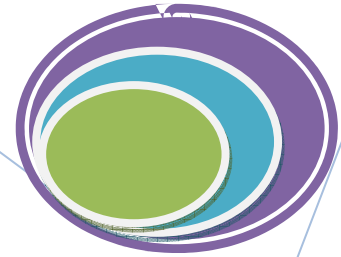
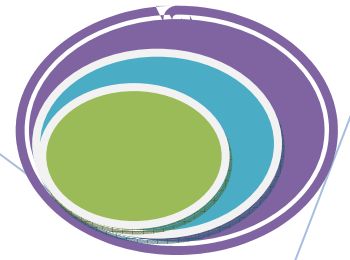


INTELLECTUAL PROPERTY AND LEGAL REQUIREMENTS IN BANGLADESH



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TRADE MARKS

Legal Basis: The Registration of Trade Marks and their protection is governed by the:-

- Trade Marks Act, 2009
- Trade Marks Rules, 1963.

Applicant: Anyone claiming to be the proprietor of a trademark may apply to the Registrar for the registration of the mark. Both National and foreigners have equal right in this regard but a foreign applicant must be represented by a local agent.

Classification of Goods: The International Nice Classification of Goods/services applies.

Requirements:

- a. Name of the Mark /Logo/Device prints or representation.
- b. Name of the Applicant.
- c. Address and Nationality of the Applicant.
- d. Status of the applicant i.e. Merchandisers / Manufacturers /Service Providers
- e. Specification of Goods/Services and Class.
- f. User date of the mark (whether the mark is in use or proposed to be used in Bangladesh).
- g. General/ Specific Power of Attorney (notarized). **Power of Attorney (POA) may be filed subsequently.**

Examination: The mark is thoroughly examined as regards – (i) distinctiveness; (ii) similarity or being identical or nearly resemble with existing trademarks on the Register of Trademarks; (iii) hurt religious susceptibilities of any class of Bangladesh and (iii) compliance with the requirements of the Trade Marks Act.

PROCEDURE FOR REGISTRATION OF A TRADEMARK IN BANGLADESH

1. Conduct Availability Search (optional).
2. **Filing the Application:** An application is made in the prescribed manner to the Registrar of Trade Marks.
3. **Acknowledgement of Application:** The Registrar, on receipt of the application, issues Official Filing Receipt. The document contains all relevant filing details on the trademark e.g. Application Number, date of application, the trademark etc.).
4. **Examination of the Application:** The Registrar examines the trademark for distinctiveness, identical or similarity with existing registered trademarks and general compliance with the requirements of the Law. If the Registrar is satisfied, he issues a Letter of Acceptance for the mark to be advertised in the Trade Marks Journal for opposition purposes. Otherwise, the Registry raised objection seeking written reply regarding objections.
 - 4.1. **Refusal of Application:** Where an application is refused, the Applicant through its local agent must submit reply to the show cause notice and may seek a hearing in the matter within **three (3) months** otherwise, the application will be deemed abandoned.
 - 4.2. **Acceptance of Application:** If the Examiner is satisfied as to (4.1) above, the Registrar accepts the mark for advertisement in the Trade Marks Journal.
5. **Opposition Proceedings:** When a trademark is advertised, any person may within *two (2) months* from the date of the publication give notice of Opposition to the Registrar on Form TM-5.

The Registrar shall send a copy of the Notice of Opposition to the Applicant and the Applicant shall within *Two month* of receipt of the Notice of Opposition, file a Counter-Statement of the grounds for which it relies for its application to be registered. Failure to file the Counter-Statement within the prescribed period will result in the application being deemed abandoned. The applicant may seek extension of time for filing Counter-Statement along with Govt. fees.

Where a Counter-Statement is filed, the Registrar shall furnish a copy thereof to the Opponent. The parties are required to file evidence by way of Affidavit and the Registrar shall, after hearing the parties, decide on whether the application should be registered or not. The Registrar's decision shall be subject to appeal to the High Court.

5. **Registration**

Where no opposition is received at the expiration of the opposition period or the opposition is determined and resolved in favour of the Applicant, the Registrar is obliged to issue a Certificate of Registration for the trademark on payment of the prescribed fee. The registration date of the trademark will be the date of filing.

Term of Registration

A registered trademark is valid for an initial period of seven (7) years from the date of filing and renewable thereafter for successive periods of Ten (10) years.

