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INTELLECTUAL PROPERTY, THE INTERNET AND ELECTRONIC COMMERCE

THE CONCEPT "USE IN TRADE ACTIVITY" IN THE BULGARIAN TRADEMARK LAW IN RELATION TO ELECTRONIC COMMERCE AND THE INTERNET

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ABSTRACT

The Bulgarian Law on Marks and Geographical Indications (1999) mentions “use in the trade activity” of the marks in two cases:

(1) when the contents of the right to a registered trademark is defined; and
(2) when the possibility is provided for revocation of the registration for non-use of the mark. The Law gives a definition for the concept “use in trade activity.”

All the provisions with respect to the said questions, however, have been destined for activity in a real world and surrounded by state border territories. In cyberspace, where the Internet functions, and its hundreds of thousands of subscribers with their electronic addresses called domain names, the situation is different. If a domain name has been used as a registered trademark or some other name, coinciding with someone’s registered trademark, does the registration of the domain name represent an infringement according to the provisions of the trademark legislation? Can the registration of one domain name be considered as the use of the mark in all countries worldwide and thus avoid revocation of a registration for non-use elsewhere?

The responses to these questions, as outlined in the effort to find solutions on national and international scales show, that the Bulgarian Trade Mark Law concept is out-of-date and unprepared for new conditions and, therefore, should be modernized.

INTRODUCTION

DoubtlesstheuseoftheInternet,asithappenedoverrecentyears(wehavein mindthe developmentoftheelectroniccommerce),itcreatedagreatnumberofseriouschallengesfor thepresentTradeMarkLaw.Oneofthemisrelatedtothequestion –Isthereanychangein thetraditionalunderstandingfortheconceptof?Whatshoul dbeconsideredasauseofthe trademarkinthetradeactivity?

TheBulgarianLawonMarksandGeographicalIndications(hereinafterreferredtoas “theLaw”)refersintwocasestotheuseofthemark:

- first,inthecasewherethedefinitionisgiven ofthecontentsoftherightsona registeredtrademark(Art. 13,paragraph1);
- second,inthecasewhereapossibilityhasbeenintroducedforrevocationofthe registrationbasedonthenon -useofthemark(Art.19,paragraph 1).

Inthefirstcaseth erightoftheownerofthemarktouseitintradehasbeenstatedas oneofthethreerights,whichtheLawgrantstothesaidownerwiththeregistrationofthe mark.TheLawitself(Art.13,paragraph2)explainswhatistobeunderstoodas“useinth e tradeactivity.”Thisis:

(1) placingthemarkongoodsoronpackagesthereof;
(2) offeringthemarkedgoodsforsale,includingonthemarket,aswellasofferingor providingservicesundersuchamark;
(3) theimportorexportofmarkedgoods;
(4) useofthemar kinbusinesspapersandinadvertisements.

Thisisthegeneralunderstandingoftheuseofthemarkasprovidedforinthelawsof othercountriestoo.

Inthesecondcase,namely –theobligationofuseoftheregisteredmarktoavoida revocationo ftheregistrationfornon -usewithinaperiodof5years,theusementionedisofa morespecifickind,referredtointheLawasrealuse.Inadditiontotheabove -mentioned cases,itincludesaswell:

(1) useofthemarkinappearance,notsignificantly differentfromtheappearancefor whichtheregistrationhasbeengranted,and
(2) placingthemarkonthegoodsorpackagesthereofintheterritoryofBulgaria, independentlyofthefactthattheyaredesignatedforexport.

Allsaidprovisions,however,h avebeendestinedforapplicationinarealenvironment andsurroundedbystateborderterritories.Whatwillhappen,however,whentheactionis transferredincyberspace,wheretherearenorealgoodsandnorealbordersbuttheInternet functions,and wherehundredsofthousandsofsubscribersparticipatewiththeirelectronic addresses,calleddomainnames?Widelyspreadpracticeisthatthedomainnameistobe definedasthename,orthetradenameofthesubscriberorhistrademark.Everyonewho entersintherespectivewebsite,canreadaninformationaboutthestatedmerchant,producer ofgoodsorserviceprovider.Insuchacase,presentingthedomainname,coincidingwitha registeredtrademark,fororinthewebsite,willitmean“useof themark”accordingtothe above-statedtextsoftheBulgarianLaw?

Atafirstglancetheresponseisasimpleone –thisisauseinadvertising –acase, statedexplicitlyinthedefinitionofArt.13,paragraph2,i.4oftheLaw.Ifeverybody, desiringtousetheInternetinBulgariacan,enterthecorrespondingsitetoreadatext,which couldbeacceptedasanadvertisement,thusallincludedinthesaidtext.includingthecode word.withwhichoneentersthewebsite,isacceptedasanadvertiseme ntontheterritoryof Bulgaria.Butifthismatterisacceptedwithoutreservations,whatwillbetheoutcome?First ofall,itappearsthatanyone,whowillregistersuchadomainname,everywhereintheworld infringestherightonatrademarkineve rycountryinwhichtherehasbeenprovidedapublic accesstotheinternet,incasethemarkhasbeenregisteredthere.ItwillmeanthatifXhasa registrationofagivenwordashistrademarkinBulgaria,andthereafterYhasgota registrationfort hesamewordashisdomainnameinCanadaorAustralia,Xwillhavethe righttostartproceedingsforliabilityagainstY(civilproceedings,criminalproceedings, administrativeproceedings –anyoneofthem)onthegroundsthatYuseswithatrade purposethemarkontheterritoryofBulgaria.

Havinginmindthatthedomainnamedoesnotcomprisemoredetailsandisnot registeredinclearlystatedclassesaccordingtotheNiceClassification,theabove -mentioned examplewillbevalidevenifXprodu cesconfectionery,andYtractors.Furthermore,the wholeregulationconcerningrevocationofregistrationsofmarksfornon -usecanbecome senseless,becauseitwillbesufficientforanownerofatrademarktoobtainaregistrationfor thesameashis domainnameinonecountry,inordertopretendthereafterthatheuses permanentlyandreallyhismarkallovertheworld.

Inrecentyears,wehavebecomewitnessesofmanyefforts,onnationaland internationalscales,toovercometheeventualconflict sbetweentheuseofthedomainnames andtherightonregisteredtrademarks.ItissufficienttomentiontheUniformDomainName DisputeResolutionPolicyof1999,theAmericanAnti -cybersquattingConsumerProtection Actof1999,andtheWIPOArbitratio nandMediationCenter.Well -knownaretheeffortsof thesaidOrganizationforworkingoutprovisionsfortheprotectionoftherightsonindustrial property,inconnectionwiththeuseofsignsontheInternet.Havinginmindtheprinciples andtheten denciesincludedinsaiddocuments,onecansaythattheconceptfor“useinthe tradeactivity”definedintheBulgarianTradeMarkLaw,requiresaseriousupdating.Inits presentappearanceitcannotsuccessfullyserveforthenormalsolutionofthepr oblems, createdbythewideenteringoftheInternetincommerce.Aspecificfurtherdevelopmentand legalregulationshouldbegiven,forexample,forthefollowingquestions:

- first,whatdoes“useintradeactivity”mean,whenthematterconcernstheu seof theInternet?
- second,whentheregistrantofadomainnameissubjecttoaliability?Thefactor “badfaith;”
- third,whattheregistrantofadomainnameshoulddoifheischargedwith infringementofatrademarkrightinordertoavoidliability?
- fourth,whatspecificsanctionsaretobeprovidedinthecaseofinfringementof thetrademarkontheInternet?

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