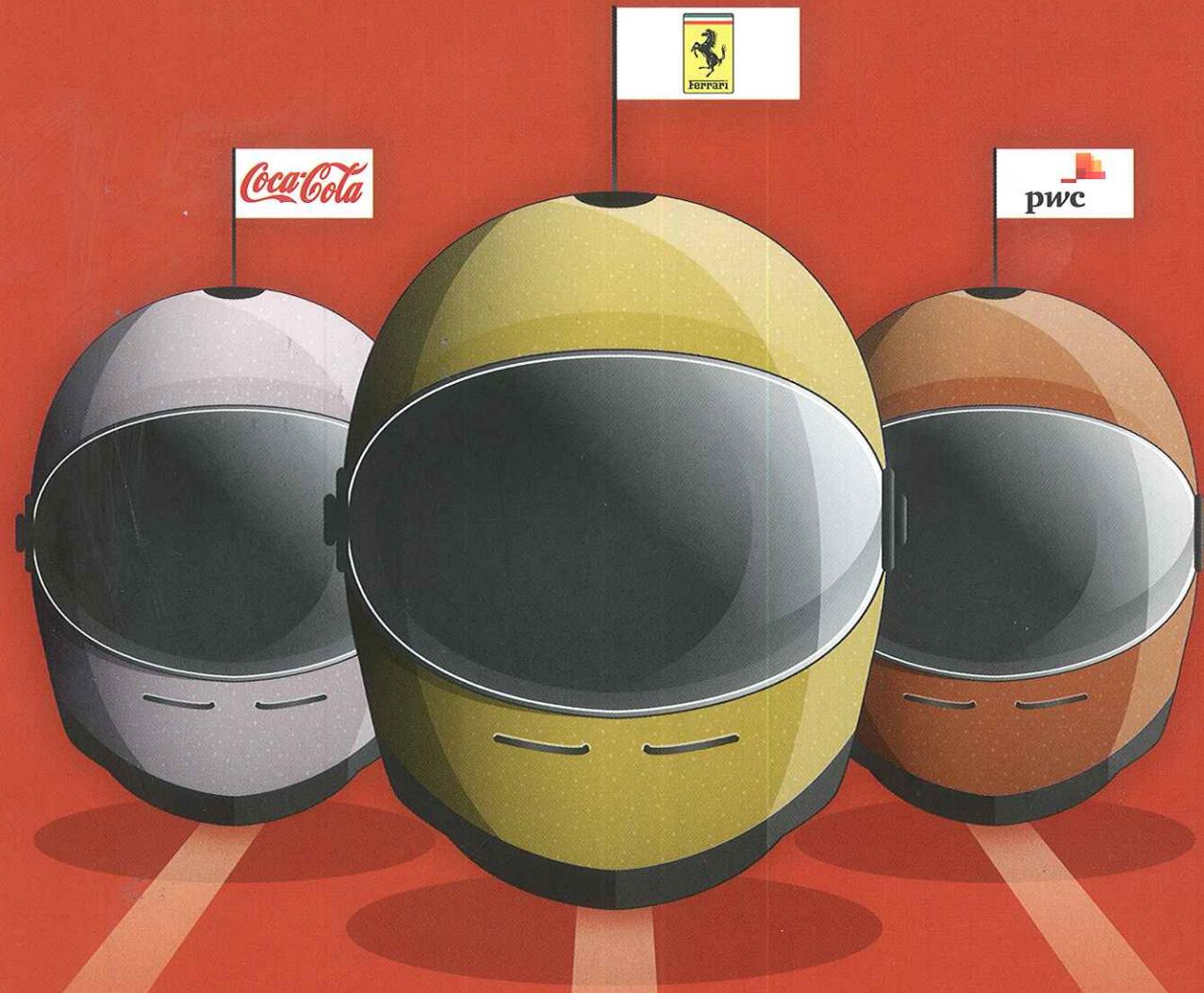


Also in this issue ...

Designs and copyright: creating a web of protection  
Creative legal approaches to the fight against fakes  
Lessons from the gTLD legal rights objection process  
A guide to Middle Eastern anti-counterfeiting regimes  
Calculating licensing royalties in India's FDI system

# World Trademark Review™



## RACING INTO THE LEAD

THE WORLD'S MOST POWERFUL BRANDS REVEALED

# National Systems

## Bulgaria's opposition system – the devil's in the detail

Trademark counsel need to be aware of the nuances of the Bulgarian trademark opposition system in order to work out the best possible trademark strategy

Bulgaria implemented a full opposition system for trademark registration in 2011 and, while the procedures are generally based on the principles of the Community trademark opposition system, there are significant differences that trademark counsel should take account of.

