

# Law of the Republic of Kazakhstan on Trademarks, Service Marks and Appellations of Origin

## Appellations of Origin

This Law shall govern the relations arising out of the registration, legal protection and use of trademarks, service marks and appellations of origin in the Republic of Kazakhstan.

### TITLE 1

#### GENERAL PROVISIONS

##### Article 1

##### Basic definitions used in this Law

The following basic definitions shall be used in this Law:

(1) “*Gazette*” means an official periodical on trademarks and appellations of origin protection matters published by Kazpatent;

(2) “*Owner of the trademark or owner of the right to use the appellation of origin*” means a legal entity or a natural person engaged in business activity and having an exclusive right in trademark or an exclusive right to use the appellation of origin under this Law;

(3) “*Geographical indication*” means an indication identifying goods that originate in a certain territory, region or place;

(4) “*Applicant*” means a legal entity or a natural person who has filed an application for registration of the trademark or for registration and grant of the right to use the appellation of origin;

(5) “*Exclusive right*” means an economic right of the owner to use the trademark or the appellation of origin in any way at his discretion;

(6) “*Use of trademark or appellation of origin*” means the use of a trademark or an appellation of origin on goods for which they are protected and/or on the packaging thereof, manufacture, use, importation, storage, offering for sale, sale of goods designated by a trademark or by an appellation of origin, use on signs, in advertising, in printed publications or in other business documents as well as any other form of marketing;

(7) “*Collective trademark*” means the trademark of an association (union) or any other group of legal entities and (or) individual businessmen (hereinafter referred to as “association”) serving to designate products (service) manufactured or brought into circulation by them that have common qualitative or other characteristics;

(8) “*International Classification of Goods and Services*” means classification adopted by the Nice Agreement of June 15, 1957 as revised and amended;

(9) “*Appellation of origin*” means the geographical indication serving to designate a product, the specific properties of which are exclusively or essentially connected with the place of production thereof, including natural and (or) human factors;

(10) “*Well-known trademark*” means a trademark recognized as well-known in virtue of international agreements to which the Republic of Kazakhstan is party, by a competent authority or court decision based on proof furnished by interested persons;

(11) “*Patent agents*” means nationals who are entitled by legislation to represent natural persons or legal entities before Kazpatent;

(12) “*Trademark or service mark (hereinafter referred to as “trademark”)*” means sign, registered under this Law or protected without registration in virtue of international treaties to which the Republic of Kazakhstan is party, serving to distinguish the goods (services) of one legal entity or natural person from goods and services of the same type of other legal entities or natural persons.

## **Article 2**

### **Legislation of the Republic of Kazakhstan on Trademarks, Service Marks and Appellations of Origin**

(1) The legislation of the Republic of Kazakhstan on trademarks, service marks and appellations of origin consists of this Law and other legislative and regulatory texts of the Republic of Kazakhstan.

(2) Where an international treaty which is ratified by the Republic of Kazakhstan contains provisions that differ from those laid down by this Law, the provisions of such international treaty shall prevail.

## **Article 3**

### **“Competent State Authority”**

The National Patent Office (hereinafter referred to as “KAZPATENT” shall, within the terms of this Law, be responsible for the State monopoly in the field of the legal protection of trademarks and appellations of origin, the receiving of applications for registration of trademarks, registration and granting the right to use appellations of origin, examination thereof and issue of certificates, shall publish official notifications on registration of trademarks and granting the right to use appellations of origin and perform other functions of a Patent office.

## **TITLE II**

### **LEGAL PROTECTION AND CONDITIONS FOR REGISTRATION OF A TRADEMARK**

## **Article 4**

### **Legal protection of trademarks**

(1) The legal protection of trademarks shall be granted in the Republic of Kazakhstan on the basis of the registration thereof under the provisions of this Law as well as without registration in virtue of international treaties to which the Republic of Kazakhstan is party.

(2) The legal protection of trademarks may be granted to any legal entity or natural person engaged in a business activity.

(3) The right in a trademark shall be attested by a certificate.

(4) The owner of the trademark shall have the exclusive right of use and disposal thereof in relation to the goods and services specified in the certificate.

No one may use a trademark protected in the Republic of Kazakhstan without the consent of the owner thereof.

