

Protection of Unregistered Well-Known Trademarks: The Bangladeshi Trademarks Regime Revisited

Dr. Mohammad Towhidul Islam* and Md. Jahid-Al-Mamun**

1. Introduction

A trademark which is a sign or symbol represents an enterprise's name, goodwill, or reputation.¹ The enterprise can register it with the Trademarks Office for its direct admissibility in evidence and often puts a circled ® after the trademark, or can use it as an unregistered trademark by putting sometimes ™ or SM after the trademark i.e. the trademark is either in the process of registration or a claim since they are descriptive, get-ups, colours or shapes and hence cannot be registered. For its being a property – an intellectual property, it can be assigned or licensed to others. However, the assignment or licensing is limited only to registered trademarks.² Further, an unregistered well-known trademark may cause a competing enterprise to involve in an unfair commercial practice to make benefits by registering or using it. Such unfair trade practices can create confusion among the consumers who are unwary having neither the time nor the desire nor the judgmental literacy to examine a trademark in detail.³ For example, in Bangladesh, about 26% of the total population i.e. one in four having no literacy and a large number of whom living in rural areas⁴ may fall within the consumers who are unknowingly deceived by the piracy of trademarks –

* Professor, Department of Law, University of Dhaka.

** Lecturer, Department of Land Management and Law, Jagannath University, Dhaka.



Creative Commons Non Commercial CC BY-NC: This article is distributed under the terms of the Creative Commons Attribution-Non Commercial 4.0 License (<https://creativecommons.org/licenses/by-nc/4.0/>) which permits non-commercial use, reproduction and distribution of the work without further permission provided the original work is properly cited.

¹ The trademark may consist of a trade name or name, domain name, or word, or phrase, or logo, or symbol, or colour, or design, or image, or slogan, or combination of such elements. See World Intellectual Property Organization, *Intellectual Property Handbook* (WIPO 2008) 138, para 2.782 (hereinafter WIPO).

² Agreement on Trade-Related Aspects of Intellectual Property, 15 April 1994, 33 ILM 1197 [hereafter TRIPS], art 21.

³ George Miaoulis and Nancy D'Amato, 'Consumer Confusion & Trademark Infringement' (1978) 42 *Journal of Marketing* 48; see also Rebecca Tushnet, 'What's the Harm of Trademark Infringement?' (2015) 49 *Akron Law Review* 627.

⁴ '1 in 4 Illiterate in Bangladesh' *The Dhaka Tribune* (Dhaka, 8 September 2019) <<https://www.dhakatribune.com/bangladesh/2019/09/08/1-in-4-illiterate-in-bangladesh>> accessed 5 September 2020.

registered and unregistered well-known marks.⁵ The 2020 Special 301 Report prepared by the United States Trade Representative (USTR) that often bears impacts on foreign investment, trade and commerce for a country, has also identified Bangladesh as an emerging source of counterfeit oncology drugs.⁶ So, it appears that the interests of trademarks owners and consumers are in frequent threat of being seriously prejudiced by the infringement of trademarks.⁷

To deal with the unfair trade practice, Bangladesh pledges to offer protection to trademarks – a treaty obligation arising of the Paris Convention for the Protection of Industrial Property 1883⁸ (Paris Convention) and the World Trade Organization (WTO) Agreement on Trade-related aspects of Intellectual Property Rights 1994⁹ (TRIPS). Despite its pledges to protect trademarks through the implementing legislation titled the Trademarks Act 2009¹⁰, there appears a dilly-dally in the protection of trademarks due to the TRIPS transition resulting from the country's least developed country (LDC) status. Nevertheless, the country expects to graduate to the developing country status in 2021 and hence, it is supposed to fulfil its TRIPS trademarks related obligations by tailoring and interpreting the local laws and administrative decisions in relation to trademarks – registered or unregistered and

⁵ See 'Fake Unilever Products Seized' *The Daily Observer* (Dhaka, 11 September 2015) <<https://www.observerbd.com/2015/09/11/110053.php>> accessed 13 September 2020; 'Cosmetics worth Tk. 50 Lakhs Destroyed' *The Daily Bangladesh* (Dhaka, 18 February 2020) <<https://www.daily-bangladesh.com/english/Cosmetics-worth-Tk-50-lakhs-destroyed/37360>> accessed 26 September 2020; 'Fake Cosmetics worth 3.5C Seized at Chawkbazar, 5 Jailed' *The Dhaka Tribune* (Dhaka, 5 September 2020) <<https://www.dhakatribune.com/bangladesh/court/2020/09/08/fake-cosmetics-worth-3-5c-seized-at-chawkbazar-5-jailed>> accessed 26 September 2020; 'RAB Seizes Cosmetics, Electronics worth 90C in Narayanganj' *The Dhaka Tribune* (Dhaka, 4 September 2020) <<https://www.dhakatribune.com/bangladesh/nation/2020/09/04/rab-seizes-cosmetics-electronics-worth-90cr-in-narayanganj>> accessed 26 September 2020; 'Seized a Huge Quantity of Fake Cosmetics' *The Daily Sun* (Dhaka, 9 September 2020) <<https://www.daily-sun.com/printversion/details/504319/Seized-a-huge-quantity-of-fake-cosmetics>> accessed 26 September 2020; '6 Jailed for Manufacturing Fake Cosmetics in Dhaka' *The Daily Star* (Dhaka, 13 September 2020) <<https://www.thedailystar.net/country/news/6-jailed-manufacturing-fake-cosmetics-dhaka-1826638>> accessed 26 September 2020; '18 Cosmetic Traders Fined Tk 13 Lakh' *The Business Standard* (Dhaka, 18 December 2019) <<https://tbsnews.net/bangladesh/18-cosmetics-traders-fined-tk13-lakh>> accessed 26 September 2020; 'RAB Seals Fake Cosmetics Factories' *Bdnews24.com* (Dhaka, 8 July 2014) <<https://bdnews24.com/bangladesh/2014/07/08/rab-seals-fake-cosmetics-factories>> accessed 26 September 2020.

⁶ '2020 Special 301 Report' (Office of United States Trade Representatives, April 2020) 27 <https://ustr.gov/sites/default/files/2020_Special_301_Report.pdf> accessed 25 September 2020.

⁷ WIPO, *Introduction to Trademark Law and Practice* (2nd edn, WIPO 1993) 22, 61.

⁸ Paris Convention for the Protection of Industrial Property 1883, 30 March 1883, 828 UNTS 305 (hereinafter Paris Convention), art 6bis.

⁹ TRIPS, art 16.

¹⁰ Trademarks Act 2009 (Act No XIX of 2009) <<https://www.wipo.int/edocs/lexdocs/laws/en/bd/bd013en.pdf>> accessed 26 September 2020.

strictly protect them with ‘domestic procedures including civil and administrative procedures and remedies, provisional measures, special requirements related to border measures, and criminal procedures for the effective enforcement of the holders’ rights.’¹¹

To protect unregistered trademarks, Bangladesh has also provided the tripartite statutory protection under other laws i.e. the Penal Code 1860¹², the Customs Act 1969¹³, the Consumer’s Right Protection Act 2009¹⁴ and the Bangladesh Standard and Testing Institute Act of 2018¹⁵ (BSTI) etc. Under the provisions of these laws, the owner of the original trademark avails the opportunity to file suits for compensation and other remedies including injunctions, the deceived consumers enjoy the opportunity to file suits for damages, and the State as a trustee of the public confidence invokes the power to take actions against the infringer. In protecting registered and unregistered trademarks, different stakeholders including the law enforcing agencies, the administrative authorities, and the judiciary are also actively engaged therein. However, the lack of awareness among the majority of the owners of unregistered trademarks, the consumers, and the stakeholders enforcing them, the absence of comprehensive legislation, and the ambiguity of legislation are the key impediments in the way to the enforcement in line with the statutory protection.

Against the backdrop, this article critically analyses the statutory protection regime of unregistered trademarks, the gap between the statutory remedy for infringement of unregistered trademarks, and the enforcement therefrom. The analysis is made in four parts. The first part discusses the philosophical foundation of protecting these marks, the second part highlights Bangladesh’s international obligations and the global best practices, the third part critically analyses the current protection regime in Bangladesh in light of its international obligations and global best practices, and then it puts a way-forward followed by the conclusion.

2. Rationale of Protecting Unregistered Well-known Trademarks

What is the object of protecting a trademark? Is it to protect the ‘brand’ or the ‘goodwill annexed to the ‘brand’? To answer these questions, it is better to resolve another issue, e.g. why someone will be prone to penetrate his product in the market

¹¹ Part III of the TRIPS Agreement deals with enforcement of intellectual property rights. section 2 comprising articles 42 to 49 of this part deals with civil and administrative procedures and remedies, section 3 comprising article 50 deals with provisional measures, section 4 comprising articles 51 to 60 deals with special requirements relating to border measures, and section 5 comprising article 61 deals with criminal procedure.

¹² Trademarks Act 2009, ss 10, 14, 24, 51, 72, 74, 96, and 97.

¹³ Customs Act 1969, s 15.

¹⁴ Consumer’s Rights Protection Act 2009, ss 2(9), 2(20), 44, 50, 66.

¹⁵ Bangladesh Standard and Testing Institute Act 2018, ss 2(3), 2(20), 15, 20, 21, 22, 27, 34, 35.

using another person's brand name or does the consumer contribute to the piracy along with the competing enterprise. It appears that it is not for using the bare name, but for using the goodwill contained in the brand or embezzlement of others' reputation to make profits. So, the ultimate object of protecting a trademark is more to protect the reputation annexed to the brand than protecting the brand only.

To consumers, a trademark acts as a quality of the product or service, so they consider the functionality, effectiveness, reliability, longevity, taste, smell, user-friendliness, etc. to choose a particular product over another. Very often, the consumers select the product not only from an instant evaluation at the time of purchase¹⁶ but the past consumption and experience of information provided by a third party also play a pivotal role to help them in choosing particular goods over another.¹⁷ A trademark does also have a distinguishing or origin function since it identifies and distinguishes the producer of a particular product as well as his reputation for its origin coupled with the quality which accelerates the repeat purchase. Nobel Laureate economist Kenneth Arrow points out that once the information and knowledge regarding the quality of a product is introduced in the market, it can be easily reproduced for its quality and can attract consumers.¹⁸ Further, the consumers can attach a status value to the product bearing a well-known brand name and the possession of status value creates an urge in the producers to enhance the quality of the product. Consequently, the producer of a well-known trademark has to invest his invaluable time, money, labour, and other interpersonal skills to enhance the reputation. In return, it influences consumers and brings commercial successes. Thus, the trademark emerges as an essential intangible asset that protects the reputation of an enterprise.

