without having the registry the third party can use the trademarks taking permission from the owner</li> <li>The police can arrest an offender in cases of infringement.</li> <li>Complying with the Madrid protocol</li> <li>Omitting the special provision for the textile goods</li> </ul>	<ul style="list-style-type: none"> <li>Highly time-consuming enforcement and court procedure</li> <li>Any factor that enhances functionality or usability is not protected.</li> <li>Lengthy pre-grant opposition proceedings.</li> <li>There are many commonly used words and the owner cannot claim exclusive rights</li> <li>For protection in more than one country, a separate international application is required to be applied in that country</li> <li>The owner has no right to prevent the subsequent sale of goods in any part of the country, as his rights over the goods are exhausted after making the first sale</li> </ul>	<ul style="list-style-type: none"> <li>Omission of the special provision of textile goods</li> <li>Compliance with the international registration of the Madrid protocol</li> <li>A single register proceeding</li> <li>Intellectual property appeal board</li> <li>Service mark registration</li> <li>Registered trademark is valid 7 to 10 years<sup>8</sup></li> </ul>
Chapter II: Register and Conditions for registration			
Chapter III: Procedure for and duration of registration			
Chapter IV (A): international registration under the Madrid protocol			
Chapter V: Assignment and transmission			
Chapter VI: Use and registered users			
Chapter VII: Rectification and correction			
Chapter VIII: Collection marks			
Chapter IX: Certification Trademarks			
Chapter X: Special provision for textile goods			
Chapter XI: Appellate Board			
Chapter XII: Offence, penalties and procedure			
Chapter XIII: Miscellaneous			

Source: Authors' compilation from various sources

### 2.8.2 Malaysia

The Trade Marks Act 1976 has been the main source of trademark registration rights in Malaysia. The development of trademark laws in Malaysia reached a significant milestone when the Trademarks Act 2019 (TMA 2019) entered into force on 27 December 2019. With the coming into force

<sup>8</sup><https://www.altacit.com/trademark/the-new-indian-trademark-act/#:~:text=The%20New%20Act%20provides%20the,%E2%80%9Csimilar%E2%80%9D%20goods%20or%20services.>

of the TMA 2019, an Act that once contained 84 Provisions has been replaced by a new one consisting of 183 provisions. The trademarks regulation of 2019 is also in force, alongside the trademark act of 2019. The new law, which took effect in 2019, made substantial changes to the old legislation by defining trademarks as "signs" along with "marks"<sup>9</sup>. An overview of the Malaysian trademarks act is presented in Table.

**Table 4: Overview of Malaysia's Trademarks Act**

Title of the chapter	Highlights	Weaknesses	Takeaways
Part I: Preliminary	<ul style="list-style-type: none"> <li>• Defines shapes, sounds, colours and scents as signs and expands the definition of a trademark to include any sign capable of being represented graphically</li> <li>• Multi-class filings would be allowed in a single application</li> <li>• Applicants will have only one strike at the examination stage either a written submission or hearing</li> <li>• Licensing regime replaces the registered user system</li> <li>• Recognizes a trademark as personal or moveable property and may be the subject of a security interest</li> <li>• Allows registered trademark owners a right to bring an</li> </ul>	<ul style="list-style-type: none"> <li>• Inadequate enforcement of the legislation.</li> <li>• Difficult for entrepreneurs to enjoy exclusive control of their marks</li> <li>• The plaintiff gets privileges and the right to initiate a lawsuit against anyone convicted of trademark infringement.</li> </ul>	<ul style="list-style-type: none"> <li>• Vienna Agreement, Establishing an International Classification of the Figurative Elements of Marks 1973 (Vienna Agreement)</li> <li>• Expanded the protection of the trademark to "sign"</li> <li>• Grounds of refusal are now categorized into "absolute grounds" and "relative grounds".</li> <li>• Multi-class filling with the help of a single application</li> <li>• Madrid Protocol</li> <li>• Action for infringement of goods and services that are similar to the goods and/or services protected under the registration<sup>10</sup>.</li> </ul>
Part II: Administration			
Part III: The registered of Trademarks			
Part IV Chapter 1: Introductory			
Part IV Chapter 2: Application for registration of Trademarks			
Part IV Chapter 3: Grounds for refusal of registration			
Part IV Chapter 4: Priority			
Part IV Chapter 5: Examination			
Part IV Chapter 6: Withdrawal, restriction, or amendment of the application			
Part IV Chapter 7: Opposition			
Part IV Chapter 8: Registration			
Part V: Division and merger			
Part VI: Duration and Renewal of registered trademarks			
Part VII: Alteration, correction, cancellation, revocation and invalidity			
Part VIII chapter 1: Effect of registered trademarks			

<sup>9</sup><https://www.lh-ag.com/wp-content/uploads/2020/01/A-Birds-Eye-View-of-Trademarks-Act-2019-Part-1-LHAG-update-20200113-1.pdf>

<sup>10</sup>[https://www.google.com/search?q=weakness+in+the+malaysia%27s+trademarks+act&sxsrf=ALiCzsYHHDlo5FEkk3PjPh4HZfq6AIESzA:1653140596154&ei=dOyIYrP0COcX2roPs7ykoAY&start=10&sa=N&ved=2ahUKEwiz\\_vzP3PD3AhXgmFYBHTMeCWQQ8tMDegQIARA2&biw=1301&bih=587&dpr=1](https://www.google.com/search?q=weakness+in+the+malaysia%27s+trademarks+act&sxsrf=ALiCzsYHHDlo5FEkk3PjPh4HZfq6AIESzA:1653140596154&ei=dOyIYrP0COcX2roPs7ykoAY&start=10&sa=N&ved=2ahUKEwiz_vzP3PD3AhXgmFYBHTMeCWQQ8tMDegQIARA2&biw=1301&bih=587&dpr=1)