## **Article 5**

### **Signs registered as trademarks**

(1) Figurative, verbal, in letters, digital, three-dimensional and other signs or combinations thereof serving to distinguish goods and services of one person from similar goods and services of other persons may be registered as trademarks.

(2) A trademark may be registered in any color or combination of colors.

## **Article 6**

### **Statutory grounds for refusal of registration of a trademark**

(1) Trademarks may not be registered where they consist solely of signs that are not distinctive, in particular:

- that have become the customary designation for goods of a particular type;
- that are symbols or terms in common use;
- that specify the type, quality, quantity, properties, function or value of the goods, or the place and time of their manufacture or sale;
- that represent life-size or schematic picture of goods for which the registration is sought;
- that represent solely colors.

These signs may be used as unprotected elements of a trademark if they are not predominant.

(2) Those signs may not be registered as trademarks that reproduce armorial bearings, flags or emblems of States, abbreviated or full names of international organizations, official signs or hallmarks of control, warranty or assay, Olympic symbol, decorations and other honorary signs as well as signs that are confusingly similar to such signs,

Such signs may be used as unprotected elements, provided that there is a consent for this of a competent authority or the owner thereof.

(3) Signs may not be registered as trademarks or as elements thereof:

- that are inaccurate or liable to mislead as to the product or its producer, including geographical indications liable to mislead as to the place of product manufacture;
- that formally indicate the real place of product manufacture, but give a wrong impression that the product originates from another territory;
- that are or include geographical indications identifying mineral waters, wines or hard liquors, to designate such products not originating from this place or where a translation is used or a sign is accompanied by such expressions as “type” or “style” or something like that;
- that are contrary to the public interest, humanitarian principles or morality.

## **Article 7**

### **Other grounds for refusal of registration of Trademark**

(1) Those signs may not be registered as trademarks that are identical or confusingly similar to:

(a) trademarks registered in the Republic of Kazakhstan earlier in the name of other person for goods or services of the same type;

(b) trademarks that are well known in the Republic of Kazakhstan for goods and services of any type;

(c) signs in respect of which an application for registration has been filed previously with Kazpatent in the name of a third party for goods and services of the same type, (excepting those withdrawn);

(d) certification marks registered according to the established procedure in the territory of the Republic of Kazakhstan;

(e) appellations of origin protected in the Republic of Kazakhstan, except where they can be incorporated as unprotected elements in a trademark registered in the name of a person authorized to use the said appellation of origin.

(2) Those signs shall not be registered as trademarks that constitute reproduction of:

- industrial designs protected in the Republic of Kazakhstan in the name of other persons on condition that they have priority;
- trade names (or parts of trade names) widely known in the territory of the Republic of Kazakhstan and belonging to third parties whose right to the said names came into being before the priority date of the application for registration of the mark for goods of the same type;
- titles of known literary, scientific or artistic works, or artistic works or parts of such works, that are protected by copyright;
- surnames, forenames, pseudonyms and names derived therefrom, and portraits and likenesses, where the reproduction of those elements infringes the non-pecuniary personal rights of the persons concerned, or their heirs or successors in title, or where those elements form part of the historical and cultural heritage of the Republic of Kazakhstan and are reproduced without the consent of the competent authority;

## **Article 8**

### **Filing of the application**

(1) The application for registration of the trademark shall be filed by applicant or applicants with Kazpatent.

(2) The application for registration of a collective trademark shall be filed in the name of the association in accordance with an agreement of its participants on use of the collective trademark.

## **Article 9**

### **Requirements for an application for registration of the trademark**

(1) The application shall relate to one trademark only.

(2) The application shall be submitted on an official form and shall contain:

- a request for registration of a sign as a trademark, in which the name of the applicant and his headquarters or residence shall be specified;
- the sign in respect of which the application is filed;
- the list of goods and (or) services for which registration of the trademark is sought, grouped in accordance with the International Classification of goods and services.

(3) The application shall be accompanied by:

- proof of payment of the prescribed fee;
- power of attorney where the office work is done through a representative.

(4) The application and any annexed documents shall be drawn in the Kazakh or Russian language. If the documents are submitted in another language the applicant shall submit their translation into Kazakh or Russian language within two months period.

