
A Critical Analysis of TRIPS: Compatibility and Limitations of Trademark Regime in Bangladesh

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Abstract

In today's global trade and business hub, trademark as one of the components of Intellectual Property (IP), is a decisive subject matter particularly to the socio-economic and technological development of a country. As such, in conjunction with other IPRs, trademark has become an international concern as the WTO member states, including Bangladesh, have the obligation to articulate their IP regime complying with the WTO Agreement on TRIPS. Consequently, Bangladesh has endorsed The Trademarks Act, in 2009 conforming the WTO Agreement on TRIPS; but this new law is not free from the criticisms of IP experts and academicians, especially in terms of standard protection and enforcement measures provided for the owner of trademark or service mark. To this context, this research is an attempt to overview the safeguards and enforcement mechanisms of trademark law in Bangladesh as well as the compatibility of Trademarks Act, 2009 with the TRIPS Agreement. This paper, thus aims to trace out the achievement and implication of the present trademark regime taking into consideration of TRIPS flexibilities. Finally, this paper concludes with some recommendations to formulate an inclusive domestic legal regime for the proprietor of trademark and service mark in Bangladesh.

Keywords

Trademark, TRIPS agreement, intellectual property, protection measures, enforcement, compatibility

Introduction

The enlargement of intensive economies has induced the rapid growth of international trade and business circle around the world. Multinational companies are in competition against each other to spread their businesses beyond national territory. These companies are trading with their goods using their trademarks and subsequently these trademarks are getting popularity boosting goodwill to the consumers after a prolonged period of use. Trademark is considered

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the core channel through which products of one enterprise is distinguished from the products of others confirming economic interest exclusively (Gould & Gruben, 1997, p. 210). The purpose of the trademark is to recite the source and originality of the goods and to provide the prospective consumers the quality of the goods or services (Narayanan, 2013, p. 147). Trademark also provides exclusive recognition and protection to the concerned trademark owner (Hossain, 2012a, p. 15). From the perspective of relationship between trade and Intellectual Property Rights (IPRs), The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) bargains for the “global system of governing the ownership and flow of intellectual properties” (Sayeed, 2016, p. 01). The TRIPS Agreement imparts a comprehensive sense to establish a global, patulous and legally enforceable substantive intellectual property rights (IPRs) standards including trademark. As such, in conjunction with other IPRs, trademark and other corresponding rights over trademark have also become an international concern as the WTO member states are under obligation to articulate their IP regime complying with the TRIPS Agreement. Bangladesh is not an exception to it as it is a signatory to the World Intellectual Property Organization (WIPO) and the Paris Convention for the Protection of Industrial Property and the TRIPS Agreement (Sayeed, 2016, p. 02). Therefore, Bangladesh Government has enacted The Trademarks Act, in 2009 conforming the WTO Agreement on TRIPS repealing the Trademarks Act of 1940 (Azam & Chowdhury, 2008, p. 115). The core object of enactment of this new law is to bring the trademark arrangement of Bangladesh in compliance with the standards set by the TRIPS Agreement as well as to corroborate the amended provisions of the Paris Convention for the Protection of Industrial Property, 1883 (Islam, 2009, p. 49). Furthermore, keeping in view the prompt development of international trade and business and to encourage harmonious trading, the need to revise the existing law of the country was imperative. However, this new 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 trademark or service mark.

The Universal Declaration of Human Rights (UDHR) 1948 notes, “Everyone has the right to the protection of moral and material interests resulting from scientific, literary or artistic production of which he is the author” (UDHR, 1948 p. 06). The TRIPS Agreement, in its Article 41 to 61 of the Part-III, emphasizes on the provisions of enforcement for IPRs. Now it cannot be denied that the Constitution of Bangladesh expressly recognizes the rights of intellectual property as large as the citizen’s right to property (Shahabuddin, 2013, p. 06). The learned Supreme Court of Bangladesh has expanded the concept of property including all the rights annexed to property and trademark as an intellectual property falls within the category of property distinct from material or physical property (Naznin, 2011, p. 15). After getting independence from Pakistan in 1971, Bangladesh inherited the Merchandise Marks Act, 1889 and the Trademarks Act, 1940 to deal the issues of trademark. Later on in 2008, the Trademark Ordinance repealed these two legislations while in 2009 this Ordinance was further repealed by the Trademarks Act, 2009. On the other hand, in 1995 Bangladesh became a signatory to the TRIPS Agreement

and thus sanctioned the Trademarks Act, 2009.

