To the Dear Members

of the scientific jury appointed

with Order № RD – 09-55 / 16.06.2020

of the Rector of Sofia University "St. Kliment Ohridski "

REVIEW

by Prof. IVAN RUSCHEV, Doctor of Science,

Faculty of Law, Sofia University "St. Kliment Ohridski "

on the dissertation presented by

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, scientific specialty

"Civil and Family Law" - Invention, Copyright and Patent Law,

on the topic

"REVOCATION OF TRADEMARK REGISTRATION"

for obtaining the educational and scientific degree "DOCTOR"

Dear colleagues, members of the scientific jury,

By order of the Rector of Sofia University "St. Kliment Ohridski "№ RD – 09-55 / 16.06.2020 I have been appointed an internal member of the scientific jury, charged with conducting the public defense of the PhD student Mrs. Tatiana Borisova Zhilova. By decision of the jury I have been appointed for its chairman, and I have been commissioned to prepare a review in this procedure. On the grounds of art. 9 of Law on the Development of the Academic Staff of the Republic of Bulgaria,

art. 30, para. 2 of the Regulations for application of the Law, I present to your attention my review of the dissertation of the PhD student at the Department of Civil Law, Sofia University, Ms. Tatiana Zhilova on "Revocation of trademark registration".

I. Biographical notes. Mrs. Tatiana Zhilova was born in 1967, in 1986 she graduated from the First Language High School in Varna (with German and English), in 1997 - higher education with a master's degree in law at the Faculty of Law of Sofia University "St. Kliment Ohridski ", and in 2009 he successfully completed a master's program in European Union Law at the same faculty. She has worked consecutively as a lawyer at the Varna Bar Association, Chief Expert-Legal Adviser in the Legal and Regulatory Services and Procedural Representation Department, Head of the European Integration and International Cooperation Department in the Administration of the Supreme Judicial Council in the period 2005-2007. Since 2007 she has been a judge in the Administrative Court of Sofia. She is a lecturer at the National Institute of Justice. Since 2018 she has been selected as a part-time assistant in the Law Faculty of Sofia University and conducts seminars on the subject Legal Regime of Intellectual Property. By order of the Rector of Sofia University № RD 20-1891 /25.10.2019, Ms. Zhilova is enrolled as a doctoral student in independent training in the doctoral program in civil and family law (invention, copyright and patent law) at the Department of Civil Law in the Law Faculty of Sofia University. After an electronic discussion in the Department of the submitted project for dissertation work on "Revocation of trademark registration", a decision was made for its early expulsion from PhD study, followed by a decision of electronic voting of the FC of 14.07.2020, Report of the Dean with ent. № 70-1—268 / 16.07.2020, Ms. Zhilova was expelled from doctoral studies by order of the Rector of Sofia University № RD 20 -1034 / 17.07.2020. After discussing the presented last project of the dissertation and passing the exams provided in the individual plan of the PhD student, by decision of the Department of CLS of the Faculty of Law the work was admitted to public defense and the composition of the scientific jury was determined.

II.Notes on the dissertation

The dissertation is 241 pages long and includes an introduction, introductory notes, seven chapters and a conclusion. The bibliography corresponds to the cited 227 footnotes and contains relatively few titles (51, of which only 7 in German and English), and the other sources used are 15. However, the content itself does not contain an indication of the pages on which the individual chapters, sections, paragraphs can be found, which definitely makes it difficult to read the work. The same applies to the presented abstract of the dissertation, which in turn truthfully reflects its content and the author's contributions.

The topic of the work is well chosen and is an indisputable novelty for Bulgarian civil law sciences. The revocation of the registration of trademarks has so far not been the subject of a comprehensive study in the Bulgarian legal literature,

and sufficient case law has already been accumulated on it to provide a basis for a systematic examination of the matter of trademarks. The topic is suitable for research and gives a strong impetus to the development of a new and still underdeveloped branch of law, with huge theoretical and practical potential - intellectual property. We cannot ignore the special value that work represents as a scientific and practical tool in the matter of brands, which is completely missing in our literature and practice.

The relevance of the topic is determined by the fact that at the end of 2019 a new Law on Trademarks and Geographical Indications was adopted. The work reflects its new provisions, which transposed the latest EU trademark directive and commented on the changes introduced in the proceedings before the administrative body. The dissertation is the first comprehensive and timely study in our country after the adoption of the new LMGI.

Structurally, the "Introductory Notes" (p.9-13) mentioned by the PhD student, which should in fact form a separate chapter (or part of a chapter), cover a historical overview of the origin, development and protection of the brand and (to which I feel reservations) are divided into three separate paragraphs - each of them on a page and a half. Better structuring of the dissertation implies a rethinking of the adopted approach, such as the historical review to be developed as in one paragraph within the limits of Chapter One, together with the review of the legal framework and the general concept of a trademark. It would be difficult to justify the structuring of the individual chapters of sections, subsections of which are paragraphs (often with one or two pages). This structuring, which seems strange in terms of the requirements for a purely academic work, can be accepted with some conditionality, as conditioned by the other great goal that the student and her supervisor have set - to present to the general public a scientific and practical study on this little-known matter to the legal community. From this point of view, the assessment of the adopted structure should not be so strict, as long as it adequately reflects the other - scientific and practical purpose of labor. It is true that the structure in academic thinking is a prerequisite, a conditio sine qua non for adequate expression of thought in essence, but it must also allow for easy recognition of the matter and finding answers to more questions in the relevant places by the reader.