(5) The filing date of an application shall be the date on which Kazpatent has received an application that meets requirements of the par.2 of this Article.

(6) The conditions to be met by the documents constituting an application shall be laid down by Kazpatent.

## **Article 10**

### **Priority of the Trademark**

(1) The priority of a trademark shall be determined by the filing date of the application in Kazpatent.

(2) The priority of a trademark may be determined by the filing date of the first application for the trademark in a State party to the Paris Convention for the Protection of Industrial Property as well as in the international or regional organization provided for in the

Convention (Convention priority) provided that Kazpatent receives the application within six months following the said date. When requesting convention priority the applicant has to indicate number, date and country of its filing and to enclose an attested copy of the first application.

(3) The priority of a trademark affixed to a product displayed at officially recognized international exhibitions may be determined by the date as from which the product in question was on public display at the said exhibition (exhibition priority), provided that Kazpatent receives the application within six months following the said date.

(4) The applicant wishing to enjoy either Convention or exhibition priority shall so declare and submit the documents substantiating the validity of such a claim on filing the application for registration or within two months following the date of receipt of the application by Kazpatent.

(5) In case of a divided application the priority of each of them shall be determined by the priority date of the first application.

### **TITLE III**

#### **EXAMINATION OF THE TRADEMARK**

##### **Article 11**

###### **Examination procedure**

(1) The examination of the application shall be carried out by Kazpatent and shall comprise the following stages:

- preliminary examination shall be carried out within a period of two months, in order to verify the contents of the application, the presence of the required documents and their compliance with the conditions set forth in Articles 5 and 9 of this Law;

- full examination shall be carried out within twelve months following the date of receipt of the application in order to verify the compliance of the trademark with the conditions set forth in Articles 6 and 7 of this Law.

(2) At any stage of the examination Kazpatent may request additional elements, which shall be submitted to it within a period of three months following the date of request sent to the applicant.

If, within the period allowed, the applicant neither supplies the additional elements nor files a request for extension of the said period, the examination of his application shall be discontinued, and the application shall be considered withdrawn.

##### **Article 12**

###### **Decisions on the Examination Findings**

(1) Depending on the finding of the preliminary examination the applicant is informed either that his application has been taken into consideration, that a corresponding number has been assigned to it, the filing date and priority date have been determined or that his application has been rejected, in which case the notification shall take the form of reasoned conclusion.

(2) Depending on the finding of the full examination, Kazpatent shall decide either to register the trademark or to refuse such registration. The decision on the registration can relate either to all list of goods and services or to a part thereof.

(3) The decision to register the trademark may be reconsidered before its entering in the State Register of Trademarks where another application previously registered has been found.

(4) The applicant shall have the right, within the three months following the date on which he has received the examination finding, to appeal the decision. Depending on the results

of consideration of the appeal, the decision is taken either to register the trademark or to confirm wholly or in part the previous decision.

(5) In the event of disagreement with the decision taken at the end of examination under par.4 of this Article, the applicant may, within three months following the date of receipt thereof, to appeal the decision in Kazpatent. The appeal shall be considered by the Board of Appeal within four months following the date of its receipt.

### **Article 13**

#### **Rights of the Applicant**

The applicant shall have the right:

- to withdraw his application at any stage of the examination;
- to intervene in connection with any question raised in the course of the examination of his application;
- to add to, specify or correct the elements of the application, without thereby substantively altering them, until the end of full examination;
- to request extension of the time limit to submit an answer or to lodge an objection but not for more than six months;
- to request restoration of the expired time limit, but not later than two months following the expiration of the time limit concerned;
- to acquaint himself with documents cited against his application.

## **TITLE IV**

### **REGISTRATION OF THE TRADEMARK**

### **Article 14**

#### **State Register of Trademarks**

- (1) Trademarks shall be registered in the State Register of Trademarks.
- (2) The following shall be entered in the State Register of Trademarks:
  - a reproduction of the trademark;
  - the particulars concerning its owner;
  - the number and registration date of the trademark;
  - the list of goods and services for which the trademark is registered;
  - the number and the date of filing of the application in Kazpatent;
  - country, number and filing date of the first application where the Convention priority is established;
  - other particulars concerning the registration of the trademark.
- (3) The State Register of Trademarks shall be open to everybody. Kazpatent shall issue an excerpt from the State Register of Trademarks at the request of any interested party.
- (4) The owner of the trademark have to inform Kazpatent of all changes concerning registration.