Renewal

Application for renewal of a trademark may be made to the Registrar in the prescribed manner, *not more than six (6) months* before the expiration of the last renewal. Renewal is for Ten (10) years. A Certificate of Renewal is issued by the Registrar as evidence of payment of the renewal fee due at that period.

Clients are advised that the renewal fee due on a mark cannot be paid until the mark is registered. Clients are therefore advised that they need not worry about the renewal fee until the mark has been registered.

POST REGISTRATION MATTER

Assignment of Trademarks

The Registered proprietor of a Trade mark has power to assign the mark and a registered Trade Mark is assignable and transmissible with or without goodwill of the business in respect of all or some of the goods for which it is registered.

Where a person becomes entitled by assignment or transmission to a registered trademark, he shall make application to the Registrar (in the prescribed manner) to register his title and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register the Assignee as the proprietor of the trademark.

To file application for recordal of assignment in Bangladesh, the following documents are required –

(i) Deed of Assignment - The Deed must be executed by the Assignor and the Assignee. A nominal consideration of US\$ 10.00 is sufficient. The document must be Legalized in the country concerned.

(ii) Form TM-24 or Form TM-23(Joint Request) -An application to register the title of a person who becomes entitled by assignment or transmission to a registered trade mark shall be made on Form TM-24 or TM -23 according it is made by such person alone or jointly with the registered proprietor.

(iii) Authorisation of Agent - The authorization is to be executed by both the Assignor and the Assignee. It may be notarized.

Licensing of Trademarks (Registered User)

There is provision under the Trademark Law for the registration of a person other than the registered proprietor of a trademark as a Registered User.

In order to file application for Registered User in Bangladesh, the following documents are required –

- (i) Registered User/License Agreement
- (ii) TM Form -28
- (iii) Statement of Case by an Affidavit.
- (iv) Authorisation of Agent

Change of Name/Address of the proprietor

If there is a change in the name and/or address of the proprietor, such change must be recorded against the trade mark. The proprietor may make application in the prescribed manner to alter its name and/or address on the Register of Trade marks.

The Registrar, if satisfied with the application, will issue a Proof of recordal of Change of Name/Address evidencing the recordal of such change in the Register.

To apply for the change of name of the proprietor of a trademark in Bangladesh, a Certified True Copy of the Certificate of Change of Name/Address or any equivalent document (e.g. Extract of Company Register) issued by the appropriate authority in the proprietor's country of origin attesting to the change of name/address. Where such document is not in the English language, a certified English translation will be required.

