

# TRADE MARKS RULES 2010

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## TRADE MARKS RULES 2010

In exercise of the powers conferred by Section 124(1) of the Trade Marks Act 2009 (Act No. XIX of 2009), the Government of the People's Republic of Bangladesh makes the following rules

### PRELIMINARY

#### 1. Citation and Commencement Section 1.

The rules may be cited as the Trade Marks Rules 2010 and shall come into force on such date as the Government may, by notification in the official *Gazette*, appoint in this behalf.

#### 2. Definitions Section 2.

(1) In this Rules, unless the context otherwise requires –

“Act” means the Trade Marks Act 2009.

“Branch Registry” means a branch of the Trade Marks Registry established under Section 3(2) of the Act.

“Degree” means graduation degree from any recognised University or Institution in Bangladesh or equivalent degree obtained any recognised foreign University or Institution.

“Form” means a form set forth in the Second and Third Schedule to these Rules.

“Institution” means any recognised University or Institution of higher learning in Bangladesh or equivalent recognised foreign University or Institution of higher learning.

“Journal” means the Trade Marks Journal.

“Office” means the Trade Mark Registry or any other Branch Registry established under Section 3(2) of the Act.

“One kind of goods or services” means a goods or services as identified and separated by semi-colon in each class in Item 1 of the Fourth Schedule herein.

“Registry” means the Trade Marks Registry.

“Registrar” means the Registrar of Trade Marks.

“Register” means the Register of Trade Marks.

“Send” includes give.

All other terms in the Rules shall have the meaning attributed to it in the Act.

#### 3. Fees. Section 117, 124(2)(e).

(1) The fees specified in the First Schedule shall be payable to the Registrar in respect of the matters specified in that Schedule.

- (2) Any fee in the First Schedule shall be paid at the same time as the filing of the matter in question.
- (3) (a) Fees may be paid by bank draft or pay order to the Registrar of Trade Marks deposited in a designated bank account in the name of the Registrar of Trade Marks or when so notified by the Registrar, through electronic transmission and notification of such payment deposited in the Registry or such bank draft or pay order deposited in the Registry.
  - (b) Bank drafts or pay orders not carrying the correct addition for commission, and / or on which the full value of the fees cannot be collected in cash within the time allowed, shall not be considered as payment.
  - (c) Electronic transaction shall be subject to prior verification and confirmation of payment in full in favour of the Registrar.
  - (d) Stamps or other modes of payment shall not be received in payment of fees.
  - (e) In the event the pay orders are not honoured by the bank for any reason whatsoever, the matter for which the fees was purported to be paid, shall be deemed as not done.

**4. (A) Filing of Documents. Section 15.**

- (1) The Registrar may refuse to accept or process any document filed at the Registry that fails to comply with the Act or these Rules.
- (2) Every document filed at the Registry shall
  - (a) be in Bengali or in English language.
  - (b) Documents not in Bengali or English language must be accompanied by a certified translation thereof in Bengali or English language by any person who declares that he is familiar with the language of the document and Bengali or English language as the case may be.
  - (c) The Registrar may refuse to accept any translation which in the Registrar's opinion is inaccurate and thereupon another translation of the document in question verified as aforesaid shall be provided.
- (3) Every document filed at the Registry shall:
  - (a) be filed using durable paper; and
  - (b) be in writing that is legible and permanent.
- (4) Where the Registrar refuses to accept any document that does not comply with paragraph (2) or (3), the Registrar shall give the applicant a notice in Form TMR 1 stating the manner in which the document does not comply with paragraph (2) or (3) as the case may be.
- (5) Where a document filed at the Registry is a copy, it must be authenticated by a Trade Mark Agent, or a Legal Practitioner, or a Notary Public in any country, or a gazetted First class officer in Bangladesh and, the Registrar may:
  - (a) decide whether to accept or process the document within five (5) days of receipt of the documents at the Registry; and

- (b) require the original to be filed with the Registry within a time stated in the request.
- (6) Affidavits filed in these proceedings must be sworn before a Notary Public if the affidavit is executed outside Bangladesh or sworn before a Notary Public or Commissioner for Oaths if sworn in Bangladesh. Legalisation of documents is not necessary, unless otherwise the Registrar directs.

**(B) Filing of documents by electronic means**

- (a) The Registrar may at his discretion, permit as an alternative to the sending by post or delivery of the application, notice or other document in legible form the filing of the application, notice or other document by electronic means subject to such terms or conditions as he may specify either generally by public notice in the Journal and in any other media, or in any particular case by written notice to the person desiring to file any such documents by such means.
- (b) The Registrar may at his discretion permit the payment of fees by electronic banking means.

**5. Forms.**

- (1) The forms referred to in these Rules are those contained in the Second Schedule, or as modified by the Registrar. All modified forms shall be posted on the Registry's website within ten (10) days of publication of the forms and published in the Journal. The modified forms shall come into force after one month of the date of Journal in which the modified forms are published.
- (2) The forms shall be used in all cases in which they are applicable, or directed to, otherwise letters addressed to the Registrar shall be filed.
- (3) Forms can be submitted in the Bengali language or in the English language.

**6. Classification of goods and services. Section 124 (2) (a)**

- (1) For the purpose of registration of trade marks under the Act and these Rules, goods and services shall be classified in the manner specified in the "Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Mark" as adopted by the World Intellectual Property Organisation (WIPO) in the manner prescribed in the Fourth Schedule and as currently in force and revisions, amendments thereto from time to time.
- (2) Textile piece goods are classified as prescribed in the Fifth Schedule.

**7. Size, etc., of documents Section 124 (2) (u).**

Subject to any other directions that may be given by the Registrar, all applications, notices, statements, counter-statements, papers having representation affixed, and other documents required by the Act or by these Rules to be left with or sent to the Registrar shall be in white colour paper, ISO A4 size and of at least 80 gms which shall have on the left hand part thereof a margin of not less than four centimetres.

**8. Signature on documents Section 124 (2) (u).**

- (1) Subject to sub rules 11(3) and Rule 12, documents and forms filed at the Registry and which require a signature shall be signed:
  - (a) in the case of an individual, by that person;
  - (b) in the case of a partnership, by all the partners, or by the principal partner stating that he is signing on behalf of all the partners;
  - (c) in the case of an association of persons other than a partnership, by the President, Chairman or the Secretary or by any other person who satisfies the Registrar that he is authorised to sign on behalf of the association;
  - (d) in the case of body corporate, by a director, the secretary or other principal officer of the body corporate, or by any other person who satisfies the Registrar that he is authorised to sign the document on behalf of the body corporate.

and the name in full and the capacity in which an individual signs a document on behalf of a partnership, association or body corporate shall be so stated below his signature.

- (2) A document filed on behalf of a partnership shall contain the names of all the partners in full and in default the Registrar may require the deficiency to be rectified and may decline to take any further step in the matter to which the document in question relates until the deficiency has been rectified to his satisfaction.
- (3) The name of the person signing a document shall be written in block letters below the signature and in the case other than 1(a) above, the capacity in which the person is signing should also be stated.
- (4) Th Registrar shall decline to recognise a person acting on behalf of an applicant if the person is not in the sole and regular employment of the applicant.

**9. Service of documents Section 111.**

- (1) Where the Act or these Rules authorises or require any document to be given or sent to, filed with or served to any party, the giving, sending, filing or service may be effected by sending the document by post and, if so sent, shall be deemed:
  - (a) to be effected by properly addressing, prepaying and posting the document; and
  - (b) unless the contrary is proved, to have been effected at the time at which the letter would be delivered in the ordinary course of post.
- (2) For the purpose of paragraph (1), a letter is taken to have been properly addressed if it is addressed to the party concerned at his address for service referred to in Rule 10 or 11.
- (3) The Registrar may at his discretion give directions for the filing of documents and communication, with persons dealing with the Registry by electronic form.

**10. Address. Section 111**

Where any person is, by the Act or these Rules, bound to furnish the Registrar with an address, the address given shall be in full as possible for the purpose of enabling the place of trade or business of such person to be found easily.

**11. Address for service. Section 111**

- (1) An applicant, opponent, registered proprietor or registered user of a trade mark or any other party, to any proceedings before the Registrar or otherwise who does not reside or carry on business in Bangladesh shall file Form TM 1 giving an address for service in Bangladesh and such address may be treated as the actual address of that person for all purposes connected with the matter in question.
- (2) Any other applicant, opponent, registered proprietor or registered user of a trade mark or any other party may, if he so desires, file Form TM 1 giving an address for service in Bangladesh.
- (3) Subject to Rule 8, Form 1 filed under these Rules may be signed by an authorised Trade Mark Agent or Legal Practitioner and in any case in which the Registrar so requires shall be signed by the applicant, opponent, registered proprietor or registered user, or any party to any proceedings before the Registrar as the case may be.
- (4) In any case in which no address for service is filed at the Registry, the Registrar may treat the business address in Bangladesh, if any, of the person concerned as his address for service for all purposes connected with the matter in question until otherwise notified by filing Form 1.
- (5) Any written communication addressed to a person at a physical address, given by him or treated by the Registrar as his address for service shall be deemed to be properly addressed. The Registrar may in addition to postal service, correspond by electronic means with the email address of the persons stated in Rule 11(1).
- (6) The Registrar may, at any time when a doubt arises as to the continued availability of an address for service entered in the Register, request the person for whom it is entered, by letter addressed to his business address in the Register, to confirm the address for service or to provide another by filing Form TM 1, and if within two (2) months of making such a request the Registrar receives no confirmation or substitution of that address, he may strike the address off the Register.
- (7) Unless an address for service as required in Rule 11(1) is given, the Registrar shall be under no obligation to send any notice or correspondence that may be required by the Act or these rules, and no subsequent order or decision in the proceedings shall be called in question on the grounds of such non-service of notice or correspondence.

**REGISTRABILITY OF TRADE MARKS**

**12. Marks subject to Statutory Restriction. Section, 8, 67( 1 )**

- (1) The Registrar shall refuse to register any application for the registration of a mark upon which any of the following appears:

- (a) the words “Registered Trade Mark”, “Registered Service Mark”, or any words to the like effect in any language;
  - (b) the representation of any of the buildings owned by the Government of Bangladesh, or City Corporation or Municipalities in Bangladesh or any colourable imitation thereof;
  - (c) any word, letter or device, if used in such a manner as to be likely to lead persons to think that the applicant either has or recently has had Presidential or the Bangladesh Government’s patronage or authorisation, whether or not such be the case;
  - (d) any national or international symbol that are protected by domestic or international laws or administrative orders.
- (2) The Registrar shall refuse to register any application for the registration of a mark or part of a mark.
- (a) which comprises or consists of any scandalous or obscene matter in any language, pictures, photographs, diagrams;
  - (b) the use of which would be contrary to any law in force in Bangladesh and/or which is contrary to public policy or to morality in Bangladesh;
  - (c) the use of which would be likely to deceive or cause confusion to an ordinary person in Bangladesh;
  - (d) which comprises or contains any matter likely to hurt the religious susceptibilities of any class of the citizens of Bangladesh;
  - (e) which would otherwise be disentitled to protection in a court;
  - (f) which is identical with, or is an imitation of, or contains as a element, an armorial bearing, flag, or other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted in Bangladesh or by, any state, country, intergovernmental organisation or organisation created by an international convention, charter or other instrument, unless authorized by the competent authority of Bangladesh or of that state, country or organisation;
  - (g) the application is made in bad faith; or
  - (h) consisting of a line heading alone in respect of use in textile goods being piece goods.

**13. Persons living or dead. Section 11**

- (1) Where the name or representation of any person appears on a trade mark which is the subject of an application for registration, the Registrar may, before proceeding to register the mark, require the applicant by issuing to the applicant Form TMR 1 to furnish the Registrar with the consent of the person, or, in the case of a person whose death took place within twenty (20) years prior to the date of the application for registration of the trademark, to furnish the consent of his legal representative.
- (2) Where the consent referred in paragraph (1) is not furnished within two (2) months from the date of issuance of Form TMR 1 and the applicant fails to satisfy the Registrar that it is impossible or impracticable in the circumstance of the case to obtain the consent, the Registrar may refuse to register the mark.

**14. Where registration of mark is not allowed. Section 10**

- (1) The Registrar shall not register a mark or part of a mark where:
- (a) the mark or part of the mark is in respect of any goods or description of goods or in respect of any services or description of services which is identical with or deceptively similar to a trademark or part of a mark which is already registered in the name of a different proprietor in respect of the same goods or description of goods or in respect of the same services or description of services, as the case may be;
  - (b) the mark is in respect of any goods or services if it is identical with or confusingly similar to another mark, or constitutes a translation of a mark or trade description, which is well-known in Bangladesh under Rule 15, for identical or similar goods or services of another proprietor;
  - (c) the mark is in respect of goods or services if it is well known under Rule 15 and registered in Bangladesh for goods or services which are not identical or similar to those in respect of which registration is applied for, if -
    - (i) the trade mark is used or proposed to be used in such a way that may create a false perception to an ordinary man in Bangladesh that there is a connection between these goods or services and the owner of the registered trade mark; and
    - (ii) the interests of the registered trade mark are likely to be damaged by such user.
  - (d) the mark is devoid of any distinctive character;
  - (e) the mark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods, or of rendering of services, or other characteristics of goods or services;
  - (f) the mark consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices in the trade;
  - (g) the mark or part of the mark is likely to mislead the public if it is a mark for a good which contains or consists of a geographical indication identifying goods, not originating in the place indicated by geographical indication in question;
  - (h) the mark or part of the mark is likely to mislead the public if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by geographical indication in question,

provided that a trade mark shall not be refused registration by virtue of sub rules (d), (e), and (f) if before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it. The applicant may be required to provide evidence, by way of an affidavit, to the satisfaction of the Registrar to establish distinctiveness. Notwithstanding the above, a line heading shall not be deemed to be adapted to distinguish textile goods being piece goods.