Under the TRIPS Agreement, adoption of strict protection standard for trademark has been made mandatory for developed, developing and least-developed countries (LDCs) of the world (Sayeed, 2016, p. 02). However, TRIPS Agreement contains flexibilities and regards that the WTO members can utilize in their own ways of enforcing the mandates of the Agreement. Bangladesh is a developing country and intellectual property laws are not well designed in every case although the advancement in the field of trade and technology is much visible (Azam & Chowdhury, 2008, p. 26). Bangladesh, in this perspective, has the opportunity to avail the flexibilities marked by the TRIPS Agreement and to interpret and arrange the administrative approaches regarding trademark. To keep pace with international economy and to comply with international treaties, Bangladesh has framed laws regarding trademark but it is not up-to the standard.

Currently the Trademarks Act, 2009 along with the Trademark Rules, 2015 are the fundamental legal basis in the trademark regime of Bangladesh. As per Section 2(8) of the Act, “the term ‘trademark’ includes service mark too.” Under the Ministry of Industries in Bangladesh, there is a Department of Patents, Design and Trademark (DPDT) which is the administrative department to deal with regulations of trademarks (Maswod, 2015, p. 103). Under the Trademarks Act, 2009 a registered trademark owner has the exclusive right upon his mark as well as the right to give license to use or to give up his rights to any other person. Though Bangladesh has successfully enacted the Trademarks Act, 2009 adopting the mandates of the TRIPS Agreement, but the law still bears deficiencies and complexities as well. The Act fails to contain any provision for compulsory registration of marks as well as protection system of trademarks for digital based business community in the field of e-commerce (Shahabuddin, 2013, p. 08). Lack of adequate enforcing and administrative mechanism of the Department of Patents, Design and Trademark has added more sufferings towards the interest of trademark owners. To this end, this study seeks to address the loopholes of the existing legal framework of trademark in Bangladesh along with its compatibility with the TRIPS Agreement. Lastly, this paper tries to provide some suggestions to overcome the challenges posed by the present Trademarks Act, 2009 and to ensure more compatibility with the TRIPS Agreement.

Methodology

This research paper is analytical in nature. The study is mainly based on relevant literature including various legislations and concerned international laws and treaties with a combination of analytical reasonings. This study is designed with information gathered from primary and secondary source of data like books, well recognized journals, articles, reported case decisions, websites and newspapers. Finally, the collected data have been processed through editing and drafting. In this paper, a brief analytical assessment is done on the provisions of the Trademarks Act, 2009 to explore its compliance with the requirements and guidelines proposed by the TRIPS Agreement. This

paper also reflects the application procedure and loopholes of the Trademarks Act, 2009 in the context of Bangladesh.

Literature Review

Various studies, research reports and critical assessment can be found in cohesion with this research paper. Considering the scopes and abridgements, some books and papers relevant to this article have been chosen with the aim of discussion based on the depth of the argument and critical study. One of the most significant studies on this topic was done by M. A. Sayeed. In his paper, he attempted to depict the compatibility of the trademark regime of Bangladesh with the TRIPS Agreement. He concentrated only on the examination of the provisions of the Trademarks Act, 2009 with the principles of the TRIPS Agreement as well as Paris Convention. In support of the prevalence of present paper, another study of Mr. Chowdhury (2018) is also relevant that critically experiments the extent of responsiveness of Intellectual Property Rights in Bangladesh with the TRIPS Agreement but has no noticeable information particularly on trademark compatibility with the TRIPS Agreement. Moreover, Hossain's paper considers the overall Trademark protection in Bangladesh beyond some ethos. Furthermore, a hand book on Intellectual Property by Sayeed discusses Intellectual Property Law elaborately, but lacks the analysis of harmony of the Trademarks Act, 2009 with international treaties. Another praiseworthy article by Naznin deliberately focused on the limitations of the Trademarks Act, 2009 along with other intellectual properties, but failed to point out the extent of compatibility of TRIPS agreement with trademark regime of Bangladesh visibly.