### **Article 15**

#### **Term of the Registration**

- (1) The term of the registration of the trademark shall be 10 years from the date of the filing of the application.
- (2) The term of the trademark registration may be renewed for further periods of 10 years at the request of the owner, which request shall be filed in the course of the last year of the

current term of the registration. The mention of the renewal of the term of the registration shall be recorded in the State Register of Trademarks and in the certificate.

(3) The time limit for request provided for in par.2 of this Article may be restored at owner's demand made within six months following expiration of the term of the registration.

## **Article 16**

### **Publication of Particulars of the registration**

The particulars concerning the trademark registration that have been recorded in the State Register of Trademarks as well as subsequent amendments concerning the registration shall be published in the Gazette by Kazpatent directly after their entering in the State Register of Trademarks.

## **Article 17**

### **Conditions Governing Re-registration of the Trademark**

When the term of the registration of the trademark has expired, that trademark may not be reregistered in the name of a person other than the previous owner for a period of three years following the date on which the term of the registration ended.

This condition shall apply also where the owner of the trademark has renounced the mark prior to the expiration of the term of the registration.

## **Article 18**

### **Trademark Certificate**

(1) A certificate of a standard pattern shall be issued for a trademark registered under this Law.

(2) The trademark certificate certifies the fact of the trademark registration, its priority, the exclusive right of the trademark owner for goods and services specified in the certificate.

(3) The form of the certificate shall be determined by Kazpatent.

## **TITLE V**

### **EXPLOITATION OF THE TRADEMARK**

## **Article 19**

### **Conditions of the trademark exploitation**

(1) The owner of the trademark shall be bound to exploit the trademark.

(2) Entrepreneurs who engage in intermediary activity shall have the right to make use, on the goods that they sell, of their own trademarks in conjunction with the trademark of the manufacturer of the goods or, subject to his agreement, in place of the latter's trademark.

(3) Owners of a collective trademark may affix their own individual trademarks in conjunction with the collective trademark on goods that they manufacture.

(4) Any interested party may file with Kazpatent a request for the cancellation of the registration of the trademark where the trademark has not been exploited in the five years following the date of registration thereof or in the five years preceding the filing date of the request. The request may relate to all or a part of goods specified in the certificate and shall be considered by the Board of Appeal within six months following the date of its receipt.

The use of a trademark on goods for which it is registered and (or) on the packaging thereof shall be deemed to constitute exploitation of the trademark. The use of the trademark in advertising, in printed publications, on official headed paper, on signs or in connection with the

display of goods at exhibitions that take place in the Republic of Kazakhstan may be considered as the exploitation thereof.

The decision on whether or not to cancel the registration of the trademark for want of exploitation may be subject to the consideration of proof submitted by the owner to show that the failure to exploit the trademark is due to factors beyond his control.

(5) Persons who began to use in good faith a trademark that is identical with or confusingly similar to a registered appellation of origin not less than six months prior to the registration date of the appellation of origin, retain the right to use it subsequently for a period fixed by Kazpatent, but not less than seven years beginning from the date of that registration. Where the trademark has not been used or has been used for less than six months prior to the registration date of an appellation of origin, the effect of the trademark shall be terminated prematurely.

## **Article 20**

### **Special marking**

The owner of a trademark certificate may add alongside the trademark a special marking by Latin letter ® or by verbal signs “trademark” or “registered trademark” indicating that the used sign is registered in Kazakhstan as a trademark.

## **Article 21**

### **Transfer of the Right to the Trademark**

(1) The exclusive right to the trademark in respect of all or some of the goods and services specified in the certificate may be contractually assigned by the owner thereof to another person.

No transfer of the right to the trademark shall be allowed where it might mislead as to the product or its manufacturer.

The transfer of the right to the trademark, including contractual or successional transfer, shall be registered in Kazpatent.

(2) The right to exploit a trademark may be granted by the owner thereof (licensor) to another person (licensee) under the terms of a license agreement in respect of all or some of the goods and services specified in the certificate.