Furthermore, a trademark is a private property that creates *jus in rem* meaning the owner of it can enforce his right against anyone in the world. In addition, an owner of a trademark cannot allow an infringer making profits out of his reputation. A trademark, whether registered or unregistered, cannot also accrue any right to outsiders. Further, the 'well-known trademark theory' or 'the prestige theory' supports the protection of unregistered trademarks when it clarifies that the registration or non-registration of a trademark cannot or should not watershed the

¹⁶ WIPO Economics and Statistics Series, '2013 World Intellectual Property Report' in *Chapter 2 The Economics of Trademark* (WIPO 2013) 13 <https://www.wipo.int/edocs/pubdocs/en/wipo_pub_944_2013-chapter2.pdf> accessed 26 September 2020.

¹⁷ *ibid.*

¹⁸ Kenneth Arrow, J, 'Economic Welfare and the Allocation of Resources for Invention' in Richard R. Nelson (ed), *The Rate and Direction of Inventive Activity* (Princeton University Press 1962) 609-625.

protection of well-known unregistered trademarks.¹⁹ Nevertheless, the registration of trademarks may be compared with the birth-registration of a child. Since a birth registration certificate cannot give birth to a child but recognizes its being born, likewise the registration of a trademark is merely a legal formality to secure an exclusive right to use. Its operation is essential to gain the reputation and it cannot change the nature but recognizes the right in it. So, by dint of the very private nature of trademark, an outsider cannot infringe the right of a trademark owner even if his right is unregistered.

Despite the strong rationales behind the protection of unregistered trademarks, outsider competing enterprise infringe trademarks – registered or unregistered for several reasons including the motive of earning higher margins of profits since imitated goods are made of low quality materials and it does not need to advertise, the lack of consumer awareness as they cannot properly read out the brand name and cannot distinguish the duplicated products from original one, or the consumers like to use the brand-named pirated products for a low price, the lack of enforcement of relevant laws, the scarcity of reputed brand items in the market, or banning of some foreign products in the country.²⁰

For the reasons mentioned and beyond, the outsider competing enterprise likes to fake consumers by infringing trademarks in different ways. Amongst them, counterfeiting meaning imitation of products but giving genuine impression, or imitation of labels and packaging, or dilution meaning blurring or tarnishment, or piracy meaning registration or use of a generally well-known trademarks of others are considered as the fastest growing and the most profitable modes of the unfair business practices.²¹ Further, when consumers cannot distinguish fake goods from the originals, the signalling power of the trademark disappears. Thus, the interests of original producers as well as consumers are seriously curbed by counterfeiting trademarks. It only benefits the producers of counterfeits.

Historically, the Government of Bangladesh opts to protect such natural rights of creators. Article 20(2) of the Constitution of People's Republic of Bangladesh has pledged that:

¹⁹ Xiaoqing Feng, 'The Unregistered Well-Known Trademark System and Its Improvement' (2012) 4 *Jurist* 115.

²⁰ A M Shahabuddin, 'The Impact of Trademark on Brand Duplication in Bangladesh: An Empirical Analysis' (2013) 5(16) *European Journal of Business and Management* 6, 7- 8.

²¹ See 'The Counterfeit Trade: Illegal Copies Threaten Most Industries' *The Business Week* (New York, December 1985) 64-72.

[T]he State shall endeavour to create conditions in which, as a general principle, persons shall not be able to enjoy unearned incomes, and in which human labour in every form, intellectual and physical, shall become a fuller expression of creative endeavour and the human personality.

This provision asks for the twofold protection of property including intellectual property – positive and negative. Since the trademark is an important intellectual property, its owner is entitled to both positive and negative protection. This means the State shall uphold the owner’s right as well as create conditions so that it can prevent others from enjoying ‘unearned income’ by using others’ trademarks. So, protecting trademarks is deemed to be a prominent public policy issue since it controls the interests of its owners as well as the consumers.

Therefore, giving exclusive rights to the owners, the trademark encourages them to gain credibility in the market by enhancing the quality of their products with an object to attract more consumers. In effect, it leads to a healthy competition among the producers of the same goods. Further, infringing a well-known unregistered trademark goes against the rule of fairness and credibility. Thus, besides the owner’s part, the protection of an unregistered trademark is justified from the consumers’ side. In addition, introducing someone’s goods in the name of a well-known trademark leads to unfair competition and fraudulent transactions. The infringement of a well-known unregistered trademark also injures the legitimate interests of the public at large. So, the State as their representative is duty-bound to protect and vindicate their rights and can criminalize and prosecute it to gain the public trust since it is a public wrong. Further, since the country’s trademark registration process is awfully slow, it takes sometimes more than ten years as is reported in a USTR’s report,²² the protection of unregistered well-known trademarks appears essential in the country.

3. International Obligations and Best Practices of Protecting Unregistered Trademarks

3.1 Paris Convention

The Paris Convention 1883 is not only one of the major but also the oldest multilateral intellectual property treaties asking for the protection of trademarks worldwide. Article 6*bis* of the Paris Convention contains several provisions²³

²² ‘Trademark Working Group Special 301 Submission for 2015’ (2015 Global Trademark Report Card) 27 <<https://www.hklaw.com/files/Uploads/Images/0209301Global.pdf>> accessed 22 September 2020.

²³ Paris Convention 1883, art 6*bis*. It runs:

‘(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark

including the provisions for refusing registration or cancellation of registration, and prohibition of the use (by way of reproduction, imitation, or a translation which is liable to create confusion) of trademarks. According to the provision, the mark to be protected must be well known and only its proprietor is entitled to benefits from using it under the convention. From the said provision, it can also be claimed that an unregistered well-known trademark requires to be protected in the member States since this provision is not only applicable to the trademark based on its registration, but also because of its use. The reason for protecting unregistered trademarks lies basically in this particular term 'use'. This provision further asks for allowing at least five years in requesting the cancellation of a junior mark from the date of its registration. The provision also says that if any person registers or uses the trademark of another person in bad faith, a request for cancellation or prohibition of the use can be made at any time since paragraph 3 of article 6*bis* does not prescribe any time limits. However, this convention does not provide any set of rules as a prerequisite of a mark to be considered as a well-known trademark, rather it leaves this power in the hands of legislators of the member States.

3.2 TRIPS Agreement

Paragraphs 2 and 3 of article 16 of the TRIPS have widened the scope of article 6*bis* of the Paris Convention. However, article 6*bis* is applicable only to the mark used for identical or similar goods. On the contrary, paragraph 2 of article 16 of the TRIPS makes article 6*bis* of the Paris Convention applicable not only to goods but also to services as well. So, the scope of article 6*bis* of the Convention is much expanded by paragraph 3 of article 16 of the TRIPS, which does not restrict its application only to identical or similar goods, rather it liberalizes its application to goods or services not similar to those in respect of which the trademark is registered. Further, member States are bound to consider the knowledge of relevant consumers in the marketplace, but not the knowledge of the public at large to determine whether a particular mark is relevant or not.²⁴

considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.'

²⁴ TRIPS, art 16.2.

3.3 Post-TRIPS Development

The World Intellectual Property Organization (WIPO) has developed a non-binding Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks. This Recommendation has provided a higher degree of protection to the well-known trademark than the erstwhile Paris Convention and the TRIPS. Article 2(2)(b) of the Joint Recommendation contains that when a trademark is considered to be well-known towards one relevant sector of the public in a member State, this mark shall be considered as well known to the whole territory of that State. In true sense, it has liberalized the rule of the classical trinity which requires that the products and services must have the goodwill to a substantial portion of consumers. Even if any particular products are famous or well-known to the consumers of the capital city and consumers throughout the rest of the country are unaware of it, this mark shall be considered as well-known throughout the whole country including areas where goodwill or reputation has not been established. Scholars criticize the wholesale territorial protection as suggested by the Joint Recommendation on the ground that it creates a likelihood of consumer confusion since a trademark can be declared as well-known among the public at large, who did not even hear its name.²⁵ Further, it benefits senior users who have not to invest for attainment of the goodwill in the whole territory of a State.

3.4 Common-Law Principle of Protecting Unregistered Trademarks

In common law countries, the unregistered trademark is protected through the doctrine of passing off also known as ‘palming off’ which has emerged in the 19th century as a descendant of fraud or deceit.²⁶ Selling one’s goods pretending that they are of other’s is known as passing off. It falls within the purview of commercial misconduct and has been a major form of unfair competition.

Further, passing off is a common law economic tort which can be used to enforce unregistered intellectual property rights. It protects the business goodwill from the defendant trying to exploit it for himself, by passing his goods and services off as his competitors. It thus protects the goodwill of the product from being misrepresented. It also prevents one trader from using another’s product name, shape, goodwill, and

²⁵ See Maxim Grinberg, ‘The WIPO Joint Recommendation Protecting Well-Known Marks and the Forgotten Goodwill’ (2005) 5 *Chicago-Kent Journal of Intellectual Property* 1, 9 <https://studentorgs.kentlaw.iit.edu/ckjip/wp-content/uploads/sites/4/2013/06/01_5JIntellProp12005-2006.pdf> accessed 27 September 2020.

²⁶ Thomas J McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th edn, 200) chapter 29:61 cited in James Faris, ‘The Famous Trademark Exception to the Territoriality Principle in American Trademark Law’ (2009) 59(2) *Case Western Reserve Law Review* 451.

quality without an authorization. It protects the prior interest of the trader as well. The rationale of introducing passing off is based on the principle of fair trading and consumer protection.²⁷

The classical definition of passing off has been developed by the English *Jif Lemon*²⁸ and *Advocaat*²⁹ cases. In *Reckitt and Colman Products Limited v Borden Inc*³⁰, popularly known as *Jif Lemon case*, the plaintiff, Reckitt, sold lemon juice in a plastic container that was shaped like a lemon under the name Jif Lemon. The defendant, Borden, started to produce lemon juice in a similar lemon-shaped container. The plaintiff sued the defendant for passing off their products as Jif Lemon juice. Both the trial court and the Court of Appeal gave the verdict in favour of the plaintiff, Reckitt.

