

## REVIEW

From: Prof. Dr.Sc. Jivko Ivanov Draganov, Department of International Law and EU Law,  
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Subject: the dissertation of Tatiana Borisova Zhilova on the topic "Cancellation of Trademark Registration", presented for the award of the educational and scientific degree "Doctor" in professional field 3.6. "Law", scientific specialty "Civil and Family Law" - Invention, Copyright and Patent Law

**The grounds** for presenting the review is my participation in the scientific jury for the defense of the dissertation according to Order № RD-09-55 / 16.06.2020 of the Rector of Sofia University "St. Kliment Ohridski ”

### **1. Information about the candidate**

Tatiana Zhilova graduated Law from the Faculty of Law at Sofia University “St. Kliment Ohridski” in 1997. Before that she has graduated Literature at the Faculty of Slavic Philology of the same university. She has a master's degree in European law from the master's program at Sofia University "St. Kliment Ohridski” and the University of Nancy, France (2009). Her professional career as a lawyer began in 2008, with her enrollment as a lawyer at the Varna Bar Association.

In 2005, Tatiana Zhilova started holding the position of Chief Expert - Legal Adviser in the Legal and Regulatory Services and Procedural Representation Department of the Supreme Judicial Council Administration, and was subsequently appointed Head of the European Integration and International Cooperation Department. From 2007 until now Tatiana Zhilova is a judge in the Administrative Court Sofia - city. She has the rank of "judge in the Supreme Court of Cassation and the Supreme Administrative Court." Since 2012, Tatiana Zhilova has been a lecturer at the National Institute of Justice.

She speaks German, English and Russian. In 2016, Tatiana Zhilova was certified by the Judicial Board of the SJC with a grade of "very good". She has participated in numerous seminars and trainings on EU trademark issues, organized by the Office for Harmonization in the Internal Market - Alicante, now the EU Intellectual Property Office, as well as in seminars on patent law, administrative justice, etc. She has participated in conferences and specialized in the European Patent Office.

Tatiana Zhilova's research and practical experience reveal a lasting and profound interest in intellectual property law and in particular in the problems of trademark protection in national and EU law.

## **2. General characteristics of the dissertation**

The dissertation is the first in our country monographic study of the legal institute of cancellation of trademark registration. It consists of an introduction, introductory notes, seven chapters and a conclusion. The volume of the dissertation is 242 pages. 227 footnotes were made. The author has attached a list of cited literature, which includes 51 scientific publications, as well as a separate list containing 15 used works. The main part of the literature is in Bulgarian, but titles in German and English are also included.

In the Introduction the author presents the subject of the research. The introductory notes provide a historical overview of the use of signs in trade. Chapter One examines the sources of trademark protection legislation at international, European and national levels. The peculiarities of the trademark as an object of legal protection and the legal requirements for trademark registration are discussed. A classification of the types of trademarks has been made, the content of the subjective right to a trademark has been analyzed, the application for registration and other important issues related to the trademark registration proceedings have been discussed. Chapter Two examines the non-use of the mark as a ground for cancellation of its registration. An analysis of the use of the mark from an objective and a subjective point of view is made, and on this basis the factual composition of the cancellation due to non-use is examined. In Chapter Three, the author considers the conversion of the mark into common name in the trade as a ground for cancellation of the registration. A comparison has been made with the EU trade mark regime, in view of some gaps in national legislation. Some issues that are important for the application of the law are analyzed, such as the