Although those papers have discussed different perspectives of Trademark regime of Bangladesh in the light of TRIPS Agreement along with limitations of the Act, no study has entirely covered the TRIPS compatibility test, drawbacks of the present Trademarks Act, 2009 and nor provided any effective parameter to resolve complexities to enforce Trademark laws in Bangladesh.

Concept of Trademark

A Trademark is a symbol, word, logo or design to indicate the manufacturer of a particular product or service and to distinguish from other manufacturer of similar product or service (Askari, 2018, p. 27). Trademark is the device to give distinctiveness and advertisement of particular goods or service (Fernandes, 2014, p. 347). In relation to goods and services, Trademark represents the originality and quality of the goods and notifies the general public about the quality of the products (Bhaduri, 2014, p. 125). Trademark is a visual sign to reveal the source of any goods as distinct from any other similar goods. As to the TRIPS Agreement "any sign or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark" (TRIPS, 1994, Art. 15).

Some countries even allow slogan, smell and sounds to be registered as trademark. Trademark can also be a unique name or image carrying the identification of any company or organization to define the goods and reputation of the company. Under Section-2(8) of the Trademarks Act, 2009 of Bangladesh, Trademark means a registered trade mark or a mark used in relation to goods or service or a mark used or proposed to be used in relation to any service or goods indicating a connection in the course of trade between the goods and person having the right, either as proprietor or as registered user, to use the mark.

Trade Marks used to ascertain services are called service marks. In Bangladesh, Service mark is also comprised as trademark and a registered service mark owner enjoys exclusive right upon his service mark. Rights relating to trademark are basically acquired by registration, but such rights can also be gained through use in common law countries of the world. Generally trademark protection is territorial, and legal action shall be taken in the concerned country where the protection is sought (Begum, 2012). The object of trademark is to acknowledge the origin of product or service to which that concerned mark belongs. The Bombay High Court of India in the case of Cluett Peabody & Co Inc. vs. Arrow Apparels (1998)18 PTC 156 held that the primary object of trademark was viewed to be protective of the proprietary right of a registered trademark holder. In fact, trademark performs an important role in supplying consumer with the necessary information that requires to be communicated (Narayanan, 2013, p. 147). A trademark performs four functions under modern business conditions like identifying the goods and its source, guaranteeing its genuine quality, advertising and creating an image of the goods.

TRIPS Compatibility in National Treatment of Trademark in Bangladesh

Under Article-2 and 3 of the Paris Convention and Article-3(1) of the TRIPS Agreement, the member states shall arrange same protection to the citizens of the other member states. Bangladesh is a signatory to the TRIPS Agreement and complying with these provisions of international treaties, under Section-119 of the Trademarks Act, 2009; Bangladesh ensures same protection system to the members of the Paris Convention and the TRIPS Agreement (Chowdhury, 2018, p. 430). As a result, if any trademark is registered in a member state other than Bangladesh of the Paris Convention or of WTO, it can enjoy protection from the same date within the territory of Bangladesh provided the owner makes an application of registration in Bangladesh within six months from the date of primary registration of the member state (Hossain, 2012b, p. 04). The TRIPS Agreement has the aim to harmonize the intellectual property laws around the world and all the member states have uniform IP laws subject to some flexibility permitted by the Agreement. The Parliament of Bangladesh though fully complied with international IP regime, has promulgated the Trademarks Act, 2009 to dispose its liability under the TRIPS Agreement (Azam & Chowdhury, 2008, p. 25). Article-16(1) of the TRIPS Agreement narrates that a registered trademark owner shall be granted exclusive

