

## **Analytical Study of the Existing Law and Reported Case Decision Regarding Deceptive Similarity of Trademark Infringement**

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### **Abstract**

The write up basically deals with the existing law and reported case decision regarding infringement of a trademark for deceptive similarity and confusion among the consumers. The *Trademark Act 2009* provides that a mark should be distinctive and it will not be deceptively similar with other trademark and it does not provide any test to measure deceptive similarity. At the time of deciding the dispute between two parties in respect of infringement for deceptive similarity how the court take their decision by considering what circumstances. Through this write up I have tried to find out whether there is any ambiguity or not in the decision of the court, whether the decision of the court varies in same situation or not. If varies on what circumstances it is varied. At the time of taking decision whether the court consider all the possible facts to measure deceptiveness or not. After analyzing the cases, which are in respect of deceptive similarity filed before the high Court Division and Appellate division of Supreme Court of Bangladesh and also the cases of others countries, I found that there is no scale to test the deceptiveness. The deceptiveness is measured by considering the factual circumstances and it varies case to case even if same situation arises. Finally I recommend that there must have a guideline to test the deceptiveness. All the possible factors should be included in this list so that the court can consider all the facts at the time of taking their decision.

**Key words:** Trademark, Infringement, deceptive similarity, national law, factual circumstance.

## Introduction

Before the achievement of independence of Bangladesh the trademark was governed by *The Trademark Act 1940* which was inherited from the pre independence era and after the independence the said law applied in Bangladesh by virtue of Article 149 of *The Constitution of the People's Republic of Bangladesh*<sup>1</sup>. After that the government of Bangladesh repealed the Act and enacted *The Trademark Act 2009*.

Trademark is a property of its proprietor. The value of which depends on how the proprietor of Trademark can gain reputation and fame over the country or even all over the world through its use. When consumers see a trademark, at a glance they get an impression on it and that mark gives them an idea regarding the product or any service.

## Methodology

The methodology in this paper has been based on qualitative research mainly relies on the deceptive similarities of trademark infringement case facts in Bangladesh and some other countries. In addition, relevant statutes, law journals, legal articles, case decisions, authoritative books, relevant theses and various news reports have been utilized in conducting this research work.

## Definition of Trademark

World Intellectual Property Organization (WIPO) provides a definition in respect of trademark which is “A trademark is a sign capable of distinguishing the goods and services of one enterprise from those of other enterprises<sup>2</sup>”.

Section 2(8) of *The Trademark Act 2009* provides that-

“Trademark means a registered trademark or a mark used in relation to goods for the purpose of indicating a connection in the course of trade between the goods and the person having the right as proprietor to use the mark or a mark used in relation to a service so that it may be indicated that the person has the right as a proprietor to use the mark in the course of trade or in relation to the other provision of this act, a mark used or proposed to be used in relation to any service or goods indicating a connection in the course of trade between the goods and the person having the right, either as proprietor or as registered user”.

## Definition of deceptive Similarity

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<sup>1</sup> Mohammad Monirul Azam, *Intellectual Property WTO and Bangladesh* ( New Warsi Book Corporation, 1<sup>st</sup> ed) 167.

<sup>2</sup> World Intellectual Property Organization, *Trademarks In general* <[http://www.wipo.int/madrid/en/faq/trademarks.html#P3\\_21](http://www.wipo.int/madrid/en/faq/trademarks.html#P3_21)>.

If we look at the definition of deceptive similarity, we can find out this word that

“Deceptive similarity mark” refers to a mark which is likely to deceive or cause confusion and nearly resemblance another mark registered under this Act<sup>3</sup>.

Sometimes the consumers cannot identify whether the mark is of that company which they desire, when they see similar mark of two different companies. They become confused and misled in that time. Therefore, the question of deceptive similarities between two or more trademarks comes to mind.

### **Cause of Infringement**

There are some barred to be registered of a trademark prescribed in *The Trademark Act 2009*. One of them is whether the mark is likely to deceive or cause confusion among the consumers or whether the mark is deceptive with the existing registered trademark<sup>4</sup>.

