

# SUPREMEiP

## What is the trademark assignment?

Trademark assignment refers to transferring the ownership rights of a trademark from one party to another. The original owner of the trademark (assignor) can transfer their ownership rights to another party (assignee) through an agreement or contract.

The assignment can be of the entire trademark or a part of it, such as a specific class of goods or services. The assignment of a trademark typically involves a formal agreement between the assignor and the assignee that specifies the terms and conditions of the transfer, such as the scope of the assignment, the consideration or payment for the transfer, and the representations and warranties of the parties.

Once the assignment is complete, the assignee becomes the new trademark owner and is entitled to use and protect the mark against infringement. The assignee can also license the trademark to others or sell it to another party.

In many jurisdictions, including Bangladesh, trademark assignment requires registration with the relevant authority to be effective. This ensures that the transfer of ownership is recorded and can be enforced against third parties.

## Trademark Assignment Procedure in Bangladesh

Trademark assignment in Bangladesh involves transferring the ownership of a trademark from one entity to another. The following is a general procedure for trademark assignment in Bangladesh:

- Draft and sign a trademark assignment agreement between the assignor (current trademark owner) and the assignee (new trademark owner).
- Submit a joint application for trademark assignment to the Department of Patents, Designs, and Trademarks (DPDT). The application should be signed by both the assignor and assignee or their authorized representatives.
- The DPDT will examine the application to ensure that it meets the legal requirements and that the assignee is eligible to own the trademark.
- The DPDT will publish a notice of the trademark assignment in the Trademark Journal and allow interested parties to oppose the assignment within 60 days from the publication date.
- If no opposition is received within the opposition period, or if the opposition is rejected, the DPDT will record the assignment in the Trademarks Register and issue a new certificate of registration to the assignee.
- The assignee can then use the trademark and enforce their exclusive rights to the mark.

It is important to note that trademark assignment can have legal implications. The agreement should be drafted carefully to ensure that all necessary terms and conditions are included. Legal advice

should be sought before initiating the trademark assignment process in Bangladesh.

### **What are the requirements for the trademark assignment in Bangladesh?**

1. **A written agreement:** The assignor and the assignee must enter a written agreement for the trademark assignment. Both parties must sign the contract and specify the transfer terms and conditions.
2. **Application for assignment:** The assignor and assignee must file a joint application for the trademark assignment with the Department of Patents, Designs and Trademarks (DPDT) in Bangladesh. Both parties or their authorized representatives must sign the application.
3. **Publication of notice:** The DPDT will publish a notice of the assignment in the Trademark Journal and allow interested parties to oppose the assignment within a specified period. The opposition period is typically 60 days from the date of publication.
4. **Verification of assignment:** The DPDT will examine the application and the assignment agreement to ensure that the requirements for the assignment have been met. If everything is in order, the DPDT will register the assignment and issue a new registration certificate to the assignee.
5. **Payment of fees:** The assignor and assignee must pay the prescribed fees for the trademark assignment.
6. **A simple POA with no notarization or legalization is required.**

It is important to note that the requirements for trademark assignment in Bangladesh may vary depending on the specific circumstances of the assignment. It is recommended that legal advice be sought to ensure all legal requirements are met.

### **What is the COST of a trademark assignment in Bangladesh?**

Official Fee: \$150+Professional Fee: Please [Contact](#)

## **Relevant Laws and Acts in Bangladesh Concerning Trademark ASSIGNMENT & TRANSMISSION**

### **Section 33. Power of registered proprietor to assign and give receipts-**

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

### **34. Assignability and transmissibility of registered trademarks-**

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

### **35. Assignability and transmissibility of unregistered trademarks**

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

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

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

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

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

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

(1) Notwithstanding anything contained in sections 34 and 35 where, as a result of the assignment or transmission, there would exist, whether, under this Act or any other law, exclusive rights in more than one of the persons concerned to the use, relating to the same goods or and the trademarks be nearly identical or resemble each other. For this reason, people may be deceived or confused, and a trademark shall not be assignable or transmissible :

Provided that an assignment or transmission shall not be deemed to be invalid if the persons assigned to sell the goods or services of a trademark within Bangladesh or to export the goods or services to the same market outside Bangladesh can not exercise their rights for the limitations imposed upon the exclusive rights.

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

(3) A certificate issued under sub-section (2) shall, subject to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under sub-section (1) of this section of the assignment in so far as such validity or invalidity depends upon the facts set out in the case :

Provided that a certificate in favor of validity shall not be treated as conclusive if an application for the registration under section 40 if the title of the person becoming entitled is not made within 6(6) months from the date on which the certificate is issued.

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

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

(2) In case of an application in the prescribed manner where the proprietor of a trademark who proposes to assign it or a person who claims that a registered trademark has been transmitted to him or a predecessor-in-title of his since the commencement of this Act, the Registrar is satisfied that in all the circumstances the assignment or transmission in the exercise of the said rights under sub-section (1) of the trademark would not be contrary to the public interest, may, approve the assignment or transmission, and assignment or transmission so approved shall not, be deemed to be invalid under this Section or section 36 of this Act.

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

### **38. Conditions for assignment other than in connection with the goodwill of a business.**

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

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

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

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

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

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

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

(1) A certification trademark may be assignable or transmissible

(a) with the prior consent of the Government on that behalf and

(b) if the application is made in the prescribed manner through the Registrar.

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

### **40. Registration of assignments and transmissions.**

(1) where a person becomes entitled by assignment or transmission to a registered trademark, he shall apply in the prescribed manner to the Registrar to register his title. The Registrar shall, on receipt of the application and proof of the title to his satisfaction, register him as the proprietor of the trademark in respect of the goods or services in respect of which the assignment or transmission has

effect and shall cause particulars of the assignment or transmission to be entered on the Register:

Provided that where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until a competent court settles such dispute.

(2) Except for an application before the Registrar under sub-section (1) of this section or an appeal from an order thereon, or an application under section 51 of this Act or an appeal from an order thereon, a document or instrument in respect of which no entry has been made in the Register in accordance with sub-section

(1) of this section shall not be admitted in evidence by the Registrar or any Court in proof of title to the trademark by assignment or transmission unless the Registrar or the Court, as the case may be, otherwise directs.