rights over the goods or service and to deter any other person from using such mark or similar mark resulting confusion without the approval of the owner. Under the Trademarks Act, 2009 registration of trademark is a precondition to acquire exclusive right upon the mark in Bangladesh (Maswod, 2015, p. 110). A registered trademark holder in Bangladesh can exclude any other person from using it, can bring a legal action in case of infringement of such rights and even give license to others to use such mark (Maswod, 2015, p. 112). Thus Section-25 of the Trademarks Act, 2009 discharges the above obligation of the TRIPS Agreement. The TRIPS Agreement under Article 16(2) and 16(3) demands protection to well-known marks and the Trademarks Act, 2009 complies with these Articles too. In Bangladesh, Section-10(4), 10(5) and 26(7) refer to the provisions regarding the protection of well-known marks. Section-10(4) of the Act permits the refusal of registration of marks on the ground of being confusingly or deceptively similar to both registered and unregistered well-known trademarks while Section-26(7) speaks only for registered well-known trademarks. In the case of Jamal Uddin Ahmed vs. Abdul Haque and another (2003) 55 DLR (HCD) 102, the learned court held that a deceitful similar mark can not claim any protection, as consumers may become confused with that mark against a duly registered trademark. However, both Article-16(2) of the TRIPS Agreement as well as Article-6b is of the Paris Convention do not ask for registration in case of well-known marks. In case of unregistered trademark, the Act recognizes the common law doctrine of "Passing off" (Hossain, 2012a, p. 17).

The TRIPS Agreement in its Article-15(1) denotes the standard of protection of trademark with subject to distinctiveness and visual perceptibility. The basic obligation under this Article is that the law permitting of registration in accordance with national law must primarily be standing upon the doctrine of distinctiveness (Sayeed, 2016, p. 05). Moreover, the Agreement has authorized the member states to shrink down the scope of registration for trademark by requiring prior use or visual perceptibility. In Bangladesh, the distinctiveness of trademark is a pre-requisition for registration as per Section-6 of the Trademarks Act, 2009. According to Section-6, any distinctive trademark shall be subject to registration and shall not be registered without proper evidence of its distinctiveness (Maswod, 2015, p. 94). In the remarkable case of Singer Company vs. Amjad Ali (1969) 21 DLR 415, the Deputy Registrar of Trademark refused the probability of the likelihood of confusion between the words 'sagar' and 'singer', and opined that these words were not similar and would make no confusion if registration is granted. In another case of Bombay sweets and Company Limited vs. Liberty Food Company (2008) V.A.D.C. (AD) 967, the court declared that the likelihood of confusion between two marks by considering the global prosperity of the visual, aural or theoretical similarity of the marks in question. The requirement of visual perceptibility is however not directly provided by the Section-6 as well as the Section-2(23) while defining the term 'marks' indicates that visual perceptibility is not necessary for registration (Sayeed, 2016, p. 05). Again for registration of trademark in Bangladesh, prior use is not a precondition because Section-2(8) of the Trademarks Act, 2009 has acknowledged the concept of prior use only to determine the

remedy for infringement of trademark but not a requirement of registration. Hence, it can be argued that the Trademarks Act, 2009 of Bangladesh has adopted the features of Article-15(1) of the TRIPS Agreement to formulate the requirements of trademark registration (Sayeed, 2016, p. 5).

On the ground of refusal of trademark, the TRIPS Agreement in its Article-15(2) indicates that member states may refuse registration of a trademark within their territory, but it is to be remembered that such ground for refusal of registration shall be conformable with the provisions of the Paris Convention along with the TRIPS Agreement (Sayeed, 2016, p. 6). The Paris Convention in its Article 6quinquies obliges WTO members to register marks in the “same form” as registered in the country of origin. Again Article-15(4) of the TRIPS Agreement establishes that a mark cannot be denied for registration on grounds that relates to the nature of the goods which is already registered in a Paris Union country. The Trademarks Act, 2009 of Bangladesh in its Section-6 to 10 bears certain grounds under which a mark can be refused from registration where conflict arises with an earlier right in connection with an earlier trademark. Subsequently, Section-119 and 121 of the Trademarks Act, 2009 have adherence for upholding the denial of the protection of “same form” marks in Bangladesh (Sayeed, 2016, p. 08). Apart from this, Section-6(1) of the Act denotes that the mark in Bangladesh without any distinctive character shall not be registered as such mark cannot distinguish the product or service of one enterprise from another (Maswod, 2015, p. 96). Thus, the prevention of registration for non-distinctive mark under the Trademarks Act, 2009 seems to be compatible with provisions of the Paris Convention, and therefore to the TRIPS Agreement. It is pertinent to mention that Section-31 of the Trademarks Act, 2009 contains the rule of cross-border reputation.