For the first time, Oliver J in the Jif Lemon case requires three elements to be fulfilled to establish the cause of action of passing off which are popularly known as ‘classic trinity formulation’:

- (i) the plaintiff(s) must prove that the product has goodwill;
- (ii) a misrepresentation has been made by the defendant(s) to the public which leads or likely to lead them to believe that the goods or services of the defendant(s) are those of the plaintiff(s); and
- (iii) the plaintiff(s) must suffer or likely to suffer damages originated from the erroneous belief by the public which caused from the defendant’s misrepresentation.³¹

In *Erven Warnink BV v J. Townend & Sons (Hull) Ltd*³², popularly known as *Advocaat* case, the plaintiff Warnink produced a Dutch liqueur which was made from a blend of hen egg yolks, aromatic spirits, sugar and brandy and sold them under the brand name ‘Advocaat’. The defendant, Townend, produced a similar drink and sold it as ‘Keelin’s Old English Advocaat’. The court held that the defendant was passing off its goods as those of the plaintiff.

²⁷ *Wise Property Care Limited v White Thompson Preservation Limited* [2008] CSIH 44; (see also C W Ng, ‘The Irrational Lightness of Trade Marks: A Legal Perspective’ in L Bentl, J Davis and J Ginsburg (eds), *Trade Marks and Brands: An Interdisciplinary Critique* (Cambridge University Press 2008) 515.

²⁸ *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491.

²⁹ *Erven Warnink v Townend* [1979] AC 731, 742.

³⁰ *Reckitt* (n 28) 491.

³¹ *ibid.*

³² *Erven* (n 29) 742.

The classic trinity formulation of *Jif Lemon* has been further illustrated by Lord Diplock in the *Advocaat* case. To be actionable under passing off, Lord Diplock requires³³ that

- (i) there must be a misrepresentation;
- (ii) the misrepresentation is made by the defendant in the course of the trade;
- (iii) the misrepresentation is made to the prospective customers;
- (iv) there is a reasonably foreseeable consequence of injury to the goodwill of plaintiff; and
- (v) the misrepresentation causes actual damage to the goodwill of the plaintiff.

Lord Fraser has made the elements noticeably clear unlike Oliver J and Lord Diplock. In *Advocaat*³⁴ he requires that

- (i) the plaintiff's goods or services has a trade name;
- (ii) the trade name distinguished the goods or services of the plaintiff from these of others in the mind of the prospective consumer;
- (iii) reputation of the goods creates goodwill of the trade name;
- (iv) the goodwill has substantial value and the plaintiff is the owner of the goodwill; and
- (v) the plaintiff has suffered or is likely to suffer damage to his goodwill by the reason that the defendant is selling goods falsely describing the trade name of the plaintiff's goods to which his goodwill is attached.

Now it is a well-settled principle that only the injured defendant, not the consumers can file a suit for passing off.³⁵ The law against passing off applies only when an actual or threatened injury to the goodwill of the plaintiff occurs. However, where there is no injury, the law against passing off is not applicable. So, the consumer protection or the protection from unfair competition is not the fundamental rationale of law against passing off, these are incidental and occasional outcomes of the action.

3.5 Civil Law Approach of Protecting Unregistered Trademarks

The civil law system accepts the principle against unfair competition in dealing with unregistered trademarks.³⁶ For example, the German Act against Unfair Competition

³³ *ibid* 742.

³⁴ *ibid* 755-756.

³⁵ *Ad-Lib Club Limited v Grantille* [1971] 2 All ER 300; *Sutherland v Music Ltd* [2002] EWHC 14; [2002] All ER 156.

³⁶ L T C Harms, 'A Casebook on the Enforcement of Intellectual Property Rights' (WIPO 2018) 52.

2010³⁷ has declared unfair commercial practices illegal. The Annexure to section 3(3) enlists some unfair commercial practices which shall always be illegal. Paragraph 13 of the Annex to section 3(3) contains that ‘promoting goods or services similar to the goods or services of a specific manufacturer, to deceive the consumer regarding the commercial origin of goods or services promoted.’³⁸ This paragraph indicates the protection of unregistered trademarks by declaring it as an unfair commercial practice and illegal.

The Japanese Unfair Competition Prevention Act 1993³⁹ in its definition of ‘Unfair Competition’ as provided in section 2(1) includes

[T]he act of creating confusion with another person’s goods or business by using an indication (meaning a name, trade name, Trademark, Mark....) that is identical or similar to another person’s Indication of Goods or Business that is well-known among consumers as that of another person’s....

This provision is extremely specific for the protection of unregistered well-known trademarks.

4. Statutory Protection of Unregistered Trademarks in Bangladesh

What statutory rights an unregistered trademark owner does have is not clearly mentioned in laws of Bangladesh. For example, section 35(1) of the Trademarks Act 2009 says that ‘an unregistered trademark shall not be assignable or transmissible except along with goodwill of the business concerned’. This provision mentions indirectly the unregistered trademark owner’s right of assignability or transmissibility if the unregistered trademark does have the goodwill. The Act also requires that registration of the assignment or transmission is necessary as per section 40 of the Act and to assign or transmit a certification mark, a prior consent of the government is essential.⁴⁰ However, this Act does not define ‘assignment’ which usually refers to the transfer, in writing, of trademark owner’s rights, title and interest in a trademark.⁴¹ In most jurisdictions, it has been considered as the most common mode of transfer of ownership.⁴² In addition, section 2(31) of the Act defines transmission

³⁷ Act against Unfair Competition in the version published on 3 March 2010 (Federal Law Gazette I) 254, as last amended by Article 5 of the Act of 18 April 2019 (Federal Law Gazette I) 466 <https://www.gesetze-im-internet.de/englisch_uwg/englisch_uwg.html> accessed 26 September 2020.

³⁸ German Act against Unfair Competition 2010, para 13 of the annex.

³⁹ Act no. 47 of the 1993 (as amended up to Act No. 54 of 10 July 2015) <<https://wipo.lex.wipo.int/en/text/401411>> accessed 26 September 2020.

⁴⁰ *ibid*, s 39.

⁴¹ For example, Trademarks Act 1999, s 2(6). It defines assignment ‘an assignment in writing by act of the parties concerned.’

⁴² WIPO (n 7) 69.

as ‘transmission under this Act, devolution on the personal representative of the deceased person and any other mode of transfer, not being assignment.’ However, how the devolution will take place on the personal representative of the deceased remains vague.

Further, section 24(2) of the Trademarks Act 2009 supports an unregistered owner’s rights when it says that ‘nothing in the Act shall be deemed to affect his rights of action against any person for passing of goods or services as the goods or services, as the case may be, of another person or the remedies in respect thereof.’ However, the words in section 24(1) “his rights of action ... for passing of goods or services” and the words “right to institute a proceeding ... for the infringement” are supposed to differentiate between actions for violations of registered and unregistered trademarks. Further, what constitutes a violation of unregistered trademarks is not mentioned as is mentioned in section 26 for registered trademarks.⁴³ For protecting unregistered trademarks, trademark owners rely only on common law principles of passing off for what incidences constitute a passing off as discussed above. Furthermore, section 96 entitles an unregistered trademark owner to institute a suit in a similar way that the registered trademark owner can do, and section 97 endows him with the relief similar to the registered owner, including ‘an injunction and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.’⁴⁴

4.1 Rights of the Owner for Assignment, Transmission, and Valuation in respect of an Unregistered Trademark

Section 35(1) requires an unregistered trademark to contain goodwill for assignment or transmission of it. However, an unregistered trademark may be assigned or transmitted without goodwill, as section 35(2) requires, if the proprietor or owner of an unregistered trademark, manufactures or sells goods or services under that mark assigns it in relations to goods or services other than those he is already manufacturing or selling. Here, the assignor does not assign the goodwill attached to his brand in relation to the goods or services he is already manufacturing or selling under such brand. As a result, both the assignor and the assignee can use the same trademark but in different goods or services.⁴⁵

⁴³ Trademark Act 2009, s 26.

⁴⁴ *ibid*, s 97. Section 97(1) says: ‘The relief which a Court may grant in a suit for infringement or passing off referred to in section 96 of this Act includes an injunction and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.’

⁴⁵ Trademarks Act 2009, s 35(2). It says: ‘... an unregistered trademark may be assigned or transmitted

In addition, if a trademark is assigned or transmitted without goodwill, the assignee must register it in order to protect it. However, since there is no goodwill, he cannot take an action for passing off and it does not confer any enforceable right upon him. Further, if the unregistered trademark is assigned without goodwill, the assignor has to apply to the ‘Registrar for directions with respect to the advertisement of the assignment’ and must advertise it accordingly.⁴⁶

Besides, the Act is silent in cases of disposition of jointly owned trademarks. In Taiwan, for example, in cases of a jointly owned trademark, the disposition of rights by way of assignment or transmission requires the consent of all right holders unless such right or share is transferred by succession, compulsory execution, a judgment of the court or operation of other law.⁴⁷ In India, the right holders may also relinquish their rights in favour of one of them and claim respective value of their shares in the trademarks from the transferee.⁴⁸

Further, as regards creation of joint rights or parallel use of the trademark, the Act follows the line of other countries when it says that the assignment or transmission can, in no way, create exclusive rights in different persons and in different parts of Bangladesh, in relation to same or similar goods or services as it may result in the parallel use of the trademark that will be likely to deceive or cause confusion.⁴⁹ As a consequence of this provision, in cases of transmission by succession or devolution, the successors may jointly hold the trademark like their other property or can, in consensus, abandon their respective shares, as per the law or faith they belong to, to one of them on payment of the value of their respective shares in the trademarks. In other parts of the world, for example in the USA, in cases of transmission by devolution on account of the death of the owner who died intestate, trademarks rights like other property vest on the personal representative usually

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 in respect of which the registered trademark is assigned or transmitted.’

