

SUPREMEiP

What is Trademark Infringement?

Trademark infringement in Bangladesh occurs when a person uses a trademark that is identical or confusingly similar to an existing registered trademark, without the permission of the trademark owner. This can include the use of a similar trademark for goods or services that are similar to those for which the original trademark is registered, or the use of a trademark that is likely to cause confusion among consumers.

The trademark owner has the right to take legal action to stop the infringing use of the trademark and to seek damages for any harm that has been caused by the infringement. This can be done through the courts or through administrative proceedings with the Intellectual Property Office of Bangladesh.

In order to prove trademark infringement in Bangladesh, the trademark owner must show that the alleged infringing use of the trademark is likely to cause confusion among consumers and that the use of the trademark is unauthorized.

It is recommended to seek the assistance of an experienced trademark attorney or lawyer in Bangladesh to help protect trademark rights and to take legal action in the event of trademark infringement.

Case law on Trademark Infringement

The Court always use its discretionary power to determine such infringement for the greater good. Even the Court is rigid enough to rectify the registered trademarks to provide a safe and non-confusing environment to the public at large to choose the right and good quality products by identifying the original brand by looking and hearing the name of the brand itself. In Baby Food Products Ltd. Vs Nabisco Biscuit and Bread Factory Ltd. 30 BLD (HCD) 2010 Page-27, it was held by the High Court Division that due to the deceptively similar name six Trademark registrations should be expunged and rectified from the Register of Trademarks. The Appellate Division in appeal by the Baby Food Products Ltd. has affirmed the decision of the High Court and held that whatever product the appellant is producing and selling in the trade name of NABISCO is likely to deceive the people at large who will presume the products to be of the NABISCO being misled by the similarity in sound.

CIVIL REMEDIES against trademark infringement in Bangladesh

Civil remedies are legal remedies that are available in the civil court system to remedy a wrong or injury, such as trademark infringement. In Bangladesh, the following civil remedies are available against trademark infringement:

Injunctions: An injunction is a court order that requires the infringing party to stop using the infringing trademark. This remedy is often sought to prevent ongoing harm to the trademark owner's rights and to prevent future infringements.

Damages: Damages refer to monetary compensation that is awarded to the trademark owner for any harm that has been caused by the infringing use of the trademark. This can include compensation for lost profits, as well as damages for any harm to the goodwill or reputation of the trademark.

Account of profits: An account of profits requires the infringing party to account for any profits that were made as a result of the infringing use of the trademark. This remedy is designed to prevent the infringing party from unjustly enriching themselves as a result of their infringing activities.

Delivery up or destruction of infringing goods: In some cases, the trademark owner may be entitled to have the infringing goods delivered up or destroyed. This remedy is designed to prevent the infringing goods from continuing to cause harm to the trademark owner's rights.

CRIMINAL REMEDIES against trademark infringement in Bangladesh

In Bangladesh, there are criminal remedies available for trademark infringement under the Trademarks Act, 2009. These remedies are intended to provide a deterrent against trademark infringement and to protect the rights of trademark owners.

The following criminal remedies are available for trademark infringement in Bangladesh:

Fines: The infringing party can be fined up to 50,000 Taka (approximately \$590 USD) for each instance of trademark infringement.

Imprisonment: The infringing party can be sentenced to imprisonment for up to three years for each instance of trademark infringement.

Seizure of infringing goods: The infringing goods can be seized by the government, and the infringing party may also be required to pay damages to the trademark owner.

It is important to note that criminal remedies are only available in serious cases of trademark infringement, and may only be pursued in addition to or in conjunction with civil remedies.

