



Non-Registered Marks as a Base for Oppositions in Bulgaria

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Introductory Notes

Bulgaria is a Member State of the European Union since 1 January 2007 and its legislation is generally in line with the EU legislation, including the regulation regarding the protection of non-registered signs. The country has availed of the opportunity available under Art. 4, par. 4, subpar. "b" of the *Trademark Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to Approximate the Laws of the Member States Relating to Trade Marks* and has granted use-based quasi protection to non-registered marks at national level.

The relevant non-registered marks provisions are transposed in the *Law on Marks and Geographical Indications* (the "LMGI"), where the regulation is further detailed in the *Regulation on the Requirements to Drafting, Filing and Examination of Oppositions under the LMGI*. In particular, pursuant to art. 38b, par. 1 in conjunction with Art. 12, par. 6 of the LMGI actual users of non-registered marks are entitled to oppose the registration of another mark, provided that the non-registered mark has been used in actual commercial activity on the territory of Bulgaria as of a date prior to the date of application of the opposed mark and the non-registered mark has been filed for registration. Rights to non-registered marks might be invoked only in the course of an opposition procedure against the registration of a later application.

The Right to Oppose

Under Bulgarian law, a non-registered mark can be used as a base for opposition against the registration of marks filed under the national procedure or internationally via the Madrid system. The conditions in order to avail of such right to oppose under the Bulgarian trademark law are as follows:

1. The opponent, as actual owner of the non-registered mark, should have filed an application for registration of the non-registered mark with the BPO, EUIPO or under the Madrid system prior to the filing of the statement of opposition;
2. The statement of opposition, supported with evidence substantiating the actual use of the non-registered mark, has been filed with the BPO within the relevant term periods Art. 38 b, paragraph 2 or paragraph 3 of the LMGI;
3. The official opposition fee has been timely paid.

Main Characteristics of a Non-registered Mark

According to the Bulgarian legislation non-registered marks are subject to the same requirements in order to qualify for protection as "ordinary" marks, i.e. they should be signs that possess the fundamental qualities to fulfill the essential function of a mark to be an indicator of origin. Pursuant to Art. 9, paragraph 1 of the LMGI a mark is a sign that is capable of distinguishing the goods or services of an individual person or a

legal entity from those of other individuals or legal entities in the marketplace and can be represented graphically. Such signs may be words, including the names of persons, or letters, numerals, drawings, figures, the shape of the article or the packaging thereof, a combination of colours, sound signals, or any combination of such elements.

The BPO considers that although filling of the application for registration of the non-registered mark is a condition sine qua non of the opposition proceeding, it is at the discretion of the actual user, whether to file an application for a registration with the BPO or the EUIPO or under the Madrid system designating Bulgaria, as far as the territorial scope of protection covers Bulgaria.

According to the BPO and the Administrative courts, the non-registered mark is a sign, which, although not registered, is actually on the national market as a mark. The right to a non-registered mark is a result of a prior genuine use of the sign as an indicator of origin. The difference between the registered and non-registered mark is that the right to a registered mark arises on the basis of its registration and the right to a non-registered trade mark is based on the actual use of the sign as a mark. Therefore, the non-registered mark must serve to identify the goods and services in respect of which the opposition is filed as originating from a particular undertaking, and thus to distinguish them from the goods and services of other undertakings

operating on the same market. Bulgarian legislation does not pose any requirements to the application for registration of the non-registered mark, except for the designation of the goods and/or services, subject to the Opposition proceeding.

What is to be proven?

The focal points to be proven in an opposition proceeding based on a non-registered mark are as follows:

(i) Who is the actual holder of the non-registered mark and who used the non-registered mark?

One of the main issues to be established is that the Opponent is the holder of non-registered mark, because only the holder of a non-registered mark is entitled to oppose.

If the non-registered mark was occasionally used in the course of trade by another person in addition to the holder thereof it should be proven that said use was performed with the consent of the right holder, i.e. the use was not without due cause.

