

SUPREMEiP

What are the main sections, laws, or acts typically cause trademark objections in Bangladesh?

According to rule 14(a), the examiner will review a trademark application under sections 6, 8, 9, 10, 11, 67(1), and 120. The following are specifics for these sections:

1. **Section 6: Requests for registration in the Register.**

Section 6(1)(a): A trademark shall not be registered in the Register unless it contains or consists of at least one of the following essential particulars: the name of a company, individual, or firm represented in a unique or particular manner;

Section 6(1)(b): the signature of the applicant for registration or some predecessor in his business;

Section 6(1)(c): one or more invented words;

Section 6(1)(d): one or more words having no direct reference to the character or quality of the goods or services, as the case may be, and not being, according to its ordinary signification, a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in Bangladesh;

Section 6(2): A name, signature, or word that does not fall within the description in clauses (a), (b), (c), and (d) of sub-section (1) except in clause (e) of this subsection shall not be registered in the Register except upon the evidence of its distinctiveness.

Section 6(3): For this Act, the expression “distinctive mark,” with the goods or services in respect of which a trademark is proposed to be registered, means a trademark that distinguishes the goods or services, as the case may be, of the proprietor from the goods or services, of the same kind in such trade and in the case of which no such connection exists, either generally or, where the trademark is proposed to be registered, subject to limitations.

2. **Section 8: Prohibition of registration of some issues;**

Section 8(a): No mark or part of a mark shall be registered as a trademark which comprises or consists of any scandalous or obscene matter; or

Section 8(b): the use of which would be contrary to any law for the time being in force; or

Section 8(c): the use of which would be likely to deceive or cause confusion; or

Section 8(e): which contains any matter likely to hurt the religious susceptibilities of any class of the citizens of Bangladesh;

Section 8(d): which is identical with, or is an imitation of, or contains as an element, an armorial bearing, flag or other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any state or international organization created by an international convention, charter or other instruments, unless authorized by the competent authority of that state or organization; or

Section 8(e): which would otherwise be disentitled to protection in a court;

Section 8(f): the application is made in bad intention and faith.

3. 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 or reparation, and any such registration shall, notwithstanding anything contained in section 29, be deemed, for section 51, to be an entry made in the Register without sufficient cause or wrongly remaining on the register, as the circumstances may require:

Provided that nothing in this section shall apply to a word that is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trademark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

4. Section 10: Prohibition of registration of identical or deceptively similar trademark:

Section 10 (1): Save as provided in sub-section (2), no trademark shall be registered in respect of any goods or description of goods or in respect of any services or description of services which is identical with or deceptively similar to a trademark which is already registered in the name of a different proprietor in respect of the same goods or description of goods or in respect of the same services or description of services, as the case may be.

Section 10 (2): In case of honest concurrent use or of other special circumstances that, in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of trademarks that are identical or nearly resemble each other in respect of the same goods or services or the same description of goods or services subject to such limitations and conditions, if any, as the Registrar may think fit to impose.

Section 10 (3): Where separate applications are made by different persons to be registered as proprietors respectively of trademarks which are identical or nearly resemble each other in respect of the same goods or description of goods or respect of same services or description of services, the Registrar may pending the applications bearing a later date until, the determination of the proceedings in respect of the earlier application, and dispose of the earlier applications in the light of the evidence tendered concerning the application and the oppositions thereto.

Section 10 (4): (4) No trademark shall be registered in respect of any goods or services if it is identical with, or confusingly similar to, or constitutes a translation or a mark or trade description which is well-known in Bangladesh for identical or similar goods or services of another enterprise.

Section 10 (5): No trademark shall be registered in respect of goods or services if it is well-known and registered in Bangladesh for goods or services which are not identical or similar to those in respect of which registration is applied, if?

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

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

Section 10 (6): In determining whether a mark stated in sub-sections (4) and (5) is well known, the knowledge of the mark in the relevant sector of the public, including knowledge obtained in Bangladesh as a result of the mark's promotions, shall be taken into account.

Section 10 (7): Nothing in this section shall prevent trademark registration where the proprietor of the earlier trademark or other earlier right consents to the registration.

Explanation: For this section, "earlier trademark" means a registered trademark with a date of

application for registration earlier than the trademark in question. Taking account, where appropriate, of the priorities claimed in respect of the trademark, and references in this section to an earlier trademark include a trademark in respect of which an application for registration has been made and which, if registered, would be earlier.

Section 10 (8): A trademark whose registration expires shall continue to be taken into account in determining its capability to be registered for a period of 1(one) year after the expiry unless the Registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry.

5. Section 11: Use of names of living persons or dead persons;

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

6. Section 67: Restriction on registration of textile goods;

Section 67(1): In respect of textile goods being piece goods?

Section 67(1)(a): no mark consisting of a line heading alone shall be capable of being registered as a trademark;

Section 67(1)(b): a line heading shall not be deemed to be adapted to distinguish;

Section 67(1)(c): registering a trademark shall not give any exclusive right to use a line head.

7. Section 120: Special Provision relating to Convention Application;

Section 120 (1): Where a person has made an application for the registration of a trademark in a Convention Country which is a member of the Paris Convention or a member of the World Trade Organization and that person, or his legal representative or assignee, makes an application for the registration of a trademark in Bangladesh within 6(six) months after the date in which the application was made

in Convention Country, together with the full particulars and certified copy of the priority application, the trademark shall, if registered under this Act, be registered as of the date on which the application was made in the Convention Country, and that date shall be deemed for this Act to be the date of registration.