- (2) Where the applicant claims honest concurrent use or other special circumstances to the right of a trade mark which is identical or nearly resembles another mark in respect of same goods or services or, same description of goods or services, the Registrar may permit the registration subject to such limitations and conditions, if any, the Registrar may think fit to impose. In this respect the Registrar shall call for written confirmation from the applicant that the other user of the mark has consented to the application, or such evidence by way of affidavit, as he deems fit, to establish the fact of honest concurrent use. This condition shall be published in the advertisement of the application under Rules 37 and 38. Rules 44 to 54 shall apply in the event there is opposition to the application.

**15. Criteria of well-known mark. Section 10**

In determining whether a mark is well-known or not in Bangladesh, the following criteria may be taken into account;

- a) the degree of knowledge or recognition of the mark in the relevant sector of the public;
- b) duration, extent and geographical area of any use of the mark;
- c) the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the mark applies;
- d) the duration and geographical area of any registrations, or any applications for registration, of the mark to the extent that they reflect use or recognition of the mark;
- e) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognised as well-known by competent authorities; or
- f) the value associated with the mark.

**16. Request for search. Section 124 (2) (u)**

- (1) Any person may request the Registrar on Form TM 4 to cause a search to be made in respect of specified goods or services classified in any one class of the Fourth Schedule to ascertain whether any trade mark is on record or applied for in the class applied and in a related service or goods respectively at the date of the search which is identical or resembles a trade mark of which a representation shall accompany the Form.
- (2) The Registrar shall cause such a search to be made and the person making the request shall be informed of the results of the search within two (2) weeks of the date of receipt of Form TM 4.

**APPLICATION FOR REGISTRATION**

**17. Form of application. Section 15**

An application for the registration of a trade mark, certification trade mark, collective mark or defensive mark for goods and services shall be made on Form TM 5 accompanied by the prescribed fee, and three (3) copies of the application.

**18. Application confined to one class. Section 15**

- (1) Each application shall be in respect of goods or services in only one class in the Fourth Schedule.
- (2) Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications.

**19. Unreasonable number of goods or services. Section 15**

In the case of an application for registration in respect of all the goods or services included in one class, or of a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or which he intends to make if and when it is registered.

**20. Claiming priority. Section 120**

An applicant in his application may claim priority under the Paris Convention, for the Protection of the Industrial Property and certified copy of the documents evidencing priority filing shall be filed together with the application.

**21. Application Fees. Section 15**

The application fees for a trade mark shall be determined by the number of kinds of goods or services in the same class as provided in the First Schedule. In the event of uncertainty on the number of kinds of goods or services, the Registrar shall decide on the number and shall inform the applicant in writing. The applicant if he is not satisfied with the decision of the Registrar can seek a hearing before the Registrar by filing Form TM 21. Any applicant not satisfied with the decision can appeal to the Court.

**22. Representation of trade mark. Section 15**

- (1) A clear representation of the trade mark shall be affixed to the form of application in the space provided for that purpose but if the representation of the mark exceeds that space in size it shall be mounted upon durable material and be annexed to the form of application.
- (2) The Registrar may, if he considers that a representation of a trade mark is mounted on a material which will not in the course of time preserve the features of the trade mark, require the applicant to furnish a further representation of the trade mark mounted on a material specified by the Registrar by giving him notice under Form TMR 1.
- (3) The representation of a mark shall be clear and durable and if he is dissatisfied with any representation the Registrar may at any time require by issuing a second Form TMR 1 another representation satisfactory to him to be substituted before proceeding with the application.
- (4) Where a representation cannot be filed in accordance with sub rule (1), within two (2) weeks of the date of Form TMR 1 a specimen or copy of the mark, either of full size or on a reduced scale, may, subject to the consent of the Registrar, be filed in any convenient form.

**23. Series of trade marks. Section 12**

When application is made for the registration of a series of trade marks under Section 12 of the Act, a representation of each mark of the series shall be affixed to the application form in accordance with Rule 22.

**24. Transliteration and translation.**

- (1) Where a trade mark contains a character, word or words in characters other than English or Bengali there shall, unless the Registrar otherwise directs, be endorsed on Form TM 5, a certified transliteration and translation of each of such words, or a certified transliteration of each character as the case may be and every such endorsement shall state the language to which the words belong, and the transliteration and translation can be in Bengali or English language.
- (2) Where a certified transliteration and translation accompanies the application, a sufficient reference to it must be endorsed in Form TM 5.
- (3) The certificate of transliteration and translation can be endorsed by any competent authority, or the applicant or his agent who declares that he is well versed in that language and Bengali or English language as the case may be.

**PROCEDURE ON RECEIPT OF AN APPLICATION FOR REGISTRATION OF TRADE MARK**

**25. Acknowledgement of receipt of application.**

- (1) Every application for registration of a trade mark in respect of any goods or services other than a certification mark, shall on receipt subject to sub-rule (2) below, be acknowledged by the Registrar or his delegated officer on the same day assigning a serial number on a first come first served basis.
- (2) No date of receipt or serial number shall be assigned unless at least the following information/document is provided in the application form:
  - (i) name and address of the applicant;
  - (ii) the specification of goods or services listed as different kinds of goods;
  - (iii) the class of goods or services;
  - (iv) a clear representation of the trade mark;
  - (v) a certified copy of the priority application if priority is claimed; and
  - (vi) signature of the applicant, Trade Mark Agent or Legal Practitioner on the application form,and the appropriate fees are paid.
- (3) In the event the application is filed by a Trade Mark Agent or a Legal Practitioner, Form TM 1 must be filed together with the application Form TM 5.
- (4) In the event of deficiency of provision of information stated in sub rule (2), and/or the correct fees not paid, the applicant shall be advised in Form TMR 1 within one (1) week, and a date of receipt and serial number if not provided earlier shall be provided within one (1) week upon the applicant providing the information requested and/or paying the correct fees.
- (5) If the applicant fails to rectify the deficiency within the time limit, the application shall be refused.

**26 Examination. Sections 6, 8, 9, 10,11 and 67(1)**

- (1) Upon receipt of an application for the registration of a trade mark, the Registrar shall examine the application on the face of it to determine that the trade mark applied for is not within the conditions stated in Sections 6, 8, 9, 10, 11 and 67(1) of the Act.
- (2) The Registrar shall, thereafter for the appropriate purpose specified in sub rules (3) or (4), cause a search to be made amongst registered marks and pending applications filed before date of application of the trade mark, or the priority date of the application, and the Registrar may cause the search to be renewed at any time before the acceptance of the application, but shall not be bound to do so.
- (3) In the case of an application for the registration of a trade mark in respect of any goods, the appropriate purpose mentioned in sub rule (2) is that of ascertaining whether, for the same goods, for the same kind of goods, for the same description of goods, or for services closely related to those goods, there are on record any marks identical with the mark applied for, or so nearly resembling it or confusingly similar as to render use of the mark applied for likely to deceive or cause confusion.
- (4) In the case of an application for the registration of a trade mark in respect of any services, the appropriate purpose mentioned in sub rule (2) is that of ascertaining whether, for the same services, for the same kind of services, for the same description of services, or for goods that are closely related to those services, there are on record any marks identical with the mark applied for, or so nearly resembling or confusingly similar it as to render use of the mark applied for likely to deceive or cause confusion.
- (5) The Registrar shall complete the search and examination within two (2) months from date of receipt of application.

**27. Registrar's acceptance. Section 15(5)**

After an examination conducted as provided for in Rule 26, and after consideration of the application and of any evidence of use or distinctiveness or any other matter which the applicant may, or may be required to furnish, the Registrar may accept the application absolutely, or he may object to it, or he may express his willingness to accept it subject to such conditions, amendments, modifications, or limitations as he may think right to impose and shall communicate such objections or acceptance in writing to the applicant within ten (10) working days from the completion of the search under Rule 26

**28. Withdrawal of acceptance. Section 16**

Despite the acceptance of an application for registration of a trade mark, the Registrar, upon being satisfied that the conditions under Section 16 are met, shall notify the applicant in writing of his intention to withdraw the application or to impose any conditions or limitations, giving his reasons for doing so. The procedure laid out in Rule 29 shall be followed.

**29. Registrar's objection. Sections 6, 8, 9, 10, 11, 15(5) and 67(1)**

- (1) If the Registrar objects to the application and/or imposes any conditions, amendment, modification or limitation either before acceptance or after acceptance pursuant to Section 16 of the Act, he shall inform the applicant of his objections in writing in Form TMR 1 within ten (10) days of the completion

of the search and examination. Unless within two (2) months from the date of communication of the objections, the applicant makes a considered reply in writing, or applies for a hearing by filing Form TM 21, he shall be deemed to have abandoned his application.

- (2) An extension of time of up to four(4) months in aggregate can be sought by filing Form TM 19.
- (3) Any considered reply in writing filed in accordance with sub rule (1) may contain proposals, conditions, amendments, modifications or limitations or arguments designed to overcome the Registrar's objections.
- (4) Where after taking into account any considered reply in writing provided in accordance with sub rules (1) and (2), or after hearing, as the case may be, the Registrar maintains his objections to the application, he shall so inform the applicant within ten (10) days of receipt of reply from the applicant or the date of hearing, or if the applicant does not apply for a hearing by filing Form TM 21 within two (2) months from the date of the Registrar's decision he shall be deemed to have abandoned the application. An extension of time of up to four (4) months in aggregate can sought by filing Form TM 19.

### **30. Hearing**

- (1) Where an application is made for a hearing, the Registrar shall fix a hearing date not more than three (3) months from the date of application for a hearing, and shall communicate it to the applicant.
- (2) The applicant by himself, or his Trade Mark Agent or Legal Practitioner shall attend the hearing which shall be presided over by the Registrar or any other designated officers of the Registry.

### **31. Decision of the Registrar. Section 91**

- (1) The decision of the Registrar after a hearing as provided in sub rule 30 or without a hearing if the applicant has duly communicated his observations in writing and has stated that he does not desire to be heard, shall be communicated to the applicant in writing within ten (10) days of receiving the communication from the applicant, and if the applicant objects to the decision of the Registrar he may within one (1) month of the Registrar's decision, require, on Form TM 6, the Registrar to state in writing the grounds of decision, and the materials used by him in arriving at his decision. The Registrar shall give his grounds of decision within one (1) month of receiving Form TM 6.
- (2) In a case where the Registrar makes any requirements to which the applicant does not object, the applicant shall comply with the requirements within ten (10) days of receiving the communication from the Registrar before the Registrar issues the statement setting out the grounds of his decision.
- (3) The date when a statement is sent to the applicant under this rule shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

## **CERTIFICATION TRADE MARKS**

### **32. Application for registration of Certification Trade Mark. Section 58**

- (1) These Rules shall apply to an application to register a certification trade mark as they apply to an application to register an ordinary trade mark, except that as provided for in Chapter VIII of the Act and for reference to acceptance of an application there shall be substituted references to authorisation to proceed with the application.
- (2) (a) Notwithstanding Section 2 (28), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.  
  
(b) However, the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).
- (3) The address of an applicant to register a certification trade mark shall be deemed to be a business address for all the purposes for which such an address is required by these Rules.

### **33. Case and Draft Rules. Section 58, 60, 61**

- (1) The application for the registration of a certification trade mark shall be sent to the Registrar together with the draft regulations governing use of the mark and a statement of case setting out the grounds on which the applicant relies in support of his application.
- (2) The Registrar may communicate to the applicant any observations he may have to make on the statement of case or the draft regulations and the applicant may modify either of those documents.
- (3) (a) Without limiting the right of the Government to consider any matter or to limit or impose conditions, the Registrar shall consider the application with regard to the following matters;
  - a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;
  - b) whether the draft regulations are satisfactory and comprehensive; and
  - c) whether in all the circumstances the registration applied for would be to the public advantage.  
(b) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark. The government may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.
- (4) On receipt of the modified draft regulations and the statement of case in duplicate the Registrar shall forward a copy of the application together with modified draft regulations and the statement of case to the Government.
- (5) The Government on receipt of the application through the Registrar may at any time, call for such evidence as it thinks proper before deciding on the application.

- (6) Upon acceptance by the Government of the application to register the certification mark, the Registrar shall notify the applicant to proceed to advertise the application in the Journal as provided under Rule 38. Such advertisement shall state that the regulations as accepted by the Government can be inspected at the Registry.
- (7) Within two (2) months from the date of any advertisement in the journal of an application for the registration of a certification trade mark, any person may give notice of opposition to the Registrar by filing Form TM 7, accompanied by the prescribed fees, and Rules 42 to 54 shall apply to the proceedings thereon.
- (8) Subject to sub rule 6, the Government instead of the Registrar shall be substituted in Rules 30 and 90 in respect of pre-hearing and hearing respectively.
- (9) The Registrar shall record the final regulations as approved by the Government and the regulations may be altered by the Registrar with the consent of the Government or on the request by the applicant by depositing Form TM 8 with the prescribed fees after obtaining approval of the Government.
- (10) Opposition to alteration of regulations of a registered certification trade mark;
  - (1) The Registrar shall cause the publication of the amendments to the regulations deposited in respect of a registered certification trade mark in the Journal under Section 61(4) of the Act and within two (2) months from the date of any advertisement in the Journal, any person may give notice to the Registrar of opposition to the proposed alteration by filing Form TM 7 accompanied by the prescribed fee.
  - (2) The subsequent proceedings shall be in accordance with Rules 42 to 50 and Rules 30 and 88 shall apply but the Government shall be substituted for the Registrar.
  - (3) The Registrar shall make available to the public the approved regulations deposited in respect of a registered certification trade mark.

**34. (1) Cancellation or Alteration of registration of Certification Trade Mark or Rules thereto.**

- (a) Any person aggrieved by the registration of the certification trademark or the Regulations governing its use shall apply to the Government to:
  - i) expunge or alter any entry in the Register relating to a certification trade mark; or
  - ii) alter the deposited regulations on the grounds that
    - a) the proprietor is no longer competent, in the case of any of the goods or services in respect of which the trade mark is registered, to certify the goods or the services respectively;
    - b) the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;
    - c) it is no longer to the public advantage that the trademark remains registered; or

- d) if the mark is to remain registered, then the regulations should be varied

by submitting Form TM 7 to the Registrar.