(ii) Identity or similarity of the earlier non-registered mark and the Opposed TM

The Opponent should establish that there exists identity or similarity between the two signs in all aspects – visual, phonetic and conceptual, which creates likelihood of confusion of the relevant public.

The criteria applicable to the comparison are the same as the ones generally

applicable to comparisons of signs for the purposes of opposition proceedings.

(iii) What goods and services the non-registered sign was used for?

The goods and/or services for which the non-registered mark has been used should be identical or similar to the goods and/or services of the Opposed TM, so that the relevant consumers might be confused regarding the origin thereof.

The Opponent should provide evidence in order to substantiate that he/she/it used the non-registered mark exactly for the goods and services, designated in the opposition statement and covered by the Opposed TM.

Further, the goods/services of the non-registered mark, as specified in the statement of opposition should be also covered by the application for registration of such mark, as filed before the filing of the statement of opposition.

(iv) Which sign was used and was it used in the course of trade?

The Opponent should provide sufficient evidence in order to prove the fact, that he/she/it has used the non-registered sign in the course of trade as an indicator of the origin of certain goods and services, i.e. as a mark. The evidence of use of the non-registered mark should pertain to use thereof as a sign indicating the origin of the goods and services of the Opponent and not as a business name. The viewpoint of the Bulgarian competent authorities –

the BPO and the courts is that the use of the business name as an object of intellectual property is different from the use of a sign as a mark.

There is no explicit limitation regarding the admissible evidence. The Opponent may for example submit evidence that the mark was duly affixed to the goods themselves or was part of the packaging of the goods, that the services were listed in catalogues or other advertising materials, bearing the sign, the sign was used in the business papers as a mark (not as a business name), that the advertisements were intended to advertise goods and services designated by a certain non-registered mark, not just advertising the activity of a company, etc.

When assessing the use in the commercial activity of the non-registered marks, Bulgarian competent authorities consider the geographical scope of use, the time-period of use, the volume and the nature of the use of the non-registered trademark in relation to the goods and services, on which the opposition is based. According to the BPO and the administrative courts, the use of the non-registered marks in the commercial activity is to be interpreted as use in the course of trade, openly intended to the relevant public and is performed with the purpose to acquire economic advantage on the market. In addition, Bulgarian administrative courts consider that, the fact that the Opponent has registered a domain name, identical or similar to non-registered trade mark, does

not necessary mean that the non-registered mark was used in the commercial activity.

(v) When the use of the non-registered mark in the course of trade commenced?

The Opponent should provide sufficient evidence in order to establish undoubtedly that the actual commercial use of the non-registered mark commenced on a date preceding the date of filing of the Opposed TM or the date of the international registration or the date of the subsequent designation, or the priority date or the seniority date, as the case may be.

(vi) Whether the non-registered mark was used within the territory of Bulgaria;

Bulgarian trademark law poses an explicit requirement for the non-registered marks to be used within the territory of Bulgaria. Such signs may be used outside the territorial scope of the country, but as far as the national trade mark protection is within the territorial boundaries of the country the use of the non-registered mark in another country is irrelevant for the opposition proceeding based on a non-registered mark.

(vii) Whether a trade mark application was dully filed with the BPO or EUIPO

Although the Regulation on the requirements to drafting, submitting and examining oppositions under the LMGI provides that the BPO has the explicit obligation to check whether the application is filed or not, it is recommendable for the Opponent to

submit a copy of the application to the BPO.

The burden to prove that all of the above conditions are met lies with the Opponent.

It is highly recommendable that the evidences to substantiate an opposition based on non-registered mark are evaluated before initiation of the proceedings. In most cases, the oppositions are rejected because the Opponent fails to prove that the non-registered sign was used in the commercial activity as a mark, not as a trade (business) name. Even if the business name coincides with the non-registered mark it is very important to prove that the mark was used exactly as an indicator of origin, and not only as business name within the meaning of the Bulgarian *Law on Commerce*.



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