The mark will not be registered in respect of any goods or services if it is well known mark and it is registered in Bangladesh for goods and services which are not identical or similar to those in respect of which the registration is applied for and the mark is used in such a way that it is seemed that there is a connection between those goods or services and the registered owner of the mark<sup>5</sup>.

In the case of *Dominous Pizza and others v Domino's Pizza inc* the plaintiff was a well known worldwide company and it acquired registration in 385 countries including Bangladesh where the registration of the said company was pending. This company has worldwide reputation goodwill<sup>6</sup>. When the defendant party started their business with the name of Dominous pizza the earlier company was incurring a huge loss. As a result they filed a suit against the defendant. There were a number of claims including a decree directing the defendants to deliver up to the plaintiff for destruction or defacement of all the products, menu cards, bill beaks, and any other offending labels, packaging and other promotional printed materials<sup>7</sup>. The district court gave its judgment in favor of plaintiff. When the defendant appealed before the high court Division, the High Court discharged the appeal without any order as to cost<sup>8</sup>. From this judgment it is clear that no trademark will be accepted which is similar with the well known mark.

The question of infringement of a mark comes to mind when a person not being the registered proprietor uses the trademark which is deceptively similar to an existing registered trademark and make confusion among the consumers<sup>9</sup>. In both case the deceptive similarity and confusion of consumers is precondition to be registered or to be infringed, but there is no scale to measure that in what cases and in the existing of what factors it will be considered as deceptive of the mark.

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<sup>3</sup>*The Trademark act 2009*, s 2(20).

<sup>4</sup> *ibid* ss 8 (c) 10 (1).

<sup>5</sup>*Ibid* s 10(5).

<sup>6</sup>*Dominous Pizza and others v Domino's Pizza inc* (2009) 60 DLR 780, 3.

<sup>7</sup>*Ibid* 2(c).

<sup>8</sup>*Ibid* 13.

<sup>9</sup> *The Trademark Act 2009* s 26 (1).

The test of deceptiveness or ordinary consumer's confusion varies case to case<sup>10</sup>. There are some IP researchers who could identify the problems regarding the test of deceptiveness or confusion. One of them is Barton Beebe who described as "in a severe state of disrepair" he also criticized the matter of formulation of confusion which varies case to case<sup>11</sup>.

### **Analyzes of existing law and reported cases**

There are various issues to enact *Trademark Law*. One of them it is formulated to prevent the deceptiveness and confusion among the ordinary consumers, but consumers often get confused and mislead and the Law could not give them any remedy. If there are scales in law to measure the deceptiveness, the consumers do not fall in this situation and they do not lose their interest to buy their desire product for the second time.

In my write up I have focused on the existing law of Trademark and the reported cases, which are in respect of deceptive similarity, filed before the High Court division and Appellate Division of the Supreme Court of Bangladesh. In most of the cases the adjudicator took their decision on the basis of either statutorily or judge-made test. There is no constructive measure to test the deceptive similarity as it is evaluated on the basis of circumstances, intention of the party and consumer's perspective and other practical issues which are raised before the court.

In *Md. Rahimuddin mia (Bharasa) v The Registrar of Trade Marks and another*, it was stated by the justice Syed Amirul Islam that

‘The test of likelihood of deception or confusion is dependent on the nature of the goods, marketing methods, consumer awareness etc’<sup>12</sup>.

In this case the situations which were considered those were factual matters of both of the parties. Since the biries are consumed by the indigenous poor people and most of them are illiterate, they buy this product identifying it by the mark and the said justice considered the mark of both parties and their channel to market the product<sup>13</sup>.

The decision of the said Justice was good in the sense that he tried to make a list of the factors which causes deception and confusion among the consumers as to the nature of the goods, marketing methods and consumer awareness.

The get up of the product itself may be responsible to be deceptively similar. If the product of one enterprise is similar in such a way that it could not differentiate by seeing the shape of the product, the color of the product, the packaging of the product of that enterprise with the product of other enterprise and make confusion among the consumers, it will also be considered infringement for

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<sup>10</sup> Barton Beebe, ‘An Empirical Study of the Multifactor tests for Trademark Infringement’ (2006) 94 (6) *California Law Review* 1581.