determination of the moment when it should be assumed that the trademark has become a common name in the trade, the issue of consideration of new facts and circumstances that occurred after the filing of the application for cancellation, etc. The fourth chapter is on the cancellation of registration due to the use of the trademark in a way that misleads the public. As in the previous chapter, here the author has again structured the exposition by following the elements of the factual composition of the studied hypothesis for cancellation of the registration. An original approach is to consider the stated ground for cancellation taking into account the limits of the exercise of subjective rights, namely the non-violation of subjective rights and legitimate interests of others. A thorough analysis has been made of the conditions under which it can be assumed that there is misleading of the public. In Chapter Five, the author discusses the peculiarities of the cancellation of the registration of collective and certificate marks in connection with the specifics of their use. The sixth chapter is devoted to the proceedings for revocation of the registration of a trademark. All issues of the administrative proceedings before the Patent Office and the peculiarities of the court proceedings are discussed in detail. In separate sections the dissertation presents respectively the proceedings for revocation of a trademark of the European Union and the grounds and proceedings for revocation of an international registration of a trademark with effect on the territory of Bulgaria. The legal consequences of the cancellation of the registration have also been studied. In the last chapter, the author made distinctions on the cancellation of trademark registration by other similar legal institutes.

### **3. Evaluation of the scientific and scientific-applied contributions of the dissertation**

The dissertation "Cancellation of Trademark Registration" is an original scientific work, which is devoted to current issues of great practical importance. The work contains many scientific and scientific - applied results, the most significant of which I have presented below.

3.1. The work is the first monographic study of the institute of cancellation of trademark registration in our country. The scientific novelty of the work also refers to the research of some specific applied aspects of the cancellation of registration. The issues related to the cancellation of the registration of a trademark of the European Union, as well

as the cancellation of the registration of an international trademark with effect on the territory of our country are also unexplored in our legal literature. The dissertation allows to a significant extent to fill the existing gaps through a detailed and in-depth analysis of the legal framework at national, European and international level.

3.2. Apart from its scientific novelty, the research is distinguished by its relevance. In December 2019, a new Law on Trademarks and Geographical Indications was adopted. It transposed the latest EU trademark directive and made changes to proceedings before the Patent Office. The dissertation is in compliance with all changes in the legislation and is the first monographic study in our country, after the entry into force of the new Law on Trademarks and Geographical Indications, which has as its subject a study of an institute of legislation in the field of trademarks.

3.3. The work contributes to the enrichment of existing knowledge in the field of trademark protection as an object of intellectual property. The historical study of the use of signs in trade and of the origin and development of the legal protection of the trademark is a contribution in this direction. The enrichment of existing knowledge also refers to the detailed study of international sources and sources of EU law.

3.4. The analysis of the cancellation of a European Union trade mark registration should be considered as a separate contribution. The significance of this part of the work is in two main directions. On the one hand, it makes it possible to examine the national legislation in a comparative way and to outline some of the imperfections of the system for cancellation of the registration of a national trade mark. On the other hand, as the cancellation of an EU trade mark in counterclaim proceedings takes place before national courts, questions of jurisdiction, grounds for revocation, etc., are important for the application of the provisions of EU law.

3.5. A contribution of the dissertation is the complex study of the institute of the cancellation of the trademark registration. Not only the substantive but also the procedural norms are studied, which allows the full and thorough clarification of the set problems. The comparative method used by the candidate contributes to the determination of the gaps and shortcomings of the current legislation in our country.

3.6. A significant contribution of the work to the development of legal science and practice is the author's in-depth analysis of basic normative concepts, as the disclosure of their content is crucial for the correct application of the law. Such concepts are "genuine use", "misleading", "conversion of the mark into a common name in trade" and others. Among the mentioned concepts there are also those that exist as normative concepts and outside the intellectual property law, for example the concept of "commercial activity". In this respect the author has reasonably and correctly concluded that the term "commercial activity" within the meaning of the LMGI has an independent meaning, which is broader than the meaning that the same concept has in commercial law. This analysis is particularly valuable to legal practitioners as it is based on a detailed review of the case law of the Court of Justice of the EU.

3.7. Most of the proposals formulated by the candidate for improvement of the legal framework have a contributing character. They cover both the substantive and procedural provisions of the cancellation of a trade mark registration and include proposals to amend existing and to create new provisions in the LMGI. Each of them is based on an in-depth analysis of objective law and case law, and some are based on the comparison with the norms of the secondary law of the European Union.

