

SUPREMEiP

Passing off is a form of unfair competition that occurs in Bangladesh when a person misrepresents his goods or services as those of another person. This often results in confusion among consumers and dilution of the goodwill and reputation associated with the original trademark or brand.

Under Bangladeshi law, passing off is a common law tort and is recognized as a form of trademark infringement. To establish passing off in Bangladesh, the following elements must be proved:

1. **Goodwill or Reputation:** The plaintiff must have established goodwill or reputation in the market for his goods or services.
2. **Misrepresentation:** The defendant must have made a misrepresentation that is likely to deceive the public into believing that the defendant's goods or services are those of the plaintiff.
3. **Damage:** The plaintiff must show that the defendant's actions have caused him damage, such as loss of sales or harm to his reputation.

If passing off is established, the remedies available to the plaintiff may include injunctions to stop the infringing behavior, damages to compensate for losses, and account of profits to recover the defendant's profits. In serious cases, criminal sanctions may also be imposed.

It is important to note that passing off actions can be complex and challenging to prove, and it is recommended to seek the assistance of an experienced trademark attorney in Bangladesh to ensure that the case is properly presented and to maximize the chances of success.

Case law on Passing off

In the case of *New Zealand Milk Brands Ltd. Vs Sanowara Dairy & Industries Ltd.* 30 BLD (HCD) 2010, the High Court Division stated that the only test that has to be applied when the court is considering a case under Section 10 is the test of identity or resemblance. Even if the applicant could establish a long user, if the respondent could establish no user at all, if there was a resemblance between the marks of the applicant and the respondent, and if there was a likelihood of deception, and if the respondent was first in the field and had their trademark registered, the applicant's trademark could not be registered.

Distinction between infringement and passing off

Infringement occurs when a person uses a trademark that is identical or confusingly similar to a registered trademark without the permission of the owner. Infringement can result in the unauthorized use of the trademark on the same or similar goods or services, and can cause confusion among

consumers and dilution of the goodwill associated with the original trademark.

Passing off, on the other hand, occurs when a person misrepresents his goods or services as those of another person. This often results in confusion among consumers and dilution of the goodwill and reputation associated with the original trademark or brand.

The main difference between infringement and passing off is that infringement requires the unauthorized use of a registered trademark, while passing off requires only a misrepresentation that is likely to deceive the public. In other words, passing off can occur even in the absence of a registered trademark, while infringement requires the existence of a registered trademark.

Both infringement and passing off are recognized as forms of unfair competition and can result in legal consequences, including injunctions to stop the infringing behavior, damages to compensate for losses, and account of profits to recover the defendant's profits. In serious cases, criminal sanctions may also be imposed.

Well-Know Trademark Protection in Bangladesh

Well-known trademarks are afforded a higher level of protection in Bangladesh under the provisions of the Trade Mark Act, 2009. A well-known trademark is one that has acquired a significant reputation and reputation among the general public and is widely recognized in Bangladesh.

In order to receive well-known trademark protection in Bangladesh, a trademark owner must demonstrate that the mark has acquired a high level of reputation and recognition among the general public and that its use is likely to cause confusion or deception among consumers.

Once a trademark has been recognized as well-known in Bangladesh, the owner is entitled to a broader range of legal remedies to protect their mark, including the right to prevent the registration of identical or similar trademarks and the right to prevent the use of identical or similar trademarks on the same or similar goods or services.

In addition, well-known trademarks are protected against infringement even if the infringing trademark is not identical or confusingly similar to the well-known mark. This means that the owner of a well-known trademark has the right to take legal action against the use of any trademark that is likely to dilute the distinctive character or reputation of the well-known trademark.

In short, the well-known trademark protection in Bangladesh provides a higher level of legal protection to trademark owners and helps to ensure that their trademarks are protected against infringement and dilution.

What legal rights and protections are accorded to registered trademarks?

In Bangladesh, a registered trademark confers several legal rights and protections to the owner of the mark. Some of these rights and protections include:

1. **Exclusive Right to Use:** The owner of a registered trademark has the exclusive right to use the mark in connection with the goods and services specified in the registration. No other person may use a mark that is identical or confusingly similar to the registered mark in connection with the same or similar goods and services.
2. **Legal Presumption of Ownership:** The registration of a trademark creates a legal presumption that the owner is the rightful owner of the mark. This makes it easier for the owner to enforce their rights and defend against infringement.
3. **Prevent Infringement:** The owner of a registered trademark can take legal action to prevent others from infringing their trademark by using similar or identical marks on the same or similar goods and services.
4. **Right to License:** The owner of a registered trademark has the right to license others to use the mark, subject to certain conditions. This allows the owner to generate additional income from their trademark.
5. **Right to Assign:** The owner of a registered trademark has the right to assign or transfer their trademark to another person. This can be done for consideration, such as money, or for no consideration, such as a gift.
6. **Right to Prevent Import of Infringing Goods:** The owner of a registered trademark has the right to prevent the import of infringing goods into Bangladesh that bear their trademark or a confusingly similar mark.

These legal rights and protections help to secure the owner's investments in their trademark and ensure that their trademark is properly protected and distinguished from similar or identical marks used by others in the market.

In accordance with Section 25 of the Trademarks Act, only the registered owner of a trademark can use the same and, in case of infringement of the registered mark, the owner reserves the right to initiate an infringement suit against the infringer before the court and obtain relief as enumerated in Section 97 of the act. Relief in this regard may include injunctions, damages or accounts of profits, together with delivery of the infringing material for destruction or erasure.