<sup>11</sup> *Ibid* 1582.

<sup>12</sup> *Md. Rahimuddin mia (Bharasa) v The Registrar of Trade Marks and another* (2008) 26 BLD (HCD) 233, 25.

<sup>13</sup> *Ibid*.

deceptive similarity. In *Pakistan Battery Manufacturing co. Karachi V Md. Hussain and others* it was stated that

“In considering whether the resemblance of the get up of the different goods is such as to cause deception, it must be remembered that the goods will not be seen side by side, and the proper test is whether the get-up of the defendant’s goods would be likely to deceive a purchaser who is acquainted with the plaintiff’s get up, but trusts to his memory”<sup>14</sup>.

The class of purchasers and the situation of buying are also the measures to be taken into consideration for the infringement due to deceptive similarity. In the same case the court stated that

“The Court must also have regard to the class of purchasers by whom the goods would normally be bought and the circumstances of sale”<sup>15</sup>.

The idea of situation of buying a product has been elaborately stated in *Jamal Uddin Ahmned V Abdul Haque and another*. In this case the court stated that

“When a member of the public goes for shopping he goes there not just for his pleasure in buying a cast iron fitting but he will want to purchase a particular item of commodity which will be some use to him”<sup>16</sup>.

From this statement of the Court it is clear that to fix a mark as a deceptive similar mark it is necessary to scrutinize all the possible matters. Here the Court tried to find out the intention of the purchasers and the situation of purchasing of that particular product.

In *MK Electric Ltd v Mozammel Haque*, Justice ATM Fazle Kabir stated that

‘From the reading of section 8 and 10 of the *Trademark Act 1940* which gives us sufficient indication to hold that there is a legal prohibition for registration of a trade mark which is phonetically identical with the previously registered trade mark’<sup>17</sup>.

In this case the said justice relied on the section 8 and 10 of the said Act which says the deceptiveness and confusion of the consumers, but this provision does not elaborately says the factors to be taken to prohibit the registration in case of deceptiveness and confusion. In this case the mark was phonetically identical. As a result the said justice ordered the Registrar not to register the mark of defendant<sup>18</sup>.

From the discussion of the case of *Md. Rahimuddin mia (Bharasa) v The Registrar of Trade Marks and Another* and the case of *MK Electric Ltd v Mozammel Haque* it can be said that the deceptiveness varies case to case. In the first case the Justice could mention the mark of opponent

<sup>14</sup>*Pakistan Battery Manufacturing co. Karachi V Md. Hussain and others* (1970)22 DLR (WP) 118, 10.

<sup>15</sup>*Ibid.*

<sup>16</sup>*Jamal Uddin ahmned V Abdul Haque and another* (2003) 55 DLR 102, 25.

<sup>17</sup>*MK Electric Ltd v Mozammel Haque* (2008) 60 DLR (AD) 53, 14.

<sup>18</sup>*Ibid* 17.

party as visually and phonetically similar which has been mentioned in second case. On the other hand in second case Justice could identify the deceptiveness through considering the matter of identical product, its marketing method, consumer awareness etc.

Sometimes the price of a product may cause confusion among the consumers. It means price of the product may be responsible to be a deceptive similar mark. If the product is such nature that which price is low, the people will not concentrate on the brand value in respect of this product. For example if someone wants to buy a candy which price is more or less one to ten taka and if the person could not find his desired brand, he will buy the other one instead of his desired brand's product. On the other hand if the product is such in nature that the price of that product is high, the people will pay concentration more on it. For example if a person wants to buy a car from TOYOTA Company, he will not go for other options to buy a car from Honda, Nissan Etc Company.

Similar price and similar products of two different enterprises may cause confusion among the consumers. In the case of, *AMF INCORPORATED, a corporation, plaintiff-appellant v SLEEKRAFT BOATS, a sole proprietorship, and Bruce E. Nescher, an Individual, Defendants-Appellees*, the United States Court of Appeals stated that-

“AMF contends these boat lines are competitive. Both lines are comprised of sporty, fiberglass boats often used for water skiing; the sizes of the boats are similar as are the prices. Nescher contends his boats are not competitive with Slick craft boats because these are true high performance boats intended for racing enthusiasts”<sup>19</sup>.

