

Claims of Priority Right

Anspruch auf Prioritätsrecht

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Abstract — This report examines the right of priority from the standard point of view. Attention is paid to the formal and substantial prerequisites of the claims of priority (conventional priority claims and exhibition priority claims), according to Bulgarian legislation. A comparative analysis is made with the prerequisites of the claims for priority - conventional and exhibition, according to European legislation. Proposals for lightening of the formal requirements of the claims are made, including the introduction of an “implicit” claim to right of priority. The possibility of partially claiming the right of priority is being considered. The question also is asked whether right of priority under art. 45, para 1 of the Law on Marks and Geographical Indication is a kind of “national” priority. The author concludes that right of priority under art. 45, para 1 of the Law on Marks and Geographical Indications is a consequence of the date of submission of the application and gives arguments.

Zusammenfassung — Dieser Bericht untersucht das Prioritätsrecht aus einer Standardperspektive. Es wird auf die formalen und materiellen Voraussetzungen des Prioritätsanspruchs der Konventions- und Ausstellungspriorität nach bulgarischer Gesetzgebung geachtet. Es folgt eine vergleichende Analyse mit den Voraussetzungen des Prioritätsanspruchs der Konventions- und Ausstellungspriorität nach europäischer Gesetzgebung. Es wurden Vorschläge gemacht, die Formerfordernisse von Ansprüchen zu erleichtern, unter anderem durch die Einführung einer "impliziten" Geltendmachung des Prioritätsrechts. Die Möglichkeit einer teilweisen Inanspruchnahme des Prioritätsrechts wird geprüft. Die Frage ist, ob das Prioritätsrecht nach Art. 45 Abs. 1 LMGI eine Art „nationale Priorität“ ist. Der Autor kommt zu dem Schluss, dass das Prioritätsrecht nach Art. 45 Abs. 1 LMGI sich aus dem Zeitpunkt der Antragstellung ergibt und liefert Argumente.

I. INTRODUCTION

A comprehensive study of the right of priority¹ has not been conducted in the Bulgarian trademark literature. In the patent law literature [2, p.157], it is considered as a civil subjective right. The view that the right of priority is a subjective civil right is also shared in the trademark literature [3].

There are different types of priority rights that are created by law. The main mentioned in Law on Marks and Geographical Indications (LMGI) [4] are “*the right of priority under international agreements*” and “*the exhibition priority*”. These different named rights of priority arise from different complex factual compositions. These different complex factual compositions for the acquisition of the right of priority are discussed in detail in the trademark literature [5, p.55, 6, pp. 55, 56, 7, pp. 96, 97, 8, pp.183, 184]. Whether in this complex factual composition should be included the “decision – finding” on the right of priority of the state expert from the Patent Office? For the present I think yes, but for the future it depends of the future regulation of this right in the Bulgarian legislation and the future studies in the area.

The right of priority, according to LMGI [4] must be claimed (or declared) before the Bulgarian Patent Office. In the article the author will make a brief overview of the regulation of the formal and substantive requirement of the claims of the mentioned rights of priority - the right of priority under

international treaties and of the right of the exhibition priority. Whether the regulated priority in Art 45, para 1 of the Law on Marks and Geographical Indications (LMGI) [4] is different type of priority will be placed.

This review will be made from a comparative point of view to serve to improve Bulgarian legislation².

II. RIGHT OF PRIORITY UNDER INTERNATIONAL AGREEMENTS

A. Prerequisites for claims

Article 45, paragraph 2 of the LMGI [4] regulates the right of priority based on international agreements. This priority is also known as “conventional priority” [2, p.157]. According to Art.45, para 2 of the LMGI [4] “The right of priority of *the applicant or his successor* is recognized from the date of a previous application, provided that:

1. The previous application has been lodged regularly in a Member State of the Paris Convention or of the World Trade Organization.

2. The previous application is *the first application* in the sense of art. 4 of the Paris Convention and is *for the same mark and for the same goods or services*.

3. The application shall be filed with the Patent Office *within six months from the date of filing* of the preceding application.”

In a relatively legal aspect according to Guidelines for Examination [1, p. 242]: “The requirements that refer to the

1. According to Guidelines for Examination (European Union Intellectual Property Office (EUIPO)) [1, p.240]: “The principles of priority were first laid down in the Paris Convention for the Protection of Industrial Property of 20/03/1883, which has been revised several times and was last amended in 1979

2. On the website of the Bulgarian Patent Office, in the section for published decisions (https://portal.bpo.bg/legal_decisions), the author did not find separately classified decisions - findings for recognition or rejection of the right of priority

substance of the priority claims are covered by Article 34 EUTMR [9] and relate to *the 6-month period, the condition of a first regular filing and triple identity (same owner, same mark and same goods and services)*".

The procedural prerequisites of the claim for conventional priority are referred to in Art. 45, para 2, item 4 of the LMGI [4].

1. The claim for priority must be made with the submission of the application.

2. The claim must contain the date and country of the previous application (the data also include the number of the previous application - argument of art. 10, para 1 of OPSEARMGI [10]).

