

## OPINION

**From:** Assoc. Prof. Tanya Panayotova Gradinarova, PhD, Associated Professor in Civil Procedure, Law Faculty, University of National and World Economy, member of scientific jury on defense of dissertation thesis for acquiring of educational and scientific degree “PhD” in research field 3.6 Law (Intellectual Property Law)

Author of Dissertation Thesis: Tatyana Borisova Zhilova, PhD candidate on individual training course in the Department of Civil Law Studies of the Law Faculty of Sofia University in research field 3.6 Law (Intellectual Property Law)

Theme of Dissertation Thesis: **“Revocation of the registration of trademark”**

### DEAR MEMBERS OF THE SCIENTIFIC JURY,

In compliance with Order №RD38-362 dated 30.07.2020 of the Rector of Sofia University I participate as a member the scientific jury on defense of dissertation thesis of **Tatyana Borisova Zhilova** on the topic **“Revocation of the registration of trademark”** for acquiring of educational and scientific degree “PhD” in research field **3.6 Law (Intellectual Property Law)**

#### **I. Description of the presented dissertation thesis and information on the PhD candidate**

1. The dissertation **"Revocation of trademark registration"** presented for defense by Tatiana Zhilova is the first comprehensive and systematic scientific research in the Bulgarian literature of the analyzed institute, its grounds, procedures and consequences. The chosen topic is relevant due to the theoretical and practical problems that arise in the application of the subject matter of the work, as evidenced by the significant volume and thoroughly analyzed by the author case law of national courts and the case law of the Court of Justice. The research meets the criteria for dissertability and provides an opportunity to contribute to the law. The work is of interest not only from a theoretical point of view, but also has a practical significance, as it is useful for the future development of case law.

2. The professional biography of Tatiana Zhilova shows a lasting interest in research in the field of intellectual property law. The PhD candidate has obtained master's degree in law at the Faculty of Law at Sofia University "St. Kliment Ohridski " in 1997, and in 2009 - Master of European Law. After graduating from law school, she worked as a lawyer, registered in the Bar Association - Varna, and subsequently - as a legal adviser in the Department of Law, Legal Services and Procedural Representation and Head of the Department of European Integration and International Legal Cooperation in the Supreme Judicial Council. From 2007 to the present she is a judge in the Administrative Court-Sofia city, with the rank of a judge in the Supreme Court of Cassation and the Supreme Administrative Court. The other qualifications of Judge Tatiana Zhilova are impressive. Since 2012 she has been combining the functions of a judge and lecturer at the National Institute of Justice, and from 2008 to the end of 2019 she has improved her professional growth by participating in over 25 international seminars, internships, discussion forums and

specialized trainings in Bulgaria and other member states of the European Union, with an emphasis on the field of its scientific interests - intellectual property rights, including as a lecturer of some of them.

The PhD candidate graduated the individual training course gaining the right to defend a thesis by order of the Rector of Sofia University "St. Kliment Ohridski" № RD-20-1034 / 17.07.2020 based on a decision of the Faculty Council of the Faculty of Law from **14.07.2020**.

3. The presented abstract in a volume of 29 pages and the reference for the contributions contained in it objectively reflect the content of the work and the main scientific achievements. At the beginning of the abstract the subject, goals and specific tasks of the research are correctly outlined (p.1 -2) and its methodological basis is indicated, in which the author skillfully uses the historical and comparative analysis (p. 2).

#### **4. Publications**

The PhD candidate published three researches on the topic of the dissertation:

4.1. The new concept of a trademark in the Law on Trademarks and Geographical Indications - Administrative Justice, 2019, № 6, pp. 11-20;

4.2. Use of trademarks in commercial activity within the meaning of the Law on Trademarks and Geographical Indications - Commercial Law, 2020, № 1-2, pp. 41-52;

4.3. Use of trademarks on the Internet. - Society and Law, 2020, № 2, pp. 33-43.

The publications on the topic of the dissertation have scientific and applied value, the expressed views of the author within take a place in the finished text of the work. The dissertation shows good scientific creation, enriching and deepening the arguments and conclusions conveyed by the publications on the subjects of research in the presented work. Probably when publishing collections on the topic of dissertation work fulfills the minimum requirements under Art. 2b of the Law on Professional Development Law. The number of the publications fulfills the minimum requirements under Art. 2b of the Law on the Development of the Academic Staff of the Republic of Bulgaria.

The presented dissertation is the result of the work of Judge Tatiana Zhilova as a PhD student on individual training course in the Department of Civil Law Studies of the Law Faculty of Sofia University with research supervisor Assoc. Prof. Dr. Rosen Karadimov.