Support should be given to the proposal to replace the term "trademark that is widely known" with the term "mark with reputation". The candidate's arguments can be shared that this would lead to a clear demarcation from the concept of "well-known mark", which in turn would contribute to the correct application of the law in the two different hypotheses.

The proposal for the creation of a new text in the LMGI, which would determine the boundaries of the examination carried out by the Patent Office in proceedings for invalidation and cancellation of trademark registration, deserves support, and in the first case the examination should be based only on the submitted by the parties allegations and facts, and in the second not to be limited to them.

The proposal for supplementing the provision of art. 68, para 1 of the LMGI in connection with the possibility of division of the registration of a trade mark in pending proceedings for cancellation of the registration is also substantiated.

The proposal to delete the requirement to present a power of attorney to an industrial property representative in the transformation of an EU trademark into a national application may also be supported, except in cases where the person falls under the hypothesis of Article 3, para. 2 of the LMGI; the proposal for excluding the word “license” from the provision of art. 38, para 4, item 2 of the LMGI; the proposal for amendment of art. 38, para 2, as well as the proposals for creation of new provisions in the LMGI for overcoming some omissions in the grounds and in the procedure for cancellation of the registration.

#### **4. Evaluation of the publications on the topic of the dissertation**

Three publications on the topic of the dissertation are presented. They are articles and have been published in reputable legal journals. The article "The New Concept of a Trademark", published in the journal "Administrative Justice", is dedicated to the new definition of a trademark in the LMGI, which was adopted with a view to transposing Directive 2015/2436, and the consequences of its adoption on extending the range of marks, who could receive registration.

In the article "Use of Trademarks in Commercial Activity within the Meaning of the LMGI, published in the magazine "Commercial Law ", the candidate examines the content of the term "commercial activity" and substantiates the concept that commercial activity as legal term used in the LMGI has a different content when compared to the same term used in the Commercial Law. According to the author, commercial use within the meaning of the LMGI covers the relations for the creation and remunerative exchange of goods and the provision of services, and also includes the relations for non-profit or charitable purposes.

The third article was published in the magazine "Society and Law" and it deals with the use of trademarks on the Internet in connection with the determination of actual use in the territory of the country where the procedure for cancellation of registration takes place. It is argued that the offer of goods or services on the Internet, which are designated with the mark, should be considered for real use of the mark, if the site is available to consumers in the country.

#### **5. Evaluation of the abstract**

The abstract consists of two parts and contains a general characteristic of the dissertation. The first part presents the subject, goals and objectives of the study, the methods used and the scientific contributions of the work, as well as its practical significance. The second part covers the presentation of the content of the dissertation by chapters and sections.

The scientific and scientific-applied contributions of the work are correctly described by the candidate.

## **6. Compliance with minimum national requirements**

A report on the implementation by the candidate of the minimum national requirements under article 2b of the Act on Development of the Academic Staff in the Republic of Bulgaria is presented. The requirements for the minimum number of points are met - 50 points from Group of indicators A and 30 points from Group of indicators D. The report is filled in correctly.

A list of the candidate's publications related to the subject of the dissertation is attached.

## **7. Critical remarks and recommendations**

Some critical remarks and recommendations can be addressed to the candidate, which I have formulated below.

7.1. Critical remarks can be made regarding the structure of the dissertation. There are significant disproportions in the distribution of the content of the dissertation by chapters. The first and second chapters cover more than half of the content of the work, and three of the remaining chapters are in a volume that is insufficient for their independent separation. The third and fourth chapters are 10 pages each, and the fifth chapter is only six pages long. The author could combine the part concerning the cancellation due to the conversion of the mark into a common name in the trade and cancellation due to the use of the mark in a way that misleads the public, together with the cancellation of the registration of collective and certificate marks in a common chapter.

The dissertation contains as separate parts of the exhibition Introduction and Introductory Notes. The introduction does not include a presentation of the subject,

objectives and tasks and methods of the research. Indeed, the author has indicated them in the Abstract, but they must also be contained in the monographic study itself.