⁴⁶ Trademark Act 2009, s 38.

⁴⁷ For example, Taiwanese Trademark Act 2016 in its article 46 says “[a]ny license, sub-license, transfer, abandonment of, or creation of pledge on the right in a jointly owned trademark or any transfer of or creation of pledge on the share in a jointly owned trademark shall have the consent of all joint proprietors, unless such right or share is transferred by succession, compulsory execution, a judgment of the court or operation of other law.” <<https://law.moj.gov.tw/ENG/LawClass/LawAll.aspx?pcode=J0070001>> accessed 4 October 2020.

⁴⁸ Martand Nemana, ‘India: Joint Ownership of Trademarks’ (Mondac, 09 July 2017) <<https://www.mondaq.com/india/trademark/600602/joint-ownership-of-trademarks>> accessed 4 October 2020.

⁴⁹ Trademark Act 2009, ss 36-7.

appointed by the court as an administrator to settle the property.⁵⁰ So, the owner of an unregistered well-known trademark is entitled to transfer title, ownership and interest in his trademark and his heirs are entitled to inherit it after his death.

For the administrator, the valuation of trademarks is especially important in order to sell it for paying debts of the deceased or for paying other necessary costs and/or distribute the remainder among the heirs. In this regard, there are three approaches, i.e. market approach, cost approach and income approach, used as the best practices worldwide to determine the valuation of trademarks as well as other intellectual property rights.⁵¹ They are as follows:

- (i) The income method commonly estimates the valuation of a trademark by ‘calculating the present value of future income streams expected to be generated by use of the trademark over its remaining useful life.’⁵²
- (ii) According to the cost approach, the analyst estimates the value of the investment costs required to develop a new trademark.⁵³
- (iii) The market method presumes how much the licensee of a trademark would pay to its owner if the owner granted a license.

The hypothetical royalty payment is calculated by ‘a market-derived running royalty rate multiplied by the actual owner’s projected revenue over the remaining useful life of the trademark.’⁵⁴ The personal representative of the deceased may follow one or all of the three methods for the valuation. If one heir of the deceased carries on business by using the trademark, he may require him to pay other heirs proportionately according to the valuation. To this end, the valuation of trademarks plays a key role at the time of merger and acquisition as well. It is equally important as the financial valuation of a company; it could help the buyer and the owner of trademarks to bargain.⁵⁵

4.2 Rights of the Owner and the Consumer in respect of an Unregistered Trademark for Instituting Suits and Claiming Remedies

The infringement of a trademark is both a public wrong as well as a private wrong. It infringes not only the rights of the owner but also the interests of the consumers deceived. Consumers are used to relying on the trademark to identify and buy the

⁵⁰ *Meinhard v Salmon* [1928] 164 NE 545 (New York).

⁵¹ John E. Elmore, ‘The Valuation of Trademark-Related Intangible Property’ (2015) *Intangible Property Transfer Price Insights*, winter, 66, 70 <http://www.willamette.com/insights_journal/15/winter_2015_8.pdf> accessed 16 October 2021.

⁵² *Ibid* 66, 70.

⁵³ Su-Lin Ang, ‘Trade Marks in Mergers and Acquisition’ (2008) *International In-house Counsel Journal* 732, 735.

⁵⁴ John E Elmore (n 51) 66, 69.

⁵⁵ Su-Lin Ang (n 53) 732.

products of the legitimate owners; their interests are adversely undermined when they purchase products of infringers known to be the products of legitimate owners.⁵⁶ To this end in view, unregistered trademarks have been protected under various statutes of Bangladesh. Statutory protection against unregistered trademark includes the protection of the owner of unregistered protection on the one side and the protection of deceived consumers on the other side.

(i) Protection of the owner of an unregistered trademark in case of its infringement

The owner of an unregistered trademark may claim protection under the Trademarks Act 2009. The Act keeps provision for the prohibition of registration, cancellation of registration, and the civil and criminal remedies for infringement of the right of the owner of an unregistered trademark.

Section 10(4) of the Trademarks Act 2009 prohibits registration of a mark identical or similar to a well-known trademark of other enterprises as the section goes—

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 a trade restriction which is well-known in Bangladesh for identical or similar goods or services of another enterprise.

In determining whether a particular trademark is well-known or not, section 10(6) of the Act has incorporated the rule as contained in the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks. It asks for taking account of the fact that the mark ‘is well-known to the relevant sector of the public, including knowledge which has been obtained in Bangladesh as a result of the promotions of the mark’. Thus, a trademark that is not registered in Bangladesh but is within the knowledge of the relevant sector of the public shall be considered well-known and protected throughout the territories of Bangladesh. Rule 14 of the Trademarks Rules 2015 says that within two months from the date of filling the application to register a trademark, the Registrar shall examine whether the conditions contained in section 10 of the Act are violated or not. If the Registrar finds any anomalies he will decide after giving the applicant an opportunity of being heard.⁵⁷ Chapter III of the Trademarks Rules 2015 keeps provision for the advertisement to notify the public at large to entertain objection against registration if any. Chapter IV of the Rules 2015 mentions the procedure to deal with such an objection against registration.

⁵⁶ Thomas J McCarthy (n 26).

⁵⁷ Trademarks Rules 2015, r 15.

Even if an unregistered well-known trademark is wrongly registered, entered into register without sufficient cause or by an error or defect, any person aggrieved may apply to the High Court Division or the Registrar in the prescribed form for expunging or varying such entry as per section 51(2) of the Act. The High Court Division or the Registrar shall decide the matter and order to rectify it if it thinks fit after giving the opposite party the opportunity of being heard.⁵⁸

In addition, Bangladesh has followed the common law to protect unregistered well-known trademarks especially through the filing of suits for remedies when the section 24(2) of the Act entitles the owner of an unregistered trademark to enforce his right of action against any person for passing off goods and services as well as he can ask for remedies in respect thereof. Further, section 96(d) of the Act requires that every suit for passing off must not be instituted in any court, not below the Court of District Judge. Section 96(d) also identifies the cause of passing off as it arises out of the use 'by the defendant of any trademark which is identical with, or, deceptively similar to, the plaintiff's trademark, whether registered or unregistered'. Section 20 of the repealed Trademarks Act 1940 had incorporated similar provisions as well.

Further, whether a particular trademark is creating any confusion or there is any likelihood of creating confusion is determined by the court and such determination varies from case to case. In the USA, in *AMF, Inc v Sleekcraft Boats*⁵⁹, the court referred eight relevant factors to determine the likelihood of confusion such as strength of the mark; proximity of the goods; similarity of the marks; evidence of actual confusion; marketing channels used; types of goods and the degree of care likely to be exercised by the purchaser; defendant's intent in selecting the mark; and likelihood of expansion of products line.⁶⁰ In another US case named *Polaroid v Polarad*⁶¹, the court considered seven factors to determine likelihood of confusion which are as follows:

[T]he strength of his mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.⁶²

In both the cases, the court emphasized more on the defendant's intention and the quality of his product than the degree of similarity between two marks in determining whether there is consumer confusion or not.

⁵⁸ Trademarks Act 2009, ss 51, 65.

⁵⁹ [1979] 599 F 2d 341 (C A 9) <<https://cyber.harvard.edu/metaschool/fisher/domain/tmcases/amf.htm>> accessed 25 September 2020.

⁶⁰ *ibid.*

⁶¹ [1961] 287 F 2d 492.

⁶² *ibid.*

In the UK, for assessing similarities, Jacob J identified some relevant factors in the *Treat* case⁶³ as follows:

[T]he respective users of the respective goods or services; the physical nature of the goods or acts of services; the respective trade channels through which the goods or services reach the market; in the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

In all of the cases, the court emphasized on trade channels through which the goods or services reach the market and determined each as an important factor for creating consumer confusion. However, the checklist provided by the US court is more comprehensive than the UK court.

In addition, section 97 of the 2009 Act specifies the remedy for passing off, which includes injunction and either damages or an account of profits at the option of the plaintiff. If the defendant can prove that he uses the alleged trademark in good faith and without knowledge of the existence of the plaintiff's trademark, the court shall exempt him from providing damages or account of profits.⁶⁴

Besides the civil remedy, this Act keeps the penalty for applying a false trademark, which includes both registered and unregistered well-known trademarks. Without a prior assent of the owner of a trademark, when a person makes that trademark or deceptively similar mark, he is said to falsify such trademark as per section 72. Section 74 keeps the penalty also for selling goods to which a false trademark is applied for which a person shall be liable to a punishment up to two years imprisonment or with fine or with both. For repetition of the same act, the person shall be liable with punishment up to three years imprisonment or with fine or with both. The court may also direct forfeiture of such goods to the government as per section 79. A criminal proceeding under this Act shall be tried by the Metropolitan Magistrate or the Magistrate of the first class who acts as the judicial officer in the regular court setting.⁶⁵

(ii) Protection of consumers in case of infringement of an unregistered trademark

⁶³ [1996] RPC 281.

⁶⁴ Trademarks Act 2009, s 97 (2) (c).

⁶⁵ *ibid*, s 83(2).

Using someone's trademark or property as that of another is a criminal offense in Bangladesh. The Penal Code 1860 has decriminalized 'using a false trademark' and 'using a false property mark'. Their definition as provided in sections 480 and 481 of the Code has the following ingredients:

- (a) someone marking any goods, packaging the goods, or using any such goods with a mark; and
- (b) the marking, packaging, or using goods has caused it to believe that these merchandise or property or goods belong to a person to whom they do not belong.

So, misleading consumers using someone's mark is enough to constitute the offenses of 'using false trademark' or 'using a false property mark'. Whether there is any goodwill attached to the mark, whether consumers are misled, or whether any injury caused to the plaintiff is immaterial here. However, these definitions are too wide to include protection of unregistered trademarks. Regarding the remedy for these offenses, section 483 of the Code says that a person using false trade or property mark shall be punished with imprisonment of one year, or with fine, or with both. Further, 'making or possession of instrument for counterfeiting a trademark or property mark'⁶⁶ as well as 'selling goods marked with a counterfeit trademark or property mark'⁶⁷ has also been penalized under this Code. Chapter xviii of the Code also penalizes offenses relating to trade, property, or other marks in sections 478 to 489E.