The license contract allowing to licensee to exploit the trademark shall specify that the quality of the licensee’s goods or services shall not be inferior to that of the licensor’s goods and services and that the observance of the said condition may be ensured by the licensor.

The effects of the license contract shall end with the end of the right to a trademark.

The transfer of the right to the trademark to another person shall not entail the cessation of the license contract.

(3) Trademark assignment contract or license contract shall be done in writing and registered in Kazpatent. In the absence of writing and registration the contract shall be deemed null and void.

## **Article 22**

### **Transfer of the right to a trademark in the event of restructuring of the Legal person by dividing**

In the event of the division of a legal entity the right to a trademark shall be transferred to the newly created legal entity to which the manufacture of the goods or the corresponding service activity has been transferred.

Where each of newly created legal entities retains part of the activities relating to manufacture of goods or services, for which the trademark is registered, new legal entities shall be recognized as joint owners of the trademark, provided that they agree between themselves.

## **TITLE VI**

### **END OF THE EFFECTS OF THE TRADEMARK REGISTRATION**

#### **Article 23**

##### **Contestation of the trademark registration**

(1) The registration of the trademark may be contested and invalidated either entirely or in part at any time during its term if the conditions specified in Articles 6 and 7, excepting Article 7(1)(a-c) of this Law, were not met, when it was effected or, during the five years following the date of the trademark registration, if it was effected in violation of requirements set forth in Article 7(1)(a-c) of this Law.

(2) Any interested person may, on grounds specified in par.1 of this Article, file with Kazpatent opposition to the registration of the trademark.

The opposition shall be considered by the Board of Appeal within six months following the date of its receipt. The person that filed the opposition as well as the owner of the trademark have the right to participate in the proceeding.

#### **Article 24**

##### **Termination of the Registration of the Trademark and its invalidation**

(1) The registration of the trademark shall cease to produce its effect:

- on the expiration of the term provided for in Article 15 of this Law;
- in case of liquidation of the legal entity or cessation of activity by a natural person that owns the trademark;
- on renunciation in writing by the owner of the trademark;
- in case of non-use of the trademark in accordance with Article 19(4) of this Law;
- in case of registration of identical or confusingly similar appellation of origin in accordance with Article 19(5) of this Law.

(2) The registration of the trademark shall be deemed invalidated entirely or in part by the decision of the Board of Appeal or Court on the grounds provided for in Article 23(1) of this Law.

(3) Kazpatent makes an entry into the State Register of Trademarks concerning a cancellation of the trademark registration because of expiration of its term or its invalidation.

## **TITLE VII**

### **LEGAL PROTECTION AND CONDITIONS GOVERNING REGISTRATION OF THE APPELLATION OF ORIGIN**

#### **Article 25**

##### **Legal protection of Appellations of Origin**

(1) Legal protection of appellations of origin shall be granted in the Republic of Kazakhstan on the basis of their registration effected in accordance with the provisions of this Law or under international treaties to which the Republic of Kazakhstan is party.

(2) The exclusive right to use the appellation of origin may be granted to one or several legal entities or natural persons engaged in business activities, manufacturing in this geographical area goods the properties of which are related, exclusively or mostly, to this geographical area, including natural and (or) human factors.

## **Article 26**

### **Designations registered as appellations of origin**

The name of a country, locality, region, including their historical names, as well as names of other geographical objects or their combination with specific appellations of goods may be registered as appellations of origin.

## **Article 27**

### **Designations not registered as appellations of origin**

The following designations shall not be registered as appellations of origin:

- those that represent the name of geographical area, but are confusing as to the place of manufacture of that product;
- those that formally indicate the real place of manufacture of a product but give an erroneous idea that this product originates from another territory;
- those that contain geographical indications not related to a place of manufacture and are widely used in the Republic of Kazakhstan as designations of some known goods.

## **Article 28**

### **Filing of the application**

The application for registration of an appellation of origin and granting of right to use the appellation of origin (hereinafter referred to as “the application”) shall be filed with Kazpatent by the applicant.