- (b) Form TM 7 shall be accompanied by a statement of the grounds on which the application is made.
- (c) The aggrieved persons shall serve Form TM 7 and a copy of the application and the statement of the grounds on the proprietor at the same time as he files the documents with the Registrar.

(2) **Counter-Statement**

- (a) Within two (2) months from the date of receipt of the copies of the application and statement from the aggrieved person, the proprietor may file with the Registrar a counter-statement in Form TM 11 setting out
  - i) the grounds on which he relies as supporting his registration; and
  - ii) the facts alleged in the application which he admits, if any.
- (b) The proprietor shall serve on the aggrieved person Form TM 11 a copy of the counter-statement at the same time as he files the counter-statement with the Registrar.
- (c) Within one (1) month, of the date of receiving the counter-statement the aggrieved person may file a response to the counter-statement.
- (d) A request for extension of time to file the counter-statement or the response shall be made to the Registrar by filing Form TM 19 within two (2) months from the date of receipt of the copies of the application or counter-statement.
- (e) The total extension of time for which the Registrar may allow to file the counter-statement or the response shall not exceed three (3) months from the date of receipt of the application or the counter-statement respectively.
- (f) The Registrar shall forward the application, grounds, counter-statement and response (if any) and all other documents relevant to the application to the Government for a decision.
- (g) The Government shall provide the proprietor and the aggrieved person with an opportunity to appear before it at a hearing fixed by it, and if the proprietor and aggrieved person wants to be heard, either of them shall notify the Government through the Registrar by filing Form TM 21.
- (h) If the proprietor or the aggrieved person does not file Form TM 21 or fails, neglects or refuses to attend the hearing, the Government can dispose of the matter as it deems fit.

(3) **Recommendation by the Registrar for cancellation or variation of the registration of a Certification Mark. Section 65**

- (a) An application by the Registrar to the Government under Section 65(1) of the Act for any one or more of the grounds of the said Section shall be forwarded to the Government. The Government at

its sole discretion shall send the copy of the recommendation as filed or as amended to the proprietor.

- (b) Within two (2) months from the date of receipt of the recommendation served by the Government on the proprietor, the proprietor may file with the Registrar a counter-statement in Form TM 11 setting out:
  - i) the grounds on which he relies as supporting his registration; and
  - ii) the facts alleged in the recommendation which he admits, if any.
- (c) A request for extension of time to file the counter-statement shall be made to the Registrar by filing Form TM 19 within two (2) months from the date of receipt of copies of the recommendation referred to in sub rule (a).
- (d) The total extension of time for which the Registrar may allow to file the counter-statement shall not exceed four (4) months from the date of receipt of the recommendation.
- (e) The Registrar shall forward the counter-statement and all other documents relevant to the application to the Government for a decision.
- (f) The Government shall provide the proprietor an opportunity to appear before it at a hearing fixed by it, and if the proprietor wants to be heard, he shall notify the Government through the Registrar by filing Form TM 21.
- (g) If the proprietor does not file Form TM 21 or fails, neglects or refuses to attend the hearing, the Government can dispose of the matter as it deems fit.
- (h) The Government shall provide an opportunity to the public to object to the registration of the certification mark or any of the regulations by advertising in the Trade Mark Journal the proposed changes. Rule 34 shall apply to person aggrieved by the Government's decision to register the Certification Mark and the approved rules.

(4) **Consent to assignment of registered certified mark**

The assignment or other transmission of a registered certification mark is not effective without the consent of the Government

## **DEFENSIVE TRADE MARKS**

**35. Application for registration of Defensive Trade Mark. Sections 2 and 43**

- 1. An application to register a defensive trade mark under Section 43 of the Act shall be filed under Form TM 5 and accompanied by a statement of grounds setting out full particulars of the facts verified by an affidavit on which the applicant relies in support of his application.
- 2. The applicant may send with the application or within such time as the Registrar may allow, such other evidence verified by an affidavit as he may desire, whether after request made by the Registrar or otherwise, and the Registrar shall consider the whole of the evidence before deciding on the application.

3. Subject to sub rule 1, these Rules shall, except to the extent that they are inappropriate or it is otherwise provided, apply to applications to register defensive trade marks as they apply to applications to register ordinary trade marks.

### **COLLECTIVE MARKS**

#### **36. Application for registration of Collective Mark. Section 2**

These Rules shall apply to collective marks subject to the following:

- (1)(a) An application to register a collective mark shall be filed under Form TM 5 and Form TM 8 and accompanied by the regulations governing the use of the mark. The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse. The Registrar may impose further requirements to the regulations.
- (b) The applicant may send with the application or within such time as the Registrar may allow, such other evidence verified by an affidavit as he may desire, whether after request made by the Registrar or otherwise, and the Registrar shall consider the whole of the evidence before deciding on the application.
- (2)(a) The Registrar shall not register a collective mark if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.
- (b) The Registrar may require that the mark include some indication that it is a collective mark. An application may be amended to comply with this requirement.
- (3)(a) A collective mark which consists of signs or indications, which may serve, in trade, to designate the geographical origin of the goods or services, may be registered.
- (b) Notwithstanding sub-rule (a), the proprietor of such a collective mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters.
- (4) The regulations governing the use of the collective mark shall not be contrary to public policy, or accepted principles of morality in Bangladesh.
- (5)(a) An amendment to the regulations governing the use of a registered collective mark is not effective unless and until the amended regulations are filed with the Registrar and accepted by him.
- (b) Before accepting any amended regulations the Registrar may in any case where in his opinion it is expedient to do so cause them to be published in the Journal.
- (c) If the amended regulations are published, notice of opposition may be given by any member of public and Rules 42 to 54 herein shall apply mutatis mutandis, except the Registrar may in his opinion waive the requirement to file evidence in support of or opposition to the amended regulations.

- (6) The regulation governing the use of a registered collective mark shall be open to public inspection as the same manner as the Register and documents therein open to public inspection.
- (7). Apart from the provisions of the Act and the rules for the grounds of revocation of a mark, the registration of a collective trade mark may be revoked on the ground that –
  - (a) the manner in which the collective mark has been used by the proprietor has caused it to become liable to mislead the public as stated in sub rule 2(a) above, or
  - (b) the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark, or
  - (c) amendment to the regulations have been made which have not been accepted and approved by the Registrar or are now contrary to public policy or to accepted principles of morality in Bangladesh.

### **ADVERTISEMENT OF APPLICATION**

#### **37. Manner of Advertisement. Section 17.**

Every application for the registration of a trade mark required or permitted to be advertised by Section 17 of the Act, shall be advertised in the Journal during such times and in such manner as the Registrar may direct and Rule 38 shall apply.

#### **38. Advertisement of Application. Section 17, Section 123 (1), (2).**

- (1) Before advertising any application in accordance with Rule (37), the Registrar shall notify the applicant and request payment of the prescribed fee in Form TMR 7 and if the applicant does not file Form TM 9 and pay the fee within one (1) month of date of the Registrar's decision, he shall be deemed to have abandoned his application.
- (2) In the case of an application where the written consent of the registered proprietor of another mark or of another applicant is required by the Registrar, the words "By Consent" shall appear in the advertisement.
- (3) Each advertisement of a trade mark application in the Journal before acceptance shall include the following information:
  - a) Name and address of the applicant;
  - b) Name and address of the Trade Mark Agent, or Legal Practitioner (if any);
  - c) Application number;
  - d) Representation of the trade mark;
  - e) Nature of mark whether ordinary, defensive, certification, collective or series;
  - f) Class of goods or services;
  - g) Description of goods or services;
  - h) Priority date, (if any); and
  - i) Restrictions or limitations (if any).
- (4) Copy of rules

In case of advertisements in the Journal in respect of certification, or collective mark, any person may apply to the Registrar to obtain a photocopy of said Rules by filing Form TM 31.

**39. Representation for advertisement. Section 17.**

The applicant shall, for the purpose of advertisement, in the Journal file Form TM 9 together with a representation of the mark in a form approved or directed by the Registrar or in a manner including in electronic format which he thinks fit and such a representation shall be of such dimensions (not exceeding 3 in x 3 in) as the Registrar may require or permit for the purpose.

**40. Advertisement of series of trade marks. Section 12(3), Section 17.**

When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in Section 12 (3) of the Act, the Registrar may, if he thinks fit, insert with the advertisement of the application a statement of the manner in which the marks differ from one another.

**41. Publication of the Journal. Section 124(2)(c)**

- (1) The Journal may also be published in electronic form on such electronic address and from such date as may be notified by the Registrar in the official Gazette and such electronic publication shall be deemed for the purpose of the Act or these rules as publication required under the Act or these rules. The Journal shall be published in hard copies and which publication date shall also be the official date of publication of the Journal in electronic form until such date the Registrar shall determine otherwise.
- (2) The Journal shall be published at least three times a year and in sufficient quantities to meet the public demand. The price of each copy of the Journal shall be determined by the Registrar.
- (3) Simultaneously the Registrar shall publish the Journal in electronic format which can be accessed by public for a fee as determined by the Registrar.
- (4) The date of publication of the Journal for the purpose of opposition proceedings shall be date of publication of the hard copies.

**OPPOSITION TO REGISTRATION**

**42. Notice of Opposition. Section 18.**

- (1) Any person may within two (2) months from the date of any advertisement in the Journal in print or electronic form as provided for in Rule 41 of an application for registration of a:
  - a) trade mark;
  - b) certification trade mark;
  - c) defensive trade mark; or
  - d) collective markgive notice in writing in duplicate to the Registrar on Form TM 7 in compliance with rule 43(1) accompanied by the prescribed fee of opposition to the registration and send a copy of the notice to the applicant or his agent on record as shown in the Journal as advance notice.
- (2) Such notice may also be given in electronic form to the electronic address of the Registrar after such address for such purpose has been notified by the Registrar in the Official Gazette, within the time prescribed in sub rule (1) followed by hard copies together with the prescribed fees within seven (7)

days failing which it will be deemed that no notice has been given under sub rule (1).

- (3) The Registrar within one (1) month from receipt of notice of opposition, shall serve a copy of the Form TM 7 on the applicant for registration according to Rule 9.

**43. Contents of notice. Section 18.**

- (1) A notice of opposition under Rules 42 (1) and (2) shall include a statement of the grounds upon which the opponent objects to the registration of the applicant's mark.
- (2) If the registration is opposed on the ground that the mark resembles another mark already on the Register or used in commerce, or the registration of which is the subject of a current application, the number and class of that other mark and, except in the case of an application not yet advertised, the number of the application, shall be set out in the notice.
- (3) Notice not given in compliance with Rules 42 and sub-rules (1) and (2) above, shall be treated as no notice. No extension of time for submission of notice of opposition shall be allowed unless reasons for non-compliance of Rule 43 (2) satisfactory to the Registrar are given.

**44. Counter-statement. Section 18.**

- (1) Within two (2) months of the receipt of a notice of opposition filed in accordance with Rule 43 as sent by the Registrar, the applicant may file a counter-statement on Form TM 11 setting out the grounds on which he relies as supporting his application and the facts, if any, alleged in the notice of opposition which he admits and at the same time send a copy of the counter-statement and Form TM 11 to the opponent as advance notice.
- (2) If the applicant fails to send his counter-statement within two (2) months to the Registrar, he shall be deemed to have abandoned his application.
- (3) The Registrar shall within one (1) month from receipt of the counter-statement and Form TM 11 send a copy of both to the applicant.

**45. Evidence in support of opposition. Section 18.**

- (1) Within one (1) month of the receipt of the counter-statement, the opponent shall file with the Registrar such evidence by way of affidavit accompanying Form TM 12 as he desires to adduce in support of his application and shall at the same time send a copy of that evidence to the applicant.
- (2) If no evidence is filed in accordance with sub rule (1), the opposition shall be deemed abandoned.

**46. Evidence in support of application. Section 18**

- (1) Within one (1) month of the receipt of the opponent's evidence, the applicant shall file with the Registrar such evidence by way of affidavit accompanying Form TM 12 as he desires to adduce in support of his application and shall at the same time send a copy of that evidence to the opponent.

- (2) If no evidence is filed in accordance with sub rule (1), the application shall be deemed abandoned.

**47. Evidence in reply. Section 18.**

- (1) Within one (1) month from the receipt by the opponent of the copies of the applicant's evidence filed in accordance with Rule 46, the opponent may file evidence in reply by way of affidavit accompanying Form TM 12 and shall, at the same time, send a copy of that evidence to the applicant.
- (2) Evidence in reply shall be confined to matters strictly in reply to the applicant's evidence.

**48. Further evidence. Section 18.**

No further evidence may be filed by either side, except that in any proceedings before him, the Registrar may at any time if he thinks fit give leave to either party to file such further evidence upon such terms as to costs or otherwise as he thinks fit.

**49. Exhibits.**

- (1) Where there are exhibits to any affidavit filed as evidence in an opposition, the party filing them shall, on the request and at the cost of the other party, send to him a copy or impression of each exhibit.
- (2) In all cases, the original exhibits filed with the Registrar shall be opened for inspection at the Registry by the other side.

**50. Opposition hearing.**

- (1) Upon completion of receipt of evidence the Registrar shall request the parties to state by notice to him in writing whether they want to be heard, if so the party shall file Form TM 13. If any party requests to be heard, the Registrar shall send to the parties Form TMR 10 stating details of the hearing.
- (2) Such notice under sub rule (1) shall provide a hearing date of at least five (5) days after date of notice, unless the parties consent to a shorter notice.
- (3) The parties shall file with the Registrar their written submissions and bundles of authorities at least 5 days before the date of hearing, and shall at the same time exchange with one another their respective written submission and bundles of authorities.
- (4) Any party who intends to appear at the hearing shall file with the Registrar Form TM 13 before the hearing.
- (5) Any party who does not file with the Registrar Form TM 13 before the hearing may be treated as not desiring to be heard, and the Registrar may proceed with the hearing in the absence of that party or may, without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit.
- (6) If, after filing with the Registrar Form TM 13, a party does not appear at the hearing, the Registrar may proceed with the hearing in the absence of that party, or may, without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit.