The Court further stated that-

“There is no evidence in the record that both lines were sold under the same roof except at boat shows; the normal marketing channels used by both AMF and Nescher are, however, parallel. Each sells through authorized retail dealers in diverse localities. The same sales methods are employed. The price ranges are almost identical”<sup>20</sup>.

From the consideration of the description given by United States Court in that case it is clear that the price of a product of an enterprise can be identical with the price of the same product of other enterprise and it may cause confusion among the consumers.

In *Team Tires Plus, Ltd. v. Tires Plus, Inc.*, the Court has identified six factors as a guideline for evaluating the likelihood of confusion. Those factors are that-

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<sup>19</sup>*AMF INCORPORATED, a corporation, plaintiff-appellant v SLEEKRAFT BOATS, a sole proprietorship, and Bruce E. Nescher, an Individual, Defendants-Appellees*, 599 F.2d 341 (9 Cir. 1979) , IV.

[http://scholar.google.com/scholar\\_case?case](http://scholar.google.com/scholar_case?case).

<sup>20</sup>Ibid 5.

(a) the degree of similarity between the marks; (b) the intent of the alleged infringer in adopting its mark; (c) evidence of actual confusion; (d) the relation in use and the manner of marketing between the goods or services marketed by the competing parties; (e) the degree of care likely to be exercised by purchasers; and (f) the strength or weakness of the marks<sup>21</sup>. After that the court said that no single factor in the multifactor test is dispositive and that all factors must be considered as an interrelated whole<sup>22</sup>.

If we relate this case with the previous two case we can easily say that when the question of deceptiveness arise in respect of two trademark, all the possible factors should describe with explanation. Otherwise there will be some ambiguity to be altered the decision by the Appellate Court.

In *Hamza Rubber industries v Golam Dastagir gazi* case the question was regarding infringement in respect of using the same mark consisting of two elephant embossed on the products by the opposite party<sup>23</sup>. Therefore the plaintiff claimed perpetual injunction to manufacture and market the products<sup>24</sup>. To dissolve this question The Court said that-

‘If the offending trade mark of the defendants infringes the trade mark rights of the plaintiff then no amount of monetary consideration can come in the way to restrain the defendants from using a trademark even nearly resembling that of the plaintiff  
.....’<sup>25</sup>.

In this case if the trademark of opposite party infringed the trade mark of plaintiff, it was not considered that how the trade mark of opposite party infringed the mark of plaintiff. Whether the mark is identical with the mark of plaintiff or identical with the product of plaintiff or the consumer awareness to buy this product, etc. And if it did not infringe the mark of plaintiff, The Court did not give any explanation as regard why the mark of opposite party did not infringe the mark of plaintiff. The question of perpetual injunction will be granted after deciding the matter whether there is infringement or not. To decide the matter of deceptiveness the court discussed a little.

In *Sunil Kumar Das v Deputy Registrar of Trade Marks and Another* case The Court said that the use of mark by the appellant was not bona fide<sup>26</sup>. The appellant adopted the mark ‘Cannon’ from the respondent no.1. The respondent no.1 was using the mark ‘canon’ from various years in Bangladesh and it is a well known mark<sup>27</sup>.

From this judgment it can be said that the test to measure the deceptiveness does not only refer to the matters described before but also includes the fact of bona fide. The intention of the proprietor to fix the trade mark of his business is also considered to grant registration before the registrar.

<sup>21</sup>*Team Tires Plus, Ltd. v. Tires Plus, Inc.*, 394 F.3d 831, 833 (10th Cir. 2005) II, <<https://casetext.com/case/team-tires-plus-ltd-v-tires-plus-inc/#.UyVJ4VfrKKE>>.

<sup>22</sup>*Ibid.*

<sup>23</sup>*Hamza Rubber industries v Golam Dastagir gazi* (2001) 53 DLR 430, 2.

<sup>24</sup>*Ibid.*

<sup>25</sup>*Ibid* 15.

<sup>26</sup>*Sunil Kumar Das v Deputy Registrar of Trade Marks and another* (2007) 27 BLD (HCD) 423, 6.

