

Bangladesh

Contributing firm
United Trademark & Patent Services



Author
Nasir Khan

Legal framework

Bangladesh's judicial and legal system is largely modelled on the Indo-Mughal and UK legal systems. The judicial structure consists of lower courts and a Supreme Court, both of which hear civil and criminal cases. The lower courts comprise administrative courts (magistrates' courts) and session judges. The Supreme Court also has two divisions: a High Court, which hears original cases and reviews lower court decisions, and an Appellate Court, which hears appeals from the High Court.

Bangladesh's IP laws can also trace their origin to the days when the country was part of British India, although these laws have been modified several times to meet the demands of international practices and obligations. IP rights in Bangladesh are handled by two separate government ministries:

- Industrial matters are administered by the Department of Patents, Designs and

Trademarks, part of the Ministry of Industries; and

- Copyright and related rights are the responsibility of the Copyright Office, part of the Ministry of Cultural Affairs.

The Department of Patents, Designs and Trademarks is a quasi-judicial organization, with the department's registrar acting as a tribunal. Any appeal against the registrar's decisions must be made to the High Court.

The pertinent statutes in Bangladesh relating to IP matters are:

- the Patents and Designs Act (11/1911);
- the Trademarks Act 2009;
- the Trademarks Rules 1963;
- the Copyright Act 2005;
- the Copyright Rules 1967, as modified in 1983;
- the Bangladesh Penal Code 1860;
- the Code of Civil Procedure 1980;
- the Customs Act 1969; and
- the Consumer Rights Protection Act 2009.

Bangladesh is also a signatory to the following international agreements:

- the World Intellectual Property Organization Convention, since May 1985;
- the Paris Convention for the Protection of Industrial Property, since March 1991;
- the Berne Convention for the Protection of Literary and Artistic Works, since May 1999; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights, since January 1995.

Border measures

In Bangladesh, all trading activities are regulated by the Ministry of Commerce under the Imports and Exports (Control) Act 1950. In addition, 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 design in which copyright exists under the Patents and Designs Act in respect of

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the class to which the goods belong or any fraudulent or obvious imitation of such design without a licence or the rights holder’s 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.”

There is no provision for the recordal of trademarks with Customs. However, upon receiving a complaint from a rights holder, Customs may take steps against any person or entity that imports goods in violation of Sections 15 and 16 of the Customs Act. Moreover, a rights holder may approach the High Court to obtain an order directing Customs to detain and/or seize the counterfeit goods.

Criminal prosecution

The following are criminal offences punishable under the Penal Code:

- using a false trademark so as to mislead consumers about the origin of the goods; and

- counterfeiting a trademark used by another person.

The punishment for using a false trademark is imprisonment for up to one year or a fine, or both. The punishment for counterfeiting is imprisonment for up to two years or a fine, or both. The courts also have the power to set the prison term and the amount of any fine.

In addition, the Penal Code identifies a number of activities as criminal offences and sets out various enforcement measures available to rights holders. Two such offences, and their punishments, are as follows:

- making or possessing any instrument for the purpose of counterfeiting a trademark – the punishment for this offence is imprisonment for up to three years or a fine, or both; and
- selling, exposing or possessing for sale or any purpose of trade or manufacture any goods bearing a counterfeit mark – the punishment for this offence is imprisonment for up to one year or a fine, or both.

Preliminary measures

In cases of counterfeiting, a rights holder may file a criminal complaint with the police, which then investigate. If the complaint is proved, the case then goes to trial before a court. In addition, police officials may launch raids against counterfeit and pirated goods and may take legal action.

All criminal proceedings begin in the magistrates court. All criminal cases relating

to false trademarks or counterfeiting are tried by a magistrates court (first or second class, or a metropolitan magistrate in an urban area). Any appeal against the magistrate’s order must be made to a district magistrate or session judge.

Remedies

Remedies available in criminal actions include the following:

- raids on the premises where the counterfeit goods are stored;
- seizure of the goods;
- destruction of the counterfeit goods; and/or
- imposition of penalties on the infringer.