- (7) If neither party appears at the hearing, the proceedings may be struck out except that it may thereafter be restored on the direction of the Registrar.
- (8) Any decision made by the Registrar pursuant to a hearing in which any party does not appear may, on the application of that party, be set aside by the Registrar on such terms as he thinks fit.

**51. Registrar's decision in opposition proceedings. Section 18 (5).**

The Registrar shall, within seven (7) days from the date of the hearing, inform the parties of his decision and the grounds thereof in writing.

**52. Extension of time in opposition proceedings. Section 93.**

Where any extension of time is granted to any party, the Registrar may, if he thinks fit, without giving the party a hearing, grant a reasonable extension of time to the other party in which to take any subsequent step.

**53. Security for costs. Section 18 (7), Section 124 (I)**

- (1) Where a party giving notice of opposition under Rule 42 or an applicant filing a counter-statement under Rule 44 neither resides nor carries on business in Bangladesh or is an applicant who intends the application to proceed under the name of a company to be incorporated, the Registrar may require him to give security, in such form as the Registrar may deem sufficient, for the costs or expenses of the proceedings before him, for such amount as the Registrar may deem fit, and at any stage in the proceedings he may require further security to be given at any time before giving his decision in the case.
- (2) In default of such security as mentioned in sub rule (1) being duly given, the Registrar may treat the application or the opposition, as the case may be, as abandoned.

**54. Costs in uncontested cases. Section 91 (1), (4)**

In the event of an opposition being uncontested by the applicant, the Registrar in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was lodged.

## **REGISTRATION**

**55. Entry in the Register of particulars of registered trade marks. Section 4, 20, 119, 120**

- (1) As soon as may be after the expiration of two (2) months from the date of the advertisement in the Journal of any application for the registration of a trade mark, the Registrar shall, subject to any opposition and the determination thereof and subject to subsection 20(1) of the Act, register the trade mark after giving notice to the applicant of his intention to register the trade mark vide Form TMR 9.
- (2) The applicant shall within thirty (30) days of receipt of notice in Form TMR 9 confirm the contents of the notice and file Form TM 10 together with the necessary fees.

- (3) The Registrar shall then after taking into consideration any correction of errors as state in Form TM 10 issue a Certificate of Registration of Trade Mark, sealed with the seal of the Trade Marks Registry as per contents in Form TMR 3. The certificate shall be in durable paper.
- (4) The entry of a trade mark in the Register shall give the following particulars:
- (a) the date of the filing of the application for registration accorded by the Registrar;
  - (b) the actual date of registration, that is the date of the entry in the Register;
  - (c) the priority date, if any, accorded pursuant to a claim to a right to priority under Sections 119 and 120 of the Act;
  - (d) the name and address of the proprietor;
  - (e) the address for service (if any) as furnished pursuant to Rule 11 above;
  - (f) any disclaimer or limitation of rights notified to the Register and/or imposed by the Registrar pursuant to these Rules;
  - (g) the goods or services in respect of which the trade mark is registered;
  - (h) where the trade mark is a collective mark, defensive mark or certification mark, that fact;
  - (i) where the trade mark is registered with the consent of the proprietor of an earlier trade mark or other earlier right, that fact;
  - (j) the name, address and description of any registered user;
  - (k) notification of assignments and transmissions;
  - (l) where the mark is registered pursuant to conversion of a mark registered or applied for under the Trade Mark Rules of 1963.
    - (i) the date of application;
    - (ii) the classification and the goods registered under the Trade Mark Rules 1963
  - (m) any other particulars as the Registrar may determine from time to time.
- (5) The Registrar shall maintain an updated and current duplicate copy of the Register at each branch office of the Department of Patents, Design and Trade Marks.

**56. Associated marks.**

- (1) Where a mark is registered as associated with any other mark or marks, the Registrar shall note in the Register, in connection with the first mentioned mark, the registration numbers of the marks with which it is associated, and shall also note in the Register, in connection with each of the associated marks, the number of the first mentioned mark as being a mark associated therewith.

- (2) An application by a registered proprietor under Section 13(4) of the Act requesting the Registrar to dissolve the association between two or more registered marks shall be made by filing Form TM 15 accompanied by the prescribed fees and a statement of the grounds of the application.
- (3) Upon receipt of Form TM 15, the Registrar, upon confirming that conditions in Section 13 (4) are satisfied, shall within thirty (30) days of receipt of TM 15 notify the registered proprietor of his decision and shall amend the Register accordingly.

**57. Death of applicant before registration. Section 92.**

- (1) If an applicant for the registration of trade mark dies:
  - (a) after his application has been made and before the mark has been entered on the Register; and
  - (b) another person proves to the satisfaction of the Registrar that he enjoys the same rights in, or in respect of, the mark that the applicant enjoyed,

the application shall, subject to sub rule (2), proceed in that other person's name and Rule 55 shall apply as if that other person were the applicant.
- (2) Before a person may be substituted on an application for registration under sub rule (1), he shall file Form TM 14 accompanied by the prescribed fee and Rule 27 shall apply.

**58. Non-completion of application. Section 20 (4).**

After issuance of Form TMR 1, if the applicant, or his agent or legal practitioner fails or neglects to file Form TM 10 within 30 days of the date of Form TMR 1, the Registrar shall give a notice of non completion in Form TMR 2. If the applicant does not complete the registration within twenty (21) days from the issuance of TMR 2, the Registrar shall abandon the application. Reinstatement of the application may be made by providing reasonable grounds of non-completion, in writing, by the applicant. The Registrar may reinstate the application if he deems it fit and just.

**REGISTER OF TRADE MARKS**

**59. Entry in Register of particulars of registrable transactions. Sections 40, 44, 45.**

Upon application made to the Registrar by such a person mentioned in Sections 40, and 44 the Registrar shall register the following particulars of registrable transactions;

- a) in the case of an assignment or transmission of a registered trade mark or any right in it –
  - (i) the name and address of the assignee or transferee;
  - (ii) the date of the assignment or transmission; and
  - (iii) where the assignment or transmission is in respect of any right in the mark, a description of the right assigned or transmitted..
- b) in the case of the grant of licence under a registered trade mark pursuant to Section 45 –
  - (i) the name and address of the licensee;

- (ii) where the licence is an exclusive licence, that fact;
- (iii) where the licence is limited in any manner, that fact; and
- (iv) the durations of the licence, whether definite or indefinite, or otherwise ascertainable.

c) in the case of a court or other competent authority transferring a registered trade mark or any right in or under it –

- (i) name and address of the transferee;
- (ii) the date of the order, and details of the entity making the order; and
- (iii) where the transfer is in respect of a right in the mark, a description of the right transferred.

and in each case, there shall be entered the date on which the entry was made in the Register.

**60. Public inspection of Register. Section 4, Section 124 (2) (e)**

- (1) The Register shall be open for public inspection at the office during the hours of business of the office.
- (2) Where any portion of the Register is kept otherwise than in documentary form, or in several documents, the right of inspection is a right to inspect the material in the documents and in other forms.

**61. Extracts from Register. Section 124 (2) (b), (c)**

The Registrar shall supply a certified copy of extract or uncertified copy or extract as requested on Form TM 29 of any entry in the Register on payment of prescribed fees except that the Registrar shall not supply any such documents which are not open to public inspection and other than documents provided by the applicant, registered user, opponent to the applicant, registered user or opponent respectively.

**RENEWAL AND RESTORATION**

**62. Renewal of registration. Section 22.**

An application for the renewal of registration of a trade mark shall be made before the expiry of the registration in Form TM 16, or not later than six (6) months after the date of expiry of the registration in Form TM 17, regardless whether the applicant receives the notice of renewal from the Registrar as provided in Rule 63.

**63. Reminder of renewal. Section 22 (3)**

- (1) At least two (2) months before the date of expiry of the registration of a trade mark, the Registrar shall (except where renewal has already been affected under Rule 62 above) send a notice in Form TMR 4 to the applicant, of the date of expiry of the registration.
- (2) Any such notification may be sent in accordance with Rule 9.

**64. Removal of trade mark from Register.**

The Registrar may remove a trade mark from the Register if no application for the renewal of registration of the trade mark is filed in accordance with Rule 62 after six (6) months of the date of expiry of the registration of the trade mark.

**65. Restoration of registration.**

- (1) An application for restoration of a trade mark which has been removed from the Register under Rule 64 shall be filed with the Register on Form TM 18, after six (6) months from the date of expiry but before twelve(12) months from the date of expiry of the registration.
- (2) The application for restoration filed on Form TM 18 shall contain a statement of the reasons for the failure to renew the registration.
- (3) The Registrar may, in any case, require the applicant for restoration to furnish such additional evidence or information, by affidavit or otherwise, as he thinks fit, within such time as the Registrar may specify.
- (4) The Registrar may restore the trade mark to the Register and renew its registration if he is satisfied that it is just to do so, and upon such conditions or limitations as he thinks fit to impose.
- (5) The restoration of the registration shall be published in the Journal, with the date of restoration shown.

**66. Record of removal. Section 23, Section 4(1).**

Where a trade mark has been removed from the Register for non-payment of the renewal fee, including late renewal fee (if any) and restoration fee (if any), the Registrar shall enter in the Register a record of such removal and of the cause thereof and shall publish the fact of removal in the Journal.

**ASSIGNMENTS AND TRANSMISSIONS**

**67. Application for Registrar's Opinion on Validity of Assignment. Section 36(2),**

- (1) Any person wishing to obtain the Registrar's written approval of a proposed assignment or transmission in accordance with Section 36 or 37 of the Act shall file an application on Form TM 20 A with the prescribed fee, a statement of case in duplicate, setting out the circumstances, and a copy of any instrument or proposed instrument effecting the assignment or transmission in question.
- (2) The Registrar may call for any evidence or further information that he may consider necessary, and may require the statement of case to be amended to include all the relevant circumstances or to be verified by affidavit; and if the statement of case is amended, two fair copies in its final form shall be filed.
- (3) The Registrar shall consider whether in all circumstances use of the trade mark in question in exercise of rights conferred or to be conferred by the proposed assignment or transmission is in the public interest and shall issue a notification in writing of approval or disapproval thereof, as the case may be, and shall seal to the notification a copy of the statement of case in its final form or give the grounds of disapproval.
- (4) The Registrar shall give the applicant a Certificate vide Form TMR 5 whether the proposed assignment would or would not be valid within one (1) month from the date of receipt of Form TM 20 A.
- (5) Where a validity opinion is given, the applicant shall file Form TM 20B within three (3) months of receipt of opinion from the Registrar.

- (6) Should the proprietor of the trademark object to the opinion of the Registrar, the proprietor may request for a Hearing by filing Form TM 21, within one(1) month from the date of receipt of the Registrar's opinion.
- (7) The decision of the Registrar following the Hearing shall be communicated to the proprietor of the trademark in writing, and if the proprietor objects to such a decision, he may within one (1) month from the date of receipt of the decision, apply for the grounds of decision from the Registrar by filing TM 6 accompanied by the prescribed fee.

**68. Application for entry of assignment or transmission. Section 40.**

- (1) Where a person becomes entitled by assignment or transmission to a registered trade mark he (or jointly with the registered proprietor) shall make application to register his title by filing Form TM 20B accompanied by the prescribed fee.
- (2) An applicant who has filed a trade mark application for and on behalf of a company to be incorporated in Bangladesh shall file the application vide Form TM 20B to record the assignment in favour of a company within one (1) month upon the issuance of the Certificate of Incorporation of the proposed company together with evidence of use of the trade mark in trade in Bangladesh by means of an affidavit or show evidence that the company as assignee is a successor to the business of the applicant to the trade mark, or the successor to that portion of the business with which the trade mark will be used and identified in Form TM 20B in which event the Registrar shall enter the name of the company as the proprietor. On failure to do so within the prescribed time shall entitle the Registrar to delete the registration or the application.
- (3) The Registrar, upon receiving Form TM 20B, shall deliver his approval or approval with conditions or non approval on the assignment within one (1) month from the date of receipt of the Form TM 20B.
- (4) Should the proprietor of the trademark object to the decision of the Registrar, the proprietor may request for a Hearing by filing Form TM 21, within one(1) month from the date of receipt of the Registrar's decision.

**69. Particulars to be provided.**

- (1) An application under sub rule 68 (1) shall contain the full name and trade or business address of the applicant and, if the applicant is a partnership, the full names of all the partners.
- (2) There shall be filed with the application for retention by the Registrar, an attested copy of the instrument, if any, under which the applicant claims his entitlement.
- (3) The Registrar may at any time, by notice in writing sent to the applicant, require him to produce for inspection any instrument of which an attested copy has been filed.
- (4) An instrument or attested copy of the instrument furnished in accordance with the Rules shall not be opened or made available for public inspection.
- (5) Where an applicant does not claim under any instrument which is capable in itself of furnishing documentary proof of his title, he shall file with the application a statement of case setting forth the full particulars of the facts upon which his claim to be the proprietor of the mark in question is based and

showing that it has been assigned or transmitted to him, and if the Registrar so requires the case shall be verified by affidavit.

- (6) The Registrar shall record on the Register, the document or instrument vesting title to the new proprietor.

**70. Proof of title.**

- (1) The Registrar may call on any person entitled by assignment or transmission and who applies to be registered as proprietor of a registered trade mark for such proof or additional proof of title as he may require for his satisfaction.
- (2) In the event there is dispute on the validity of an assignment or transmission between the parties, the Registrar may refuse to register the assignment or transmission until he is served a copy of the order / judgement of a competent court.