3. It is necessary to pay a state fee for priority (this fee can also be paid within the terms under Art. 46, para 1 of the LMGI [4]).

4. Within two months from the date of submission of the application, the applicant must submit a priority document issued by a competent authority of the country in which the previous application was submitted.

In a relatively legal aspect according to Art. 35, para.1, sentence 1 of the Regulation (EU) 2017/1001 [9]: "Priority claims shall be filed *together with the EU trademark application* and shall include the date, number and country of the previous application." In Art. 35, par.1, sentence 2 from the Regulation (EU) 2017/1001 [9] is stated that "The documentation in support of priority claims shall be filed within three months of the filing date". According to art.35, par.2 from the Regulation (EU) 2017/1001 [9] "The Commission shall adopt implementing act specifying the kind of documentation to be filed for claiming the priority of a previous application in accordance with paragraph 1 of this Article". It is interesting that according to art.35, par.3 from the Regulation (EU) 2017/1001 [9] "*The executive Director may determine that the documentation to be provided by the applicant in support of the priority claim may consist of less than what is required under the specifications adopted in accordance with paragraph 2, provided that the information required is available to the Office from other sources*". Therefore, one characteristic feature of the European regulation is that it is aimed at minimizing the formal requirements for claiming the right of priority. Moreover, in EUIPO practice, it is accepted also *implicit* to make the claim to the right of priority. Thus, it can be accepted without an explicit claim of the priority right that the right of priority has been claimed. According to Examination Guidelines [1] "The claim may be implicit, such that the submission of the priority documents with the application or in a separate communication filed on the same date as the European Union trademark application will be construed as a declaration of priority. Simple filing receipts containing the country, number and date of the earlier application(s) are accepted" [1, p.241]. This decision seems right to me because it simplifies the formal requirements for the claims. In this way the cases in which the right of priority is lost because the claim for priority has not been formally made, will be avoided. However, to respect the legal logic that requires a claim to a right of priority to be done to be recognized, it is good to have a text in the LMGI [4] that a claim to a right of priority is made by filing the application or on the same day with a separate declaration. It can then be clarified that this claim is considered to be made "implicitly" if the application provides certain exhaustively listed data for the previous application or declaration with this data. Currently, in Article 42, paragraph 3, item 10 of the LMGI [4] does not contain as an element of the content of the application the claim for priority. It is specified in Art. 42, para 3, item 10 of the LMGI [4] that the application must

contain only "data for claimed priority, if is claimed, such". Does this mean that the Bulgarian legislator has regulated as a rule the implicit claiming of the right of priority? Rather, not. In this case, in Article 42, paragraph 3, item 3 of the LMGI [4] "the claim for priority, if is claimed, such" must be also included.

B. *Partial assertion of the right of priority*

The LMGI [4] does not explicitly regulate the so-called "partial priority"³. In a relatively legal aspect Article 34, item 1 of Regulation (EU) 2017/1001 [9] regulates "partial priority", because the second application, which derives the right of priority, may contain some of the goods or services for which the first application is applied for. In Article 34, point 1 from Regulation (EU) 2017/1001 [9] is said that the right of priority shall be enjoyed "... in respect of goods or services which are identical with or *contained within* those for which the application has been filed". It can be said that even without it being explicitly regulated in the LMGI [4], if a priority is partially claimed (only about certain goods and/or services from the first application), it should be respected. Nevertheless, for better regulation in Bulgaria from the point of view of business and for facilitation in practice, the partial priority can be explicitly regulated.

III. DEFINITION OF THE RIGHT OF PRIORITY

There is no legal definition of the right of priority in the LMGI [4]. The clear definition of the right of priority makes an extremely good impression in the European regulations. According to Article 36 of Regulation (EU) 2017/1001 (Effect of priority right) [9] "*The right of priority shall have the effect that the date of priority shall count as the date of filing of the EU trademark application for the purposes of establishing which rights take precedence*". The right of priority needs to be legally defined in Bulgarian legislation as well. The right of priority has a specific place and meaning in the proceedings for protection of objects of industrial property, for the registration of a trademark and it is better to be legally defined.

IV. EXHIBITION PRIORITY

Article 45, paragraph 4 of LMGI [4] regulates exhibition priority. According to Art. 45, para 4, items 1 and 2 of the LMGI [4], the right of exhibition priority of *the applicant or his successor* shall be recognized from the date of exhibition of the goods or services marked with the applied mark at an official or officially recognized exhibition, provided that: 1) the application is filed *within 6 months from the date of the first exhibition of the goods or services*, 2) the application is for the *same trademark and for the same exhibited goods or services*. §1 of the Additional Provisions of the LMGI [4] determines which is an "Official or officially recognized exhibition". Under §1 of the Additional Provisions of the LMGI [4], "Official or officially recognized exhibition" is an exhibition within the meaning of the Convention of 22 November 1928 for international exhibitions organized in the Member States of the Paris Convention, as amended. [8]

According to Art. 38 of Regulation (EU) 2017/1001 [9]: "If an applicant for an European Union trade mark has displayed goods and services under the mark applied for, at an official or officially recognized international exhibition falling within the terms of the Convention relating to international exhibitions signed at Paris on 22 November 1928 and last revised on 30

3. The partial priority is discussed on the patent law literature [2, p.162]

November 1972⁴, he may, if he files the application within a period of six months of the date of the first display of the goods or services under the mark applied for, claim a right of priority from that that within the meaning of Article 36” (Effect of priority right - author's note).