Section 120 (2): Where applications have been made for the registration of a trademark in two or more Convention Countries, the period of 6(six) months referred to in sub-section (1) shall be reckoned from the date on which the earliest of those applications was made.

Section 120 (3): Nothing in this Act shall entitle the proprietor of a trademark to recover damages for infringement before the date of application for registration under this Act.

What are the reasons for trademark objections or office actions in

Bangladesh?

Trademark objections or office actions in Bangladesh can occur for several reasons, including:

1. **Similarity with existing trademarks:** The Trademark Office may object if the trademark being applied for is too similar to existing trademarks in the same class of goods or services
2. **Descriptive Trademarks:** If the trademark is descriptive of the goods or services it represents, the Trademark Office may object to its registration.
3. **Generic Trademarks:** If the trademark is generic and does not distinguish the goods or services it represents, the Trademark Office may object to its registration.
4. **Lack of Distinctiveness:** If the trademark is not distinctive enough to differentiate it from other trademarks, the Trademark Office may object to its registration.
5. **Trademark Conflict with Prior Rights:** If the trademark conflicts with the rights of another party, such as a trademark registration, the Trademark Office may object to its registration.
6. **Trademark Conflict with Geographical Indications:** If the trademark conflicts with a geographical indication, the Trademark Office may object to its registration.
7. **Trademark Violates Public Order and Morality:** If the trademark is considered offensive or violates public order and morality, the Trademark Office may object to its registration.
8. Those trademarks which is identical with, or is an imitation of, or contains as an element, an armorial bearing, flag or other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any state or international organization created by an international convention, charter or other instruments, unless authorized by the competent authority of that state or organization; or which comprises or consists of any scandalous or obscene matter; or which contains any matter likely to hurt the religious susceptibilities of any class of the citizens of Bangladesh; or the use of which would be contrary to any law for the time being in force; or (c) the use of which would be likely to deceive or cause confusion; or which would otherwise be disentitled to protection in a court; or the application is made in bad intention and faith;

It is important to note that these objections are not final and the trademark applicant may respond to the objections by submitting evidence or arguments in support of their trademark registration.

How to overcome trademark objection/office action in Bangladesh?

If you receive a trademark objection or office action in Bangladesh, you have the option to respond and overcome the objections. Here are some steps you can follow:

1. **Review the Objection:** The first step is to carefully review the objection/office action letter to understand the reasons for the rejection of the trademark application.
2. **Address the objections:** Based on the objections raised, it is necessary to take appropriate actions to overcome the objections. This may involve submitting additional documents or clarifying any misunderstandings
3. **File the Response:** Submit the response to the trademark office within the prescribed time frame. The response to the objection/office action should be filed in writing to the Trademarks Office of Bangladesh. The response should clearly and concisely address each of the objections raised in the letter.

4. **Evidence and Arguments:** The response should include any evidence and arguments that support the trademark application. This could include copies of any previous trademark registrations or use of the trademark in commerce.
5. **Consider Hiring a Lawyer:** If you are unsure about how to prepare a response or if the objections raised are complex, consider hiring a lawyer who specializes in IP law. A lawyer can help you prepare a strong response and increase your chances of overcoming the objections. It may be helpful to seek the advice of a trademark attorney, who can help guide you through the process and prepare a strong response to the objections.
Wait for a Decision: Once you have submitted your response, the trademark office will review it and make a decision. This process can take several months, so be patient.
6. **Appeal the Decision:** If the trademark office denies your trademark application, you have the option to appeal the decision. In this case, it is recommended to seek the advice of a lawyer to help you file an appeal.

Note: The process of overcoming trademark objections in Bangladesh can be complex, so it is advisable to seek the help of a lawyer to ensure the best outcome.

What are the qualities of a good trademark in Bangladesh?

1. **Distinctiveness:** A good trademark should be unique and easily distinguishable from other trademarks in the same class of goods or services.
2. **Relevance:** The trademark should be relevant to the goods or services it represents and should not be misleading or deceptive.
3. **Non-descriptiveness:** The trademark should not be too descriptive of the goods or services it represents, otherwise, it may be difficult to register.
4. **Non-genericness:** The trademark should not be generic or too common, as it would not be able to distinguish the goods or services it represents.
5. **Non-conflict with prior rights:** The trademark should not conflict with the prior rights of another party, such as a registered trademark.
6. **Compliant with public order and morality:** The trademark should not violate public order and morality, and should not be considered offensive or obscene.
7. **Easy to remember and recognize:** A good trademark should be easy to remember and recognize, and should not be easily confused with other trademarks.
8. **Memorability:** A good trademark should be easy to remember and recall.
9. **Relevance:** A good trademark should be relevant to the goods or services it represents.
10. **Simplicity:** A good trademark should be simple and easy to understand.
11. **Flexibility:** A good trademark should be adaptable to changing business conditions and technology.
12. **Durability:** A good trademark should have the potential to remain in use for a long period of time.
13. **Protectable:** A good trademark should be protectable under trademark laws and regulations in Bangladesh.

It is important to note that the Trademark Office may still issue objections to a trademark that has these qualities, as there may be other trademarks that are similar or have prior rights. The trademark applicant should be prepared to respond to any objections through evidence or arguments.