**71. Assignment without goodwill. Section 38**

- (1) An application for an assignment of a trade mark without goodwill in respect of any goods or services vide Form TM 20 B shall state:
  - (a) whether the mark was, at the time of the assignment, used in a business in any of those goods or services, as the case may be; and
  - (b) that the assignment was made otherwise than in connection with the goodwill of the business.
- (2) (a) Request to the Registrar for approval and directions with respect to advertisement of the assignment without goodwill under sub rule (1) above shall be made by the assignee, by filing Form 20C, within six (6) months from the date on which the assignment was made. An extension of up to three (3) months may be allowed by the Registrar.
- (3) Within one(1) month of receipt of the Form 20C the Registrar shall deliver his decision on whether the assignment is approved with or without any conditions or limitations Together with the approval of the assignment, ( if allowed ) the following directions on the advertisement shall be given by the Registrar to the assignee:
  - (i) the advertisement shall be advertised in at least one (1) prominent newspaper;
  - (ii) the advertisement shall state that the assignment was otherwise than in connection with the goodwill of the business concerned;
  - (iii) the full name and address of the assignor and the assignee shall be included in the advertisement; and
  - (iv) the trademark registration number, a clear representation of the trademark and the full description of the goods and/or services of which the trademark is applied to shall be included in the advertisement.
- (4) A copy of the advertisement as published shall be filed with the Registrar and until this has been done the assignment shall be deemed not to have taken effect.

- (5) Should the Registrar object to the assignment, the assignee may request for a Hearing by filing Form TM 21, within one(1) month from the date of receipt of the Registrar's decision.

**72. Entry of Assignment in Register.**

- (1) When the Registrar is satisfied as to the title of an applicant under Sections 33 to 38 and 40, and rule 68, he shall cause the applicant to be registered as proprietor of the trade mark in respect of the relevant goods or services and shall enter in the Register:
  - (a) the name and the trade or business address of the new proprietor, including the names of all the partners where the new proprietor is a partnership;
  - (b) any address for service filed under Rule 11; and
  - (c) particulars of the assignment or transmission.
- (2) The Registrar shall reject the application if he is of the opinion that the assignment is invalid under the Sections of the Act referred in sub rule (1) above, or in the case of Certification Marks, no consent is given by the Government, and shall inform the applicant within one (1) month of date of receipt of the Form TM 20B or the date of decision of the Government as the case may be.

**73. Partial assignment. Section 34.**

Where, pursuant to an application under rule 68 and as a result of a division and separation of the goods or services of a registration, different persons become registered separately, whether or not under different official numbers, as subsequent proprietors of a registered trade mark, each of the resultant separate registration in the names of different persons shall be treated as a separate registration for all purposes of the Act.

**74. Appeal by applicant.**

- (1) Where the application to record a deed of assignment filed under Rule 68 or 71 has been objected to by the Registrar, or where the Registrar has issued a certificate of invalidity of proposed assignment under sub rule 67(4), the applicant may if he desires seek a hearing before the Registrar by filing Form TM 21 together with grounds of appeal within one (1) month from date of Form TMR 5.
- (2) If the applicant fails to file a request for hearing by filing Form TM 21 within one (1) month of the date of Form TMR 5 the Registrar's decision under sub rule 67(4) shall be deemed final.
- (3) The Registrar on receiving the Request for Hearing in Form TM 21, shall allocate a date / time / place of hearing in the office portion of Form TM 21 and shall forward the same to the applicant within one (1) month of receipt Form TM 21 from the applicant.
- (4) If the applicant fails to attend the scheduled hearing or fails to make alternate arrangements before the hearing date, the decision of the Registrar shall be considered final or the Registrar may change his decision after reviewing the grounds of appeal stated in Form TM 21

**75. Assignment or transmission of certification trade mark and associated trade marks. Section 39.**

- (1) Application of an assignment or transmission of a certification mark shall be made to Registrar in Form TM 20 B, who shall forward the form together with all accompanying documents to the Government for the issuance of certificate of validity or invalidity. The Registrar may give his comments and recommendation in respect of the application.
- (2) The Government after consideration of the application shall issue the Certificate of Validity or Invalidity as per Form TMR 5 which form shall be forwarded to the applicant by the Secretary or Registrar.
- (3) The applicant may appeal against the issuance of Certificate of Invalidity by adopting the procedure, in Rule 74 as modified appropriately, where the term "Registrar" shall be replaced by the word "Secretary".
- (4) Assignment and transmission of associated trade marks shall be in respect of all the trade marks. Form TM 20 B shall be filed in respect of each registered trade mark.

**REGISTERED USER**

**76. Application for entry of registered user. Section 45.**

- (1) An application to the Registrar under Section 45 of the Act for the registration of a person as a registered user of a registered trade mark shall be made by the registered proprietor and the proposed Registered User by filing Form TM 22 accompanied by the prescribed fee.
- (2) A separate application shall be made for each proposed registered user of the registered mark and for each registered trade mark.
- (3) The Registrar if he is satisfied that the conditions in Section 45(2) are satisfied, shall register the registered user, that date being the date on which the person mentioned in the application as a registered user was so registered or the effective date of the registered user agreement whichever is earlier.
- (4) The Government to prevent trafficking in trade marks shall consider the following factors in deciding to whether to entertain an application to register a registered user:
  - (a) applicant of the trade mark has ongoing and existing business in which the trade mark is used in all or part of the goods and / or services that is included in the proposed registered user agreement;
  - (b) agreement includes clauses and conditions relating to product or service specifications and quality control measures; and
  - (c) any other conditions set by the Government on its own or on the advice of the Registrar.
- (5) The Registrar upon receipt of the application to register a registered user agreement, may refuse or conditionally accept the application, giving his reasons for the refusal or conditional acceptance.
- (6) The applicant and the proposed registered user (if he so desires) who is not satisfied with the decision of the Registrar under sub rule (5) above shall apply for hearing before the Register by submitting Form TM 21 together with

the fees thereon within four (4) weeks of receipt of the decision of the Registrar.

- (7) The Registrar shall inform the applicant and the proposed registered user (if any) of the date and time of hearing, not exceeding four (4) weeks from the date of receiving Form 21.
- (8) If the applicant does not appear at the hearing, the proceedings may be struck out except that it may thereafter be restored on the direction of the Registrar.

**77. Variation or cancellation of entry of registered user. Section 47.**

- (1) Application by the registered proprietor of a registered trade mark for the variation or cancellation of the registration of a registered user of the mark under Section 47 of the Act shall be made by filing Form TM 23 accompanied by the prescribed fee and where the registered user in question consents, the written consent of that registered user.
- (2)
  - (a) Where the application to vary or cancel a registered user agreement is filed by a registered proprietor of a trade mark or the registered user, the Registrar shall notify in writing the registered user or the proprietor of any such applications made to him. Any person so notified who intends to intervene in the proceedings shall within one (1) month of the receipt of such notification give notice to the Registrar in Form TM 23 to that effect. The applicant shall serve Form TM 23 as advance notice to the registered proprietor and the registered user at the same time he files the application at the Trade Marks Registry.
  - (b) The Registrar shall thereupon serve copies of such notice to the other parties and the applicant of the date and time the Registrar appoints to hear the application. The registered proprietor, registered user and the applicant may file evidence in support of their respective case and the Registrar after giving the party an opportunity of being heard may accept or refuse the application, or accept it subject to any condition, amendments, modifications or limitations he may think right to impose.
  - (c) The parties applying to vary or cancel the registered user agreement, the applicant, and the registered user shall follow the Rules 42 to 54 mutatis mutandis and the Registrar shall take note accordingly.
- (3) If the variation or cancellation affects more than one registered user of the mark a separate application shall be made in respect of each of them.
- (4) If the Registrar is satisfied in the matter, he shall cancel or vary, as the case may be, the entry on the Register relating to the registered user concerned, in accordance with the application.
- (5) The Registrar shall send to the registered proprietor, the registered user of the trade mark in question or the applicant in sub rule 2(a) above (if any) a notification of the variation or cancellation.

**78. Expiry or striking out of registered user agreement. Section 47.**

- (1) Where, in accordance with Section 47(1) of the Act, the registration of a registered user is for a period and the period expires before the expiration of

the last registration of the trade mark, the Registrar may strike out the relevant entry at the end of that period.

- (2) If an entry is struck out or varied otherwise than at the instance of the registered proprietor, the Registrar shall within five (5) days of his decision send written notification of the striking out or variation to the registered proprietor and to any registered user whose permitted use is affected.

#### **ALTERATION OF AND REMOVAL FROM THE REGISTER**

#### **79. Alteration of, name, address, description of registered user. Sections 51, 52 & 53.**

- (1) A registered proprietor or a registered user of a trade mark shall file Form TM 24 together with the prescribed fee, to enter any change in or correct the name, business address or description of registered user or address for service respectively.
- (2) A registered proprietor or a registered user of a trade mark whose registered business address or address for service is altered by a public authority but the address as altered designates the same premises as before shall make a request for the appropriate alteration of the address to the Registrar on Form TM 24 and if the request is accompanied by a certificate of the alteration given by the said authority, the Registrar shall alter the Register accordingly if he is satisfied as to the facts of the case, without payment of fee.
- (3) Form TM 24 shall be in respect of one trade mark application or registration only.

#### **80. Application for making, cancelling, varying or correcting an entry by a registered proprietor, registered user or aggrieved person. Sections 42, 43, 52, 53 & 54**

- (1) An application under Section 51(1) or Section 51(2) shall be made either to the Registrar or to the High Court Division without prejudice to appeal against the decision of the Registrar.
- (2) Subject to Rule 79, an application to the Registrar under Sections 42(1), 43(4), 51(1), 52(2), 53 or 54 of the Act, for making, cancelling or varying an entry in the Register other than for matters stated in Rule 79 above shall be made by filing Forms TM 25, TM 26 or TM 27 as the case may be, accompanied by the prescribed fee.
- (3) Every application under sub rule (1) shall be accompanied by a statement setting out fully the nature of the applicant's interest, the facts on which he bases his case and the relief he seeks.
- (4) Where the application is made by a person who is not the registered proprietor of the mark in question, the applicant shall forthwith send copies of the application, the statement of case and evidence (if any) to the registered proprietor at his trade or business address as entered in the Register and the Registrar and, if an address for service different therefrom is entered in the Register, at that address also.
- (5) In any particular case the Registrar may require a statement made under sub rule (2) or evidence adduced to be verified by an affidavit and filed together with Form TM 12.

- (6) The applicant under sub rule (3) and the registered proprietor of the mark in question shall without prejudice to Rules 81 and 82 follow the Rules 44 to 54 mutatis mutandis and the Registrar shall take note accordingly.

**81. Advertisement in Journal. Sections 53 & 54.**

Before deciding on a request on Form TM 25 or TM 26 under Rule 78 for the entry of a variation in the Register other than the business or trade address, address for service, and registered user or on Form TM 27 for the entry of a disclaimer or memorandum, the Registrar shall advertise the request or his proposal as the case may be in the Journal to enable any person wishing to oppose the request or his proposal to state in writing, within two (2) months from the date of the advertisement, together with any reasons against the making of the entry and the parties shall follow Rules 44 to 54 in disposing of the contested matter.

**82. Appeal to the Court. Section 100 (2)**

- (1) Any party not satisfied with the order or decision of the Tribunal may appeal against it to the High Court Division within two (2) months of the date of the order or decision or date of delivery of a copy of the order or decision whichever is later.
- (2) A copy of every application to the court under the Act shall be filed at the Trade Mark Registry by the applicant, accompanied by a covering letter by the applicant, Trade Mark Agent or the Legal Practitioner.
- (3) No concurrent application shall be made to the Registrar and to the High Court Division in respect of the same trade mark application or registration.

**83. Order of Court.**

- (1) Where an order is made by the Court in any case under the Act, the person in whose favour the order is made or, if there is more than one, such one of them as the Registrar may direct, shall file an office copy of the order with the Registrar and, if rectification or alteration of the Register is required, Form TM 25 shall be filed, accompanied by the prescribed fee.
- (2) The Register shall, where appropriate, be rectified or altered by the Registrar pursuant to the terms of the order of the Court.
- (3) If the Registrar considers that an order made by the court under the Act should be given publicity he may publish the order or abstract of the order as the Registrar deems appropriate in the Journal.

**84. Certificate of validity. Section 110.**

- (1) Where the court has certified with regards to the validity of a registered trade mark as provided in Section 110 of the Act, the registered proprietor of the mark may, by filing Form TM 28 accompanied by the prescribed fee and an office copy of the certificate, request the Registrar to add to the entry in the Register a note that the certificate of validity has been so granted.
- (2) The proceedings in the course of which the certificate was granted shall be named in the request.
- (3) On receipt of a request made in accordance with sub rule (1), the Registrar shall enter a note in the Register as requested and publish the certificate of

validity or abstract of the certificate as the Registrar deems appropriate in the Journal.

**85. Application for removal from Register and imposition of limitation. Sections 42 & 51.**

- (1) An application to the Registrar for:
  - (a) revocation of or varying the registration of a trade mark under Section 51(1);
  - (b) a removal from the Register and or imposition of limitations on grounds of non-use under Sections 42(1)(a) or (b); and
  - (c) cancelling the registration under Section 43(4).shall be made on Form TM 26, together with a statement of the grounds on which the application is made.
- (2) The applicant shall serve a copy of the application and the statement on the proprietor at the same time as he files these documents with the Registrar.