## **II. General evaluation of the dissertation thesis**

1. The dissertation is in the volume of 242 pages, including content and bibliographic reference, covering cited literature from a total of 51 sources, 44 of which Bulgarian and 7 foreign. Structurally, it contains an introduction, a section called 'introductory notes', but in fact contains a historical overview of the development of the trademark as an institute, seven chapters and a conclusion. The proposals for improvement of the legal framework are made systematically in the separate chapters, as they are

summarized in the final part of the dissertation thesis. There is no balance between the individual chapters - for example, Chapter Five has a volume of only 6 pages, and the issue in Chapter Seven, containing a total of 23 pages, is insufficient for separation in a separate chapter. In the introduction the PhD candidate outlined the subject of development, defined its goals as an attempt to systematize the grounds for revocation of trademark registration and legal consequences, taking into account the peculiarities of different types of trademarks (p.8). The main purpose of this section of the work has been achieved.

The research follows the classic model of dissertation work in scientific research of an individual law institute. The section entitled "Introductory Notes" (pp. 9-13) contains a general historical overview of the legal regimes in the development of the trademark from antiquity to the end of the 19th century, but without focusing specifically on the research institute. The first chapter, entitled "Concept of a trade mark" (p.14-75) has an introductory character and contains a chronological description of the objective law, as a positive side of which should be emphasized the consistent presentation of international and Community law to the current Regulation (EC) 2017 / 1001 of 14 June 2017 on the European Union trade mark (pp. 14-24). The following sections are devoted to the trademark as an object of intellectual property rights (pp. 30-51), with a worthy attempt of the dissertation to propose an up-to-date classification of brands according to different criteria (pp. 40-51), as well as the analysis of the origin, the content and the various grounds for termination of the subjective right to a trademark (p.51-75). It can be regretted that the general characteristics, the derivation of the peculiarities and the purpose of the institute, subject of the research, have not been given enough attention (pp. 70-71). The second, third and fourth chapters are devoted to the three separate grounds for revocation of the registration of a trademark, regulated in Art. 35, para 1 of the LTMGI, as the essential part of the research is contained in chapter two with consistent and thorough analysis of practically the most applicable ground for revocation of the trademark registration - its non-use (pp. 76-139). The fifth chapter, entitled "Revocation of the registration of collective and certificate marks" contains a schematic statement of some of the peculiarities in the grounds for cancellation of their registration (§ 48 - p.160-162; § 49 - p. 162-163), as well as two grounds of the Community act (Article 57 of Regulation (EU) 2017/1001), missing in the national law. The sixth chapter, entitled "Proceedings for revocation of registration and consequences" (pp.165-213) contains a consistent scientific study of the development of the phases in proceedings for cancellation of registration of a national mark (pp.165-191), an EU trade mark (pp. . 191-201) and an international trade mark (pp. 201-206), with a study of the different in nature and scope legal consequences of the cancellation of registration (pp. 206-209). The statement in Chapter Seven, entitled "Distinction of the revocation of registration by similar institutes and proceedings" (pp. 21-237) contains a comparison of the researched institute and the proceedings in which it takes place with the requests to prove the actual use of the mark in proceedings under opposition (pp. 215-219), by deletion (pp. 219-222), with the objection for genuine use in the proceedings for infringement of the mark (p.222-223), as well as with the institutes of restriction of the rights of the trademark owner (pp. 223-232) and refusal of registration (pp. 234-236). The conclusion includes a summary of the PhD student's proposals *de lege ferenda*.

The dissertation is presented in the form and has a volume that meets the requirements of the Department of Civil Law of the Faculty of Law at Sofia University "St. Kliment Ohridski ", and its content corresponds to the conditions of Art. 64 of the Regulations on the terms and conditions for acquiring scientific degrees and holding academic positions at Sofia University "St. Kliment Ohridski ".

2. The presented dissertation work contains general merits, scientific and scientific-applied results of contributory nature.

2.1. The topic is a successful choice and provides an opportunity for its author to thoroughly analyze and shed light on the theoretical and practical problems that arise in the administration of justice in revoking trademark registration. It is characterized by undoubted relevance, theoretical and practical significance, which the PhD student correctly emphasizes.

2.2. The dissertation reveals sufficient theoretical knowledge on the topic, in-depth knowledge and critical analysis of the legal framework and case law in our country, as well as in historical, comparative law and community context. The author has used a good scientific apparatus, the exhibition is built in understandable legal language. The elaboration contains correct controversy and analysis of the different opinions in the theory and case law, with the ability to derive and substantiate the supported scientific theses, with sufficient arguments in their support.