The WTO’s Appellate Body, by citing the Panel in the dispute settlement case of the US-section 211 Omnibus Appropriations Act 1998 (DS176), established that lack of worthy ownership can be a valid ground to deny the registration of mark in the country concerned (Sayeed, 2016, p. 7). Section-6(1), Clause (b) of the Trademarks Act, 2009 provides that ownership is a requirement for the registration of marks and such registration can be refused on the basis of lack of ownership. Similarly section-8 of the Trademarks Act, 2009 interdicts the registration of the marks which carry any scandalous or indecent matter; or the use of which may deceive or cause confusion; or which may cause hurt to religious susceptibilities of any class of the citizens of Bangladesh. Thus, under Article-6quinquies (B) of the Paris Convention such provision of refusal of registration under the Trademarks Act, 2009 is well compatible with the TRIPS Agreement. Moreover, section-10 of the Trademarks Act, 2009 prohibits the registration of a mark that is deceptively similar to a trademark which is meanwhile registered in the name of a specific proprietor in respect of the same product or service. In Bangladesh Section-18 of the Trademarks Act, 2009 grants right to a registered trademark owner to restrain a conflicting mark from being registered. In this respect, it can be assured that the trademark law of Bangladesh maintains consistency with the provision of Article-15(5) of the TRIPS Agreement. Typically, Article-15(5) of the TRIPS Agreement further forces the WTO members to ensure reasonable opportunity

for cancelling registration of conflicting marks (Sayeed, 2016, p. 15). Here Section-51 of the Trademarks Act, 2009 carries provisions relating to annulment or cancellation of registration of mark and thus the Act once again complies with the standards of the TRIPS Agreement.

Existing Legal Framework to Safeguard Trademark in Bangladesh

The Trademarks Act, 2009 is the primary legal basis of trademark in Bangladesh (Naznin, 2011, p. 15). Under this Act, registered trademark owner enjoys exclusive right to use the mark in respect of goods or service. Under Section-22(1) of the Trademarks Act, 2009 a trademark gets registration for a period of seven years and under Section-22(2) such registration of trademark may be renewed for a further period of ten years and again renewals in each ten years may be continued for indefinite time (Maswod, 2015, p. 109). The acts or omissions what constitute the infringement of trademarks are specifically designed by the Act. Infringement means any sort of unauthorized use of a registered as well as unregistered trademark (Narayanan, 2013, p. 198). Any person using a trademark without the approval of the owner commits infringement. According to Section-25 of the Trademarks Act, 2009 if such right of the registered trademark owner is infringed by any person who is not the registered proprietor of the trademark, the registered user may bring an action for the infringement of registered trademark (Chowdhury, 2018, p. 430). Protection under the Trademarks Act, 2009 is also available for the owner of unregistered trademark in case of passing off (Hossain, 2012a, p. 17). However, it becomes complicated to take legal action against the offender if the trademark is unregistered. As per Section-97 of the Act in case of infringement of trademark the owner may obtain relief in the way of issues such as compensation, injunction, accounts of profit, delivery up of the infringing labels and marks destruction or erasure, injunction etc. The Specific Relief Act, 1877 provides the provisions regarding the issuance of injunctions to restrain forthcoming or further infringement. Both civil and criminal remedies are available under the Act and suits in this regard shall be filed in the court of District Judge (Chowdhury, 2018, p. 430). In such case, anyone aggrieved by the decision of the District Judge may file an appeal to the High Court Division. Sections 73-91 of the Trademarks Act, 2009 contain the provisions of criminal proceeding for violation of trademark rights in Bangladesh. Under these sections, criminal allegations can be brought for offences like using a false trademark to mislead consumers, molding, possessing or making of any instrument for counterfeiting a trademark, and counterfeiting a trademark without the approval of the proprietor. These offences can be tried by the Magistrates of the first class or Metropolitan Magistrate (Hossain, 2012, p. 17). If any person commits an offence under the items (a) to (g) in Section-73, he shall be subject to pay penalty of up to taka two lacs with sentence of up to two years for the first offence and up to three lacs with sentence up to three years for the second offence (Naznin, 2011, p. 15). The usual time limit under Section-86 of the Act

to take action against an infringement of trademark is three years from date of cause of action arose.