**86. Counter-statement.**

- (1) Within two (2) months from the date of receipt of the copies of the application and statement, the proprietor may file with the Registrar a counter statement in Form TM 11 setting out:
  - (a) the grounds on which he relies as supporting his registration; and
  - (b) the facts alleged in the application which he admits, if any.
- (2) The proprietor shall serve on the applicant a copy of the counter-statement at the same time as he files the counter-statement with the Registrar.
- (3) In the case of an application for revocation of the registration of a trade mark or on the grounds referred to in Sections 42(1)(a) or (b), 42(3), 43(4) or 51(1) as the case may be, the proprietor shall file, together with the counter-statement, evidence of the use by him of the trade mark or of other matters relied upon by him, and shall also serve this on the applicant at the same time.
- (4) A request for an extension of time to file the counter-statement shall be made to the Registrar by filing Form TM 19 within two (2) months from the date of receipt of the copies of the application and statement.
- (5) The total extension of time for which the Registrar may allow to file the counter-statement shall not exceed five (5) months from the date of receipt of the application and statement.
- (6) The Registrar may refuse to grant the extension of time if the proprietor fails to show a good and sufficient reason for the extension.
- (7) In the case of an application for revocation on the grounds referred to in Section 42(1)(a) or (b) of the Act, the application shall be granted where no counter-statement has been filed within the time allowed.

**87. Further Procedures.**

- (1) Upon an application being made under Rule 85 and a counter-statement being filed under Rule 86, Rules 44 to 54 shall apply, with the necessary modifications, to further proceedings thereon except that, in the case of an application for revocation on the grounds of non-use under Section 42(1) (a) or (b) of the Act, the application shall be granted where no evidence of use has been filed under Rule 86 (3).
- (2) For the purpose of the application of Rules 44 to 54:
  - (a) references in those rules to the applicant shall be treated as references to the proprietor;
  - (b) references in those rules to the application shall be treated as references to the proprietor's registration;
  - (c) references in those rules to the opponent shall be treated as references to the applicant for revocation or a declaration of invalidity of the registration; and
  - (d) the references in Rule 44(2), 45(2) as to the abandonment of the application shall be treated as a reference to the admission by the proprietor to the facts alleged by the applicant in his application for revocation or a declaration of invalidity of the registration.

**88. Procedure for Intervention.**

- (1) Any person, other than the registered proprietor, claiming to have an interest in a registered trade mark which is the subject of an application under Rule 85 may apply to the Registrar vide Form TM 30 for leave to intervene stating the nature of his interest.
- (2) The Registrar may, after hearing the parties concerned if he so required, refuse such leave, or grant leave to intervene upon such terms and conditions (including any undertaking as to costs) as he thinks fit.
- (3) Any person granted leave to intervene shall, subject to the terms and conditions imposed in respect of the intervention, be treated as a party to the proceedings in question.

**SUPPLEMENTARY**

**89. Case management conference. Section 91.**

At any stage of any proceedings before the Registrar, the Registrar may, in contested matters, direct that the parties to the proceedings attend a case management conference where they shall have opportunity to be heard with regards to the future conduct of the proceedings, and in particular with regards to the proposed exercise of any of the Registrar's powers under the Act and the Rules. The Registrar shall give the parties at least fourteen (14) days notice of the date and time of the case management conference.

**90. Pre-hearing review. Section 91.**

Before hearing any party who desires to be heard in any proceedings before the Registrar, the Registrar may direct that the parties to the proceedings attend a pre-hearing review at which the Registrar may give such directions as to the conduct of

the hearing as the Registrar thinks fit. The Registrar shall give the parties at least fourteen (14) days notice of the date and time of the pre-hearing review.

**91. Extension of time. Section 93.**

- (1) If, in any particular case, the Registrar is satisfied that the circumstances are such as to justify an extension of time for doing any act or taking any proceeding under these Rules, not being a time expressly provided or prohibited by the Act or prescribed by Rules 62 and 65(1), he may extend the time upon such notice to other parties, and upon such terms as he may direct, and the extension may be granted though the time has expired for doing the act or taking the proceeding.
- (2) Every application for an extension of time under sub rule(1) shall be made on Form TM 19 stating the circumstances in sufficient detail to enable the Registrar to determine whether the extension is justified and shall be accompanied by the prescribed fee.
- (3) Where, in an *inter-partes* proceeding an extension of time is sought, the party seeking the extension shall at the same time send to every other person who at the time is a party to the proceeding, a copy of the request for extension filed with the Registrar.
- (4) Any party may, within fourteen (14) days of receiving a copy of the request in accordance with sub rule (3), send to the Registrar observations on the request for an extension and if no observations are so sent he shall be deemed to consent to the extension being granted by the Registrar.
- (5) In considering whether to grant an extension of time in a case falling within sub rule (3) the Registrar shall take into account the circumstances set out in the request for an extension and of any observations submitted by other parties to the proceedings and he shall send a copy of his decision to the party seeking the extension and to every other party referred to in sub rule (3).

**92. Excluded days. Section 124(2)(o).**

- (1) The following days shall be excluded days for all purposes under the Act and these Rules:
  - (a) all Government approved weekly holidays;
  - (b) any day specified as or proclaimed by the Government to be a public holiday;
  - (c) any day proclaimed to be an excluded day by notice displayed to public view at an office of the Registry.
- (2) Whenever the last day fixed by the Act or by these Rules for doing any act or thing at the Office falls on a day which is an excluded day, it shall be lawful to do the act or thing on the first day following such excluded day, which is not an excluded day.

**93. Application for hearing.**

- (1) Pursuant to Section 91(5) of the Act the Registrar may review his decision, on his own motion or on the application made by the applicant or registrable proprietor or registered user, and before confirming his decision he shall

issue Form TMR 6 to the party of his proposed decision and notify the respective party in writing, and if any of them do not agree to the proposal, they shall file Form TM 21 within two (2) weeks of receiving Form TMR 6.

- (2) Before exercising adversely to an applicant for registration or a registered proprietor any discretionary power given to the Registrar by the Act of by these Rules, the Registrar shall hear that person thereon if so required by that person.
- (3) Any request for a hearing under sub rule (2) shall be made to the Registrar by filing Form TM 21 within one (1) month from the date of the Registrar notifies him that he proposes to exercise a discretionary power.
- (4) The decision of the Registrar in the exercise of any such discretionary power shall be notified to persons affected.

**94. Power to dispense with evidence.**

Where, under these Rules any person is required to do any act or thing, or any document or evidence is required to be filed, and it is shown to the satisfaction of the Registrar that by any reasonable cause that person is unable to do that act or thing or that document or evidence cannot be filed, the Registrar may, upon the production of such other evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing, or the filing of such document or evidence.

**95. Amendment of documents. Section 19.**

Any document filed in any proceedings before the Registrar and any mistake in a drawing or other representation of a trade mark may on the application by the applicant by filing Form TM 14 and/or if the Registrar thinks fit, be amended, and any irregularity in procedure in or before the Office may be rectified, on such terms as the Registrar may direct.

**96. Affidavit.**

- (1) Any affidavit required under the Act or these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:-
  - (a) in Bangladesh, in accordance with the provisions of the (Oaths Acts 1873)
  - (b) in any other part of the world before any court, judge, justice of peace, magistrate, notary public or other officer authorised by law in that country to administer an oath for the purpose of legal proceedings.
- (2) Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by sub rule (1) to take a declaration may be admitted without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

**97. Supply of copies of documents. Section 124(2)(b).**

The Registrar shall supply a certified copy or extract or uncertified copy or extract, of any entry in the Register or any document filed in respect of a trade mark application as requested in Form TM 31.

**98. Branches of the Trade Mark Registry. Section 3(2), Section 124(2)(m).**

- (1) The Government may establish branches of the Trade Mark Registry in any part of the country for facilitating the working of this Act, and for convenience of the public.
- (2) A document required or permitted by this Act to be submitted at the Trade Mark Registry may be submitted to any branch of the Trade Mark Registry and reference in this Act to the submission to the Registry or Registrar includes reference to the submission at the branch of the Registry.
- (3) The Registrar shall make available at the branch Trade Mark Registry
  - (i) copies of the Register duly updated within ten (10) days of entries made in the Register in central Registry;
  - (ii) an index of registered trade marks;
  - (iii) an index of trade marks in respect of which applications for registration are pending;
  - (iv) an index of the name of the proprietors of registered trade marks;
  - (v) an index of the names of registered users;
  - (vi) regulations governing use of certification marks and variations or applications to vary such regulations;
  - (vii) regulations governing use of collective marks and variations or applications to vary such regulations;
  - (viii) such other documents that the Government has by notification in the official gazette notified.
- (4) The Registrar shall make available at the branch Trade Mark Registry, copies of the Trade Mark Journal for public inspection and for sales to the public.
- (5) The Registrar shall make available facilities to make photocopies of documents stated in sub rules (2), (3), (4), and to provide certified or uncertified copies thereof on payment of fees thereon.

**99. Award of Costs. Section 91 and 124(2)(j).**

Subject to the provisions of rule 54, in all proceedings before the Registrar, the Registrar may, save as otherwise expressly provided by the Act, award such cost not exceeding the amount admissible under the Sixth Schedule as he considers reasonable having regard to all the circumstances of the case.

**SPECIAL PROVISIONS FOR TEXTILE MARKS**

**100. Textile Mark.**

The expression "textile mark" means a trade mark or a certification trade mark used or proposed to be used in relation to goods specified in Rule 101 as "textile goods" for the purposes of Chapter IX of the Act.

**101. Textile goods.**

The classes of goods to which Chapter IX of the Act shall apply and which are in the Act and these Rules referred to as textile goods shall be classes 22 to 27 (inclusive) of the Fourth Schedule.

**102. Items of textile goods.**

A separate application for the registration of a trade mark shall be made in respect of each of the items of textile goods stated in the Fifth Schedule when the mark consists exclusively of letters or numerals or any combination thereof.

**103. Grouping of items in the Fifth Schedule.**

- (1) For the purpose of application for the registration of trade mark consisting exclusively of letters, numerals or any combination thereof, the items of the Fifth Schedule to these rules shall be grouped as follows: and goods falling in each group shall be deemed to be goods of the same description, and goods falling in different groups shall be deemed to be goods of different description.

Group 1 Items 1, 4, 5, 8, 9, 10, 11, 12, 16, 19, 20, 22, 23, 24, 25, 26, 27, 30, 33, 36, 37, 39, 41, 42, 44, 45, 48, 49, 54, 55, 59, 61, 62, 65 and 91.

Group 2 Items 2, 3, 14, 17, 18, 34, 35, and 47.

Group 3 Items 6, 7, 21, 38 and 52

Group 4 Items 13, 29, 75, 77 and 78.

Group 5 Items 15, 28, 31, 40, 60, 66, 79, 88, 90 and 93.

Group 6 Items 32, 43, 64 and 94.

Group 7 Items 46, 83 and 85.

Group 8 Items 50, 51, 56, 57, 63, 76, 80, 84, 86, 87 and 89.

Group 9 Items 53.

Group 10 Items 58, 82 and 92.

Group 11 Items 67, 68, 69, 70 and 71.

Group 12 Items 72.

Group 13 Items 73.

Group 14 Items 74.

Group 15 Items 81.

- (2) Without prejudice to Rules 12, 14 and 15, the Registrar shall not register marks which are identical or confusingly similar or deceptive to earlier mark applied for or registered in respect of good falling within the same Group in the Fifth Schedule.

**104. Rules under Section 67(2).**

- (1) **Definition** – For the purposes of this Chapter, unless there is anything repugnant in the subject of context:-

(a) “balanced numeral” means a trade mark consisting of either identical numerals or identical letters of not less than three nor more than seven digits;

(b) “digit” includes a single letter;

(c) “letter fraction” means a fraction containing one or more letters.

- (2) **Non-registrability of certain marks** – In respect of textile goods the following marks shall not be capable of registration, namely:-

(a) any numeral of one digit or of more than six digits not being a balanced numeral;

- (b) a single letter or any combination of letters of more than six letters not being a balanced numeral;
- (c) any combination of numerals and letters of more than eight digits;
- (d) any fraction or letter fraction consisting of more than eight digits together;
- (e) any fraction or letter fraction having less than three digits together;
- (f) any combination of numerals and fraction of more than six digits;
- (g) any combination of numerals, letters, fractions and letter fractions eight having more than eight digits or ending with a fraction of more than one digit in the numerator or in the denominator;
- (h) numerals or letters representing cloth dimensions;
- (i) a balanced numeral which does not consist of at least two more or two less digits than balanced numeral of the same series already registered in the name of a different person in respect of the same goods or description of goods.

(3) **Marks likely to deceive or to cause confusion.** (1) A trade mark consisting a numerals, letters, fractions, letter fractions, or any combination thereof, and not being a balanced numerals, shall not be capable of being registered as a textile mark if it does not differ from a trade mark registered in the name of a different person in respect of the same goods or description of goods:-

- (a) in the case of numeral not exceeding four digits, in at least one corresponding digit;
- (b) in the case of numeral of five digits, in at least two corresponding digits;
- (c) in the case of numeral of six digits, in a at least three corresponding digits;
- (d) in the case of combination two letters, in at least one corresponding letter;
- (e) in the case of combination of three or four letters, in at least two corresponding letters;
- (f) in the case of a combination of five or six letters, in at least three corresponding letters;
- (g) in the case of a mark consisting of one letter and one numeral digit, in at least one of them;
- (h) in the case of mark consisting of one letter and two or three numeral digits, in at least one corresponding numeral digit;
- (i) in the case of mark consisting of one letter and four or more numeral digits, in at least two corresponding digits;
- (j) in the case of mark consisting of two or more letters and one or more numeral digits, in at least one corresponding letter and one corresponding numeral digit;
- (k) in the case of a fraction or letter fraction or any combination thereof in which the total number of digits in the numerator and denominator is three or four, in at least one corresponding digit from either the numerator or the denominator;
- (l) in the case or a fraction or letter fraction or any combination thereof in which the total number of digits in the numerator and denominator is five or more, in a least one corresponding digit in the numerator and one corresponding digit in the denominator or two corresponding digits in either the numerator or the denominator;
- (m) in the case of a combination consisting of a numeral and a fraction in at least one corresponding numeral digit;
- (n) in the case of a combination of letters, numerals, and fractions (including letter fractions);
  - (i) where the total number of digits excluding the fraction is not more than three, in at least one corresponding digit;
  - (ii) where the total number of digits, excluding the fraction, is four or more, in at least two corresponding digits.