The procedural prerequisites are pursuant to art. 45, paragraph 4, item 3 of the LMGI [4]:

1. The claim for priority is made with the submission of the application, indicating the date of the exhibition and the country in which the exhibition is organized

2. A state fee for priority has been paid (the priority fee may be paid within the terms under Art. 46, para 1 of the LMGI [4])

3. Within two months from the date of submission of the application, the applicant is required to present a document issued by the administration of the exhibition, proving the date of display of the goods or services marked with the mark applied for.

According to Art. 13, para 2 of LMGI [4] the document under art. 45, para 4, item 3 of the LMGI [4] is a certificate for participation in the exhibition, issued by the administration of the exhibition. The document shall also indicate the brand under which the goods and / or services were displayed.

Pursuant to Guidelines

“exhibition priority can be claimed either in the application or subsequent to the filing of the EUTM application but still on the same day.

The claim must include the name of the exhibition and the date of first display of the goods or services.

Within 3 months of the date of submitting the declaration of priority, the applicant must submit to the Office a certificate issued at the exhibition by the responsible authority. This certificate must state that the mark was in fact used for the goods or services, and indicate the opening date of the exhibition and, where the first public use did not coincide with the opening date of the exhibition, the date of first public use. The certificate must be accompanied by an identification of the actual use of the mark, duly certified by the authority.”

Like the convention priority the claim may be implicit.

Therefore, the above conclusions regarding the claim of conventional priority are applicable.

V. RIGHT OF PRIORITY UNDER ART. 45, PARA 1 OF THE LMGI [4] OR A CONSEQUENCE OF THE DATE OF SUBMISSION OF THE APPLICATION?

Pursuant to Art. 45, para 1 of the LMGI [4] “The right of priority of the applicant over later filed applications for identical or similar trademarks intended for identical or similar goods or services shall be recognized *from the date of filing the application with the Patent Office.*”

This norm is quite strange.

The question can be asked, is this a kind of “national” priority?

Indeed, I think that is not.

The arguments are:

The right of priority generally introduces a *point in time prior* than the date of filing the application - the “priority date”⁵. In the case of conventional priority, this earlier moment is the date of the filing of the “first application”. In the case of exhibition priority, the earlier moment is the date of display of the goods or services at the specified exhibitions. If the right to a convention or exhibition priority is claimed and recognized,

4. According to Guidelines for examination [1, p. 256], these exhibitions are very rare and can be found on the following site: <http://www.bie-paris.org/site/en/>.

5. Regarding the “priority date” in patent literature [2, 157]

this “priority date” (the earlier moment in time) *shall be equated with legal consequences to the filing date of the application* “for the purposes of establishing which rights take precedence“ (if the definition of the right of priority of the Regulation (EU) 2017/1001) is used [9, art 36]). That is why, in my view, Art. 45, para 1 of the LMGI [4], *outlines the legal consequences of the date of filing the application.*

In addition, the LMGI [4] uses the term “date of filing the application” instead of “national priority” when the effect of the priority under Art.45, para 1 of LMGI [4] is applicable. For example:

The proprietor of an “earlier mark” may lodge an opposition under 52 of the LMGI [4] and to prevent the registration of a trademark filed after it in certain hypotheses of Art. 12, para 1 of the LMGI [4, art.12, para 1]. Defining the term “earlier mark”, Article 12, paragraph 2 of the LMGI [4] clarifies that this is:

- Trademark, *with an earlier date of filing the application* or with an earlier priority, registered under this law, as well as
- Trademark applied for *with an earlier filing date* or with an earlier priority if it is registered under this law.

For these main reasons, I consider that the consequences of the “right of priority” under Article 45, paragraph 1 of the LMGI [4] are rather substantive legal consequences on the date of filing the application.

In a relatively legal aspect, this priority “over later applications” is not regulated by the Regulation (EU) 2017/1001 [9] as a type of right of priority.

VI. CONCLUSION

In this report, the author examines the prerequisites for claiming the right of priority and makes a brief comparative analysis of the right of priority with European legislation. Based on the analysis, several proposals for improving the Bulgarian legal framework can be derived and summarized:

1. To lighten the formal requirements for claiming the right of priority, including allowing the claim to be made implicitly.
2. To introduce a partial claim to the right of priority.
3. To give a legal definition of the right of priority in Law on Mark and Geographical Indications [4].
4. To connect the definition under Art. 45, para 1 of the Law on Mark and Geographical Indications [4] with the legal consequences of the date of filing the application.

All these proposals are in view of supplementing the Bulgarian legislation and its better implementation in practice.

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