## **Article 29**

### **Conditions to be met by the Application**

- (1) The application shall relate to one appellation of origin only.
- (2) The application shall be presented on a standard form and shall contain:
  - a request for registration and (or) the grant of the right to use the appellation of origin, in which the applicant and also his headquarters or place of residence shall be specified;
  - the designation in respect of which the application is made;
  - the type of product;
  - a description of the particular properties of the product;
  - a mention of the place of manufacture thereof (limits of the geographical area).
- (3) The application shall be accompanied by the following:
  - document proving the payment of the prescribed fee;
  - a statement from the competent body to the effect that the applicant is located in the geographical area specified and manufactures a product whose particular properties are determined by natural and (or) human factors characteristic of the geographical area in question;
    - in the case of a foreign applicant a document attesting his right to use the appellation of origin in question in the country of origin of the product;
    - a document attesting the powers of the representative (if the application is filed through such a representative).
- (4) The application and annexed documents shall be written in the Kazakh or Russian language. If the said documents are written in another language the applicant shall submit within two months following the date of filing of the application their translation into the Kazakh or Russian language.

## **TITLE VIII**

### **EXAMINATION OF THE APPELLATION OF ORIGIN**

#### **Article 30**

##### **Examination procedure**

(1) Within six months following the filing date of the application Kazpatent shall carry out an examination during which it verifies the compliance of the application with conditions set out in articles 26, 27 and 29 of this Law.

(2) At any stage of the examination Kazpatent may request additional elements which shall be submitted to it within a period of three months following the date of sending of the request to the applicant.

If, within the period allowed, the applicant neither supplies the additional elements nor files a request for extension of the said period, the examination of his application shall be discontinued and the application considered withdrawn.

#### **Article 31**

##### **Decisions on the Examination Findings**

(1) On the basis of the examination findings Kazpatent shall decide:

- either that the application has been taken into consideration and a number assigned to it, or that the application has been rejected, in which case the decision shall take the form of reasoned conclusion;

- to register the appellation of origin and (or) grant the right to use it;

- to refuse the registration of the appellation of origin and (or) the grant of the right to use it.

(2) The applicant may, within three months following the date of receipt of the decision concerning the refusal to register the application, to submit a reasoned objection with request to reconsider the examination findings.

In the case of disagreement with this new decision the applicant may contest it under the procedure specified in Article 12(5) of this Law.

#### **Article 32**

##### **Rights of the Applicant**

In the case of the examination of the appellation of origin the applicant shall have the rights specified in Article 13 of this Law.

## **TITLE XI**

### **REGISTRATION AND GRANT OF THE RIGHT TO USE THE APPELLATION OF ORIGIN**

#### **Article 33**

##### **Procedures of Conduct of the State Register of Appellations of Origin**

(1) The registration of appellations of origin and grant of the right to use appellations of origin are being effected in the State Register of Appellations of origin on the basis of the examination findings.

(2) The following shall be entered in the State Register of Appellations of origin:

the appellation of origin itself, the number and the date of registration, a description of the particular properties of the product, the particulars of all owners of the right to use appellations of origin with a mention of their location, numbers and dates of filing of the applications and other particulars concerning the registration.

(3) The owner of the right to use the appellation of origin shall be obliged to inform Kazpatent of all changes concerning the registration. A mention on changes shall be entered by Kazpatent in the State Register of Appellations of origin and in the certificate.

(4) Kazpatent shall issue an excerpt from the State Register of Appellations of origin at the request of any interested party.

#### **Article 34**

##### **Term of the registration of the appellation of origin and of the right to use the appellation of origin**

(1) The registration of the appellation of origin shall have an effect without time-limit on condition that a product manufactured in the territory of a said geographical area retains the properties of the product.

(2) The term of the right to use the appellation of origin shall be 10 years from the date of filing of the application with Kazpatent.

(3) The term of the right to use the appellation of origin shall be extended by periods of 10 years at the demand of the owner filed during the last year of its term provided that the product in respect of which the appellation of origin has been registered retains its properties.

(4) The demand to extend the term of the right to use the appellation of origin shall be submitted simultaneously with a statement by a competent authority in accordance with Article 29 of this Law. Any extension of term of the registration shall be recorded in the State Register of Appellations of origin and in the certificate.

(5) The time-limit to file a demand fixed in par.3 of this Article shall be restored at the request of the owner filed during six months following the expiration of the term of the registration.