Title of the chapter	Highlights	Weaknesses	Takeaways
Part VIII chapter 2: Infringement of trademarks	<p>action for infringement of goods and services that are similar to the goods and/or services protected under the registration</p> <ul style="list-style-type: none"> <li>• Accession to the Madrid Protocol</li> <li>• Reduction of the registration conclusive period from 7 years to 5 years</li> </ul>		
Part IX: Trademarks as the object of property			
Part X: Licencing			
Part XI: International matters			
Part XII Chapter 1: Madrid Protocol			
Part XII Chapter 2: Convention and international arrangement			
Part XIII: Border Measures			
Part XIV: Trademarks Agent			
Part XV: Offence			
Part XVI: Investment and enforcement			
Part XVI Chapter 1: Investigation and complaints			
Part XVI Chapter 2: Information gathering powers			
Part XVI Chapter 3: Powers of arrest, search, seizure etc			
Part XVII: A legal proceeding in court, cost and evidence			
Part XVIII: Miscellaneous and general			
Part XIX: Repeal, saving, and transitional provision			

Source: Authors' compilation from various sources

### 2.8.3 Indonesia

In Indonesia, trademark regulation dates back to the colonial period, when the Reglement Industriele Eigendom of 1912, which governed the use of company marks, was in effect. To replace the colonial-era legislation, Law No. 21 of 1961 on Company Trademarks and Commercial Trademarks (1961 Trademarks Law) was enacted after independence. To update the 1961 Trademarks Law, Indonesia enacted Law No. 19 of 1992 on Trademarks. Indonesia then decided to sign the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement") on April 15, 1994. Following that, in 2001, Indonesia enacted Law No. 15 of 2001 on Trademarks (2001 Trademarks Law) to bring Indonesia's intellectual property rules and regulations into compliance with the TRIPS Agreement. However, new trademark legislation is needed to keep up with global changes. As a result, the Trademarks Bill was signed into law by the House of Representatives on October 27, 2016. The

new law (the "2016 Trademarks Law") had been anticipated for a long time, as it relates to the requirement that all ASEAN member countries implement the 1989 Protocol to the Madrid Agreement Concerning the International Registration of Marks, as stated by the ASEAN Economic Community ("AEC") accords. The overview of the Indonesian Trademarks act is given in Table 5.

**Table 5: Overview of the Indonesian Trademarks Act**

Title of the chapter	Highlights	Weaknesses	Takeaways
Chapter I: General Provision	<ul style="list-style-type: none"> <li>• Trademark law protects both traditional and non-traditional trademarks, as well as visible and non-visible components.</li> <li>• Allows a trademark application to be submitted online</li> <li>• Allows the registration of the generic trademark as long as it incorporates additional words as distinguishing features</li> <li>• The Madrid protocol</li> <li>• There is legal protection for the well-known trademark owner even though it is not registered yet</li> </ul>	<ul style="list-style-type: none"> <li>• There is a limitation to recognising the well-known mark</li> <li>• Slow application pendency</li> <li>• Limitations to prevent bad faith trademark squatters and taking effective enforcement actions</li> </ul>	<ul style="list-style-type: none"> <li>• Compliance with the international registration of the Madrid protocol</li> <li>• Intellectual property appeal board</li> <li>• Protection of the well-known marks even if no registration of well-known marks</li> <li>• The non-electronic and electronic registration process</li> <li>• Allows registration for conventional marks, such as 3D, sound, hologram</li> </ul>
Chapter II: Scopes of Marks			
Chapter III: Application and Procedure of Mark			
Chapter IV: Registration of Marks			
Chapter V: Collective Marks			
Chapter VI: Geographical indication and source of origin			
Chapter VII: Nullification and cancellation of registration of the mark			
Chapter VIII: Collection marks			
Chapter IX: Administration of Marks			
Chapter X: Fess			
Chapter XI: Settlement of disputes			
Chapter XII: Provision decision by the court			
Chapter XIV: Criminal Provision			
Chapter XV: Transitional provision			
Chapter XVI: Closing provision			

*Source: Authors' compilation from various sources*

### 3. The Trademarks act 2009 and its relevance to SHE trade

The goods and services produced by entrepreneurs should be protected through trademark registration so that the goodwill of the new entrepreneur is not harmed. For that reason, the EU introduced a quality certification system that provides farmers and small-scale food producers with tools to help them build strong local collective brands and promote rural entrepreneurship (Rytönen et al., 2010). Women in Bangladesh have made remarkable achievements in entrepreneurship over the last decade, stepping out of the home to participate in the economy. Particularly, Women have made significant contributions to the small and medium enterprise (SME) sector, which accounts for around 20 per cent of Bangladesh's GDP (BBS, 2022). SMEs directly employ 7.8 million people and give livelihoods to 31.2 million people. However, evidence shows that fewer women than males use the intellectual property system, and this gender difference should be curbed for a variety of reasons, including the fact that gender equality is a human right<sup>11</sup>.

Trademarks act is a gender-neutral act. The trademarks act provides the protection of the registered mark holder irrespective of whether he is male or female. There is no need to create a special provision for women due to the procedure of trademark registration and protection under the trademark act for both men and women are similar. However, there is still a gender gap in intellectual property (IP) rights access. When considering recent patent applications, it is clear that there is a significant disparity between the number of female and male applicants; women are notably absent from all aspects of the patent system (Burk, 2018). This condition also applies to other forms of intellectual property, such as trademarks.

The fact that women are underrepresented in the IP system is concerning. It may have an impact on economic productivity and innovation, putting a strain on the economy's wealth and growth. According to the WIPO, many factors can account for these disparities along with innovation and entrepreneurship, three are of particular relevance from an economics perspective.

- Men are more likely than women to pursue a career in the STEM fields (science, technology, engineering, and mathematics). This disparity creates a difference in the share of innovation and entrepreneurship between men and women.
- A significant share of women in the STEM fields leaves the workforce. The reason is that talented women may succeed in school and the early stages of their careers, but their opportunities later in life may be restricted due to the time spent raising children and managing household affairs.
- Women who strive to be entrepreneurs and innovators confront challenges in commercializing their ideas. There are social dogmas and superstitions against women that work behind the barriers to women's entrepreneurship rise.

