

## OPINION

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**On the dissertation paper for obtaining the PhD degree with subject "Revocation of trade mark registration"**

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1. Tatyana Borisova Zhilova, PhD student in self-study, has presented for defense before a scientific jury dissertation paper for obtaining the PhD degree with subject "Revocation of trade mark registration".

The dissertation has a net volume of 242 pages. The dissertation paper has been structured in an introduction and introductory notes; Chapter One: Concept for Trade Mark; Chapter Two: Revocation of registration due to non-use of the trade mark; Chapter Three: Revocation of trade mark registration due to conversion of the mark into a common name; Chapter Four: Revocation of registration due to use of the trade mark in a way that misleads consumers; Chapter Five: Revocation of the registration of collective and certificate trademarks; Chapter Six: Revocation proceedings and consequences; Chapter Seven: Distinction of the registration revocation from similar institutes and proceedings; Conclusion; List of cited literature and the other sources. 227 footnotes has been made.

The content of the work is built within the established scientific tradition.

3 (three) publications in specialized and popular periodicals have been published on the topic of the dissertation.

2. The subject of the dissertation is research of an actual and significant for the legal theory and practice problem - revocation of trademark registration.

2.1. In the introductory part the PhD student outlines the relevance of the subject of the research. The historical development of the trade mark protection concept has been included in the course of the research and traced.

2.2. Chapter One is devoted to the concept of the trademark. The normative permits for the legal nature of the trademark in the national and international law, incl. Community law. The analysis in this part is correct. The formulated conclusions are substantiated. For example, the author rightly maintains that, I cite, "The principle of national regime implicitly contains the principle of independence of national registrations of a trademark, including with regard to registration in the country of origin." (p. 15).

The controversy in absentia with other authors is correct and well-argued - for example, the controversy developed in the footnote p. 19. The author rightly maintains that respect for the

ECHR by the EU cannot change the legal nature of the Convention as an act of international law and become a source of EU law.

2.3. Chapter Two is devoted to the revocation of the registration due to non-use of the mark.

The study is relatively well structured and balanced. The author's theses are substantiated - for example, the thesis formulated on page 112 that the use of a company name or trade name can be considered a genuine use of the mark within the meaning of the LMGI only if it is placed directly on the goods and services or used in connection with the goods and services for which the mark is registered (p.112).

I believe that significant contributing elements are contained in the study of the issue of succession in the use of the mark (p.119 et seq.). The author correctly states that in all cases of succession - translational or constitutive - the use made by the attorney is considered to be used by the successor as well.

The above finding can be made with regard to the analysis of the use of the trademark in the Internet space (p.88 et seq.). The author relevantly emphasizes the problem of the so-called "Self-regulation" of the Internet, which takes place at a non-institutional level.

2.4. Chapter Three is devoted to the revocation of the registration of a trademark due to its becoming a common designation (common name). The research in this part has a strong practical significance. The author rightly and reasonably states that if the use of the mark as a common name in the event of exhaustion or infringement of the trademark right is so widespread that it is impossible and economically unjustifiable for the trademark owner to defend his right under the law or to lead advertising and awareness campaigns, there will be circumstances that exclude the causal link. In these cases, the mark will not be able to be revoked on this ground and will remain valid, although it can no longer perform its distinctive function (p. 148).

2.5. Chapter Four deals with the revocation of registration due to the use of the mark in a way that misleads consumers. The research in this part has a strong practical significance. The formulated theses are substantiated. For example, the author rightly maintains that the use of the mark by other persons in cases of exhaustion of the right to the mark and infringement of the right to the mark, in which the rightholder is not able to influence the conduct of the persons, cannot be included into the factual composition of the grounds for revocation of the registration of the mark. The institute of revocation contains an element of sanction for the bad faith behavior of the owner of the mark, due to which the actions of persons who are not under his control are irrelevant (p. 150).