#### **Article 35**

##### **Publication of the particulars on the registration**

The particulars on the registration of the appellation of origin and the granting of right to use the appellation of origin as well as any subsequent changes shall be published by Kazpatent in the Gazette immediately after their entering in the State Register of Appellations of Origin.

#### **Article 36**

##### **Certificate Attesting the Right to Use the Appellation of Origin**

(1) The certificate of a determined form shall be issued for the appellations of origin registered in accordance with this Law.

(2) The certificate attests the fact of the registration of the appellation of origin and the exclusive right of the owner to use it in respect of product specified in the certificate.

(3) The form of the certificate shall be determined by Kazpatent.

## **TITLE X**

### **EXPLOITATION OF THE APPELLATION OF ORIGIN**

#### **Article 37**

##### **Conditions governing Exploitation of the Appellation of Origin**

(1) The owner of the right to use the appellation of origin shall have the exclusive right to use it.

(2) The geographical indication may not be used without registration where it is identical with or confusingly similar to the appellation of origin that has been registered for similar goods.

(3) The appellations of origin may not be used where they are or include geographical indications identifying mineral waters, wines or hard liquors, to designate such products not originating from this place even if the real place of origin is indicated or a translation is used or a sign is accompanied by such expression as “type” or “style” or something like that.

(4) The alienation, other transactions concerning transfer of the right of use of an appellation of origin and the grant of the right to use the appellation of origin on the basis of a license agreement shall not be authorized.

#### **Article 38**

##### **Special marking**

The owner of the right to use the appellation of origin may add alongside the appellation of origin a special marking by Latin letter ® or by verbal signs “registered appellation of origin” or “reg. AO”.

## **TITLE XI**

### **END OF THE LEGAL PROTECTION OF THE APPELLATION OF ORIGIN**

#### **Article 39**

##### **Contestation of the appellation of origin registration and (or) of granting of the right to use the appellation of origin**

(1) The registration of the appellation of origin and (or) of the granting of right to use the appellation of origin may be contested and invalidated if the conditions specified in Articles 26, 27 and 29 of this Law, were not met.

(2) Any interested person may, on grounds specified in par.1 of this Article, file with Kazpatent opposition to the registration of the appellation of origin and (or) of granting of the right to use the appellation of origin.

The opposition shall be considered under procedure and within time-limit provided for in Article 23(2) of this Law.

#### **Article 40**

##### **Termination of the registration of the Appellation of Origin and of the Right to use the Appellation of Origin and their invalidation**

(1) The registration of the appellation of origin shall cease to produce its effect:

- where the factors characteristic of the geographical area in question are no longer present, making it impossible to manufacture a product with the properties specified in the State Register of Appellations of Origin for the appellation of origin in question;

- in the event of the end of the legal protection for the appellation of origin in the country of origin.

(2) The validity of the right to use the appellation of origin shall terminate:

- on the expiration of its term specified in Article 34 of this Law;

- where the product no longer possesses the specific properties recorded in the State Register of Appellations of Origin in relation to the appellation of origin in question.

- on the basis of a request of the owner of the right to use the appellation of origin filed with Kazpatent;

- in the event of liquidation of the legal entity or cessation of business activity by a natural person who owns the right to use the appellation of origin.

(3) The registration of the appellation of origin and (or) of granting of the right to use the appellation of origin shall be deemed invalidated by the decision of the Board of Appeal or Court on grounds specified in Article 39(1) of this Law.

(4) Kazpatent makes an entry into the State Register of Appellations of Origin concerning a cancellation of the registration of the appellation of origin or of granting of the right to use the appellation of origin because of the termination of their validity or their invalidation.

## **TITLE XII**

### **DEFENCE OF RIGHTS OF TRADEMARK OWNERS AND OF RIGHTS TO USE THE APPELLATIONS OF ORIGIN**

#### **Article 41**

##### **Board of Appeal**

(1) The Board of Appeal, a structural unit within Kazpatent, shall be the competent authority entrusted with extrajudicial consideration of disputes relating to the notice of opposition filed in accordance with Article 12(5), Article 19(4), Article 23(2) and Article 39(2) of this Law.

The Statute of this Board of Appeal and the appropriate procedure for filing and consideration of the notice of opposition shall be approved by Kazpatent.