In addition, the infringement of an unregistered trademark appears also to have a certain relationship with cheating. It can be protected under section 415⁶⁸ read with

⁶⁶ Penal Code 1860, s 485. It contains that '[w]hoever makes or has his possession any die, plate or either instrument for the purpose of counterfeiting a trade mark or property mark, or has in his possession a trade mark or property mark for the purpose of denoting that, any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, shall be punished with imprisonment of either description for a term which may extend to three years, or with fine, or with both'.

⁶⁷ *ibid*, s 486. It says that '[W]hoever sells, or exposes, or has in possession for sale or any purpose of trade or manufacture, any goods or thing with a counterfeit trade mark or property mark affixed to or impressed upon the same or to or upon any case, package or other receptacle in which such goods are contained, shall unless he proves-

- (a) that, having taken all reasonable precautions against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, and
 - (b) that, on demand made by or on behalf of the prosecutor, he gave all the information in his power in respect to the persons from whom he obtained such goods or things, or
 - (c) that otherwise he has acted innocently,
- be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both'.

⁶⁸ *ibid*, s 415. It contains that '[w]hoever, by deceiving any person, fraudulently or dishonestly induces

section 417⁶⁹ of the Penal Code. Illustration (b) to section 415 mentions that ‘A, by putting a counterfeit mark on an article, intentionally deceives Z into a belief that this article was made by a certain celebrated manufacturer, and thus dishonestly induces Z, to buy and pay for the article, A cheats.’ The term ‘this article was made by certain celebrated manufacturers’ proves that the article must have certain goodwill. Very importantly, the term ‘deceives Z into a belief that....’ proves misrepresentation to the consumer. To be protected under this provision, the unregistered trademark must be well known having prestige, goodwill, or reputation.

Further, section 15 of the Customs Act 1969 has provided that goods containing a counterfeit trademark, or a false trade description shall not be brought into Bangladesh, whether by air or land or sea. The goods so imported in breach of section 15 shall be liable to be detained and confiscated and shall be disposed of in such a manner as may be prescribed.⁷⁰ The concerned officer may search any person if he has reason to believe that such person is carrying with himself any goods liable to be confiscated.⁷¹ The officer may also arrest any person if he has reason to believe that such person has committed an offence under the Act.⁷² The government may empower the officers with the power of a Magistrate of the first class for the purpose of search, seizure and arrest.⁷³ The Commissioner⁷⁴, Additional Commissioner⁷⁵,

the person so deceived to deliver any property to any person, or to consent that any person shall retain any property, or intentionally induces the person so deceived to do or omit to do anything which he would not do or omit if he were not so deceived, and which act or omission causes or is likely to cause damage or harm to that person in body, mind, reputation or property, is said to "cheat".

Explanation. A dishonest concealment of facts is a deception within the meaning of this section.’

⁶⁹ *ibid*, s 417. It says that ‘[w]hoever cheats shall be punished with imprisonment of either description for a term which may extend to one year, or with fine, or with both’.

⁷⁰ Customs Act 1969, s 17. It says that ‘[w]here any goods are imported into or attempted to be exported out of Bangladesh in violation of the provisions of the 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.’

⁷¹ *ibid*, s 158(1). It says that ‘[t]he appropriate officer, if he has reason to believe that any person is carrying about himself goods liable to confiscation or any documents relating thereto, may search such person, if he has landed from or is on board or is about to board a vessel within the Bangladesh customs-waters, or if he has alighted from or is about to get into or is in any other conveyance arriving in or proceeding from Bangladesh or if he is entering or about to leave Bangladesh or if he is within the limits of any customs-area.’

⁷² *ibid*, s 161(1). It says that ‘[a]ny officer of customs authorised in this behalf who has reason to believe that any person has committed an offence under this Act may arrest such person.’

⁷³ *ibid*, s 158A.

⁷⁴ Commissioner of Customs shall have jurisdiction to try cases in which the value of confiscated goods is exceeding 20 lacs Tk.

⁷⁵ Additional Commissioner of Customs shall have jurisdiction to try cases in which the value of confiscated goods is not exceeding 20 lacs Tk.

Joint Commissioner⁷⁶, Deputy Commissioner⁷⁷, and Assistant Commissioner⁷⁸ shall have the power under this Act to adjudicate such offence under section 179 of the Act to act as the officer. So, the unregistered trademark or property mark can be protected under these provisions. These provisions not only protect domestic but also foreign unregistered well-known trademarks.

Furthermore, the Consumer's Right Protection Act 2009 has been enacted to protect the right of consumers as well as to prevent anti-consumer right practices.⁷⁹ This Act criminalizes the *making or manufacturing of fake goods* for which the offender shall be liable to be punished with imprisonment for a term not exceeding three (3) years, or with fine not exceeding Taka 2 lacs, or with both.⁸⁰ The term 'fake' has been defined to be meant that 'making or manufacturing of similar goods without authorization imitating the goods authorized for marketing whether the properties, ingredients, elements or quality of the goods authorized exist or not in such fake goods.'⁸¹ According to this Act, a trademark is the private property of its owner and thus the owner is the person authorized to use it. Further, section 21(1) of the 2009 Act empowers the Director General of the Directorate of National Consumers' Right Protection to 'take all necessary actions as he deems expedient and necessary for the protection of the rights of the consumers, prevention of anti-consumer right practice, and disposal of the complaint against violation of the rights of the consumers'. If he has any reason to believe that any person has committed an offence under this Act, he may issue a warrant of arrest under section 24. This Act empowers any officer to seize such goods after search and arrest the accused related to such goods.⁸² The Director General or any officer empowered in this behalf may make order of temporary closure of any shop, commercial enterprise, etc. for any anti-consumer right practice.⁸³ Upon the request of assistance by the Director General or any officer empowered by him, any law enforcing agency or any other public or statutory

⁷⁶ Joint Commissioner of Customs shall have jurisdiction to try cases in which the value of confiscated goods is not exceeding 15 lacs Tk.

⁷⁷ Deputy Commissioner of Customs shall have jurisdiction to try cases in which the value of confiscated goods is not exceeding 5 lacs Tk.

⁷⁸ Assistant Commissioner of Customs shall have jurisdiction to try cases in which the value of confiscated goods is not exceeding 2 lacs Tk.

⁷⁹ Consumer's Right Protection Act 2009, preamble.

⁸⁰ *ibid*, s 50.

⁸¹ *ibid*, s 2(9).

⁸² *ibid*, s 25. It says that '[i]f any officer, while conducting any inquiry or investigation under this Act, has reason to believe that there are goods contrary to this Act in any open place or any vehicle, he may, recording reasons thereof in writing, seize such goods after search and arrest the accused related to such goods.'

⁸³ *ibid*, s 27.

authority is bound to render such assistance.⁸⁴ According to section 32, the goods which are related to an offence under this Act, shall be liable to confiscation.

Further, the Act of 2009 criminalizes imitating the goods which is authorised for marketing. So, the ultimate object here is marketing which is the ordinary business practice whereby the goods manufactured are marketed under a trade name. Thus, the phrase ‘imitating goods’ essentially includes ‘imitating trademark’. Further, though the definition ‘fake’ does not directly mean the trademark, it indirectly indicates so. The affected consumers thereby may file a suit for civil remedies in appropriate cases in the regular civil court.⁸⁵

In addition, to deceive consumers by an untrue or false advertisement to sell any goods or services has been included in the definition of ‘anti-consumer right practice’⁸⁶ which is a punishable offense under section 44 of the Act. The person so deceives shall be punished with imprisonment for a term not exceeding 1 year, or with fine not exceeding Taka 2 lacs, or with both. Further, false or untrue ‘advertisement campaigns’ can be termed as ‘misrepresentation’⁸⁷ and it is treated as the foundation of all liability in ‘passing off’.⁸⁸ So, if a person uses the trademark of another person whether registered and unregistered, and thereby falsely advertises it as his own to the consumers, he shall commit a punishable offense under this Act. The affected consumer may file a civil suit in a competent civil court asking for civil remedies for the anti-consumer right practice, hereby deceiving consumers by untrue or false advertisement.⁸⁹ The remedies provided by the civil court include injunction, damages etc. The Competition Act 2012 has also empowered the Bangladesh Competition Commission to ensure the protection of consumer rights through the review of the actions taken under any other law.⁹⁰

In light of the analysis, it may be argued that the statutory protection regime has incorporated the common law principle of passing off directly, and the civil law principle against unfair practices to protect unregistered well-known trademarks

⁸⁴ *ibid*, s 28.

⁸⁵ *ibid*, s 66.

⁸⁶ *ibid*, s 2(20).

⁸⁷ *Cadbury-Schweppes Pty. Ltd. v Pub Squash Co. Pty. Ltd.* [1981] RPC 429 (though it was held there that the use of the advertising campaign did not, in the circumstances, amount to a misrepresentation).

⁸⁸ Suman Naresh, ‘Passing Off, Goodwill and False Advertising: New Wine in Old Bottles’ (1986) 45(1) *Cambridge Law Journal* 99.

⁸⁹ Consumer’s Right Protection Act 2009, s 66.

⁹⁰ Competition Act 2012, s 8(1)(j).

indirectly since the legal provisions mentioned above hold a strong commitment to prevent the promotion of goods or services similar to the goods or services of a specific manufacturer, and prevent the putative infringers from deceiving the consumers regarding the commercial origin of goods or services promoted. So, giving the strongest statutory protection to unregistered well-known trademarks appears to be more than the required in compliance with its treaty obligations.

Further, section 2(3) of the BSTI Act 2018 defines ‘trademark’ as any registered trademark, or any marks used or proposed to be used with any goods which indicate the right of its proprietor owner in it. This definition includes both registered and unregistered trademarks. Section 15 prohibits using standard marks in a trademark without taking a license. Section 2(20) defines ‘standard mark’ as a certification mark issued by the BSTI. The Government in consultation with the BSTI can impose restrictions on import and export and can prohibit selling, distributing or advertising of goods which do not contain standard mark, or which violates conditions on which the licence was granted as per sections 20 and 21. In addition, according to section 27(1), if any person violates section 15 by using a trademark with the license, he shall be liable to be punished with imprisonment for a term not exceeding 2 years or with fine not exceeding 1 lakh but not below 25,000 Tk or with both. Further, according to section 27(2), the court trying such offences may seize the property in respect of which the provisions of the Act are violated. To inspect whether any trademark contains any standard mark wrongfully, the BSTI can appoint an Inspector as per section 22(1). The Inspector shall also have the power as given under section 22(2) to inspect any product using standard mark, to collect their sample, to exercise power of Sub-inspector to search, arrest and investigate any matters, and any other power.

