

## OPINION

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Research Field Civil and Family Law

Concerning: 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**

Theme of Dissertation Thesis: **"REVOCATION OF THE REGISTRATION OF TRADEMARK"**

Grounds for presentation of the review: participation as a member of scientific jury on defense of dissertation thesis in compliance with Order №RD38-362 dated 30.07.2020 of the Rector of Sofia University.

### **1. Information on the PhD Candidate**

Mrs. TATYANA BORISOVA ZHILOVA is enrolled on 25.10.2019 as 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) and graduated gaining the right to defend a thesis as of 10.07.2020 after successfully passing the exams stipulated in her individual PhD training course plan.

### **2. General Description of the Presented Dissertation Thesis**

The dissertation thesis has a total volume of 242 pages, including list of used literature, covering a total of 66 theoretical sources, of which 7 foreign language (in German and English). The paper covers 227 footnotes, most of which are substantive, and a number of them with references to case law (in our country and the Court of Justice).

The paper is structured in an introduction with introductory notes, seven chapters divided into paragraphs and paragraphs with subject titles in sequential numbering, and

a conclusion. The orderly, detailed structure of the work makes a good impression, which is presented clearly in the content and contributes significantly to the easier tracking of the course of the research.

The introduction substantiates the relevance of the topic chosen by the PhD candidate and the need for a comprehensive, systematic study; the subject, goals and tasks of the research are outlined, namely to systematize the substantive grounds for the revocation of registration of a trademark, considered differently in view of the legal features of the different types of trademarks and analyzing the consequences of the revocation. The introductory notes also provide a brief legal historical overview of the origin, development and protection of a trademark.

In the seven chapters, which feature the main structure of the thesis, the concept of a trademark (Chapter One) is consistently clarified; as well as certain types of grounds for revocation of a trademark registration (Chapters Two, Three and Four); the revocation of the registration of collective and certificate marks (Chapter Five); the proceedings in which the registration of a trademark is revoked and the legal consequences of the revocation (Chapter Six). In the last Chapter Seven of the thesis, some comparisons and distinctions are made between the revocation of the registration of a trademark and some similar legal figures.

In the conclusion, the author's proposals for improvement of our domestic legal framework on the grounds for revocation of the registration of a trademark and of the procedure in which this revocation is carried out are set out, including how to achieve a higher degree of compliance with the regulations of the EU.

The theme of the dissertation thesis is undoubtedly relevant and of great theoretical and practical importance for the nowadays civil and commercial turnover. Until now, the problem of the grounds and the procedure for revocation of a trademark registration and its consequences have not been the subject of an independent and comprehensive systematic scientific study in our country, and there can be no doubt that such a study is necessary because the issues of termination or restrictions on the subjective right to the trademark are important primarily for the security of civil turnover and the protection of constitutionally recognized rights. The connection of the chosen theme with the greatly topical issues of consumer protection and measures for maintaining a healthy competitive environment on the market should also be emphasized. This is necessitated by fact that among the components of unfair commercial practices adversely affecting the interests of competitors and consumers, there are many actions related to trademark law - in addition to actions of other legal entities, in violation of the exclusive trademark right, also the conduct of the holder of this right himself.

The structure of the study is coherent and logical and corresponds to the author's goal to clarify in detail the substantive grounds and procedure for revocation of trademark registration, taking into account the specifics of the national, European and international trademarks, as well as the specifics of individual trademark categories (such as collective and certificate marks). In the right systematic places, the legal consequences of the revocation of the registration of a trademark are discussed and some useful distinctions for doctrine and practice from similar legal figures are made.

The work on the theme of the thesis involved a number of general and special research methods that are adequately applied. The PhD candidate was particularly successful in using the comparative law method, which in many places in the study made an analytical comparison between the permissions in Community law (especially in view of Directive (EU) 2015/2436 of the EP and the Council for the convergence of the legislation of the Member States concerning trademarks) and the new regulation of trademarks, adopted in our country in December 2019. This comparison was made not for its own purpose, but with a view to establishing the high degree of compliance of our regulation and formulating proposals *de lege ferenda* for its improvement.