The division of the content into seven chapters is also atypical in relation to the approved samples, which the PhD student justifies with the indicated specificity of the exposition.

In the same context, the serious discrepancy between the title of the paper and its content should be considered - much broader than the formulated topic. The work clearly goes beyond the revocation of the trademark registration, because the first 70 pages of it - almost 1/3 of the work (paragraphs 1-13 of Chapter One), are devoted to other issues: the concept of a trademark, including both the sources of trademark law; the mark as an object of law and as a subjective right. The idea of the supervisor, accepted by the PhD student, was here - broken under the relatively narrow topic, to give the opportunity to get acquainted with many more issues of

the institute of the brand, which have not hitherto been adequately reflected in the Bulgarian legal literature.

So among **the contributions** of the work is, in addition to a comprehensive study of the institute of revocation of trademark registration, also the attempt to make a comprehensive statement on the institute of the trademark in general.

The Introduction presents the subject of research substantiates the tasks of work, and the so-called **Introductory notes** are devoted to the historical overview of the origin, development and protection of the trade mark. Although they go beyond the topic of revocation of the mark, they represent a useful historical introduction to it.

As a contribution point in **Chapter One "Concept of a trademark"** can be considered the systematization of the relevant domestic and international legislation and the acts of EU law. Although it is possible to make a remark on the chosen criterion of their consideration - by chronology and not by individual aspects of the legal regime, and related to the trademark in general, they are a useful summary, given the dissertation's approach to a comprehensive scientific and practical presentation of the matter of the trade mark in general. Taking in account the essential distinction that the science of intellectual property makes between the object and the subjective right of the holder over it, it is appropriate to distinguish these two aspects of the trade mark, incl. the distinction of this object of intellectual property from the other objects, the requirements to the trademark. An attempt to move beyond the very broad scope of the exhibition is to focus on the registration of the trademark as a way to create the rights to it (Section III), the examination of the elements of the factual composition of the registration and its effect. Only at the end of this first chapter - pp.66-75, in paragraphs 14-15, when considering the grounds for termination of the right to the mark, in item 5 (p.70) is the connection with the topic of the dissertation - the revocation of registration. As I noted above, these pages, which are essentially useful, hardly have a place in the adequate construction of the structure of the work as a scientific research, but rather are justified in order to serve as a comprehensive scientific and practical commentary on the whole matter for brands in general. From this point on, the statement is already refracted to the main provisions of the repeal, to which the following chapters (2-7) are devoted to the end.

The real part of the work begins with **Chapter Two**, where a number of questions are asked successively, many of the answers to which are of a contributory nature. This refers to the characteristic of the obligation of genuine use, which is justified by the fact that it is not of a purely legal nature, but is only a condition for the validity of the mark, as well as the content of this concept used in the law (Section I). Contributing character can be seen in the distinction between the concept of "commercial activity" under the LMGI from that in the Commercial Law, in the analysis of the concepts "degree of use of the mark", the figure of the variant use of the mark, compared with the use of related trademarks. , the general use of the mark in commercial activity and when it should be considered as its actual use - all in the

section on the objective limits of the genuine use. Of fundamental importance are the places in section III, discussing the right to use the trademark by its owner, resp. - by third parties with his consent - as a fundamental power of this holder, which constitutes a contribution to the doctrine of the content of complex subjective rights. The same assessment should be given to the development of the question of the genuine use of the mark and the joining of the use in the transfer of trade mark rights. Should be supported the thesis of the indivisibility of the trademark as a sign, enabling each co-owner to use it in full, finding expression in the impossibility to cancel the registration in respect of the co-owner who has not used it continuously in a term of 5 years, and to remain in force only for the co-owners who have used it - on the one hand, and on the other - compared with its divisibility in respect of all goods and services for which it is registered.

A number of contributing moments are present in **Chapter Three**, dedicated to the revocation of the registration of the trademark due to its becoming a common designation as a result of (in) action of its owner. A comparison has been made in this direction between the regime of the EU trademark in Regulation 2017/1001 and the internal norm of Art. 35, para 1, item 2 of the LMGI, as the individual elements of this ground for revocation of the registration are considered in detail in a systematic plan. A comment has been made on issues left unresolved in the legislation, such as the one for the moment when the transformation of the brand into a generic concept is assessed; the assessment of new facts and circumstances that occurred after the registration of the mark, the lack of legal significance of the restoration of the distinctive character of the mark, etc.