Some feminist legal scholars have criticized the IP system, stating that although it is ostensibly neutral, it may put women at a disadvantage position. To include women in the IP system, it may be necessary to provide opportunities for their education in science and technology,

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<sup>11</sup> [https://www.wipo.int/ip-outreach/en/ipday/2018/innovation\\_creativity\\_gender\\_gap.html](https://www.wipo.int/ip-outreach/en/ipday/2018/innovation_creativity_gender_gap.html)

build a woman-friendly atmosphere, and encourage women to participate in product innovation and branding.

## 4. Findings

In this chapter, the finding from the qualitative response is presented, since the study has already analysed the finding from the desk research in section 2.6 (mostly secondary source). The qualitative data consisting of the FGD, KIIs and public consultation is presented in a distinct section. The findings gathered from the qualitative data are cross-matched with the relevant authority and relevant secondary sources to make the finding strong.

### 4.1 Findings from the FGD, KIIs and Public Consultation

**The act is for TRIPS compatibility-** Though it was initially believed that the act was enacted to give protection through registration and protection from its violation and ensure that no one could use the marks to harm the reputation of any recognized brand, the act was primarily enacted to comply with international IP treaties, particularly the TRIPS agreement. Such a requirement for establishing a strong IP regime raises the question of whether Bangladesh has the infrastructure required, administration, and enforcement procedures to protect trademark rights owners. Since the beginning of the adaptation of the IP regime, Bangladesh has shown a weakness in the implementation of the IP system, as well as in taking effective administration and enforcement procedures. The failure to put the legislation into effect raised the issue of how to address the weaknesses and limitations to strongly comply with the TRIPS agreement the qualitative responders suggest, though Bangladesh has already complied with the “minimum standard” of the TRIPS agreement.

**Lacking resources within administrative authority-** Qualitative comments from the relevant administrative authority (DPDT) were used in the study to analyse the current condition of the department. During the FGD in the DPDT, the investigation discovered that there is a lack of manpower and inadequate equipment to deal with trademark registration. Moreover, the survey reveals that the DPDT is the busiest department among the IP registration departments. The real issue is when the trademark office was converted to DPDT in 2003, the number of applications increased from 15000 to 27,000. The study also found that, out of 12 examiner requirements in this wing, currently there have only 6 examiners. Furthermore, the examiner and register have less incentive to stay in the department for a long time. According to a descriptive study, such a disincentive to stay in the department for a long time hinders a person's ability to be adequately trained and educated to deal with IP.

**Conventional registration procedure-** The traditional paper-based trademark registration process is still widely used, rather than the modern IT-based online registration approach. Though the initial registration process has been made online, the entire process from "middle to end" must be done by the manual procedure. In a traditional procedure, filing processing, responding to inquiries, and submitting the document in person at the trademarks office are all required. As a result of the conventional method for trademark registration, qualitative data indicates that, in a smooth case, the trademark registration process takes about 24-36 months to complete if it receives any complaints. As a result, the implementation and enforcement of trademarks are hindered by such slowness during the registration process.

**The gap between theory and practice-** The qualitative data suggest that, theoretically, trademark affairs are well articulated by the existing laws, however, the practice reflects a different picture. In comparison to Bangladesh's sociocultural practice, the laws have yet to establish a consistent protection mechanism against trademark infringement. Furthermore, according to qualitative respondents, the reason for the law enforcement agencies' lack of responsiveness and promptness in the event of trademark infringements is that copying marks and well-known marks are still not deemed morally wrong in Bangladesh. As a result, there is a disconnection between theoretical law and actual legal procedures.

**Inadequate demand-side incentives** - DPDT performs the supply-side function of providing trademark protection despite a lack of adequate infrastructure and labour. However, according to the qualitative respondents, there is a lack of understanding and consciousness among business owners and entrepreneurs to submit a trademark registration application and the protection they get after registration. Consequently, there is less demand for trademark registration and protection. However, if Bangladesh does not continue to maintain strong IP protection after graduating from the LDC category, the country will be forced to fulfil some obligations from the developed country. This is something that neither our government nor our politicians are aware of. In order to prevent this from happening, the nation as a whole needs to establish capacity development, awareness-raising, and education initiatives about IP, especially in the business and industry sectors.

**Trademarks and SMEs-** There is no special provision for small and medium enterprises in the trademarks act of 2009. Since the SME sector's contribution to the economy is growing, it requires special attention in order for any innovation to be protected. To encourage new entrepreneurship, the right to use any new goods and services by a small and medium enterprise as an exclusive authority should not go through the same process as large enterprises. In Bangladesh, the registration of a trademark takes a long time and costs a significant amount of money. The DPDT is entirely funded by the government, government may consider introducing a special provision that gives SMEs more flexibility in terms of reduced registration fees and a faster registration process.

**The act is silent for digital-based businesses-** Although the enactment of the Trademarks Act, 2009 projected a breakthrough towards the trademark protection and TRIPS obligation of Bangladesh, the Act did fail to contain any provision for the compulsory registration of trademarks in Bangladesh. It is also pertinent to note that the Trademarks Act, 2009 is very silent regarding digital-based business or e-commerce communities. With the dynamic growth of e-commerce in international trade and business, trademark protection in this field is a demand of time now. Thus, such lacking of the Act has escalated the opportunity for unfair business practices throughout Bangladesh. Another shortage of the existing trademark regime is that under the Trademarks Act, 2009 protection is elongated up to class 34 under the International Classification of goods. No visible and effective measure has been initiated by the concerned authority to prolong the protection of products and services beyond class 34, the qualitative responders suggest.

## **5. Recommendation/ Action plan/Way forward**

In this chapter, we offer some suggestions for revising the existing trademarks act, based on the analysis and challenges that would arise as a result of changes in worldwide and domestic economic patterns. The method of KII is used to support the recommendation. Though the trademarks act was just passed in 2009, as part of the ongoing process of reviewing the act, this review may propose some amendments based on the opinions of associated stakeholders in order to benefit them.