<sup>27</sup> *ibid* 2.

When a trade mark of a proprietor of a business is identical with the well known mark, it should be considered that there must have ill intention to mislead the consumers. PARIS Convention and our law give protection to the well known mark. Article 6bis of PARIS Convention says that if anyone comes to register to the registrar of a mark which is identical or similar with the well known mark, the registration of that mark will be refused or canceled the registration and prohibited using the mark if the legislation of that country permits. Section 10(4) of *The Trademark Act 2009* provides that no trade mark shall be registered in terms of any goods or services if it is identical with, or confusingly similar to well known mark.

In *Sunil Kumar Das v Deputy Registrar of Trade Marks and Another*, the appellant used the mark ‘CANNON’ which is identical with the mark of opponent party<sup>28</sup>. The appellant failed to produce any valid reason for adopting the mark which is registered in favor of respondent no.1 and the use of the same mark will make confusion and the conduct of the appellant in using the trade mark of a foreign country is not proper<sup>29</sup>.

In *Nabisco Biscuit and Bread Factory Ltd v baby Food products ltd and Another* case the petitioner alleged that the opposite party No.1 has dishonestly obtained registration of the Trade mark “NABICO” in order to benefit from the good will of the business of the petitioner who had registered the Trade Mark “NABISCO”<sup>30</sup>.

In this case the question was that whether the impugned Trade Mark “NABICO” is similar to the Mark “NABISCO” or not<sup>31</sup>. The court said that two words are visually and phonetically similar when pronounced in English. When these two words are pronounced in Bangla, it does not appear to be quite similar phonetically and visually<sup>32</sup>.

In this case the Trade mark of Respondent No.1 has been scrutinized properly at the time of giving judgment by the court. The mark comprises with the device comprising a crescent moon and star, the letter B and a photograph of a lady<sup>33</sup>. The Court said that the Trade mark is to be looked at as a whole and if looking at the Mark as a whole the impugned Mark and the Mark of the petitioner appear to be dissimilar<sup>34</sup>. After that The Court considered the marketing process of products of both parties and consumer’s view. Considering the consumer’s view the court said that there is every likelihood that the consumer, who will take for consumption a single candy, will see the either “NABISCO” or “NABICO” written on the candy itself or on the wrapper and the similarity of the words is such that the consumers are bound to be confused or deceived. In such view of the matter, the registration of the Trade Mark of opposite party infringes the provision of section 8 (a) of the *Trade mark Act 2009* <sup>35</sup>.

From this case it is clear that in spite of being dissimilar of that mark, this mark can be liable for infringement for the confusion of consumer. Now the question is whether there is any test to

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<sup>28</sup>*Sunil Kumar Das v Deputy Registrar of Trade Marks and another* (2008) 60 DLR 44, 2.

<sup>29</sup>*Ibid* 6.

<sup>30</sup>*Nabisco Biscuit and Bread Factory Ltd v baby Food products ltd and another* (2006) 58 DLR 287,2.

<sup>31</sup>*Ibid* 12.

<sup>32</sup>*Ibid*.

<sup>33</sup>*Ibid*.

<sup>34</sup>*Ibid*.

<sup>35</sup>*Ibid*.

measure the confusion or not. If the wrapper of the product, the photograph of lady, the letter of B, the device comprising of crescent moon and star are not similar with the mark of opponent party, how it will create confusion among the consumers, since it is a distinctive Mark.

If we look at the *Sony Kabushika kaisha v Sonyo Industrial Co. pvt. Ltd. And Another*, we can see that the respondent No.1 filed a trade Mark application for the registration of mark “SONYO” to the registrar which is similar with the Mark “SONY” of appellant<sup>36</sup>. After considering all the process the registrar accepted the Trade mark and registered the Mark<sup>37</sup>. When an appeal was filed before the HCD the court reversed the decision of registrar and the registrar is directed to dispose of the opposition case<sup>38</sup>.

From this case it is clear that the Mark “SONYO” of respondent No.1 is visually and phonetically similar to the Mark “SONY” of appellant and the consumer may confuse with those mark at the time of buying product.