Under the Penal Code, 1860 any infringement of right in relation to a trademark also amounts to be a criminal offence (Islam, 2016, p. 95). This Code in its Section- 482, 483, 485, 486, 487 and 488 says that making or possessing any machinery to counterfeit a trademark would constitute an offence and the penalty for such offence is the confinement of either description for a term that may extend to three years or with fine or both. In Bangladesh, all the trading functions are governed by the Ministry of Commerce under the Imports and Exports (Control) Act, 1950. If a complaint is received from a rights holder, the concerned customs authority can take action against any person or organization that imports goods violating the provisions of Section-15 and 16 of the Customs Act, 1969 (Shahabuddin, 2013, p. 08). Here the Customs Act, 1969 denotes that importing of product, whether by air or land or sea regarding trademarks and any product which are imported in violation, are to be enclosed and seized by the official of customs. Marketing of any goods under a forged trademark or fake trade description or products made outside Bangladesh but marked under the name of any manufacturer or trader in Bangladesh is strictly prohibited under Section-15 of the Customs Act. According to 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 trademark owner may also move to the High Court Division to get an order directing customs to seize the goods with forged mark.

Loopholes in Existing Legal Setting

Despite 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 trademark in Bangladesh (Islam, 2016, p. 95). However, the Act positively prohibits the registration of any trademark which bears any scandalous design, causes fraudulent confusion or hurts religious susceptibilities of any person, or contradictory to any law or morality. It is also pertinent to note that the Trademarks Act, 2009 is very silent regarding digital based business or e-commerce community (Shahabuddin, 2013, p. 08). With the dynamic growth of e-commerce in international trade and business, the trademark protection in this field is a demand of time now. Thus such lacking in the Act has escalated the opportunity of unfair business practice throughout Bangladesh. Another shortage of the existing trademark regime is that under the Trademarks Act, 2009 protection is

elongated up to class 34 under International Classification of goods. No visible and effective measure has been initiated by the concerned authority to prolong the protection to products and services beyond class 34 (Islam, 2016, p. 95).

Furthermore, competent and efficient enforcing authority has not been found to safeguard the rights ensured by the Act (Islam, 2016, p. 96). More interestingly, the trademark office in Bangladesh under the Trademarks Act lacks adequate manpower. Though around five hundred applications are filed in trademark office every year, sometimes it takes more than three years to get registration of trademark which is very frustrating for the trademark holders (Naznin, 2011, p. 16). Apart from these deficiencies, the previous Trademarks Rules, 1963 was very old which has been recently replaced by the new Trademarks Rules, 2015 to comply with the provisions of new Trademarks Act, 2009. Under the Trademarks Act, 2009 new provisions relating to collective marks have been introduced but registration procedure for such marks has not been described in the Act. Such lacking of the Act is also not convinced by the Trademark Rules, 1963.

Way Forward

Bangladesh being a member of WTO has enacted necessary laws in the field of intellectual properties. To comply with the standards of TRIPS Agreement, the Parliament of Bangladesh has newly passed the Trademarks Act, 2009 repealing the previous law. The new law has focused on trademark acquisition and denial system of trademark registration and discussed about the rights of the trademark owner taking the extract of TRIPS Agreement. However, the enforcing mechanism and administrative function regarding IPRs are not well-standards in Bangladesh. Administrative approach of Department of Patents, Designs and Trademarks is quite poor due to lack of manpower, ancient manual system and expert on intellectual property. In the light of such circumstances following recommendations are proposed-