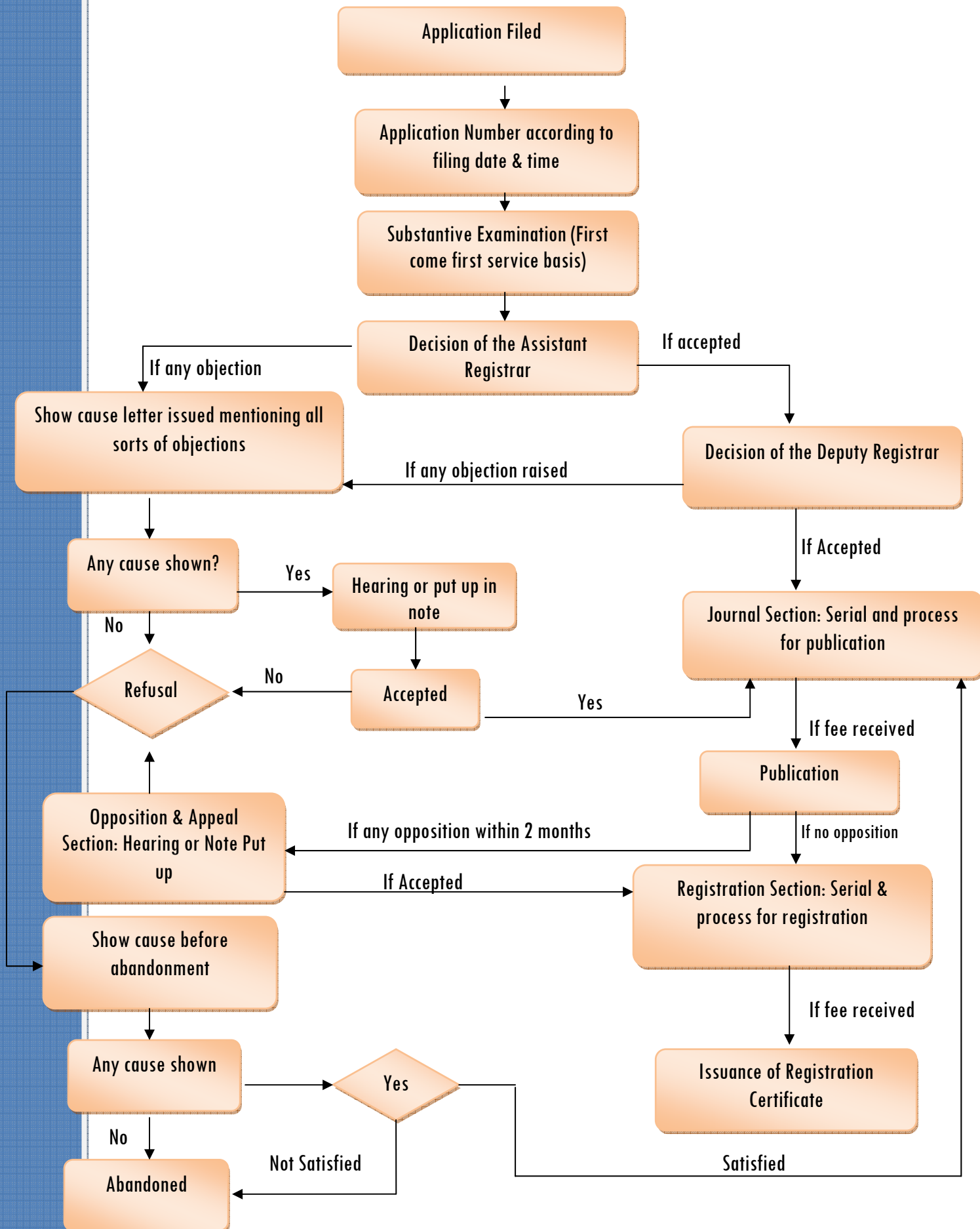
Foreign Priority/Convention Applications

The Law makes provision for an Applicant to claim priority of a foreign trademark within 6 months from the date of application to the member country of Paris Convention or WTO in Bangladesh.

Service Marks

Service Marks are now registerable in Bangladesh. Applicants can now apply for registration of service marks in Bangladesh in International Classes 35 to 45. The International Nice Classification of Services is applicable for the purpose.

FLOWCHART FOR REGISTRATION OF TRADE MARKS



PATENTS

Legal Basis: Patent & Designs Act, 1911

Applicant: Any person claiming to be the true and first inventor may file an application in the prescribed form, in the Department of Patents, Designs and Trade Marks for a Patent to protect his invention in Bangladesh.

Examination: The submitted applications are considered for substantive examination according to the provisions of the Act.

Term: Life of Patents in Bangladesh is 16 years from the date of filing or from the convention date subject to payment of renewal fees annually after the fourth year.