The Fourth Chapter deals with the other substantive ground for revocation of registration - the use of the mark in a way that misleads consumers. A contribution point here can be seen in the study of the broader theoretical question of the limits of the exercise of subjective rights by their holder, which is not sufficiently developed either in the general theory of law or in the theory of civil law. The author has made an original distinction between the misleading according to the LMGI, the abuse of a right in the CA and the fraud as a ground for annulment of the contracts under Art. 29 of the Law on obligations and contracts. The consideration of the misleading about the geographical origin of the goods / services, compared with the geographical origin as a separate object of intellectual property, is of a contributory nature.

The subject of research in **Chapter Five** are the peculiarities of the revocation of the registration of collective and certificate marks, imposed by the specifics of their use. It is original to claim that the rules for the use of collective and certificate marks are part of the content of the subjective right to the mark and not a legal means of exercising that right. Even if it provokes disagreement, the thesis is well-argued and has a contribution character. Another contribution is the consideration of two of the grounds provided for in Regulation 2017/1001, but not regulated in the new LMGI - the misleading of the meaning of the trademark and the amendment of the rules of use presented in the register.

The Sixth Chapter is devoted to the procedural issues of proceedings for revocation of the registration of a trade mark. The proceedings for revocation before the National Patent Office are characterized - as a special administrative procedure, which is not adversarial in nature and the court two-instance proceedings for appeal of individual administrative acts (decisions of the President of the IP rejecting the application for registration or revoking the trademark registration). Special research has been made on the differences in the proceedings for revocation of the registration of a trademark before the Bulgarian court and that of an EU trademark - before the EU Intellectual Property Office, respectively - the grounds and proceedings for revocation of the international registration of a trademark with effect on the territory of Bulgaria (Section III), as well as the legal consequences of the revocation of the effect of the registration (Section IV).

In the last **Chapter Seven** are made useful distinctions of the revocation of the registration of a trademark by similar legal institutes. I consider that the place of these distinctions is systematically in the chapter on the concept of revocation of the registration of a trade mark before the examination of the figure on the merits, but placing them there is not fatal. It is generally assumed that this type of distinction is of a contributory nature, as is the case in most of the peer-reviewed work. This applies in particular to the distinction of revocation due to non- use (Section I) of the claim for proof of genuine use as a counterclaim in opposition proceedings, in a request for cancellation of a later mark or in infringement proceedings. The distinction between revocation in cases of non-use and restriction of the right to a trademark as a result of inaction with regard to the use of a later trademark is considered in the most detail - Art. 37 LMGI, resp. - the so-called "Limitation in consequence of acquiescence" as expressed in Regulation 2017/1001 (Section II). Of a significant contribution nature is the distinction between the revocation of the registration and the refusal for registration is where no subjective right to the trademark has arisen. These notions of the general theory of private law here are enriched and richly illustrated with hypotheses of trademark law.

Apart from the contributions mentioned in this part of the review, also should be seen those related to the analysis of the revocation of the registration of a European Union trademark, as well as the revocation of the registration of an international trademark with effect on the territory of our country, as well as most of the proposals de lege ferenda referred to on page 4 of the author's abstract concerning the supplementation of the substantive legal grounds and the procedural rules of revocation of the mark. It is unlikely that the proposal to replace the term "well-known mark" with the term "reputation mark" can be accepted, due to the danger of confusing the general known mark with the well-known one, at least because the LNA provides for the use of in the commonly used Bulgarian language, unless it concerns special legal terms, which is not a “mark with a reputation”. The comprehensive and detailed study of the institute of the revocation of the registration of a trademark, covering not only the material, but also its procedural aspects, should be assessed as an overall contribution of the work.

Most of the scientific contributions of the work are mentioned in the review of the content of the work, which is why they will not be repeated here.
The presented three scientific articles on the topic of the dissertation should be positively evaluated: “The new understanding of a trademark in LMGI”, published in the magazine “Administrative Justice”, 2019, issue 6; "Use of trademarks in commercial activity within the meaning of the LMGI", published in the magazine "Commercial Law", 2020, issue 1-2; "Use of trademarks on the Internet", published in the magazine "Society and Law", 2020, issue 2. As far as they fall within the scope of the dissertation, I will not discuss them in detail, because the opinions presented in them have found a place in the review of the dissertation.

Despite the critical remarks made, the dissertation has achieved the qualities of a significant work in modern doctrine on trademark issues, with projections on major issues of intellectual property and private law doctrine in general. The presented dissertation is a work that subsequent researchers of the trade mark regime, whether they accept or challenge the views expressed in it, will have to take into account.

For these reasons, I propose with conviction to the esteemed jury to award Ms. Tatiana Borisova Zhilova - PhD student in self-study in a doctoral program in civil and family law (invention, copyright and patent law), at the Department of Civil Law, Faculty of Law, Sofia University "St. Kliment Ohridski ”educational and scientific degree“ Doctor ”.

10/12/2020 Sincerely,

Prof. IVAN RUSCHEV, Ph.D.