2.6. Chapter Five is devoted to the revocation of the registration of a collective and certificate mark.

The study is relatively well structured and balanced. The author's theses are substantiated. The author rightly states that the legislator does not impose any requirement for the genuine use of the mark in violation of the rules, nor for a harmful result. Taking into account the sanction element in the institute of revocation in general, in my opinion the fact of the given permission for

use in contradiction with the rules is sufficient. The holder of a subjective right, who does not respect the rules set by him self, admits a serious abuse of a right and accordingly should bear the heaviest sanction - loss of the right (p. 161).

2.7. Chapter Six deals with revocation proceedings and their consequences.

In this part the author - despite the silence of the law - argues the grounds for regularity and admissibility of the request for revocation of the registration of a trademark. In this sense, the analysis has a strong contribution character.

The above finding can also be made regarding the study of the issue of proving the genuine use of the mark (pp.189-190). The author's suggestion that, I cite, the "shifted burden of proof in the revocation proceedings on the ground of non-use of the mark, which alleviates the applicant, probably contributes to the largest number of claims for revocation on that ground compared to the other two grounds."

2.8. Chapter Seven deals with the distinction between trade mark revocation proceedings and other similar institutes and proceedings.

The research in this part is well structured and balanced. The author's theses are substantiated. On p.221, for example, it is correctly maintained that the burden of proof cared by the opponent in a request for proof of the genuine use has a deterrent effect against the abuse of the right of opposition. Anyone requesting the invalidity of a registered trade mark must know that he may be required to prove the actual use of his earlier trade mark, and if he cannot cope with the burden of proof, the request for invalidity will be rejected.

In the concluding part, the author emphasizes again the importance of brands in modern turnover and for the development of public relations. The reader's attention is drawn to the shortcomings of the national legislation. In this regard, an attempt has been made to formulate and systematize relevant proposals de lege ferenda.

3. The presented abstract in general is consistent with the dissertation and correctly reflects its main points.

4. From the attached list of cited literature and other bibliographic sources it is evident that the author has used most of the available Bulgarian and foreign specialized literature.

5. Some critical remarks and recommendations can be made on the dissertation:

5.1. In the introductory part the scientific thesis and the scientific methods used by the author should be highlighted more clearly.

5.2. I consider that the questions concerning the historical origin and development of the legislation on trade mark protection should be addressed in Chapter One but not in the introductory part.

5.3. The study would be enriched if it was supplemented by a more thorough comparative analysis between the trademark and the trade name - for example in terms of legal protection.

5.4. I recommend the author to formulate a more specific proposal de lege ferenda in connection with the argumentation of p. 66.

5.5. I recommend the author to enrich the research - before submitting it for publication - with an analysis of opinions expressed in foreign literature, combined with the relevant controversy, to highlight the author's theses.

5.6. I believe that the author's abstract of the dissertation should systematically present the scientific contributions and proposals made de lege ferenda.

I take into account the complexity of the issues, subject of the dissertation research, as well as the different, sometimes completely exclusive opinions in the researched field of legal knowledge.

My overall assessment of the dissertation is positive. The study is completed. Its purpose and task have been fully achieved. The these supported by the author are grounded. Some parts of the work have a strong scientific and applicable character. Others have a strong theoretical character with signs of original theoretical generalizations.

The author shows a very good knowledge of the case law on the subject.

From the content of the dissertation work are established scientific and applicable results, which represent an original contribution to science.

The PhD student shows in-depth theoretical knowledge in the relevant specialty and ability for independent research.

#### **CONCLUSION:**

The dissertation on the topic "REVOCATION OF TRADEMARK REGISTRATION" corresponds to the regulatory requirements for obtaining the educational and scientific degree "Doctor", in view of which I recommend Tatiana Birisova Zhilova to be given the educational and scientific degree "Doctor" in professional field 3.6. Right.

Prepared the opinion:

/ Assoc. Prof. A.Grozdanov/