On the other hand if we look at the case of *Major General Amjad Khan Chowdhury v Parle Agro products Ltd. And another*, we can see that in this case the court said that there is no conflict in between the Trade Mark “PRAN FROOTO” and FROOTI, if both the product with their respective Trade Name appears in the self of the market shop<sup>39</sup>. The court further said that the Mark PRAN FROOTO is completely dissimilar with the Mark FROOTI and it will not create any confusion among the consumers<sup>40</sup>. As a result the Mark FROOTI is considered as a distinctive mark by the court.

Now if we relate this case with the previous two cases we can see that In *Nabisco Biscuit and Bread Factory Ltd v baby Food products ltd and another*, case the court, although the mark is distinctive and dissimilar and even the court scrutinized all the possible measures, decided that the mark infringed the mark of opposite party as it may create confusion among the consumers. In the last case there is possibility to arise confusion among the consumers as their color of product the phonetically and visually outlook are similar even the price of the both product is similar with each other. In this case the court did not consider the class of consumers, the marketing policy. The consumers of their product are urban people as well as the rural people. The rural people are not very much aware about their health. As a result they buy the product which has been shown before them by the shopkeeper. In the case of *Sony Kabushika kaisha v Sonyo Industrial Co. pvt. Ltd. And another*, the court considered the matter of confusion among the consumers, the class of consumers, their marketing policy like through what channel the product are disseminated, phonetically and visually similarity of the Mark.

In the case of *Universal Pharmaceutical Ltd and another v Social marketing Company and others* the Plaintiff started producing and marketing the life drug in the 1983 and obtained registration in the same year by the name of Orsaline<sup>41</sup>. The defendant started producing and marketing the life

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<sup>36</sup>*Sony Kabushika kaisha v Sonyo Industrial Co. pvt. Ltd. And another* (2008) 16 BLT (HCD) 49, 2.

<sup>37</sup>Ibid 5.

<sup>38</sup>Ibid 13.

<sup>39</sup>*Major General Amjad Khan Chowdhury v Parle Agro products Ltd. And another* (2012) 10 BLC 730, 35.

<sup>40</sup>Ibid.

<sup>41</sup>*Universal Pharmaceutical Ltd and another v Social marketing Company and others* (1998) 50 DLR 548, 1.

drug in the year of 1994 and obtained registration in the year of 1993 by the name of Oralsaline<sup>42</sup>. The respondent filed a suit stating that the appellant was producing and marketing the product with a similar get-up of respondent and they were making financial gain by the goodwill of Orsaline<sup>43</sup>.

In this case The Court stated that-

“Phonetically and visually the marks “Orsaline” and “Oralsaline” invite confusion and deception among the consumers and since the products are life drug, more consideration needs to be given”<sup>44</sup>.

From the consideration of the matter discussed above the court disposed of the appeal and directed the appellant not to run the business marketing and selling of the said products<sup>45</sup>.

The decision of the court was good in the sense that the court considered the health risk of consumers as a measure of deceptive similarity beside the other measure to test the deceptive similarity.

### **Competitive analysis with the national law of Bangladesh and other countries in respect of trademark**

Although the gist of Bangladeshi *Trademark Act* and the *Trademark Act* of other countries is same, there are some different in wording. Through analyzing this word the wideness of the act can be justified to prevent the deceptiveness and confusion among the ordinary consumers.

If we look at the *Trademark Act 2009* of Bangladesh which states regarding deceptive similarity that the trademark of any enterprise will not be registered if the use of which is likely to cause confusion or deception among the consumers. On the other hand the *Trademark Act 1946* of USA which states that-

“The trademark of one enterprise will not be registered if it Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States”<sup>46</sup>.

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<sup>42</sup>Ibid 2.

<sup>43</sup>Ibid 3.

<sup>44</sup>Ibid 14.

<sup>45</sup>Ibid.

<sup>46</sup>*Trademark Act 1946 ( USA ) s-2.*

In the Bangladeshi Act there are scattered of the provisions in respect of deceptive similarity. To find out whether there is deceptive similarity or not it is necessary to overlook all the provision altogether whereas in USA law there is uniformity in the provision. All the factors for not to grant the registration are in one provision. Although there are not any measures to test the deceptiveness in respect of an alleged mark, there are some clues to find out the deceptive similarity in same provision. For instance there are clues to test the connection between the alleged mark and the mark of the other party, the geographical indication etc.