During this review is conducting, the DPDT has already proposed some changes to the trademarks act, 2009. There is a limited chance of going beyond what DPDT has already suggested in this review. we took the DPDT comments and recommendations and go forward beyond their suggestions and includes the relevant stakeholders in our analysis of the act. Additionally, we establish a link between the required amendments to the act and the facilitation of global trade and commerce.

Here are some key recommendations for the trademarks act.

**Increasing the activities of DPDT:** The act provided DPDT with the authority to examine, give, and cease trademark registrations. The DPDT has three different units: trademarks, patents, and design, with the trademarks unit being the busiest and most active. It does, however, lack resources in terms of manpower, modern infrastructure, and logistical support. Moreover, the agency lacks trained people with expertise in intellectual property. As a result, the trademark office is succumbing to its inadequate logistic support in dealing with the influx of trademark files, resulting in unreasonable delays in file processing, responding to queries, issuing official decisions to facilitate enforcement mechanisms, and thus creating an impasse at the beginning of appropriate enforcement practice. To minimize the challenges that now exist in the DPDT, the government must increase the DPDT's activities. To achieve so, the qualitative respondents suggest that the number of registry offices may be increased, with appropriate people to carry out trademark regulatory administrative responsibilities. Examinees must be trained on a regular basis under WIPO supervision and support. Furthermore, the DPDT must recruit adequate manpower as a requisite of its activities.

**Empower the DPDT-** The responsibility of DPDT under the act is to keep records of trademark registrations. DPDT examines trademark applications and either accepts or rejects them. It also functions as a tribunal in limited situations when considering objections and oppositions. However, in the context of trademark infringement, the DPDP has no authority to take action against the infringer under this legislation; all authority is given to the Court. According to the qualitative respondents, the judiciary is not well equipped or prepared to provide immediate assistance regarding trademark infringement. As a result, it takes a substantial amount of time for a trademark infringement to bring to an end after getting a court order. To make an effective trademark governance structure, it is required to delegate certain power to the DPDT so that it can create its enforcement facilities or delegate cognizance power to the law enforcement agency in situations of trademark infringement.

**Making efficient application procedure and time duration-** Previously, DPDT allowed multiple classes of goods to be registered with a single application. In the current application system, however, the system has been repealed. Each registration of goods requires a separate application. The number of applications equals the number of registrations. DPDT

does this because it generates revenue for the department and the government. However, such an application approach results in a loss. Foreign businesses often refuse to conduct business in Bangladesh unless trademark protection is guaranteed. Foreign businesses worry about coming to Bangladesh right away because obtaining trademarks takes 24-36 months in a smooth situation. According to the qualitative respondents, such a prolonged period to provide a registration discourages both domestic and foreign businesses from registering their trademarks and obtaining trademark protection. Meanwhile, the marks are infringed and could be used to harm the trade's reputation while the trademark registration is being processed. Registration of trademarks, as a result, for the long-term benefit of the economy, the registration procedure must be lowered to around 6 months, and a single application must be reinstating for multiple classes of goods registration to reduce file processing and paperwork. Both electronic and non-electronic application submissions must allow for the reduction of trademark registration delays, which necessitates the digitization of the application system.

**Fee structure-** As a developing country, Small and Medium Enterprises (SMEs) play a significant role in terms of contributing to the development of the country. Over the last decades, SMEs is growing and the new brand has emerged and new entrepreneurship has increased. However, SMEs and entrepreneurs have faced difficulties in terms of availing of bank loans, issuing licensing and filing any type of registration. By the same token, the government fees prescribed for filling trademark registration are overcharged in the context of the socio-economic condition of the country, which is implicitly creating prima facie hurdles for small-ranged investors as new entrepreneurs start a business with a poor capital base. Therefore, the trademark registration fees must be designed in such a way that the free structure could be results-driven and new entrepreneurs could be supported.

**Compliance with the Madrid protocol-** Under this act, each WTO member country must file an application for trademark registration in Bangladesh within six months of receiving registration in their own country. In the same way, if Bangladesh has to protect its trade with any of the WTO member countries, the same procedure has to be followed in Bangladesh also. This process has a significant disadvantage in terms of the time and effort required to establish the trademark right in several nations. 32 WTO member nations, such as India and Malaysia, have conformed to the Madrid Protocol, which states that a single application filed at a WIPO focal point can assure trademark registration in all other WTO member countries. Despite the fact that it reduces revenue earned by the DPDT, it encourages foreign brands to enter Bangladesh. Similarly, Bangladeshi brands may have equal access to the international market. Moreover, This membership would give us a 90% discount on the certification fee for Bangladesh.

**Defining the textiles goods under the NICE agreement-** the special chapter for identifying textiles goods in the trademarks act is underutilized since the country accepted the 9<sup>th</sup> edition of the NICE classification, the qualitative data responses. India has omitted the chapter of the special provision for textiles goods in its trademarks act 1999. Since Bangladesh follows the NICE agreement for identifying the goods and services for the trademark registration, the qualitative responders suggest omitting the chapter from the act. Using both special provisions of textiles goods and NICE classification made often ambiguous situations in terms of identifying the textiles goods.

**Global IPR Registration of Trademarks-** Bangladesh must facilitate, accelerate, and enhance the IPR value-added market share of Bangladesh products in domestic and international markets through international IPR Registration without having to take on any additional international obligations other than those it has already taken on. Bangladesh must join, like the other LDCs, in order to consolidate the ever-expanding regional and global markets and to gain its share of global IPR registration.