The scientific controversy is conducted correctly, in a constructive spirit, with arguments and with respect for the authors, with whose views disagreement is expressed.

The language of the study is clear and terminologically accurate.

### **3. Evaluation of the Scientific Contributions and the Scientifically Applicable Results of the Research**

The thesis boasts numerous contributions to the development of Bulgarian doctrine, case law and rule-making. It is impossible to list all of them in details within the framework of this review, and its purpose is not to do so.

When evaluating the scientific contributions and scientific-applied results of the research it should be borne in mind that the dissertation thesis of the PhD student Tatyana Zhilova is not only the first comprehensive and systematic theoretical study on the topic in our country, but also the first monograph on the current Trademarks and Geographic Names Act, which were put forward for discussion half a year after the law was passed. This circumstance is indicative of the novelty and the original nature of the research and determines its great cognitive value and usefulness for the development of the doctrine and for the practice of application of the new regulation. The frequent reference to native Bulgarian and foreign case law, mainly of decisions of the Court of Justice of the EU, and their expert discussion in the course of the theoretical analysis also contributes to this fact.

Among the scientific contributions of the work should be highlighted the derivation of the factual compositions, raised in substantive grounds for revocation of the registration of the different types of trademarks. The differentiation of the separate types of grounds, depending on the nature of the behavior of the trademark owner, carried out in Chapters Two, Three and Four, is original and of a contributing nature.

Of great theoretical and practical usefulness is the differentiated examination of the proceedings, in the order of which the revocation of the registration of trademarks is carried out depending on their nature - national, European or international (Chapter Six). The detailed study of the peculiarities of each of these proceedings is of a nature to directly support the law enforcement activity. The high quality of the research in this procedural part has been visibly contributed to by the fact that the author is an active

judge with extensive practical experience, which makes the analysis and its conclusions even more useful.

Of significance for the enrichment of the Bulgarian theory and jurisprudence are the analytical distinctions made by the author between the revocation of the registration of a trademark and some other legal figures with which it shows certain external similarities.

Finally, the practical worthiness of the results of the study is measured by the proposals made in the conclusion to the work to supplement and amend the Trademarks and Geographical Indications Act, to bring in the greatest compliance of our regulation of the grounds and procedure for revocation of the registration of trademarks with the norms of the EU and the international law on the matter. These include proposals to amend Article 112 (2) of the Trade Marks and Geographical Indications Act in order to bring them into line with Regulations of EU) 2017/1001; the proposal to amend the Trademarks and Geographical Indications Act with a view to regulating the substantive conditions and the procedure for subsequent revocation of the registration of a trade mark in the special case of Article 14 of Directive 89/104 / EEC on the convergence of the legislation of the Member States on trade marks, as far as the possibility of establishing invalidity or revocation of the trademark and after its action has already been suspended due to the expiration of the term of protection or due to waiver of rights, etc.

#### **4.Evaluation of the Publications on the Theme of the Dissertation Thesis**

In the present procedure the PhD candidate has presented three scientific publications in the specialized legal periodicals related to the topic of the dissertation, namely: "The new understanding of a trademark in the Trademarks and Geographical Indications Act" - Administrative Justice, 2019, № 6, p. 11-20; "Use of trademarks in commercial activities within the meaning of the Trademarks and Geographical Indications Act." - Commercial Law 2020, № 1-2, pp. 41-52; "Use of trademarks on the Internet" - Society and Law 2020, № 2, pp. 33-43. These publications are valuable above all because they reflect the novelties in the legal framework of trademarks contained in the just adopted (at the time of publication) Law on Trademarks and Geographical Indications. The special usefulness of these articles for the development of doctrine and practice is that they discuss the degree of compliance between our updated national legislation on trademarks and geographical indications of December 2019 and EU law. Without mechanically reproducing parts of the dissertation, these articles further develop one or another aspect of the topic of the research. Each of these publications has a scientific apparatus and meets the requirements for high quality research.