In addition, section 34 says that the offences under this Act shall be adjudicated by the Magistrate of the first class or Metropolitan Magistrate. Further, section 35 empowers the mobile court constituted under the Mobile Court Act 2009 to try the offences mentioned under this Act. So, there appears a clear contradiction between sections 34 and 35 in respect of jurisdiction of the court, since in one place it gives jurisdiction to the Magistrate Court and in other places it gives jurisdiction to the Executive Magistrate led mobile courts. The courts - Magistrate Courts or Executive Magistrate led mobile courts do not play any role in protecting intellectual property rights like unregistered trademarks since they may not have any formal knowledge in intellectual property law. Further, the Executive Magistrate does not require any formal educational background in legal studies. They are, in many cases, not familiar with fundamental judicial norms. On several writ petitions filed before the High Court Division (HCD), a Division Bench declared a mobile court conducted by the

Executive Magistrates illegal and unconstitutional.⁹¹ It criticized empowering the Executive Magistrates with judicial powers and held that it is ‘a frontal attack on the independence of the judiciary and is violative of the theory of separation of powers’.⁹² The case is now pending at the Appellate Division (AD) of the Supreme Court although it has stayed the HCD judgment until the final disposal of the case.

5. Judicial Response towards Protection of Unregistered Well-Known Trademarks in Bangladesh

There are different stakeholders in protecting unregistered well-known trademarks, e.g. Tribunal comprising the Registrar of the Department of Patents, Designs and Trademarks⁹³, the Commissioner of Customs⁹⁴, the District Court, the High Court Division, and the Appellate Division constructed and empowered under various statutes including the Trademarks Act 2009. The role of the District Court and others has been discussed above. This part shall deal with the attitude of the higher judiciary meaning the High Court Division and the Appellate Division of the Bangladesh Supreme Court in protecting unregistered well-known trademarks. The upper judiciary is in true sense expanding the protection regime contained in the various legislation.

For instance, the protection of an unregistered well-known trademark under section 20 of the Trademarks Act 1940 (now repealed) has been reiterated in *Dominous Pizza and others v Domino’s Pizza Inc.*⁹⁵ where the plaintiff carried out worldwide business of manufacture and merchant of pizza and pizza related products under the trademark ‘Domino’s Pizza’. Due to an extensive use of high quality of the plaintiff’s products and advertisements, this mark acquired excellent reputation and goodwill. The plaintiff filed an application for registration of the mark in Bangladesh. During the pendency of application, the defendant started to produce pizza and pizza related products by using a similar trademark ‘Dominous Pizza’ and thereby earning

⁹¹ Three separate writ petitions; *Kamruzzaman Khan vs Bangladesh represented by the Secretary, Ministry of Law, Justice and Parliamentary Affairs, Bangladesh Secretariat, Ramna, Dhaka and others, Md. Shafiullah and others vs Bangladesh represented by the Secretary, Ministry of Law, Justice and Parliamentary Affairs, Bangladesh Secretariat, Ramna, Dhaka and others, and Md. Mujibur Rahman and others vs Bangladesh represented by the Secretary, Ministry of Law, Justice and Parliamentary Affairs, Bangladesh Secretariat, Ramna, Dhaka and others*; having same issue were heard together. See <http://www.supremecourt.gov.bd/resources/documents/382548_WP8437of2011.pdf> accessed 26 September 2020.

⁹² *ibid*, 61.

⁹³ Trademarks Act 2009, s 2(6).

⁹⁴ Customs Act 1969, s 109. It empowered Commissioners of Customs to require information in respect of imported goods and false trademarks. This provision was omitted by section 33 of the Finance Act 2001.

⁹⁵ [2009] 61 DLR 780.

huge profits and causing an irreparable loss to the plaintiff. The loss included a huge economic and reputational loss to the plaintiff by passing off substandard products resulting in deception among the customers, who believed that they were customers of products as prepared by the plaintiff. In this case, the HCD held that ‘section 20(1) of the Act (Trademarks Act 1940) relates to the institution of any proceedings by any person to prevent or recover damages for the infringement of an unregistered trademark...’

In this case, the HCD has relied on the decision of the Pakistan Supreme Court in *Messrs Tabaq Restaurant v Messrs Tabaq Restaurant*⁹⁶ in which it was held that ‘what is described as a passing off action may be passing off action simpliciter or a case of infringement of trademark coupled with passing off trademark being registered or unregistered’. In the case, the Pakistan Supreme Court also construed the phrase ‘suit otherwise relating to any right in the trademark’ as contained in section 73⁹⁷ of the [Pakistan] Trademarks Act 1940 and held that

[T]he word ‘otherwise’ is of comprehensive significance and it is cut down in its scope and meaning only when it is followed by an enumeration and when it receives *ejusdem generis* construction. There is no enumeration therefore no restriction can be imported. Similarly, the words ‘relating to’ bring in comprehensiveness and wider import. In a passing off action, which is based on the infringement of an unregistered trademark, section 73 would be applicable and it is to such passing off cases that the words ‘otherwise relating to any right in a trademark’ suggest that the section also applies to actions of passing off.⁹⁸

The erstwhile Trademarks Act 1940 also allowed assignment and transmission of an unregistered trademark subject to some conditions. In *Sohan Kumar Agarwala v Assistant Registrar, Department of Patent Design and Trademark and others*,⁹⁹ an Indian national, Raj Kumar Agarwala, filed an application to get his trademark ‘Dulhan’ registered on 28.05.1997. The respondent no 2 was substituted in place of Raj Kumar Agarwala since he acquired the proprietorship of the unregistered trademark ‘Dulhan’ by virtue of deed of assignment dated 30.12.2003 given by Raj Kumar in his favour. The petitioner, Sohan Kumar Agarwala, had applied for registration of the same trademark ‘Dulhan’ in 2004, i.e. long 7 years after filing the trademark application by Raj Kumar. The matter in issue in this case was whether the unregistered trademark ‘Dulhan’ was assignable or not. In this case, the Appellate Division of the Supreme Court has considered and reiterated the provision contained

⁹⁶ [1987] SCLR 1090.

⁹⁷ Trademarks Act 1940 (Pakistan), s 73. It states that ‘no suit for the infringement of a trademark or otherwise relating to any right in a trademark shall be instituted in any Court inferior to a District Court having jurisdiction to try the suit.’

⁹⁸ [1987] SCLR 1090.

⁹⁹ [2015] 38 BLD 139 (AD).

in section 30 of the 1940 Act that ‘an unregistered trademark shall be assignable or transmissible except in connection with the goodwill of a business only if, at the time of assignment or transmission, such trademark is used in the same business as a registered trademark.’ A similar fact of assigning the unregistered trademark ‘RANI’ without use of the mark meaning assignment without goodwill appeared in the *Danish Foods Limited v Department of Patents, Designs and Trademarks*¹⁰⁰ where the High Court Division gave the decision against the assignment.

In the *British Broadcasting Corporation (BBC) v Department of Patents, Designs and Trademarks*¹⁰¹, the question arose whether the British Broadcasting Corporation (BBC) a well-known unregistered trademark can be registered and protected where two applications for registering trademarks, namely, Brown, Boveri & Cie AG (BBC) and Bangladesh Brevy Center (BBC) were filed earlier and pending registration. The High Court Division opines that ‘the priority use of this mark [British Broadcasting Corporation (BBC)] gets paramount consideration compared to registration’¹⁰² and hence it is protected.

Further, the terms ‘deceptively similar’ and ‘likelihood of confusion’ were elaborated in *Nasir Miah, Malik Nasir Soap Factory v Md. Anwar Hossain, Executive Officer, Commander Soap Factory Limited*.¹⁰³ In this case, the plaintiff has claimed that the defendant used the word ‘MOSCO’ in his soap packet which was phonetically and visually similar to ‘COSCO’ used by the plaintiff in his soap packet which could create doubt and confusion. The trial court ordered for a temporary injunction and the defendant appealed. In the appeal, the HCD found that the defendant had been trying to pass off his Mosco soap as that of the plaintiff’s Cosco soap and dismissed the appeal. In this case, the court relied on *Shafaquat Haider v Md. Al-Amin*¹⁰⁴ in which it was held that ‘in case of similarities between two names likely to create confusion in the minds of customers temporary injunctions can be granted to restraint the defendant from passing off his goods as that of the plaintiff’s.’

An interim remedy in the form of temporary injunction was granted to protect the unregistered trademark in *Kohinoor Chemical Co. (BD) Limited v Unilever Bangladesh Limited*.¹⁰⁵ In this case, the plaintiff started manufacturing of a fairness cream under the brand name ‘Fair & Lovely’ in 1964 which acquired popularity at home and abroad, but the defendant started business of similar product in 2006

¹⁰⁰ Trademark Appeal No. 09 of 2011.

¹⁰¹ [2017] 5 CLR 101.

¹⁰² *ibid.*

¹⁰³ [1996] 48 DLR 28.

¹⁰⁴ [1987] BLD 130 (AD).