**State of the protection-** The sole motive of the trademarks act enacted by Bangladesh is to primarily comply with the international agreement, particularly the Paris and TRIPS agreement and ensure the protection of the trademark's holders. However, in the comparison with the socio-cultural practice as existed in Bangladesh, the law has not ensured the standard protection mechanism for trademark infringement. Since Bangladesh is struggling with economic ossifications, brand protection is rarely a prioritized issue. Though the recent legislations provide specific recourses to stop the infringement of trademarks, a trademark infringer can take advantage of its weak enforcement mechanism. Moreover, copying the mark, particularly the mark that is familiar in practice, is yet to be considered morally wrong in the country. The reason for the lack of enforcement is that the administrative and judicial systems are not adequately prepared to intervene immediately during an infringement. To ensure a strong enforcement mechanism, extra attention must be paid to the enforcement agency's structure, such as the creation of a separate tribunal devoted specifically to intellectual property issues, for getting instant decisions on any IP-related issue. India has already set up intellectual property appeal board. Furthermore, the qualitative data suggest that IP-related issues be included in academic syllabuses at the high school, college, and university levels.

**Practical implementation of Well-known marks-** On the basis of the international, national and cross-border reputation, the trademarks registry recognizes well-known marks. Bangladesh has yet to recognize any single well-known mark. The act provides special protection for well-known marks in the case of infringement. Since Bangladesh has yet to recognize any well-known trademarks, global corporations such as "Coca-Cola" must get trademark registration from the registrar of Bangladesh. The well-known mark is kept in the legislation, although it is not implemented in practice. The qualitative respondents recommend that the well-known mark be recognized and given protection as provided by the laws. Furthermore, who and what marks received the registration has yet to be published in the trademarks journal. If one cares to know whether a particular mark has been registered or not, one must approach the DPDT. The DPDT then displays the marks based on the application acceptance. Such a procedure raises the bar for an immediate registration application. As per the qualitative data, the DPDP is required to publish the shape of the registered mark on a regular basis on its website.

**IPR enforcement (export and import) rules, 2019-** As world trade and commerce have increased, the protection of intellectual property has become a crucial issue in the case of export and import. The custom act 1969 provides some prohibition on counterfeit coin, forged or counterfeit currency notes, and goods imported to Bangladesh by air, land or sea, the act gives the power the custom to restrict the entry of specific trademark goods. Moreover, counterfeiting export is more frustrating for the renowned Bangladeshi brand,

particularly the apparel brand. This trend of counterfeit importation and exportation of branded goods has resulted in infringement or violation of the brand owners' intellectual property rights. National Board of Revenue (NBR) introduced the IPR Enforcement (Import and Export) Rules, 2019 under the Custom act 1969. Under this rule, Intellectual property, such as a trademark, patent, design, geographical indication, copyright, or trade secret, can be registered with a country's customs department to prevent or restrict the import or export of unauthorized or counterfeit goods. To ensure the protection of tradable products in customs, the DPDT, NBR, and customs must work together to apply the rules proactively. This rule will make trade protection considerably more active.

**Extension of definition of marks to non-traditional-** Trademarks are no longer limited to the traditional visible sign alone, due to the global trend of digitalization and the fourth industrial revolution. There was a time when nothing but ordinary letters, figures, words, slogans, symbols, logos, photos, and combinations thereof needed to be protected. However, this time, people may be more familiar with music and motion, which attracts greater attention in the rapidly changing digital environment. The scent, colour, shape, and three-dimensional design are all examples of modern trademarks that now need protection. Such recognition necessitates a proper description of non-traditional marks as well as a reduction in subjectivity whenever we need to identify them. Apart from recognizing non-traditional signs, traditional marks frequently have figurative elements, figurative elements comprise graphics or images (without word elements). If a mark contains such figurative elements, the applicant should classify the marks using the Vienna classification of figurative elements. Bangladesh is required to sign the Vienna Convention in order to follow the classification of figurative elements while registering a trademark which contains the figurative elements.

Along with the general advice given in the study, some more particular advice in the form of an expansion, inclusion, or exclusion of a trademark act provision is also explored. Table 6 contains specific recommendations with details information.

**Table 6: Recommendation of the future Trademarks Act**

Chapter	The stated provision in the Trademarks act 2009	Unchanged	Extension	New inclusion	Drop
Chapter I: Preliminary Definitions	1. Short title, extent, and commencement 2. Definitions of various terms related to the Act	NA	NA	<ul style="list-style-type: none"> <li>• Defining the shapes, sounds, colours and scents as signs and expanding the definition of a trademark.</li> <li>• Complying with the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks 1973 (Vienna Agreement)</li> </ul>	NA
Chapter II: Trademarks Registry and conditions of the Registration	3. Trademarks Registry wing and department 4. The register to record all registered trademarks 5. Registration of a certain class of goods or services 6. Requisites feature of “Trade” for registration in the Registration 7. Limitation of using colour decided by Tribunal 8. Prohibition of registration of certain matters – Any Trade that is scandalous, contrary to law, anti-religious, imitation, or cause of confusion is prohibited. 9. Prohibition of names of chemical materials	NA	NA	<ul style="list-style-type: none"> <li>• Grounds of refusal are recommended to be categorized into “absolute grounds” and “relative grounds”.</li> </ul>	NA

Chapter	The stated provision in the Trademarks act 2009	Unchanged	Extension	New inclusion	Drop
	<p>12. Opportunity to have Registration of parts of trademarks and trademarks as a series</p> <p>13. Registration of trademarks as associated trademarks</p> <p>14. Registration of trademarks subject to a disclaimer</p>				
Chapter III: Procedure For and Duration of Registration	<p>15. Application for the Registration</p> <p>15(5). Application may be either accepted or rejected or accepted subject to amendments and modifications required</p> <p>16. Withdraw from the acceptance</p> <p>17. Advertisement of application</p> <p>18. Opposition to registration (Any other person claims the same Trademarks)</p> <p>19. Register is obliged to permit the correction of any error</p> <p>20. Registration completed subject to application accepted, not opposition claim, and opposition is in favour of the applicant</p> <p>21. The act doesn't permit two-person to use the same trademarks independently but rather permits jointly owned trademarks</p> <p>22. Duration, renewal and restoration of registration</p> <p>23. Effect of removal from registration for failure to pay the fee for renewal</p>	NA	Expand the trademarks registration validity from 7 years to 10 years	<ul style="list-style-type: none"> <li>Allow application in multiple classes. In other words, one application may include several classes of goods and/or services.</li> <li>Late renewable could be considered given the registration fee and other terms and condition requires to maintain</li> </ul>	NA
Chapter IV: Effect of Registration	<p>24. The act doesn't ensure the protection of any infringement on unregistered Trademarks</p> <p>25. Right conferred by Registration-Exclusive right enjoyed by the proprietor after the registration</p>	NA	NA	<ul style="list-style-type: none"> <li>The registered trademark could be considered personal or moveable property</li> </ul>	NA