Civil enforcement

The Trademarks Act establishes that infringement suits must be instituted before the appropriate district court. In the case of infringement suits, the trademark must be registered in Bangladesh as per Section 24(1) of the act. The act also provides for passing-off actions for unregistered trademarks before the Dhaka District Court. Although civil remedies are available for both registered and unregistered trademarks, it can be extremely difficult to prove passing-off actions and obtain relief for unregistered trademarks.

In the case of civil proceedings, trademark infringement suits can be instituted only at a district court or higher. However, passing-off proceedings can be instituted before an assistant judge or joint district judge. The Code of Civil Procedure establishes that rights holders may file suits for permanent injunctions before the Dhaka

District Court. If the infringement is proved, a suit for damages may then be filed separately.

Preliminary measures

The administrative authorities have no direct jurisdiction over counterfeiters and the seizure and/or confiscation of the infringing goods in question. The law governing agencies such as the police, the Bangladesh Rifles and the Rapid Action Battalion takes cognizance of any matter relating to counterfeiting only after being directed to by the Chief Judicial Magistrate's Court, since the imitation or use of false trademarks is a non-cognizable and bailable offence under Sections 482, 483, 485 and 486 of the Code of Criminal Procedure.

In addition to a civil infringement suit, rights holders may file an application for a temporary injunction under Order 39, Rules 1 and 2 of the Code of Civil Procedure. If it is proved that there is a *prima facie* arguable case and that the balance of inconvenience is in the rights holder's favour, then the court may grant a temporary or interlocutory injunction against the counterfeiter when the suit is filed.

It can take up to three to four years for a case to be finally decided.

Remedies

The following remedies are available by way of civil action:

- temporary injunction;
- permanent injunction and attachment order with a declaration that the goods are counterfeit; and
- claim for damages.

Anti-counterfeiting online

Bangladesh's IT industry has been expanding exponentially and is making its presence felt in both the public and private sectors. Industry estimates put the number of personal computers now in use at 5 million and the number of internet users at 3 million.

The government has made a commitment to establishing Digital Bangladesh by 2021. To this end, it has approved legislative amendments calling for jail terms and heavy financial penalties for new forms of electronic crime. The proposed law would introduce prison terms of up to 10 years and fines of up to Tk10 million (approximately \$150,000) as punishments for hacking into computer networks and placing false and libellous information or indecent material online.

The government plans to consult with the Supreme Court to set up one or more

cyber-tribunals for the speedy and effective prosecution of such offences.

Preventive measures/strategies

The government needs to undertake several measures to strengthen Bangladesh's IP system. These include measures to strengthen the IP office and further revisions to existing IP laws. In general, the following must be addressed:

- raising awareness of the importance of intellectual property among the business community and the general public – this could be done through campaigns in newspapers and electronic media, as well as through regular workshops, seminars and study tours for concerned stakeholders;
- carrying out regular training for officials at the relevant departments to equip them to tackle such issues – such projects might follow the template set by a recent government collaboration with the European Union over IP training;
- introducing a formal customs recordation procedure for rights holders; and
- empowering the administrative authorities to initiate actions against infringers on receiving a complaint from a rights holder. [WTR](#)



Biographies

United Trademark & Patent Services

United Trademark & Patent Services
PO Box 72430
Dubai
United Arab Emirates
Tel +971 4 343 7544
Fax +971 4 343 7546
Web www.utmps.com



Nasir Khan
Lawyer
dubai@unitedtm.com

Nasir Khan is a senior member of the Dubai branch of United Trademark & Patent Services. He graduated with an LLB from Karachi University, Pakistan and also holds an LLM in IP and competition law from the Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich. Dr Khan has also undertaken various advanced courses in copyright and related rights, trademarks and e-commerce, among others. His practice includes counselling on the registrability of IP rights, contract drafting, franchising, licensing and IP rights enforcement. Dr Khan also has experience in conducting and supervising civil and commercial suits for clients in the Middle East and South Asia.