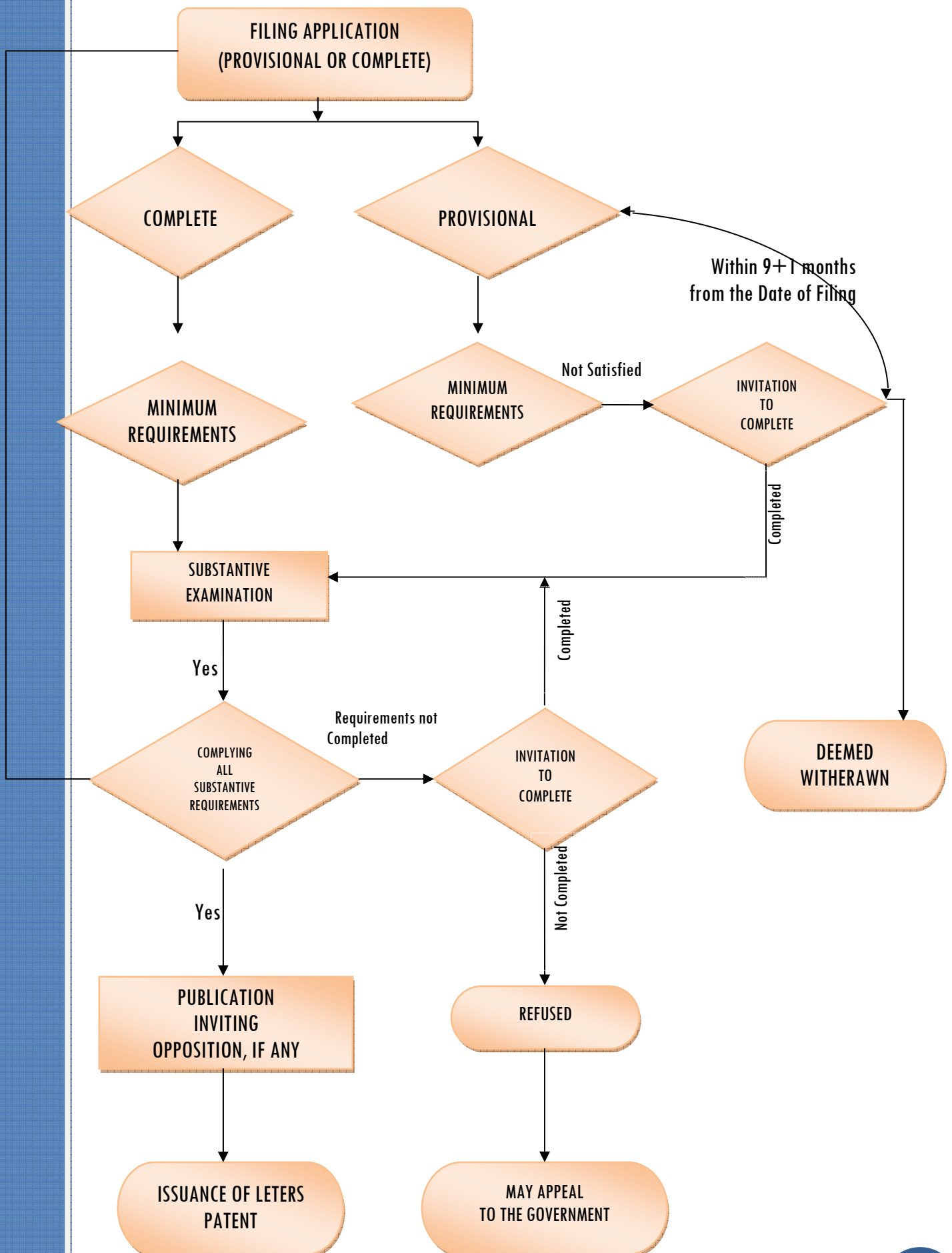
Convention: Bangladesh is a member of the Paris Convention and priority can be claimed within one year from first of the applications filed in any Member country.

Priority cannot be claimed from PCT application even if it designates one of these countries.

Documents Required: The following documents are required to file a patent application –

- ❖ Name, address and nationality of the applicant(s) and the inventor(s).
- ❖ 2 copies of specification in English with abstract and drawings. We can also prepare necessary copies if you send only one copy.
- ❖ Formal drawings on tracing cloth or paper can be filed any time before acceptance
- ❖ Power of Authority - can be filed subsequently.
- ❖ Assignment - can be filed within three months or later with an application seeking extension of time.
- ❖ Priority document has to be filed along with the application or within three months of filing the application. A verified/notarized English translation of the priority document is also required, if the document is in any language other than English.

FLOWCHART FOR PATENT GRANTING SYSTEM



Legal Basis: Patent & Designs Act, 1911
Patent & Designs Rules, 1933

Applicant: Any person claiming to be the proprietor of a new and original design may apply for the registration in the prescribed form.

Requirements for Filing:

- ❖ Four (4) copies of the representation of clearly showing the features of the design by different views and name of the views. The representation may contain drawings, photographs, tracing or specimens of the design the design;
- ❖ Power of Attorney (Authorisation).
- ❖ Statement of Novelty.

Convention Application: Application based on a foreign design application is possible within six (6) months from the date the foreign application. A certified copy of the application of the member of the Paris Union country must be filed along with the application.

Duration of Registration: The Registration of an industrial design is valid five (5) years from the date of the application and renewable for two (2) further consecutive periods of five (5) years on payment of the prescribed fee.

FLOWCHART FOR REGISTRATION OF INDUSTRIAL DESIGN