2.3. The work presents in a logical sequence a comprehensive study of the topic. The author's style is accurate, the scientific analysis in the development is sufficient, the research is harmonious and achieves a convincing impact on the reader. The general impression from the reading of the paper leads to the conclusion that the dissertation student has the ability for independent thinking and creative approach in deriving and defending the supported theoretical and applied theses, for comprehensibility and consistency of development.

2.4. The dissertation shows the characteristics of a scientific product with good qualities. The individual issues discussed and the proposals were systematically submitted. The PhD student easily uses the general scientific dialectical, historical and critical-analytical method of research and with the necessary skill and sense of balance applies the scientific methods of interpretation of legal provisions, supported by an in-depth analysis of national and community practice.

### **III. Scientific contributions**

The dissertation also contains a number of specific scientific merits and contributions of scientific and applied nature, the most significant of which are:

1. The elaboration is the first comprehensive monographic study devoted to the scope of the substantive grounds for revocation of a trade mark registration (national, European and international), as well as to the different nature of proceedings for its enactment at national and Community level. In the research the author makes a successful attempt to discuss some traditional solutions in positive law and reaches reasonable independent ones, some of which differ from those generally accepted in

theory and case law. The set topic requires in-depth substantive and procedural knowledge, which the PhD candidate shows in the presented work.

2. The research dedicated to the outline of the concept and the legal nature of the use of the trademark (p.76-80), the comparison between the use of the trademark and the other intellectual property rights (p. 77-78), as well as the substantiated author's thesis about the combined consideration of the two different concepts "genuine use" of the mark and "use in commercial activity", defined as cumulative conditions for the use of the marks in order to preserve the validity of their registration (pp. 82-86).

3. Interesting and successful is the study dedicated to the so-called admissible "variable use of the mark" and the criteria for its establishment in different types of marks (p.96-106). Logically constructed, systematic and with scientific and practical theses is the part of the work containing an analysis of the concept of "reasonable reasons" for non-use of the brand and the criteria for determining them (p.134-139).

4. Thorough and substantiated, with contribution moments is the statement dedicated to the differences between the misleading as an element of fraud as a ground for invalidity of legal transactions and the identically named concept as an element of the ground for revocation of trademark registration under Art. 35, para 1, item 3 of the LMGI (pp. 152-153) and the highlighting of the peculiarities of the latter.

5. Consistent and with scientific contribution is the development in the part of the research on the occurrence of another terminating fact in the course of the proceedings for revocation of the trademark registration and the possible complications in these hypotheses (pp. 167-168), the in-depth comparative analysis between the hypotheses under Art. . 76, para 11 of the LMGD and the term for opinion of the applicant regulated in the provision, on the one hand, and the possibility for requesting renewal of the registration within 6 months after its expiration under art. 65, para 3 of the LMGI, on the other.

The conclusion of the author for compliance of the actions of the administrative body with the principle of proportionality under Art. 6, para 1 of the APC, and upon expiration of the term of registration of the trademark within the administrative proceedings for revocation, to wait for expiration of the maximum term for renewal of the registration before a term for confirmation by the applicant is provided. The author's well-founded thesis for unfoundedness, and not inadmissibility of a request for cancellation of trademark registration due to non-use, submitted before the expiration of the 5-year continuous period of use (p. 169) is also of a practical-applied nature.

6. Consistent, in-depth and with scientific contribution is the research in the part of the detailed examination and analysis of the burden of proof and the subject of proof of the three separate grounds for revocation of a national mark (pp. 189-191).

7. Positive features of the work are the extensive reference to national case law and the in-depth analysis presented by the PhD student of the case law of the Court of Justice of the EU on various issues within the research institute and the procedures for revocation of trademark registration.

8. Scientific contribution is also contained in the argumentation of the proposals made by the PhD candidate *de lege ferenda*, among which I would highlight the proposal to supplement § 1, item 1 of the Additional Provisions of the LMGI with other holders of the subjective right to a trademark (p. 55) and the inclusion of the commercial activity in the use of the mark as a common designation in Art. 35, para 1, item 2 of the LMGI (p. 140).

#### **IV. Critical remarks and recommendations**

According to the presented dissertation, some recommendations could be made, which do not affect its scientific merits, but could serve the author in preparation for its future publication:

1. It is recommended that the historical review proposed by the PhD student contains accents and conclusions for the researched institute, and not to be devoted in general to the origin and development of the brand.