(2) The filed notice of opposition shall be considered by a collegium of experts of the Board of Appeal within the time limit prescribed by this Law.

The said time limit may be extended, at the request of the contestant or the owner of the trademark or of the right to use the appellation of origin, for the period not exceeding six months from the date of expiration of the prescribed time limit.

(3) The contestant, the trademark owner or the owner of the right to use the appellation of origin may contest in court the decision of the Board of Appeal within six months following the date of receipt of the decision.

#### **Article 42**

##### **Settlement of Disputes**

(1) The competence of the courts shall extend to disputes arising from:

- the legality of the grant of a certificate;

- infringements of the exclusive right of the trademark owner or the owner of the right to use the appellation of origin;

- the conclusion and execution of license contracts for the use of the trademark;

- other disputes arising out of the protection of rights evidenced by a certificate.

(2) Kazpatent shall, on the basis of a court decision, publish information on changes concerning the registration.

#### **Article 43**

#### **Liability of legal entities or natural persons for infringement of laws on trademarks and appellations of origin**

(1) A non-authorized marketing of a trademark or an appellation of origin or of signs that are confusingly similar to them in relation of similar goods or services shall be considered as an infringement of the exclusive right of the trademark owner or the owner of the right to use the appellation of origin.

(2) Any person who uses the protected trademark or the appellation of origin or a sign that is confusingly similar to it, violating requirements of this Law, shall be liable to sanctions under the legislation of the Republic of Kazakhstan.

#### **Article 44**

#### **Obligations of the person who infringes the rights of the trademark owner or the owner of the right to use the appellation of origin**

Any person who unlawfully uses a trademark or an appellation of origin or a sign that is confusingly similar to it shall be bound:

- to discontinue their use and to compensate the trademark owner or the owner of the right to use the appellation of origin for the amount of the prejudice caused;
- to destroy the manufactured representation of the trademark or of the appellation of origin, to remove from a product, its packaging, headed forms or other documentation the unlawfully used trademark or appellation of origin, as well as a sign that is confusingly similar to them.

Where this requirement cannot be met, the goods in question shall be destroyed under procedure provided for by the legislation of the Republic of Kazakhstan.

### **TITLE XIII**

#### **FINAL PROVISIONS**

#### **Article 45**

#### **Fees for Legal Acts Payable to Kazpatent**

The performance by Kazpatent of legal acts provided for in this Law including the receipt of applications for registration of a trademark, applications for registration and grant of the right to use the appellation of origin, carrying out examination, issue of certificates and any other acts giving rise to rights and obligations for participating parties, shall, under legislation in force, be subject to payment of fees to Kazpatent.

#### **Article 46**

#### **Patent Agents**

(1) Natural persons who are nationals of the Republic of Kazakhstan having their residence in its territory and whose professional qualities meet the prescribed requirements may qualify for a patent agent. The requirements to be met by patent agents and the appropriate procedure for their qualification and registration shall be determined by Kazpatent.

(2) Natural persons having their residence outside the territory of the Republic of Kazakhstan and foreign legal entities shall be required to act through patent agents registered

with Kazpatent in all proceedings conducted for the purpose of registration of trademarks and appellations of origin, for lodging an appeal with the Board of Appeal and participating in its consideration.

Natural persons having their permanent residence in the Republic of Kazakhstan but temporarily residing outside its territory may act on their own in all proceedings conducted for the purpose of registration of trademarks and appellations of origin provided that they indicate the address for business in the Republic of Kazakhstan.

(3) The powers of the patent agent shall be certified in a power of attorney.

#### **Article 47**

##### **Registration abroad**

(1) The legal entities and natural persons of the Republic of Kazakhstan may have a trademark registered abroad or have it registered internationally. The application for international registration of the trademark shall be filed through Kazpatent.

(2) The registration of the appellation of origin abroad may be effected after its registration and receipt of the right to use this appellation of origin in the Republic of Kazakhstan.

#### **Article 48**

##### **Rights of Foreign Natural Persons, Legal Entities and Stateless Persons**

Foreign natural persons, legal entities and stateless persons shall enjoy the rights and have the obligations provided for in this Law on the same footing as natural persons and legal entities of the Republic of Kazakhstan unless otherwise provided for by legal enactments of the Republic of Kazakhstan.