Chapter	The stated provision in the Trademarks act 2009	Unchanged	Extension	New inclusion	Drop
	<p>26. Infringement of Trademarks (Identical to registered trademarks, harm reputation of the mark)</p> <p>27. Acts not constituting infringement</p> <p>28. Registration to be prima facie evidence of validity</p> <p>29. Registration to be conclusive as to validity for 7 years</p> <p>31. Savings for use of the name, address, or description of goods or services</p> <p>32. Savings for words as the name or description of an article or substance or service.</p>			and may be subject to a security interest in the same way as other personal or moveable property	
Chapter V: Assignment and Transmission	<p>33. Power of registered proprietor to assign and give receipts to any other person</p> <p>36. Restrictions on assignment or transmission where multiple exclusive rights would be created</p> <p>37. Restrictions on assignment or transmission when exclusive rights would be created in different parts of Bangladesh</p> <p>39. With government prior consent and application made to the Registrar, the assignment and transmission of certification trademarks are permissible</p> <p>40. The procedure of Registration of assignments and transmissions</p>	NA	NA	<ul style="list-style-type: none"> <li>Introducing strong and explicitly defined compulsory licensing provisions which will be TRIPS compliant.</li> </ul>	NA
Chapter VI: Use of Trademarks and Registered users	<p>41. Under the act registered trademark is used to form the company</p> <p>43. Defensive registration of well-known trademarks</p>	NA	NA	<ul style="list-style-type: none"> <li>Licence to use a registered trademark is a right in person name and shall be binding on every successor in</li> </ul>	NA

Chapter	The stated provision in the Trademarks act 2009	Unchanged	Extension	New inclusion	Drop
	<p>45. Join application of the proprietor and proposed register users for registration as registered users</p> <p>46. Power of registered user to take proceedings against infringement</p> <p>47. Power of registered to vary or cancel registration as a registered user</p> <p>48. Registered users don't have the right of assignment and transmission</p>			title to the grantor's interest	
Chapter VII: Rectification and Correction of the Register, etc.	51. The acts have given the power to the High Court division and Registrar to cancel and vary or rectify the Register on the ground of contravention	NA	NA	NA	NA
	52. Correction of the register if any error occurs or any amendment is required in the application 53. Registered is allowed to alter the trademarks by not substantially affecting the identity	NA	NA	NA	NA
Chapter VIII: Certification of the Trademarks	<p>55. Some section is inapplicable to the certification trademarks</p> <p>56. A mark is ineligible to be a certification trademark in the name of a person who carries on a trade in goods or services of the kind certified</p> <p>57. Determine whether a mark is fitted to be a certified trademark</p> <p>58. Application for registration of certification trademark</p> <p>59. The application for registration is under consideration by the government.</p> <p>60. Opposition to registration of certification trademarks</p>	NA	NA	NA	NA

Chapter		The stated provision in the Trademarks act 2009	Unchanged	Extension	New inclusion	Drop
		60(2). Government can either refuse or accept subject to amendment or modification required 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. Provision is applied for textile goods under the International classification 67. Restriction on registration of textile goods 68. Stamping of the length of piece goods, cotton yarn and thread 69. "Piece goods" declaration 70. Government definition to determine the textile goods	NA	NA	NA	<ul style="list-style-type: none"> <li>Should drop this chapter</li> </ul>
Chapter X	Utility of Trademarks	71. Meaning of applying the trademarks and trade description	NA	NA	<ul style="list-style-type: none"> <li>Include "non-conventional mark" as a trade description such as colour, 3D, sound and scent</li> </ul>	NA
	Offence	72. Falsifying and falsely applying for trademarks	NA	NA	<ul style="list-style-type: none"> <li>Define the cases in which a non-traditional mark is infringed</li> </ul>	NA

Chapter		The stated provision in the Trademarks act 2009	Unchanged	Extension	New inclusion	Drop
	Penalty	73. Due to applying false trademarks and false trade description 74. Due to selling goods to which a false trademark or trade description is applied 75. Due to removal or attempts to remove or cause to remove of piece goods 76. Due to falsely representing a trademark as registered 77. Due to improperly describing a place of business as connected with the Trademarks office 78. Due to the falsification of entries in the Register	NA	NA		<ul style="list-style-type: none"> <li>Drop section number 75 as the act complied with NICE classification</li> </ul>
	Offence	79. Forfeiture of goods 80. Unintentional contravention of the law relating to marks and description 82. Offence committed by the company 83. Cognizance of certain offences	NA	<ul style="list-style-type: none"> <li>Extent the provision by providing permission to the court other than Metropolitan Magistrate or Magistrate of lower than the first class</li> </ul>	NA	NA