The official fee for filing an opposition is more than twice as high as the trademark application fee. This imposes a significant burden on rights holders, which must pay double to protect their marks. It also makes it easier for subsequent applicants, which can simply file applications until they financially exhaust the owner of a prior trademark – a practice that has been observed in the last two years.

All facts and evidence must be submitted upon filing the opposition. There is no possibility to file a formal request and then submit additional statements on grounds. If no grounds and motivation are submitted upon filing the opposition, the opponent will receive a notice of irregularity and will have two months in which to make corrections.

The grounds for filing an opposition are generally the same as these set by the Trademark Regulation, except that no opposition may be filed based on a prior company name used in the course of trade.

As soon as an opposition is filed, the trademark applicant receives a formal notice stating that its application is subject to an opposition. However, no copy of the opposition is presented; nor is the applicant given additional information about the grounds and extent of the opposition. This puts it in a position of extreme uncertainty, which can last for months. During this time, the opposition is formally examined and each notice of irregularity is followed by a period defined by the examiner for the submission of corrections. There is no deadline for completion of the formal examination or limit to the number of notices of irregularity which can be filed. Without

knowing either the scope or the grounds of the opposition, the trademark applicant cannot even build a strategy for defence or enter into negotiations with its opponent.

### Cooling-off period and objections

The cooling-off period under the new regime is three months instead of two and may be extended twice upon a request filed by both parties and payment of an official fee. Extensions are rare in practice, however, as reaching a settlement in the cooling-off period does not lead to the return of the opposition fees. This means there is little incentive for parties to use the cooling-off period effectively. In addition, the extra month unnecessarily prolongs the procedure.

The trademark applicant has two months in which to submit an objection. This term is subject to one extension, upon payment of an official fee. The term starts to run after the expiration of the cooling-off period, but does not commence automatically – the examiner rather sends a letter setting the deadline by which objections must be made. There is no timeframe within which the examiner must set this deadline, which starts to run from the date of receipt of notification. Both of these circumstances may (and often do) cause delays and uncertainty in the procedure.

### Right to reply and costs

Any objections filed by the trademark applicant are presented to the opponent, which has one month to respond. During that month it may submit further facts and evidence.

If the applicant requests the opponent to present proof of use, it has two months in which to do this. This term may be extended once by a further two months, on payment of an official fee.

Any additionally submitted evidence – regardless of whether it relates to proof of use or substantiation of the earlier rights – is presented to the applicant, which is also given one month to comment. Any comments on the proof of use are presented to the opponent. Even if not explicitly mentioned, the opponent then has the opportunity to submit further

materials. In this way, the timeframe for exchange of materials may be substantially extended and depends on the behaviour of both parties.

If, as result of the opposition, the applicant restricts or withdraws its application, the opponent must explicitly confirm whether it plans to maintain its opposition. In cases where the application is fully withdrawn, this additional procedure generally has no meaning, but is still provided by the law. Further, if the opponent wishes to withdraw the opposition as a result of restriction, an explicit power of attorney is necessary (if the opponent is represented by a trademark attorney). This applies even if the whole application has been withdrawn (which would leave the procedure irrelevant).

The Opposition Division's decision does not deal with costs. Each party bears its own costs. This is why the trademark applicant usually has little or no incentive to settle a possible trademark conflict before an opposition is actually filed – it has nothing to lose. The worst result will be the partial or full rejection of the application.

### Objections on absolute grounds

Objections on absolute grounds are examined by the Opposition Division rather than by the trademark examiner. This places a burden on the Opposition Division, as each objection is formally examined by three people instead of one. As a result, objections are disregarded in most cases.

This article has attempted to clarify the particularities of the opposition system in Bulgaria as compared to the Community trademark opposition procedure. As can be seen, the Bulgarian system differs slightly and in minor details. However, these details are important and should help rights holders to tailor a better strategy for protecting their marks and making best use of the system – whether as applicants or as opponents. **WTR**

**Ivan Ivanov** is a European trademark attorney and **Aglika Ivanova** an attorney at law at IP Consulting  
*ivanivanov@ipconsulting.eu*  
*avianova@ipconsulting.eu*