¹⁰⁵ [2011] 16 BLC 60 (HCD).

imitating the brand name and the package named 'Fair & Care'. Both of them had no trademark registration certificate. The plaintiff filed a suit against the defendant under section 96 read with section 24(2). The District Judge granted a temporary injunction in respect of manufacturing, marketing and selling of fairness cream with the trademark 'Fair and Care'. On appeal from the order of injunction, the HCD observed that

[T]he matter in issue raised by the parties is absolutely the subject matter of evidence. The Court below failed to ascertain such facts of either party. When a particular dispute is in seisin of the Civil Court neither party should be allowed to take any undue advantage and nature and character of the subject matter of the suit should be protected so long the dispute is pending before the Court.¹⁰⁶

It directed both parties to maintain status quo in respect of manufacturing, distributing, selling and marketing of their respective product fairness cream with trademark 'Fair & Lovely' and 'Fair & Care' and directed the District Court to dispose of the suit within 3 months. In this case, the HCD emphasized on merit of the case in granting injunction as it observed that 'the matter in issue raised by the parties is absolutely the subject matter of evidence'. But in principle, it is sufficient to prove the prima facie case to get an order of temporary injunction; it is immaterial to prove the merit of the case.¹⁰⁷ Here, the plaintiff proved the prima facie case since it launched the business in 1964 and continued the business with reputation. The plaintiff need not prove the actual merit of the case. The Court's order to stop business of both the parties was not the right solution as it results in a great economic loss for both the parties.

The notion 'consumer confusion' was illustrated in *Nabisco Biscuit and Bread Factory Ltd. v Baby Food Products Ltd.*¹⁰⁸ In this case, the trademark applications by the Opposite Party no. 1 pertain to the registration of the impugned trademark consisting of a deceptively similar trademark "NABI", "NABISO", "NABICO", "NAVICO", "NOBICO" and "NABICO". All the six trademarks are registered under similar circumstances notwithstanding identical pre-existing trademarks of the petitioner named "NABISCO". The petitioner approached the court. The court found

¹⁰⁶ *ibid*, para 9.

¹⁰⁷ In *Nurul Haq v Bangladesh Bank* (39 DLR 310) the court held that 'it is no part of the court's function at that stage to try to resolve conflict of evidence, not to decide complicated questions of fact and of law which called for detailed arguments and mature consideration. These are matters to be dealt with at the time of trial. The court is not required to enter into the merit of the case as is necessary for passing a decree after hearing the evidence'. See also *IDBP v Master Industries* (26 DLR 157); *Dalpat v Prahlad* [1993] AIR 276 SC.

¹⁰⁸ [2010] 30 BLD 241 (HCD).

the merit in petitioner's case and directed the Registrar to expunge the impugned trademarks. The court reiterated the legislative requirements not to deceive or not to cause confusion to the consumers in order to be considered for registration as a trademark. The court based its judgment on sections 8(a) and 10(1) of the Trademarks Act 1940. Of the highlighted provisions, section 8 requires that a trademark to be registered shall not contain any matter which would be disentitled to protection in a Court of Justice by reason of its being likely to deceive or to cause confusion. Further, section 10 as referred to, prohibits the registration of identical or similar trademarks which so nearly resembles such trademarks as to be likely to deceive or cause confusion.

In this *Nabisco* case¹⁰⁹ Syed Refat Ahmed, J has enunciated a test by holding that it should place itself in the shoes of that ordinary consumer to at the precise moment that the discretion to buy is exercised and to ensure that such exercise of discretion is indeed an informed one and not improperly induced by deception. The court was of the opinion that mere 'ocular comparison may not always or solely prove to be the decisive test. Rather, a probable resemblance between two marks must be considered with reference to the ear as well as eye' which was referred from *K.R. Chinna Krishna Chettiar v Sri Ambel & Co. and another*¹¹⁰. The court thus emphasized on the protection of the unwary purchaser from deception. The court noted that

[I]t must always be careful to make allowances for imperfect recollections of the distinguishing marks of a preferred product and how that recollection is susceptible of corruption by the effect of careless pronunciation and speech on the part not only of the person seeking to buy under a trade description but also of the shop assistant attending the person's wants.¹¹¹

So, it appears that the Honourable Supreme Court of Bangladesh just reiterated the statutory provisions regarding the protection of unregistered well-known trademarks. However, the court seems to be conservative to dealing with the matter relating to the common law doctrine of passing off. They only reiterated the relevant provisions of the trademark law. They did not discuss Bangladesh's international obligations under different treaties and global best practices in respect of protection of unregistered well-known trademarks. They could develop jurisprudence by analysing the global best practices and other relevant domestic laws in addition to the trademark law. They could also find out and fill up the gap between national laws and international obligations as regards the tests for passing off evolved in other jurisdictions. The counsel on behalf of the parties could also play a vital role by assisting the court in this regard.

¹⁰⁹ *ibid.*

¹¹⁰ [1970] AIR 146 (SC).

¹¹¹ [2010] 30 BLD 241 (HCD).

6. Protection of Unregistered Trademarks of Trade Names and Domain Names

Section 11(1) of the Companies Act 1994 provides that ‘a company shall not be registered by a name identical with that by which a company in existence is already registered, or so nearly resembling the name that there is likelihood of using the name to deceive’. A literal interpretation of this section may reveal that this provision will only be applicable to the similar name of companies already registered, but it has nothing to do with the similar name of, or the trademark used by other business entities including partnerships, sole proprietorships etc. whether incorporated or unincorporated.¹¹² Nevertheless, in *Shafquat Haider & Others v Mr. Al-Amin and Another*¹¹³, the Appellate Division of the Supreme Court of Bangladesh granted an injunction order to restrain the respondents from using the trade name ‘Ciproco Computers’, which is a sole proprietorship business, till disposal of the petition for winding up of the ‘Ciproco Computers Ltd’, which is a company. Thus in light of this decision, it is well settled that the bar against using an identical or similar name as laid down in section 11 is not only limited in its application to a company with reference to another company but can also be applicable to an incorporated and unincorporated business entity including a sole proprietorship, a partnership firm etc., particularly when there is some sort of deception.¹¹⁴ However, it is not clear whether an unregistered well-known trademark that may also consist of a tradename will be protected under this provision. For example, ‘Khan and Khan’ which is a well-known unregistered trademark may face challenges regarding the protection of its trademark under this provision if another business is registered as a company with the same tradename ‘Khan and Khan’.

In similar line, section 53 of the Partnership Act 1932 empowers every partner of a partnership firm to restrain any other partner or his representative from using the firm’s name in a similar business until the firm has been completely wound up. The underlying object of the provision is to fix the value of the goodwill attached to the name and distribute it among partners as evident from the proviso clause which contains that this section will not affect the right to use the firm’s name by a partner who has bought the goodwill. Considering a liberal interpretation of this provision, it may be said that this provision is not limited only to partners but to the public at large using the firm’s name.

¹¹² Shima Zaman, ‘The Scope of Statutory Protection on the Use of Identical or Confusingly Similar Names by Businesses in Bangladesh’ (2020) 31 *Dhaka University Law Journal* 49, 53.

¹¹³ [1987] 39 DLR (AD) 103.

¹¹⁴ Md. Rizwanul Islam, ‘Use of Similar Names by Companies’ *The Daily Star Online* (Dhaka, 23 December 2014) <<http://www.thedailystar.net/use-of-similar-names-by-companies-56593>> accessed 2 February 2021.

In addition, the protection of a trademark involving the domain name appears recently in Bangladesh when the Facebook Inc., a US tech giant and largest social media company, files a suit against the Bangladeshi A1 Software Limited in the Dhaka District Court.¹¹⁵ Here in the case, the defendant, A1 Software Limited company bought a domain name (facebook.com.bd) in 2008 from the Bangladesh Telecommunication Company Limited (BTCL) that owns all dot bd (.bd) domains and it sells the domain name to the public,¹¹⁶ although the plaintiff, Facebook Inc. has achieved worldwide popularity from the very day of its inception in 2004. In 2020, the Facebook makes an application for a dot bd (.bd) domain from the BTCL but is declined since there is an existing domain in the similar name ‘facebook.com.bd’.

The Facebook tries to settle this matter amicably but fails, and thus files a suit seeking a ban on the operation of facebook.com.bd to prevent fraudulent activities through it and asks for USD50000 as compensation.¹¹⁷ The court grants an ad interim injunction against the defendant along with a show cause notice to respond within 15 days.¹¹⁸ This case is the first of its nature, which contains an issue relating to the protection of a well-known foreign domain name as a trademark in Bangladesh. Since the plaintiff company has the goodwill, which is being misappropriated and misrepresented by the defendant company and thus causes damages to the former’s goodwill, this case is taken by the court to have fulfilled the requirement of passing off. This relief may be a milestone regarding the protection of an unregistered well-known domain name as a trademark in Bangladesh. Further, if the local company also registered the name ‘Facebook’ as a trademark in Bangladesh, the Facebook Inc., although not registered here as a trademark, could file an application with the Registrar of Trademarks for cancellation of the registration due to its already being a well-known trademark.¹¹⁹

7. Examining the Enforcement of Unregistered Trademarks and Suggesting the Way-forward

Despite having a strong commitment towards the protection of unregistered well-known trademarks, there are some lacunae in the protection regime. This part identifies those lacunae and proposes some solutions to overcome them.

¹¹⁵ Trademarks Act 2009, ss 96, 24.

¹¹⁶ ‘Facebook to sue ‘facebook.com.bd’ domain in Bangladesh’ *The Daily Star* (Dhaka, 20 November 2020) <<https://www.thedailystar.net/toggle/news/facebook-sue-facebookcombd-domain-bangladesh-1997677>> accessed 1 February 2021.

¹¹⁷ ‘Facebook to Sue ‘facebook.com.bd’ Domain in Bangladesh’ *The Daily Star* (Dhaka, 20 November 2020) <<https://www.thedailystar.net/toggle/news/facebook-sue-facebookcombd-domain-bangladesh-1997677>> accessed 1 February 2021; see also Trademarks Act 2009, ss 96, 97.

¹¹⁸ ‘facebook.com.bd: Court Stops Domain Use as Facebook Files Case’ *The Daily Star* (Dhaka, 15 December 2020) <<https://www.thedailystar.net/backpage/news/facebookcombd-court-stops-domain-use-facebook-files-case-2011485>> accessed 1 February 2021; see also Trademarks Act 2009, s 97.

¹¹⁹ See Trademarks Act 2009, s 51.

The protection regime of an unregistered well-known trademark has been designed to protect the owner of it, the consumers, and most importantly the national interest. The infringement of an unregistered trademark also involves a breach of both public interests and private interests. In this regard, the statutory regime provides for the protection of public interests (right of the consumers and national interests) by the criminal court and protection of private interests (right of the owner) by the civil court.