Chapter		The stated provision in the Trademarks act 2009	Unchanged	Extension	New inclusion	Drop
	The procedure of implementing legal	85. Costs of defence or prosecution 86. No accusation never be commenced after 3 years expiry date 87. Government officer is not compelled to any court regarding the information as to the commission of offence 88. Punishment for Abatement of any offence committed outside of Bangladesh 89. Authority of the Government to issue an instruction	NA	NA	NA	NA
Chapter XI	Miscellaneous procedure if a certain	90. Warranty is provided under the act on the sale of marked goods 91. Procedure and powers of Registrar-Registrar possess the same power as the Civil Court at a certain case 92. Procedure of the registering marks in case of death of register during the proceeding of the marks	NA	<ul style="list-style-type: none"> <li>Giving the registrar the power to make decisions on the issue of the provision mentioned in section 91</li> </ul>	NA	NA
	Other procedures of	93. Extension of application time subject to logical cause 94. Abandonment of application 95. Submission of the affidavit and oral evidence before the government	NA	NA	<ul style="list-style-type: none"> <li>Include the new provision which allows that case can be instituted in any court inferior to a District Court</li> </ul>	NA
	Suit	96. Suit for the infringement before a district court 97. Relief's in suits for infringement or passing off 97(2). The reason for not granting relief from the suit 97(2) (C). Suit for passing off	NA	<ul style="list-style-type: none"> <li>Extend the present rule by allowing infringement suits to be filed in both the district and lower courts.</li> </ul>	<ul style="list-style-type: none"> <li>Special provision to include the DPDT as an authority to deal with the suit against infringement</li> </ul>	NA

Chapter		The stated provision in the Trademarks act 2009	Unchanged	Extension	New inclusion	Drop
	Rectification	98. Application procedure for rectification of Register to be made to the High Court Division in certain case 99. Application procedure for application for rectification of the Register before the High Court Division	NA	NA	NA	NA
	Appeals and rule of the	100. Appeals 101. Power of the High Court Division to make rules 102. Procedure where the validity of registration of the trademarks is questioned	NA	NA	<ul style="list-style-type: none"> <li>Provision for the creation of a special tribunal to handle IP-related lawsuits and appeals</li> </ul>	NA
	Power and duty of the	103. Right to appear and be heard any suit by the registrar 104. Costs of Registrar in proceedings before High Court Division 106. Evidence of entries in the Register and things done by Registrar	NA	NA	<ul style="list-style-type: none"> <li>Increase the registrar's legal power to take the action against trademark infringement.</li> </ul>	NA
	Power and rule of government	108. Power of Government to require goods or services to show an indication of origin 109. Power to prohibit imported goods bearing false trademarks 112. Trade usage is taken into account during the trial 114. The document that not be registered 115. Keeping the index of the registered trademarks 116. Document open to the public inquiry	NA	NA	NA	NA
	Fee	117. Prescribed government fee	NA	NA	<ul style="list-style-type: none"> <li>Special provision to reduce the fee structure for the SME</li> </ul>	NA

Chapter		The stated provision in the Trademarks act 2009	Unchanged	Extension	New inclusion	Drop
	Exemption	118. Exemption from the act	NA	NA	NA	NA
	Special provision	119. Relating to Convention Countries 120. Relating to the Convention Application 121. Relating to reciprocity 122. Relating to collective marks	NA	NA	<ul style="list-style-type: none"> <li>Adoptation of the Madrid protocol</li> </ul>	NA
	Government rule for the act	123. The government is obliged to make a rule for implementing this act 125. Report regarding trademarks to parliament	NA	<ul style="list-style-type: none"> <li>Revise the Trademarks Rules of 2015, and consider the online registration procedure</li> </ul>	NA	NA
	Repeal and	127. Repeal and saving 128. Special provisions relating to savings	NA	NA	<ul style="list-style-type: none"> <li>Inclusion of the IPR enforcement (export and import) rules, 2019</li> </ul>	NA

Source: Authors' compilation from various sources

**Table 7: Further inclusion/exclusion in the trademarks Act**

Topic	Stated provisions in the Trademarks act, 2009	New inclusion/Exclusion
<b>Special provision relating to the protection of trademarks through international registration under the Madrid Protocol</b>	No mention	<ul style="list-style-type: none"> <li>Separate legislation should be enacted under the act to protect the trademarks of WTO member countries by a single registration in any WTO's focal point</li> </ul>
<b>Special Tribunal for IP</b>	No mention	<ul style="list-style-type: none"> <li>Establishment of a special tribunal of IP</li> </ul>
<b>Omission of the special provision of textiles goods</b>	Mention	<ul style="list-style-type: none"> <li>Provisions should be excluded as we have a NICE classification</li> </ul>
<b>Vienna Agreement Establishing an International Classification of the Figurative Elements</b>	No mention	<ul style="list-style-type: none"> <li>Provision related to the Vienna agreement to follow the classification of the figurative elements</li> </ul>

*Source: Authors' compilation from various sources*

## 5. Conclusion

The trademarks act has been enacted in Bangladesh to secure the protection of brands and names that define the unique characteristics of specific goods and services and to comply with international IP-related treaties, particularly the TRIPS agreement. Initially, trademark protection was conferred by the Penal Code of 1860, followed by the Merchandise Mark Act of 1889 and the Trademarks Act of 1940. All three acts, however, left out some part of trademark protection. Moreover, one single act related to trademark protection was necessary after the liberation of Bangladesh in 1971. The long unorganized law was combined into a single act in 2009 and designated the trademarks act, 2009.

Our primary **finding** from the review is that Bangladesh lacks the infrastructure to implement the act, clearly demonstrating that it has been enacted to comply with an international agreement, or that it was imposed on us by a developed country in the name of securing foreign investment through sound technology transfer and knowledge sharing. The qualitative statistics indicate that the trademark act is not being implemented at practically all levels, from administrative authority to business and individual alignment with the act. Looking at the close comparison with the international best practice, Bangladesh is lagging in terms of facilitating the trademarks service and complying with the international treaty, particularly the Madrid protocol. The administration of providing trademarks (DPDT) does not reveal the "who and what marks received" trademark registration on a regular basis; instead, who and what marks receive trademark registration would be notified through a manual procedure after submitting an application to the DPDT. The application of trademark registration procedure is lengthy, and the fee structure for trademark registration is quite

high, depending on the socio-economic structure of Bangladesh. The judicial framework is inadequately and unprepared to respond quickly to any trademark infringement. Despite the fact that the existing statute relates to the defensive registration of well-known marks, the DPDT has yet to recognize well-known marks, therefore the world's most well-known businesses have to take registration and they suffer challenges in getting effective protection. During the review, we noticed a pattern of trademark infringement in the course of exporting and importing products and services. The trademarks of the Apparels brand are being violated in export, and cosmetic-related counterfeit items are being imported. Given the fact that the customs legislation allows the customs authority to restrict the entry and exit of counterfeit goods, there is a lack of coordination between the DPDT and the customs authority to enforce this practice.