#### **5.Evaluation of the Abstract**

The abstract correctly reflects the structure and content of the dissertation, the applied system of research methods, the practical significance of the research, as well as the author's suggestions for improving the legal framework, but is quite economical in listing scientific contributions. I am sure that the reviewers and the other members of

the scientific jury will find other scientific contributions than those mentioned by me in point 3 of this opinion.

## **6. Critical Remarks, Recommendations and Questions**

In view of the forthcoming publication of the dissertation - something that I strongly recommend to the author Mrs. Zhilova, I dare to point out that the usefulness of this work for doctrine and practice would be even greater if in the appropriate systematic place at the beginning of the study are clarified the generic features of the very legal concept of "grounds for revocation" of trademark registration as a key and fundamental for the entire dissertation thesis. I find that such an approach fits perfectly into the goals and objectives of scientific research, which the author herself has set, namely: to define the concepts for which there is no legal definition (page 1 of the abstract, last paragraph). The author has discussed in great detail and in depth the different types of grounds, derived according to different criteria (chapters Two to Five inclusive), but somehow out of her attention is the very legal concept of "grounds for revocation" of trademark registration, which is the logical center of the subject of scientific research. Since the law does not provide a legal definition of this concept, the task of legal science is to define it by indicating its essential legal features, derived in an interpretative way from the provisions governing the specific grounds for revocation of trademark registration. In this sense, giving such a theoretical definition of the very concept of "grounds for revocation" of trademark registration in the dissertation thesis can be considered as a scientific contribution that will further increase the significance of the paper for the development of doctrine and case law.

Without delving into further details, I will give only two more recommendations.

First, it seems to me that the understanding of page 64, first paragraph above, in relation to the content of the trademark right, that in addition to the three substantive independent powers of the trade mark proprietor (the right to use the mark, the right to impose prohibitions on third parties of using it and the right to dispose of the mark - page 63 below), "the subjective right to the trademark includes the procedural rights that the owner has in defense of the mark". Does this mean, according to the author, that the right to a trademark includes in its content the right to a claim in a procedural sense?

Second, it is advisable to substantiate in more detail the view on page 52 (first and second paragraphs) that traditionally intellectual property rights "belong to the category of possessive subjective rights", and at the same time according to the next paragraph - that the right to intellectual property "also applies to the category of non-possessive transforming rights". I think that in this context it is good to add some theoretical clarifications about the legal qualification of the various powers on a trade mark that may arise from the manifestation of additional legal facts and thus to clarify why some of them bear the marks of possessive and others - of non-possessive, and in particular secondary, testamentary subjective rights.

I would like to emphasize that the recommendations do not in any way affect the opinion about the high scientific value and practical significance of the work, nor reduce the quality of the scientific research and its general contribution to the development of Bulgarian private law doctrine and case law. The work deserves a high overall evaluation and I believe that the scientific jury, and after the printing of the work - and the readership, will give this high evaluation to the author and her research paper.

## **7. Conclusion**

Guided by the above stated considerations, I accept with conviction that in view of the substantive legal requirements under Article 6, paragraph 3 of the Act for the Development of the Academic Staff in the Republic of Bulgaria the submitted dissertation thesis of TATYANA BORISOVA ZHILOVA on "REVOCATION OF TRADEMARK REGISTRATION" contains scientific and applied results, which represent an original contribution to science and shows that the candidate has in-depth theoretical knowledge in the field of civil and commercial law and possesses ability for independent research. In view of this, I propose to the esteemed scientific jury to give Mrs. TATYANA BORISOVA ZHILOVA the educational and scientific degree "Doctor", in support of which I will vote without hesitation.

Sofia, 3.08.2020

Professor Ekaterina Mateeva, PhD

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