1. The government of Bangladesh like many other countries of the world has to design a fruitful, effective and prospective structure of IP laws including trademark and strengthen the enforcing mechanism of IPRs throughout the country.
2. Government should set up separate and specialized IP courts or tribunals instantly to settle the disputes related with the trademark around the country. Such courts or tribunals must be presided by the competent and well-trained judges having in-depth knowledge on the laws of intellectual property for satisfactory and early disposal of disputes regarding IPs.
3. Short term and long term training program shall have to be launched for the lawyers dealing with the cases of IPs. Besides seminar, workshop and symposium may also be arranged to create awareness among the IP right holders and interested stakeholders.
4. Adequate arrangements should be initiated for early disposal of the trade-

mark disputes along with other IPs for the interest of smooth trade and business within the country. To this end, ADR system may be introduced for the speedy and cheap remedy for the litigants and to encourage common people towards the assistance of law.

5. The traditional and outdated procedure of registration of trademark is to be reformed taking into consideration of global trade practice. Rather, online system for trademark application must be immediately introduced as the number of registry office for trademark is few around the country.

6. Number of trademark registry office must be increased with sufficient manpower to conduct the administrative functions of trademark regulation. Officers and other official stuffs must be recruited at the Department of Patents, Designs and Trademarks considering the aspects of trademark in Bangladesh.

7. The new rules must be effectively enforced to publish trademark journal which is not covered by the Trademarks Act, 2009. In addition, registration procedure of collective mark shall also be maintained by the rules which are not covered by the Act.

8. With a view to visible development in the field of trade and industry, particularly for the IT based e-commerce business, policy must be framed in the regulation system of trademark in Bangladesh.

9. Finally, taking into consideration of the international aspect of IPRs, the trademark regime of Bangladesh should be restructured from time to time in conjunction with TRIPS Agreement.

Concluding Remarks

From the foregoing analysis, it is revealed that the present law on Trademark of Bangladesh has absorbed the important features of TRIPS Agreement and Paris Convention, particularly giving special attention on the acceptance and rejection of trademark registration in Bangladesh. Moreover, under the current trademark regime, the nature and scope of the rights of trademark holder also conform to the standards of the TRIPS Agreement giving special emphasis on ‘distinctiveness’ character. However, the new trademark regime of Bangladesh does not prescribe any specific requirement for visual perceptibility; rather, the Act embedded that “non-visually perceptible subject matter” is registerable under the existing trademark regime. Consequently, such kind of extensive umbrella over the scope of registerable subject matters of trademark, especially from Bangladesh perspective, turned it into a TRIPS-Plus feature in terms of compatibility assessment which is deemed to be an imprudent exploitation of TRIPS flexibilities.

However, regarding grounds of refusal of trademark registration in Bangladesh, Section-8 of the Trademarks Act, 2009 is evidently consistent with the

Article 6ter of the Paris Convention. In respect of protecting well-known marks, Section-10(4) of the Trademarks Act, 2009 is also found TRIPS responsive as to the Article-15(5) and 16(2) of the TRIPS Agreement. Conversely, regarding the infringement of trademark, Section-26(2) of the Act, for the protection of unauthorized use of mark, has pondered a broader line of “likelihood confusion” which has added a little higher standard beyond the provisions of the TRIPS Agreement.

It goes beyond saying that the strong and effective administrative and enforcement procedure is not sufficient enough to engulf expected protectionism of trademark rights of the owner although the Act contains some supportive provisions to deal with the issues of trademark infringement and subsequent remedies in conjunction with the TRIPS Agreement. Thus, it is predictable that some provisions of existing Trademarks Act, 2009 should be modified or amended for the sake of trade promotion and development in the essence of advancement in technology. In order to ensure the protection and promotion of rights of the trademark owner, the significance of promoting public awareness and efficiency of concerned officials of the Department of Patents, Designs and Trademarks can hardly be exaggerated. The government shall make arrangements to make citizens conscious about IPRs and such awareness of the common people can strengthen the trademark regime of Bangladesh in the light of the TRIPS Agreement. To this end, direct financial and logistic support from the government and collaboration between public and private sectors must be needed as well. In addition to this, there should be a strong and effective nexus among IP experts, academic personality, research bodies and industries with a view to rebuilding an all-inclusive IP hub leading to visible development in the field of trade and industry, particularly for the IT based e-commerce.

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