- (2) Nothing in sub rule (1) shall be construed to signify that where a trade mark does not come within the scope of a any case specified in the said sub rule, the mark shall necessarily be regarded as not being likely to deceive or to cause confusion.
4. In the case of a trade mark consisting of letters, numerals or any combination thereof which in respect of the same goods as those in relation to which registration is applied for, has been continuously used (either by the applicant for registration or by some predecessor in his business, and either in its original form or with additions or alterations not substantially affecting its identity) during the period from a date prior to the date of application for registration, the Registrar shall not refuse registration by reason only of the fact that the trade mark does not satisfy the conditions and restrictions laid down in clause (i) rule 111 or in rule 112 and may register such mark on evidence of user.

**105. Sampling of textile goods. Section 70**

- (1) To ascertain whether textile goods which are claimed by an applicant for a trade mark registration, to be of uniform number, quantity, measure, gauge or weight, the Registrar shall require the applicant to bring to the Registry during its business hours, a reasonable quantity of the textile goods. The Registrar shall or take random sample of three items in each category of goods. The sample of goods shall be placed in three different envelopes or containers and sealed after marking the identification of the samples on the envelope or container. One sample shall be given to the applicant and acknowledgement of receipt of sample be obtained from the applicant. The Registrar shall forward one sample to a competent government authority to verify the parameters given in the application for trade mark registration. The third sample shall be kept in the Registry's file for further verification if necessary.
- (2) The Registrar shall record the results of the tests of the samples by the Government authority in the application form for registration of trade mark.

**106. Application to register word mark.**

An application for the registration of trade mark consisting exclusively of a pronounceable word or words relating to textile goods shall be made in Form TM 5 provided always that a line heading above shall not be deemed to distinguish and shall not be registrable as trade marks.

**107. Application to register letters or numerals.**

An application for the registration of a trade mark consisting exclusively of letters or numerals or combination thereof relating to textile goods shall be made in Form TM 5 and shall be subject to conditions and restrictions as the Registrar deem fit to impose.

**AGENTS, LEGAL PRACTITIONERS, AUTHORISED PERSONS**

**108. Agents, Legal Practitioners Section 113.**

- (1) Except as otherwise required by the Act or these Rules:
  - (a) any application, request or notice which is required or permitted to be made or given to the Registrar;

- (b) all other communications between an applicant or a person making such request or giving such a notice and the Registrar; and
- (c) all other communications between the registered proprietor or the registered user of a trade mark and the Registrar or any other person,

may be signed, made or given by or through an Agent or Legal Practitioner and the Registrar may in any particular case, require the personal signature or presence of the applicant, opponent, registered proprietor, registered user or other person.

- (2) (a) Where a party to proceedings before the Registrar appoints an Agent or Legal Practitioner for the first time or appoints one Agent or Legal Practitioner in substitution for another, the Agent or Legal Practitioner appointed shall file Form TM 1 with the Registrar on or before the first occasion on which he acts as an Agent or Legal Practitioner for that party in the proceedings or at the latest within three (3) months of receiving Form TMR 1.
- (b) The Registrar may at his discretion refuse to proceed with any act in the proceedings before him, or revoke all earlier acts in respect of the trade mark in the event Form TM 1 is not filed within three (3) months, after Form TMR 1 is served on the Trade Mark Agent or Legal Practitioner.
- (3) (a) No person may appoint more than one Agent or Legal Practitioner practising in different firms to act for him concurrently in respect of the same trade mark application, or registered trade mark, whether in respect of the same or different transactions; and where more than one Agent or Legal Practitioner is on record, the Registrar shall recognise only the latest Agent or Legal Practitioner duly appointed and all previous appointment of Agents or Legal Practitioners shall be deemed revoked.
- (b) Notwithstanding sub rules 2 and 3(a), an applicant may appoint more than one Agent, or Legal Practitioner all practising in one firm to act for him. Any one of the Trade Mark Agents or Legal Practitioners from one firm identified in Form TM 1 can act for him in any matter stated in sub rule (1).
- (4) The Registrar shall decline to recognise as an Agent or Legal Practitioner any person who is not currently on the Register of Trade Mark Agents of Bangladesh compiled and maintained under Rule 102, or who is not currently holding a valid practising certificate of the Bar Association of Bangladesh.

### **REGISTER OF TRADE MARK AGENTS**

#### **109. Registration of Agents. Section 113.**

- (1) The Registrar shall maintain a Register of Trade Marks Agents.
- (2) An application to be approved as a Trade Mark Agent shall be made to the Registrar on Form TM 2 accompanied with payment of the prescribed fee.
- (3) (i) In order to be approved for registration in the Register of Trade Marks Agents, the applicant shall satisfy the Registrar that he is domiciled or resident in Bangladesh and has a principal place of business in Bangladesh, and:

- (a) holds a Bachelors Degree recognised by the Government of Bangladesh and has had at least two (2) years of working experience working under the direct supervision of an Registered Trade Mark Agent who has been admitted on the Register of Trade Mark Agent for at least five (5) years or has had specific training in Intellectual Property including Trade Marks for at least five (5) years; or
  - (b) has had at least two (2) years of experience in the field of intellectual property by virtue of the being an ex-officer of the Trade Marks Registry; or
  - (c) has acted as a Trade Mark Agent to the satisfaction of the Registrar before these Rules came into force.
- (ii) Notwithstanding sub rule 3 (i) above, the Registrar may by prior notice of at least one year, arrange a Trade Mark Agents qualifying examination and frame Rules governing the conduct of the examination.
- (iii) Persons passing the examination are entitled to practice as Trade Mark Agents.
- (iv) Before the establishment of Trade Marks Agents qualifying examination stated in Rule 109(3)(ii);
- (a) On receipt of an application for the approval of registration of a person as a Trade Mark Agent, the Registrar shall appoint a date not exceeding three (3) months from the date of receipt of Form TM 2, on which the candidate shall appear before him for an interview.
  - (b) After the candidate has been interviewed, and any further information bearing on his application, which the Secretary of the Administrative Ministry may consider necessary has been obtained, and upon the Secretary ascertaining that Rule 109(3)(i) is satisfied, shall approve the candidate as a Trade Mark Agent and shall issue an approval letter within three (3) months from the date of interview or obtaining all information whichever is later. The candidate shall then file the Form TM 3 with the prescribed fee to register as a Trade Mark Agent for the calendar year ending on 31<sup>st</sup> December of that year.
- (v) Procedure under Rule 109(3)(iv) shall be discontinued after the establishment of Trade Mark Agent qualifying examination.
- (4) The Secretary shall not register any person as a Trade Mark Agent who has been convicted of any cognisable offence, or any criminal offence involving fraud or dishonesty; who has been struck off the role of Advocate by the Bar Association of Bangladesh.
- (5) An Agent shall be removed from the Register of Trade Marks Agent by the Secretary if he:
- (a) is no longer domiciled or resident of Bangladesh or no longer has a principal place of business in Bangladesh;
  - (b) is convicted of a cognisable offence or any criminal offence involving fraud or dishonesty;

- (c) is an undischarged bankrupt;
  - (d) has been adjudged by a court of competent jurisdiction to be of unsound mind; or
  - (e) does any fraudulent practice or misconduct provided that he is given an opportunity to defend himself.
- (6) An application for the registration or renewal of registration as a Trade Mark Agent shall be made to the Secretary on Form TM 3 together with payment of prescribed fee by 31<sup>st</sup> December of each year. The full annual fee is payable regardless date of application to register or renew the registration.
- (7) The Secretary shall upon being satisfied that the conditions specified in Section 113 of the Act and sub rules (3) and (4) above continue to be satisfied, register or renew the registration of the Trade Mark Agent for a term expiring on 31 December of that year or the following year as the case may be.
- (8) Where an application for trade mark is made by a person in the sole and regular employment of the principal the Secretary may require the person to provide evidence to his satisfaction that the person is in full time employment of a named principal which principal is the proprietor of the trade mark in question.
- (9) Where an applicant for registration of a trade mark does not reside or carry on business in Bangladesh, he shall appoint an Agent or Legal Practitioner to act for him.
- (10) The Secretary may demand evidence by way of affidavit from a person, referred to in sub rule (9) that the business is principally in Bangladesh or the Trade Mark Agent or Legal Practitioner is domiciled or resident in Bangladesh.
- (11) The Register of Trade Mark Agents shall be published from time to time as the Secretary may deem fit, or at least once a calendar year the entries being arranged in the alphabetical order of the surnames of the registered agents and copies thereof shall be placed on sale at each Branch Office of the Registry and, shall be published in the Registry's website.
- (12) (a) A registered Trade Mark Agent shall file his application for renewal for the ensuing year before 31<sup>st</sup> December the previous year. Application filed after 1<sup>st</sup> January but before 31<sup>st</sup> March shall be subject to late filing fee. If the renewal is not filed by 31<sup>st</sup> March, the Secretary shall suspend the registration of the Trade Mark Agent for another three (3) months after which the registration of the Trade Mark Agent shall be revoked. A Trade Mark Agent shall not represent himself as a Trade Mark Agent once his registration is revoked.
- (b) A Trade Mark Agent whose registration has been revoked for non renewal of his registration shall apply for reinstatement by filing Form TM 3 together with a statement of case stating reasons for non renewal of registration, with annual renewal fee and payment of reinstatement fee.
- (c) The Secretary on receiving Form TM 3 shall renew the application, or shall consider the reasons for failure to renew the application and if reasonable, approve the application for reinstatement, and if not approved, so inform the applicant within two (2) weeks, of receiving Form TM 3 giving his grounds of refusal to reinstate.

- (d) Any person whose application for reinstatement is rejected by the Registrar may appeal to the Secretary within two (2) weeks of receiving the decision and grounds of refusal from the Secretary, by filing a letter of appeal to the Secretary. The Secretary shall attend to the letter of appeal and inform the person of his decision within three (3) months of receipt of letter.
- (e) Any decision of the Secretary shall be appealable to the Court within three (3) months of date of decision.

**110. Trade Marks Journal. Section 17 and 124 (2)(t).**

- (1) The Registrar shall publish a journal called the Trade Marks Journal containing particulars of any application for registration of a trade mark, (including a representation of the mark), such information as is required to be published under these Rules and such other information as the Registrar thinks fit.
- (2) The Journal shall be published in hard copy and in electronic form and made accessible at the Registry and/or by the internet.

**CHANGE OF CLASSIFICATION**

**111. Change of classification in respect of existing registration. Section 54.**

- (1) Subject to Section 54(3), the Registrar may:-
  - (a) in order to reclassify the specification of goods of a subsisting registered trade mark in the Register which is founded on the Fourth Schedule of the Revised Trade Mark Rules 1963, to one founded on Fourth Schedule of these Rules, or
  - (b) consequent upon an amendment of the International Classification of Goods and Service referred to in Rule 6 above.

make such amendments to entries in the Register as he considers necessary for the purpose of reclassifying the specification of the registered trade mark.
- (2) Before making any amendment to the class of goods and/or the specification of goods on the Register under paragraph (1) above, the Registrar shall give the proprietor of the mark written notice of the Registrar's proposal for amendments by forwarding Form TMR 8 and shall at the same time advise him that:-
  - (a) he may make written objections to the proposals, within three (3) months of the date of the notice, stating the grounds of his objections; and
  - (b) if no written objections are received within the prescribed period, the Registrar will publish the proposals and the proprietor will not be entitled to make any objections thereto upon such publication.
- (3) If the proprietor makes no written objections within the period prescribed in paragraph (2) (a) above, or at any time before the expiration of that period gives the Registrar written notice of his intention not to make any objections, the Registrar shall as soon as practicable after the expiration of that period or upon receipt of the notice publish the proposals in the Journal.

- (4) Where the proprietor makes written objections within the period specified in paragraph (2) above, the Registrar shall, as soon as practicable after the Registrar has considered the objections, publish the proposals as amended in the Journal.

**112. Opposition to the proposals. Section 54 (3).**

- (1) Notice of any opposition shall be filed in Form TM 7 within two (2) months of the date of publication of the proposals under Rule 111 above and together with the grounds of opposition, and, in particular, how the proposed amendments would be contrary to Section 54(3).
- (2) The Registrar may require or admit evidence by way of affidavit directed to the questions in issue and if so requested by person opposing the proposal, give that person the opportunity to be heard thereon before deciding the matter. Any person opposing the proposal shall request for hearing by filing Form TM 21.
- (3) If no notice of opposition under paragraph (1) above is filed within the prescribed time, or where the opposition has been determined, the Registrar shall make the amendments as proposed and shall enter in the Register the date when they were made.

**REPEAL AND SAVINGS**

**113. Revocation.**

The Trade Marks Rules 1963 are hereby repealed.

**114. Transitional Provisions.**

1. (1) In this Rule “existing registered mark” means a trade mark, certification trade mark, defensive mark or collective mark registered under the repealed Acts immediately before the commencement of this Act;  
  
“the repealed Acts” means the Trade Marks Act 1940 and The Merchandise Marks Act, 1889; and  
  
“the old law” means that Act and any other enactment or rule of law applying to existing registered marks immediately before the commencement of this Act.
- (2) For the purposes of this Rule –
  - (a) an application shall be treated as pending on the commencement of this Act if it was made but not finally determined before commencement, and
  - (b) the date on which it was made shall be taken to be the date of filing under the repealed Acts.
2. (1) Existing registered marks in the Trade Mark Register kept under repealed Acts shall be transferred on the commencement of this Act to the register kept under this Act and have effect, subject to the provisions of this Rules, as if registered under this Act.