On the other hand, the Introductory Notes refer to the historical development of the use of signs in trade and to the emergence and development of trade mark protection and should rather be included in Chapter One. The first chapter is entitled 'Trademark Concept' and covers an analysis of a much wider range of issues, such as the sources of the legal framework and the content of the subjective right to a trade mark. The title needs to be changed to correspond to the content.

The distinctions of the cancellation of registration from similar institutes and proceedings are made at the end of the work, and this should be done at the beginning, after the essence of the institute of the revocation of the registration of a trademark has been clarified. The dissertation would benefit if a detailed comparison was made at the beginning between the cancellation and invalidation of the trademark. The author has generally considered the invalidation of the registration in Chapter One, but without making a comparison with the cancellation.

7.2. The author could expand the list of used scientific literature. Indeed, the scientific literature in our country is poor in titles in the field of trademark protection, but the author speaks English, German and Russian, which allows him to use scientific publications in these languages. This would contribute to a fuller and more in-depth clarification of the issues at stake.

7.3. The author has not made the necessary distinction between national trade mark right and supranational trade mark right of the European Union. I believe that the work would benefit if the essence of the EU trade mark as a unitary right was clarified in a separate section. The consequence of the lack of such a distinction is that in some places, such as on page 54 of the paper, the candidate justifies the need to change the national protection because of contradiction between the LMGI with Regulation 2017/1001. Indeed, the contradictions of the LMGI with the provisions of Directive 2015/2436 will be infringement of EU law, but it is not infringement to have differences in the protection regime of the EU trademark, which is defined in Regulation 2017/1001, and the protection regime of national brand according to LMGI. The lack of such a distinction also leads to the use as synonyms of terms that are from different legal systems and should not be confused. For example, on page

64, the author speaks of a declaration of invalidity under the Regulation, putting the word 'cancellation' in brackets.

7.4. Some of the proposals made for the improvement of the legal framework cannot be supported.

The proposal to include in §1, item 1 of the Supplemental Provisions of the LMGI regarding the legal capacity of persons to be holders of a subjective right to a trademark, civil partnership and associations that are not legal entities to be considered as possible rightholders, should not find support. The main reason for this is that civil partnerships under Bulgarian law cannot be holders of subjective rights and obligations in their own name. I do not consider that the lack of such a text is in contradiction with Regulation 2017/1001, as Art. 3 provides that “companies or firms and other legal bodies shall be regarded as legal persons if, under the terms of the law governing them, they have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts, and to sue and be sued”.

The proposal for supplementing Art. 39, para 5 and Art.40, para 6 from the LMGI on the grounds for cancellation of collective mark and certification mark, introducing a specific ground for cancellation - misleading the public as to the type of mark where it is used in such a way that it is not clear that it is a collective or certificate mark, cannot be supported. The author justifies this proposal by arguing that in the case of these two marks it is necessary for them to be clearly perceived by the society as collective or as certificate marks. The latter is promulgated with the publication of the registration, and the rules for their use are entered in the State Register of Trademarks. In this way, the use of a collective or certificate mark is announced to the public by making the publications in question.

The critical remarks and the recommendations addressed to the author do not change my positive assessment of the qualities of the presented research.

## **8. Conclusion**

The dissertation "Cancellation of Trademark Registration" is an original scientific research on current issues of intellectual property law and in particular of the legal protection of trademarks. The research is distinguished by many scientific and scientific - applied merits and is a valuable contribution to legal science and practice in our country. The work meets

the national minimum requirements established in the Act on Development of the Academic Staff in the Republic of Bulgaria and in the Regulation for its implementation and should receive a positive assessment.

Based on my overall impression of the qualities and merits of the work, I strongly suggest that the scientific jury decide to award Tatiana Borisova Zhilova the educational and scientific degree "Doctor" in the professional field 3.6. "Law", scientific specialty "Civil and Family Law" - Invention, copyright and patent law.

30.08.2020

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