The statutory protection regime is scattered in different laws and enforced by different authorities sometimes over a single cause of action. For example, as per section 96(d) of the Trademarks Act 2009, the user of an unregistered well-known trademark shall have to institute a suit for passing off arising out of the use by the defendant of any trademark which is identical to or similar with his trademark in the District Court. Here the District Court means the Court of District Judge and includes the Court of Additional District Judge and Joint District Judge.¹²⁰ On the other hand, a criminal proceeding against the infringer under this Act shall be tried by the Metropolitan Magistrate or the Magistrate of the first class.¹²¹ Further, the offences under the Consumer Protection Act 2009 is to be tried by the Metropolitan Magistrate or the Magistrate of the first class.¹²² For civil remedies in appropriate cases, the affected consumers have to file a suit in Court of the Joint District Judge having local jurisdiction.¹²³ Furthermore, the offences under section 417 and 478 to 489E of the Penal Code 1860 shall be tried by the Metropolitan Magistrate or the Magistrate of the first class.¹²⁴

So, it appears that using others' unregistered well-known trademarks without authorization has a close connection with making fake, unauthorized, adulterated, substandard products, and selling them to the market. These unfair business practices are quite common here in Bangladesh.¹²⁵ The infringers use local and foreign well-known trademarks or brand names for that purpose.¹²⁶ The infringers produce their

¹²⁰ Trademarks Act 2009, s 2(4).

¹²¹ *ibid*, s 83(2).

¹²² Consumer's Rights Protection Act 2009, s 57.

¹²³ *ibid*, s 66. Under 66(2), "a competent Civil Court" shall mean the Court of Joint District Judge having local jurisdiction.

¹²⁴ Code of Criminal Procedure 1898, Column 8 of the Schedule II.

¹²⁵ See, *The Daily Observer* (n 5); *The Daily Bangladesh* (n 5); *The Dhaka Tribune* (n 5); *The Daily Sun* (n 5); *The Daily Star* (n 5); *The Business Standard* (n 5); *Bdnews24.com* (n 5).

¹²⁶ These products include for example cosmetics, face wash, toothpaste, soap, lotion, electronics, body sprays and perfumes, powder, talcum powder, baby powder, body lotion, fairness cream and shampoo etc. The product of famous brands includes for example Unilever, Dove, Fair & Lovely, Sensodyne, Fogg, Axe Signature, Blue Lady, electronics labelled Sony, Panasonic, and LG.

own products and label them with reputed foreign company's logos. As a result, there may be several causes of action arising of one single incident of this kind of infringement e.g. making unauthorized products, making fake products, adulterating products, selling those products to the market, finally and most importantly infringement of a well-known trademark. Very often, the Mobile Court led by the BSTI with the help of law enforcing agencies including the Rapid Action Battalion (RAB) raids the factories, shopping centres, etc. engaged in manufacturing or selling those goods. Usually, they recover those goods and destroy them. The people engaged in making fake, unauthorized, adulterated, substandard, products, and selling them to the market are usually punished with fines as well as sentenced to imprisonments under the BSTI Act 2018. However, in these incidents, the Mobile Court led by the BSTI interferes only when the manufacturer produces goods without following the Bangladesh standard as set by the BSTI, or uses standard certificate in the trademark without taking a license from the BSTI etc. Further, this court has no jurisdiction to try for passing off, or for offences relating to unregistered trademarks as it cannot try an offence having an imprisonment of more than two years.¹²⁷

In addition, the review of the BSTI Act 2018 shows that under this Act, mobile courts can try offences relating to not using standard mark in a trademark or using standard mark in a trademark whether it is registered or not without a license or violating conditions upon which the licence was granted. Hence, the offences relating to an unregistered trademark, or the infringement of an unregistered trademark is outside the jurisdiction of the court.

Further, there appears a lack of coordination among the laws dealing with or the enforcement procedure relating to the unregistered trademark. For example, there are different civil and criminal courts to try the issue arising from the same transaction. In a wrong of the infringement of an unregistered well-known trademark, there are several rights: consumer's right to initiate criminal proceedings as well as claim civil remedies, owner's right to initiate criminal proceedings as well as claim civil remedies, and finally State's right to initiate criminal proceedings to protect national interests. The infringement of an unregistered trademark along with making fake, unauthorized, adulterated, substandard products and selling them to the market arises out of the same transaction. When the same issues are tried by several civil and criminal courts, the same procedures are repeated in every trial. Further, when the

¹²⁷ Mobile Court Act 2009, s 8(1). It says that 'in the case of imposing a penalty by a mobile court conducted under this Act, imprisonment not more than two years shall be imposed under this Act, irrespective of the penalty prescribed by the relevant laws for the offense concerned'.

causes of actions arise out of the same transaction, the parties remain the same, the same are with the witnesses. So, it is unnecessary to initiate several proceedings. It imposes an extra-burden upon our judiciary, while it is already overburdened. It creates a considerable delay, great expense, and unnecessary complexity.

To avoid such problems, a joinder of civil and criminal relief is *sine qua non*. It was regular and constant practice in Anglo-Saxon and Norman times.¹²⁸ The civil codes prevailing in the countries of Continental Europe and Latin America allow a person injured by a crime to appear before a court as a party to a criminal proceeding as well as to ask for restitution and damages in the same proceeding.¹²⁹ Thus, a joinder of civil and criminal relief will save the time and expense of the parties, witnesses and public machinery of justice. The purpose behind such joinder is the judicial economy and convenience. Such a joinder will make the whole process of trial convenient to the parties, witnesses, and public authorities as well as it will conserve funds.

Further, the language of the texts of different laws is ambiguous and needs a liberal interpretation to ensure protection of unregistered well-known trademarks. The legislation should clearly specify it. The enforcement mechanisms provided under various laws are also overly complex and haphazard.

Having said so, a comprehensive enforcement model is required to protect unregistered well-known trademarks. A coordination among the National Consumers' Right Protection Council, the BSTI, and the DPDT etc are also essential. So, a monitoring cell consisting of members from the DPDT, BSTI, Customs excise and VAT Commissionerate, and law enforcing agencies shall have to be established to ensure a continuous and frequent monitoring of the matter relating to infringement of trademarks. They should act jointly to prevent such infringement. They should have been given power to raid, search, and investigate the matters.

The enterprise using unregistered trademarks may also take initiatives to create public awareness. They can also declare rewards for helping them in detecting any infringements.

Further, one specialized trial court and one appellate court should be constituted to look after the matters. Bangladesh may follow India's example here. Through the Commercial Courts Act 2015, India establishes a separate Commercial Court, Commercial Appellate Court, Commercial Appellate Division at the High Court, and Commercial Appellate Division.¹³⁰ These courts are given the jurisdiction to try

¹²⁸ Felix Forte, 'Joinder of Civil and Criminal Relief in Indiana' (1932) 7 *Notre Dame Law Review* 500.

¹²⁹ *ibid*.

¹³⁰ Commercial Court Act 2015 (India), ss 3, 3A, 4 and 5.

commercial disputes which essentially incorporate intellectual property issues. However, there is no law in Bangladesh to define ‘commercial disputes’ or no specialized court exists to deal with such matters although there is a commercial bench in the High Court Division. Establishing such specialized commercial courts may help in developing the jurisprudence for protecting unregistered well-known trademarks. Further, such a court may be given a comprehensive power to try both criminal and civil matters relating to the infringement of unregistered trademarks. The cause of actions like making fake, unauthorized, adulterated, substandard products, and selling them to the market which arise out of the same transaction along with infringement of an unregistered well-known trademark should be joined in the same case before the same court.

Finally, the Trademarks Act 2009 which provides for the protection of an unregistered trademark in line with the registered trademark, can contain incidences which constitute a violation of an unregistered trademark. For a registered trademark, the incidences mentioned in section 26 of this Act, can cause the infringement committed by any person not being registered owner or registered user of a trademark when he uses a trademark in course of trade, which is identical or deceptively similar with the mark of the former whether it is used in relation to goods or services or whether it is used in relation to goods or services which are not similar to those for which the trademark is registered.¹³¹ For example, DASH & DASH is a well-known registered trademark used in relation to food and beverage. If someone carries on the same food or beverage business under the same trademark, or if someone used a similar trademark in relation to another business, i.e. electronics business, both incidences shall tantamount to infringement of the trademark ‘DASH & DASH’ under section 26. But in case of an unregistered trademark, if any person uses an existing unregistered trademark without authorization of its owner in relation to goods or services other than those of the original owner shall not be an infringement of the former until it creates a confusion to the consumers – a test developed in the common law remedy of passing off, not revealed in our law.¹³² For example, if the term ‘Western Bank’ becomes well-known as an unregistered trademark and if someone uses later on the term ‘Western University’, the later does not lead to a breach of the former trademark until there is any consumer confusion.

8. Conclusion

The Bangladeshi trademarks regime follows a double protection mechanism in preventing infringement of an unregistered well-known trademark. The regime protects both the owner of an unregistered trademark as well as the consumers injured

¹³¹ Trademark Act 2009, ss 26(2) and (3).

¹³² *American Steel Foundries v Robertson, Commissioner* [1926] 269 US 372, 379.

by such infringement. It has adopted the common law principle of ‘passing off’ in its Trademarks Act 2009. A person, natural or legal - accused of passing off goods or services under a trademark, which is used by another person shall be liable to pay damages, or an account of profits. The court may also grant injunction in this regard. The Penal Code 1860 criminalizes using false trademarks and using others’ trademarks is tantamount to cheating. The similar approach of criminalizing action is done under other laws including the Consumer’s Right Protection Act 2009. The higher judiciary has expressed its firm commitment in protecting unregistered well-known trademarks herein Bangladesh. Thus, the recent Bangladeshi trademarks regime has provided significant protection towards unregistered well-known trademarks. However, there are several lacunae in dealing with the protection regime. For example, the business enterprises are not aware enough to protect their brand names, the legislation dealing with the protection of the unregistered well-known trademarks is not crystal clear, the Supreme Court only deals with passing off protection of unregistered well-known trademarks though they can interpret other laws relating to such protection, and finally the enforcement stakeholders do not take comprehensive initiative to prevent the infringement. Besides a strong statutory protection regime, a comprehensive enforcement mechanism is essential to protect unregistered well-known trademarks.