- (2) Existing registered marks registered as a series under the repealed Acts shall be similarly registered in the new register. The Registrar may give directions for putting such entries in the same form as is required for entries under this Act.
  - (3) In any other case notes indicating that existing registered marks are associated with other marks shall cease to have effect on the commencement of this Act.
- 3.
- (1) Proceedings under the repealed Acts to expunge or vary registration for breach of condition which are pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.
  - (2) A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall be transferred to the new register and have effect as if entered on the register in pursuance of section 14 of this Act.
  - (3) A registered user agreement entered on the former register in relation to an existing registered mark immediately before the commencement of this Act shall be transferred to the new register and have effect as if entered in pursuance of section 44 of this Act.
- 4.
- (1) Sections 24 to 32 of this Act apply in relation to an existing registered mark as from the commencement of this Act and Section 26 of this Act applies in relation to infringement of an existing registered mark committed after the commencement of this Act, subject to subparagraph (2) below.
- The old law continues to apply in relation to infringements committed before commencement.
- (2) It is not an infringement of –
    - (a) an existing registered mark, or
    - (b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,
- to continue after commencement any use which did not amount to infringement of the existing registered mark under the old law.
- 5.
- (1) Sections 33 to 40 of this Act applies to transactions and events occurring after the commencement of this Act in relation to an existing registered mark; and the old law continues to apply in relation to transactions and events occurring before commencement.
  - (2) Registration of assignments and transmissions entered under the repealed Acts shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under Section 40 of this Act.

The Registrar may give directions for putting such entries in the same form as is required for entries made under this Act.

- (3) An application for registration of an assignment or transmission of a trade mark under the repealed Acts which is pending before the registrar on the commencement of this Act shall be treated as an application for registration under section 40 of this Act and shall proceed accordingly.

The Registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

- (4) An application for registration of an assignment or transmission of a trade mark under the repealed Acts which has been determined by the registrar but not finally determined before the commencement of this Act shall be dealt with under the old law; and sub-paragraph (2) above shall apply in relation to any resulting entry in the register.

- (5) Where before the commencement of this Act a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration after commencement shall be made under Section 40 of this Act.

- (6) In cases to which sub-paragraph (3) or (5) applies the repealed Acts continue to apply (and Section 40 of this Act does not apply) as regards the consequences of failing to register.

6. (1) Section 46 of this Act applies only in relation to licences granted after the commencement of this Act; and the old law continues to apply in relation to licences granted before commencement.

- (2) Existing registered user entries under repealed Acts shall be transferred on the commencement of this Act to the register kept under this Act and have effect as if made under Section 45 of this Act.

- (3) An application for registration as a registered user which is pending before the registrar on the commencement of this Act shall be treated as an application for registration of a licence under Section 45 of this Act and shall proceed accordingly.

The registrar may require the applicant to amend his application so as to conform with the requirements of this Act.

- (4) An application for registration as a registered user which has been determined by the registrar but not finally determined before the commencement of this Act shall be dealt with under the old law; and sub-paragraph (2) above shall apply in relation to any resulting entry in the register.

- (5) Any proceedings pending on the commencement of this Act under the repealed Acts shall be dealt with under the old law and any necessary alteration made to the new register.

7. Any proceeding commenced before the Registrar before the entry into force of these Rules shall proceed under the Trade Mark Rules 1963 as amended or under Trade Mark Act 1940 and the Merchandise Marks Act 1889 as appropriate; but where a new step is to be taken on or after the coming into force of these Rules in relation to any proceedings commenced under the Trade Mark Rules 1963, these Rules shall apply to such proceedings from that date.

8. Section 120 of this Act applies to an application for registration under this Act made after the commencement of this Act notwithstanding that the Convention application was made before commencement.
9. (1) If the application for registration under this Act claiming priority under the PARIS Convention is made within the six (6) month period –
- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the priority application, and
- (b) the registrability of the trade mark shall not be affected by any use of the mark in the Bangladesh in the period between that date and the date of the application under this Act.
- (2) Any filing which in a Convention Country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.
- A “regular national filing” means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application.
- (3) A subsequent application concerning the same subject as the priority application, filed in the same country, shall be considered the priority application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application –
- (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and
- (b) it has not yet served as a basis for claiming a right of priority.
- The previous application may not thereafter serve as a basis for claiming a right of priority.
- (4) A right to priority arising as a result of a priority application may be assigned or otherwise transmitted, either with the application or independently.
10. (1) Section 22 (1) of this Act applies in relation to the registration of a mark in pursuance of an application made after the commencement of this Act; and the old law applies in any other case.
- (2) Section 22 (2) of this Act applies where the renewal falls due on or after the commencement of this Act; and the old law continues to apply in any other case.
11. An application to alter a registered trade mark made under repealed Acts which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.
12. (1) An application to remove from register or imposition of limitation on ground of non-use made under repealed Acts which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration made to the new register.

- (2) An application to revoke an existing registered mark for non-use may be made at any time after the commencement of this Act under this Act.

Provided no such application for the revocation of the registration of an existing registered mark which is a defensive registration of a well-known trade mark may be made until more than five (5) years after the commencement of this Act.

- 13. (1) An application for the registration of trade mark which is pending on the commencement of this Act shall be dealt with under this Act.
- 14. (1) Regulations governing the use of an existing registered certification mark deposited at the Trade Mark Office in pursuance of repealed Acts shall be treated after the commencement of this Act as if filed under the provisions of this Act.
  - (2) Any request for amendment of the regulations which was pending on the commencement of this Act shall be dealt with under the old law.
- 15. A certificate of validity of contested registration given before the commencement of this Act under the repealed Acts shall have effect as if given under Section 110 of this Act.

**FIRST SCHEDULE  
(Rule 3)**

**FEES**

The following fees shall be paid in respect of applications, registration and other matters under the Act. Such fees must in all cases be paid before or at the time of doing the matter in respect of which they are to be paid.

<b>Form TM</b>		<b>Fee Taka</b>
1	Form of Authorisation and Request to Enter, Alter or Substitute an Address for Service	1,000
2	Application to Register as a Trade Marks Agent	2,000
3	Application for Renewal of Registration / Reinstatement of Trade Marks Agent	1,500
4	Request for Search	1,000
5	Application for Registration of a Mark *For one kind of goods / services *Two to Four kinds of goods / services *Five and more kinds of goods / services	1,500 2,500 3,500
	For Certification Mark (flat fee)	7,000
	For Collective Mark	5,000
	Additional fee for Series Marks	600
6	Request for Statement of Grounds of Decision	1,500
7	Notice of Opposition	2,000
8	Filing of Regulations Governing the Use of a Collective Mark or Certification Mark	1,000
9	Instruction to Advertise in Journal	1,000
10	Instructions to Register and Issue a Certificate of Registration *For one kind of goods / each item of Textile goods / services *Two to Four kinds of goods / each item of Textile goods / services stated *Five and more kinds of goods / Textile goods /services Additional fee for Series Marks	5,000 10,000 15,000 600
11	Counter-Statement to a Notice of Opposition, and other Proceedings	1,500
12	Filing of evidence by way of affidavit	1,000
13	Notice to the Registrar of attendance at hearing	500
14	Request for correction of a clerical error in an application or for permission to otherwise amend an application for registration	1,000
15	Application to dissolve the Association between a Registered Trade Mark and other Registered Trade Mark(s)	600
16	Application for Renewal of Registration of a Trade Mark *For one kind of goods / services	5,000

	*Two to Four kinds of goods / services	10,000
	*Five and more kinds of goods / services	15,000
17	Application for Late Renewal of Registration of a Trade Mark	
	*For one kind of goods / services	7,000
	*Two to Four kinds of goods / services	13,000
	*Five and more kinds of goods / services	20,000
18	Application for Restoration and Renewal of Registration	
	*For one kind of goods / services	8,000
	*Two to Four kinds of goods / services	14,000
	*Five and more kinds of goods / services	21,000
19	Application for Extension of Time (per application)	1,000
	*Per month of extension (limited to maximum of 6 months)	500
20A	Application For Registrar's Opinion for The Validity of Proposed Assignment of a Registered Trade Mark	1,500
20B	Application and Declaration of an Assignment / a Transmission for Registration as Proprietor of a Trade Mark	1,000
20C	Request for Approval and Directions for Advertisement (of Assignment Without Goodwill)	1,000
21	Request for Hearing	1,000
22	Application for Registration of Registered User	5,000
23	Application for Variation or Cancellation of the Registration of a Registered User	1,500
24	Request by the Registered Proprietor / Registered User of a Registered Trade Mark for entering a change in the description, alteration of Trade / Business Address or Correction of an Error in the Address in the Register	1,000
25	Request by Registered Proprietor of a Registered Trade Mark for making, cancelling or varying of an entry in the Register	1,000
26	Request by a person who is not the Registered Proprietor of a Registered Trade Mark to Strike Out Goods or Services, Revoke the Registration, Impose / Limitations, Vary the Registration	1,000
27	Request by Registered Proprietor of a Register Trade Mark for Entry of a Disclaimer or Memorandum	1,000
28	Request by registered proprietor of a Registered Trade Mark for Entry on the Register of a Note of a Certificate of Validity by the Court	600
29	Request for Certified copies, extracts etc, other than Certificate of Registration	600
30	Application to Intervene in Proceedings	1,000
31	Request for search of documents open to public inspection	100 per 30mins inspection
	and/or to obtain photocopies of documents available to applicant / public	10 per page

**SECOND SCHEDULE  
(Rule 5)**

**FORMS**

<b>Form TM</b>	
1	Form of Authorisation and Request to Enter, Alter or Substitute an Address for Service
2	Application to Register as a Trade Marks Agent
3	Application for Renewal of Registration / Reinstatement of Trade Marks Agent
4	Request for Search
5	Application for Registration of a Mark *For one kind of goods / services *Two to Four kinds of goods / services *Five and more kinds of goods / services  For Certification Mark (flat fee) For Collective Mark Additional fee for Series Marks
6	Request for Statement of Grounds of Decision
7	Notice of Opposition
8	Filing of Regulations Governing the Use of a Collective Mark or Certification Mark
9	Instruction to Advertise in Journal
10	Instructions to Register and Issue a Certificate of Registration *For one kind of goods / each item of Textile goods / services *Two to Four kinds of goods / each item of Textile goods / services stated *Five and more kinds of goods / Textile goods /services Additional fee for Series Marks
11	Counter-Statement to a Notice of Opposition, and other Proceedings
12	Filing of evidence by way of affidavit
13	Notice to the Registrar of attendance at hearing
14	Request for correction of a clerical error in an application or for permission to otherwise amend an application for registration
15	Application to dissolve the Association between a Registered Trade Mark and other Registered Trade Mark(s)
16	Application for Renewal of Registration of a Trade Mark *For one kind of goods / services *Two to Four kinds of goods / services *Five and more kinds of goods / services
17	Application for Late Renewal of Registration of a Trade Mark *For one kind of goods / services *Two to Four kinds of goods / services *Five and more kinds of goods / services

18	Application for Restoration and Renewal of Registration *For one kind of goods / services *Two to Four kinds of goods / services *Five and more kinds of goods / services
19	Application for Extension of Time (per application) *Per month of extension (limited to maximum of 6 months)
20A	Application For Registrar's Opinion for The Validity of Proposed Assignment of a Registered Trade Mark
20B	Application and Declaration of an Assignment / a Transmission for Registration as Proprietor of a Trade Mark
20C	Request for Approval and Directions for Advertisement (of Assignment Without Goodwill)
21	Request for Hearing
22	Application for Registration of Registered User
23	Application for Variation or Cancellation of the Registration of a Registered User
24	Request by the Registered Proprietor / Registered User of a Registered Trade Mark for entering a change in the description, alteration of Trade / Business Address or Correction of an Error in the Address in the Register
25	Request by Registered Proprietor of a Registered Trade Mark for making, cancelling or varying of an entry in the Register
26	Request by a person who is not the Registered Proprietor of a Registered Trade Mark to Strike Out Goods or Services, Revoke the Registration, Impose / Limitations, Vary the Registration
27	Request by Registered Proprietor of a Register Trade Mark for Entry of a Disclaimer or Memorandum
28	Request by registered proprietor of a Registered Trade Mark for Entry on the Register of a Note of a Certificate of Validity by the Court
29	Request for Certified copies, extracts etc, other than Certificate of Registration
30	Application to Intervene in Proceedings
31	Request for search of documents open to public inspection and/or to obtain photocopies of documents available to applicant / public

### THIRD SCHEDULE

#### TMR FORMS

Form TMR	
1.	Notice of Non-compliance / Missing Information
2.	Notice by Registrar to Applicant of Non-completion of Registration
3.	Certificate of Registration
4.	Notice of Expiry of Registration of a Trade Mark
5.	Certificate of Registrar in respect of Proposed Assignment / Transmission
6.	Notice by Registrar to review his Decision
7.	Notice of Intention to Advertise for Registration
8.	Notice by Registrar to Change Classification
9.	Notice of Intention to Register the Trade Mark
10.	Notice by Registrar of Hearing

**FOURTH SCHEDULE  
(Rule 6)**

**CLASSIFICATION OF GOODS AND SERVICES**

1. International Classification of Goods and Services for the Purposes of the Registration of Marks established pursuant to the Nice Agreement of 15 June 1957 including any amendments made to it from time to time.
2. International Classification of the Figurative Elements of Marks established pursuant to the Vienna Agreement of 12 June 1973 including any amendments made to it from time to time.

**FIFTH SCHEDULE**

**(List of Textile Goods refer to in Rule 102)**

**(To reproduce List of Items given in the draft Trade Mark Rules 2009)**

## SIXTH SCHEDULE

Scale of Costs allowable in proceedings before the Registrar commenced on or after \_\_\_\_\_  
(date of coming into force of these Rules)

		<b>Fee Taka</b>
1.	Application or Notice of Opposition and accompanying statement	2,000
2.	Considering statement of case in reply	1,500
3.	Preparing and filing evidence	Up 10,000
4.	Considering evidence	On half of Item 3
5.	Preparation and attendance at hearing	Up to 10,000
6.	Where a party appears in person or where attendance of a party's witnesses is required by the opposite party, allowance will be made for general expenses and travelling, but the allowance for general expenses and travelling will not exceed TK 5,000 per person per day, nor an overall maximum per party of TK 7,000 per day (regardless of the number of witnesses)	