From the perspective of policy implications, this fact has thus led to the concern that the trademarks law of Bangladesh has failed to accommodate the bursting benefits of TRIPS flexibilities that it could otherwise exploit as a member of the LDCs. Given this, it is thus understandable that some provisions of the Trademarks Act of Bangladesh should be revised yet again to bring them into conformity with the developmental and trade-promotional prospects of Bangladesh. In so doing, the scheme of reform should, however, be considered in light of advancements in technology and changes in consumer perception and behaviour in Bangladesh and beyond.

In light of this, the review makes **recommendations** for effective implementation, taking into account impending challenges such as LDC graduation, UMIC, Covid-19, and the fourth industrial revolution. Infrastructure development is the first and foremost need for ensuring strict IP protection, and such infrastructure development might include increasing the manpower in DPDT and providing them with proper training on IP expertise, as well as empowering the DPDT to deal with trademark registration violations. The application procedure requires completion quickly, digitalization of the application may be considered as a means of reducing time delays in the current system. DPDT is required to update its website and provide online service by first assuring the regular publication of registered marks on the website. Seminars, symposiums, and workshops could be held on a regular basis to raise public knowledge about IPRs, and academic and training institutions could integrate trademarks and other IPRs into their curricula. The existing shortcoming in the DPDT must be addressed in partnership with the highest trade organization in order to make it DPDT as WTO's focal point. Furthermore, a special tribunal might be established to deal with IP violations and strengthen the enforcement system. As we follow the NICE classification, a special provision of textiles goods is required to be omitted. We don't need a specific provision for textiles; in fact, having one adds ambiguity in identifying the goods with the NICE categorization. To apply the IPR enforcement (Export and Import) rules 2019, the DPDT requires collaboration with customs authorities to restrict the entry and exit of counterfeit items during export and import.

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## Annexure

### A. List of KIIS

Organisation/Association	Key informant
Legal expert	<ul style="list-style-type: none"> <li>Barrister Shaleh Akram Somrat (Advocate, Supreme Court of Bangladesh)</li> </ul>
Ministry of Industry	<ul style="list-style-type: none"> <li>Sheikh Faezul Amin [Additional Secretary (Policy, Law and International Co-operation), Ministry of Insutries]</li> <li>Md. Salim Ullah (Senior Assistant Secretary, Ministry of Industries)</li> <li>Dr A.F.M Amir Hussain (Deputy Secretary, Ministry of Industries)</li> </ul>
Department of Patents, Designs, and Trademarks	<ul style="list-style-type: none"> <li>Zanendra Nath Sarker (Registrar, Additional In Charge)</li> <li>Kongkan Chakma (Deputy Registrar, Trademarks)</li> <li>Md. Belal Hossain (Examiner, Trademarks)</li> <li>Nihar Ranjan Barman (Examiner, Patent)</li> </ul>
Federation of Bangladesh Chambers of Commerce and Industries	<ul style="list-style-type: none"> <li>Manzur Ahmed, Adviser, FBCCI</li> </ul>
Metropolitan Chamber of Commerce and Industry	<ul style="list-style-type: none"> <li>Md. Saidul Islam, Additional Secretary-General, MCCI</li> <li>M. Abdur Rahman, Deputy Chief, MCCI</li> </ul>
Women Entrepreneur	<ul style="list-style-type: none"> <li>Fahima Supria, Owner of Shororitu</li> </ul>

### B. Team Composition

Name of staff	Area of expertise relevant to the assignment	Designation for this assignment	Assigned tasks or deliverables
Dr. Bazlul Haque Khondker	Economist, Institutional analysis expert, Survey expert, FGD and KII expert	Team Leader	Finalize questionnaire, FGD, and KII checklists, Evaluation, and analysis, Draft synthesizing summary, Draft short summaries Finalizing reports
Dr. Selim Raihan	Economist, Political economy and institutional analysis expert, Survey expert, FGD and KII expert	Co-Team Leader, Trade Expert	Coordinating and monitoring the team, monitoring all the activities performed by the team members, finalizing questionnaire, FGD, and KII checklists, evaluation, and analysis draft synthesizing summary and finalizing reports.
Mahtab Uddin	Policy analysis and evaluation, Survey	Policy Analyst	Monitoring all the activities performed by the team members, finalizing questionnaire, FGD and KII checklists,

<b>Name of staff</b>	<b>Area of expertise relevant to the assignment</b>	<b>Designation for this assignment</b>	<b>Assigned tasks or deliverables</b>
	expert, FGD and KII expert		evaluation, and analysis, draft synthesizing summary and finalizing reports.
Mohammad Golam Sarwar	Legislative consultant, development law practitioner	Legal Expert	Analysing the legal terms and provisions of the study, identifying the possible grounds of alterations, extensions, and exclusion of current legal provisions, and providing legal recommendations.
Mir Ashrafun Nahar	Data analyst, Survey Experts	Senior Research Associate	Desk review, analysing secondary data, designing questionnaires for KIIs, supervising and conducting FGDs, analysing primary data, and drafting reports.
Md. Nadim Uddin	Data analyst, Survey Experts	Research Associate	Desk review, analysing secondary data, designing survey questionnaires for KIIs, supervising the survey, conducting FGDs, analysing primary data, and drafting the reports.
Farhin Islam	Data analyst, Survey Experts	Research Associate	Research and analysis of relevant literature, primary and secondary data, supervising and conducting KIIs and FGDs.
Afia Mubasshira Tiasha	Data collection and Supervision	Research Associate	Desk Review, developing KII questionnaire, assisting in conducting the KIIs, conducting FGDs.
Samantha Rahman	Data analysing, and Data cleaning	Research Associate	Assisting in the KIIs collection, analysing and interpreting KIIs data.



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