

Trademark Legislation in Kazakhstan Has Been Amended Significantly

By Aigoul Kenjebayeva and Aliya Seitova, Dentons Kazakhstan LLP, Kazakhstan

First published at www.dentons.com

On June 20, 2018, the RK President signed the Law of the Republic of Kazakhstan No. 161-VI “On Amendments to Certain Legislative Acts of the Republic of Kazakhstan Concerning the Improvement of Legislation in the Sphere of Intellectual Property” (hereinafter the “**Law**”). The Law was enacted on July 3, 2018 and, in particular, amends the regulation of trademarks in Kazakhstan. Please see below the following significant changes that will affect the procedure for the defense and protection of trademark rights.

1. **Publication of information about applications:** after conducting a preliminary examination, the expert organization¹ will publish information on an application in the bulletin within 5 business days. This innovation will lead to an increase of the extent of awareness of potential applicants and rights holders about the designations submitted for examination and will also allow applicants to inform third parties of the priority of their applications in order to exclude the use of identical or confusingly similar designations by third parties.
2. **Cancellation of the two-stage system of consideration of trademark applications:** preliminary and final decisions will be made by the expert organization and will no longer be subject to mandatory approval by the authorized body. The same change involved a reduction of the period of examination of the application for a trademark from 9 to 7 months.
3. **Right of the expert organization to revise the decision:** the expert organization will have the right to revise the decision taken before the trademark is entered in the State Register following the identification of an application with an earlier priority. This situation will affect the rights of the applicants and will mean that even if there is a positive decision, the applicant cannot be sure that its trademark will be registered.
4. **Trademark rights are proved by certificates:** right holders may now refer to certificates and attachments to them without requesting additional extracts from the State Register of Trademarks in order to confirm registration, amendment of registration, renewal, and etc.
5. **Date of creation of the exclusive right:** the date of the creation of the exclusive right is determined – it is the registration date of the trademark. Before the adoption of this rule in practice, the issue of the date of the creation of the exclusive right was controversial.

¹ RSE National Institute of Intellectual Property of the Department for Intellectual Property Rights of the RK Ministry of Justice.

6. **Simplification of the procedure for registration of contracts:** examination of contracts is excluded. The subject of state registration will not be the contract itself, but the legal fact. The law excludes unjustified requirements for the execution of contracts. It is expected that in practice the procedure of state registration will be reduced from 40 to 10 business days.
7. **Mandatory terms of the license agreement:** the license agreement must specify the territory on which the use of the trademark is allowed. If the territory is not specified, the licensee has the right to use the trademark throughout the entire territory of the Republic of Kazakhstan. The license agreement should specify the validity period of the right to use the trademark. If the period is not specified, the period shall be considered equal to five years from the registration date of such agreement.
8. **Simplification of the requirements for the documents to be submitted:** a new procedure for submitting a power of attorney is envisaged: The patent attorney is obliged to present the original of the power of attorney within 3 months from the date of the filing of the application or objection. After confirmation of the authenticity, the original of the power of attorney must be returned to the patent attorney. The law establishes the requirements for the execution of the letter of consent: if the owner is a legal entity, the written consent must be submitted on a letterhead, signed by the authorized person and sealed by the legal entity (if the seal exists), and if the owner is an individual, the signature must be notarized.
9. **Trademarks may be used in a modified form:** it is prohibited to restrict the use of a trademark in a modified form, including in a different font, a different color version, or a different form.
10. **New grounds for challenging the registration of a trademark:** the list of the grounds is supplemented with the following two grounds. An objection against registration of a trademark may be filed by any interested person:
 - If the trademark was registered in the name of a representative of the legal owner of the trademark registered in the country party to the Paris Convention² without its consent (for example, the trademark was registered in the name of the distributor);
 - If the trademark is identical or confusingly similar with respect to similar goods and/or services with the trade name of another person, the exclusive right to which originated in the Republic of Kazakhstan earlier than the priority date of the trademark.
11. **Term for appealing the decisions of the Appeal Board in court:** the law does not provide for a term for appeal against the decision of the Appeal Board in court. We note that such term may be specified in the rules for consideration of objections by the Appeal Board, which must be adopted following the Law.
12. **The owner's right for payment of monetary compensation:** a provision is included that allows the right holder, in the case of a proven fact of the offense, to demand compensation from the infringer in the amount determined by the court, based on the nature of the infringement, the market value of the similar (original) goods. Given that it is difficult to prove the amount of losses in practice, the provision on the possibility of collecting monetary compensation will undoubtedly be useful in cases of infringement of exclusive rights to trademarks.
13. **Procedure for cancellation of a trademark based on non-use has been changed:** the mandatory pre-trial consideration of disputes on cancellation action based on non-use of a trademark has been canceled; now the application must be submitted to the court, bypassing the Appeal Board. Evidence of non-use must refer to three years preceding the date of filing an application with the court, and not to any three years from the date of the registration of the contested trademark.

² For the Republic of Kazakhstan, this Convention is valid from February 16, 1993 in accordance with a special declaration of the RK Prime Minister of RK sent to WIPO.

14. **Use of the trademark in the mass media:** now infringement of the exclusive right to a trademark is recognized not only by the use of the trademark on the Internet but also in any form of periodic or continuous public distribution of mass information, including periodicals, television or radio channels.
15. **Counterfeit goods:** the concept of “counterfeit goods” is defined as: goods and their packaging, on which a trademark or designation confusingly similar to it is placed without the right holder’s consent. It is established that counterfeit goods are to be withdrawn from circulation and destroyed at the expense of the infringer on the basis of a court decision that entered into legal force.

For more information, please contact:



Aigoul Kenjebayeva
Managing Partner
Dentons Kazakhstan LLP
aigoul.kenjebayeva@dentons.com
www.dentons.com



Aliya Seitova
Associate and Trademark Attorney
Dentons Kazakhstan LLP
aliya.seitova@dentons.com
www.dentons.com