If we look at the *Trademark Act 1994* of the UK which states in respect of deceptive similarity that-

“The trademark of one enterprise will not be registered which is in such a nature that this trademark will deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)”<sup>47</sup>.

In the Act of UK after describing the fact of deceptive similarity for not to grant registration there has been mentioned some examples like the nature, quality, and geographical indication to measure the deceptive similarity. On the other hand in our law the provision is so direct and there is not any clue to test the deceptive similarity.

From the consideration of above discussion regarding the trademark law of these three countries it is clear that although there are no measures to test the deceptiveness in respect of an alleged mark but in the consideration of wording of the provision of the of the law of the said countries are different. Some of them are more elaborate than the others and some of them are uniform it means all the factors are in one provision.

## **Conclusion**

Although it is a practical issue whether an alleged trademark of an enterprise is deceptive with other enterprise or not, the court can consider all the possible measures to test the deceptiveness. The provision of law of our country in respect of deceptive similarity has been uttered in such a way that there is left a discretionary power to the court. The provision says that if the mark of one enterprise is deceptively similar with the mark of other enterprise, it will be considered infringement of the mark of that enterprise. How the court will measure the deceptive similarity and what measures should be taken into consideration, it is not described in law. Even the wording of the provision is so direct that it depends on the wish of court whether the court will consider all the possible measures and scrutinize all the factors. In that time the court will not be bound to take all the possible measures to take the decision. Therefore in some of cases we can see that the

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<sup>47</sup>*Trademark Act 1994* (UK) s-3(3) (b).

decision taken by the court without scrutinize all the measures, although in some cases it was stated that at the time of decision all the factors should be taken into consideration. From the consideration of our statutory law and the case law described above I can draw a conclusion that there is not exhaustive list to test the deceptiveness and the causes to confusion among the consumers. Therefore the ambiguity comes to mind from the decision of the court. One can agree with the decision and another can disagree with the decision as our law does not give any idea regarding the test of deceptiveness. In this situation my recommendation is to insert all the possible measures in the provision of our law by observing all the cases filed in Bangladesh as well as in abroad regarding the deceptive similarity between two Mark, which includes all the possible factors which may cause deception and confusion among the consumers. I am not telling to insert all the possible measures in a separate provision under the heading of multifactor test of deceptive similarity rather it can be stated in the provision of law in such a way that after describing the provision in respect of deceptive similarity the measures to test the deceptive similarity can be written in the place of examples. For example “no trademark shall be registered in respect of any goods or services if it is deceptively similar (for instance if it is phonetically similar, visually similar, similarity in marketing method, similarity in price, the situation of purchasing, the intention of the purchaser, the nature of the product, quality of the product, the geographical indication of the product, etc)”. It will guide the court make it easy to take their decision. If it happens, the possibility of ambiguity will be decreased. This section will not give the exhaustive list of factors but it will give the list which has been considered in various cases.

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11. *Pakistan Battery Manufacturing co. Karachi V Md. Hussain and others* (1970)22 DLR (WP) 118.
12. *Sony Kabushika kaisha v Sonyo Industrial Co. pvt. Ltd. And Another* (2008) 16 BLT (HCD) 49.
13. *Sunil Kumar Das v Deputy Registrar of Trade Marks and Another*(2007) 27 BLD (HCD) 423.
14. *Sunil Kumar Das v Deputy Registrar of Trade Marks and Another*(2008) 60 DLR 44.
15. *Team Tires Plus, Ltd. v. Tires Plus, Inc.*, 394 F.3d 831, 833 (10th Cir. 2005)
16. *Universal Pharmaceutical Ltd and another v Social marketing Company and others* (1998) 50 DLR 548.

### **C (Legislation)**

17. *THE Trademark Act* 2009.
18. *Trademark Act (UK)* 1994.
19. *Trademark Act (USA)* 1946.
20. WIPO world Intellectual Property Organization, Trademark In general.