2. The proposed structure of the elaboration may be revised insofar as there is a lack of balance between some of the individual chapters and some of the paragraphs contain a brief statement which does not require their separation (eg § 36, § 52 and § 61).

3. The maintained opinion needs to be reconsidered for strict restriction of the official inspection with an argument from art. 76, para 6 of the LMGI, insofar as the provision contains an obligation of the administrative body to rule on the request, objection, opinions and evidence submitted by the parties, but does not contain any other restriction than the restriction for verification within the maintained grounds for cancellation (166). The substantiated thesis for non-adversarial nature of the administrative proceedings for revocation of the registration (pp. 173-174) contradicts the understanding of its “special character” in comparison with the other administrative proceedings due to the participation of opposing parties in it (p. 171). A somewhat incorrect understanding of the adversarial principle has been expressed as a principle related to “oral and direct hearing of the parties” in the general claim process (p. 174), which could lead to an incorrect opinion about the lack of adversarial proceedings, e.g. in the first phase of the selective cassation appeal under the Civil Procedure Code, which takes place in a closed session without an “oral hearing” (Article 288 of the Civil Procedure Code). I could not share as too extreme the thesis that the negative facts are not subject to proof (p. 190), as it does not correspond to the procedural theory and interpretive practice of the Supreme Court of Cassation (TR № 6/2013 of 15.07.2014 under Interpret. .d. 6/2013, OSGK of the Supreme Court of Cassation). It is also necessary to clarify the opinion expressed that the applicant has reverse evidence to establish the non-use of the mark as a ground for revocation, which he carries out by challenging the evidence presented by its owner (p. 190). In many cases, only counter-evidence will be provided, not reverse proof, which will suffice.

4. Nor can I agree with the expressed opinion that the infringement action in the case of an application for revocation of a trade mark, which is being examined at the administrative stage, should be stayed (p. 196). Such grounds for suspension shall not

be included in the factual composition of Art. 229, para 1, item 4 of the Civil Procedure Code, insofar as the text requires the preliminary ruling to be in the judicial phase of its development to order the suspension. I do not share the view that in case of contradiction between a court decision, a result of completed claim proceedings for an established violation, and a decision of the administrative court on revocation of the registration, the revocation of the entered into force decision under Art. 303, para 1, item 1 of the Civil Procedure Code (p. 208), insofar as the decision of the administrative court does not constitute a newly discovered circumstance or evidence, such as the scope of the provision under the Civil Procedure Code. Applicable could be the hypothesis of Art. 303, para 1, item 3 of the Civil Procedure Code, but not the one under item 1.

5. A more detailed justification of the opinions supported by the author is needed in some places in the work. I find too laconic and unfolded the statement dedicated to the counterclaim as a legal remedy for revocation of the registration of an EU trade mark in infringement proceedings (Article 58, paragraph 1 of Regulation (EU) 2017/1001; pp. 195-198 ). The institute is interesting and specific, and deserves more attention and analysis from the PhD student, especially to provide more arguments in favor of the controversial author's thesis that the decision to uphold the counterclaim for cancellation of registration will have the force of *res judicata*. something *erga omnes*, while that of its rejection - *inter partes* (p.206). The norm of art. 177, para 1 of the APC is not a sufficient argument for substantiation of such a conclusion.

## **V. Conclusion**

A comprehensive and in-depth scientific study of a monographic nature on the current topic "Cancellation of trademark registration" is presented for defense. The dissertation meets the requirements provided in Art. 6, para 3 of the Law for the development of the academic staff in the Republic of Bulgaria (ZRASRB), of art. 27, para 3 of the Regulations for its application and art. 64 of the Regulations on the terms and conditions for acquiring scientific degrees and holding academic positions at Sofia University "St. Kliment Ohridski ". The work contains scientific and scientific-applied results with a contribution character, reflects the in-depth theoretical knowledge of the dissertation in the specialty, reveals her abilities for independent research and creative approach to the issues included in the subject of research.

For these reasons, I give my positive assessment and suggest to the members of the scientific jury to vote positively in order to acquire Tatiana Borisova Zhilova - PhD student at the Department of Civil Law at the Faculty of Law of Sofia University "St. Kliment Ohridski " the educational and scientific degree " doctor " in professional field 3.6. Law (Civil and Family Law).

Sofia, September 12, 2020.

Member of the scientific jury:

Assoc. Prof. Dr. Tanya Gradinarova