Customs Enforcement against trademark infringement in Bangladesh

In Bangladesh, all trading activities are regulated by the Ministry of Commerce under the Imports and Exports (Control) Act 1950. Upon receiving a complaint from a rights holder, the relevant customs authority may take steps against any person or entity that imports goods in violation of Sections 15 and 16 of the Customs Act. Section 15 of the Customs Act prohibits the import of goods, whether, by air, land or sea, that fall within the following categories:

- goods marketed under a counterfeit trademark or false trade description;
- goods made or produced outside Bangladesh and intended for sale under a copyrighted design under the Patents and Designs Act in respect of the class to which the goods belong or any fraudulent or obvious imitation of such design without a license or the rights holders written consent;
- and goods made or produced outside Bangladesh and marketed under any name or trademark being or purporting to be the name or trademark of any manufacturer, dealer or trader in Bangladesh.

As per Section 17 of the Customs Act:

if any goods bearing registered trademarks are imported into or attempted to be exported out of Bangladesh in violation of the provision of Section 15 or of a notification under Section 16, such goods shall, without prejudice to any other penalty to which the offender may be liable under this act or any other law, be liable to be detained and confiscated and shall be disposed of in such a manner as may be prescribed. A rights holder may also approach the High Court Division to obtain an order directing Customs to detain or seize the counterfeit goods.

What is the Administrative remedies against trademark infringement in Bangladesh?

In Bangladesh, administrative remedies are one of the methods available to address trademark infringement. Administrative remedies refer to the actions taken by government agencies to resolve disputes and enforce intellectual property rights.

Under the Trade Mark Act, 2009, the Registrar of Trade Marks is empowered to take administrative action against trademark infringement. This may include the suspension or cancellation of the infringing trademark registration, the imposition of fines, and the issuance of cease and desist orders to stop the infringing use of the trademark.

Additionally, the Department of Patents, Designs and Trademarks (DPDT) can conduct investigations into trademark infringement and take administrative action against the infringers. The DPDT can also assist trademark owners in resolving disputes and protecting their rights through negotiation, mediation, and alternative dispute resolution mechanisms.

In conclusion, administrative remedies are an important component of the trademark enforcement system in Bangladesh and provide trademark owners with a more efficient and cost-effective way to address infringement and protect their rights.

Under Section 42 of the Act 2009, an aggrieved person can apply to the Registrar of Trademark for removal of a registered trademark from the Register on the grounds either that the registered trademark lacks bonafide intention on the part of the owner to use it about those goods or services and there has been no such use till the date one month before the date of the present petition or the registered trademark was not used for five years or longer period up to a date one month before the date of the present petition.

Alternatively, under Section 43 of the Act 2009, an aggrieved person can apply to the Registrar of Trademarks for cancellation of trademark registration as a defensive trademark. Defensive trademark means a trademark consisting of any invented word has become so well-known as respects of any goods or services in relation to which it is registered and has been used, that the use thereof in relation to other goods or services, as the case may be, would be likely to be taken as indicating a connection in the course of trade.

What defenses are available to infringers in Bangladesh?

In Bangladesh, there are several defenses that may be available to a person accused of trademark infringement. Some common defenses include:

Fair Use: The use of a trademark in a fair and reasonable manner, such as for comparative advertising or for news reporting purposes, may be a defense against trademark infringement.

Prior Use: If the accused infringer can show that they were using the trademark before the trademark owner, they may have a defense against trademark infringement.

Non-Infringing Use: If the accused infringer can show that their use of the trademark is not likely to cause confusion among consumers, they may have a defense against trademark infringement.

Lack of Knowledge: If the accused infringer can show that they did not know about the existence of the trademark and that their use of the trademark was not intentional, they may have a defense against trademark infringement.

Invalidity of the Trademark: If the trademark owner's trademark registration is found to be invalid, the accused infringer may have a defense against trademark infringement.

In case of infringement of a trademark, the defendant may use the following defenses also;

- the doctrine of laches (if applicable);
- the doctrine of estoppel (if applicable);
- the dissimilarity between the marks (in cases where the plaintiff alleges similarity between the marks);
- the nature of the defendant's goods are entirely different from that of the plaintiff;
- the defendant's customer base is entirely different from that of the plaintiff; and
- the defendant's goods and services are distinguishable from the plaintiff's goods and services.