

# **LAW No. 456 of 26th JULY 1999 OF THE REPUBLIC OF KAZAKHSTAN**

## **CONCERNING TRADE MARKS, SERVICE MARKS AND APPELLATIONS OF ORIGIN**

The present Law shall regulate the relations which arise in connection with the registration, legal protection and use of trade marks, service marks and appellations of origin in the Republic of Kazakhstan.

### **CHAPTER 1. GENERAL PROVISIONS**

#### **Article 1. Basic Concepts Used in the Present Law**

The following basic concepts shall be used in this Act:

- 1) the exclusive right - a property right of right holder to use the trademark or appellation of origin in any manner at his discretion;
  - 1-1) confusingly similar signs - similar signs or designations having distinction of individual elements and perceived by consumers as identical;
  - 1-2) identical trade marks - signs or designations that coincide in all the elements ;
  - 1-3) goods or services of the same kind - goods or services that perform the same kind (type) of function that may cause the consumer believe that they belong to the same manufacturer;
- 2) newsletter - official periodical on protection of trade marks and appellations of origin;
- 3) name of the geographical object - is an indication that identifies a product originating from a particular territory, region or locality;
- 4) well-known trademark - a designation that is used as a trademark or a trademark acknowledged as well-known by virtue of international agreements the Party of which is the Republic of Kazakhstan, the decision of the competent authority or court, based on the evidence of interested parties;
  - 4-1) Madrid Agreement - the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891 ;
- 5) applicant - legal person or individual filed an application for trademark registration or registration and granting right to use the appellation of origin;
- 6) patent agents - citizens of the Republic of Kazakhstan entitled in accordance with the legislation of the Republic of Kazakhstan to represent individuals or legal entities to the competent authority and the expert organization;
  - 6-1) Singapore Treaty - the Singapore Treaty on the Law of Trademarks of March 27, 2006;
- 7) International Classification of Goods and Services - classification adopted by the Nice Agreement dated June 15, 1957, as subsequently amended;
- 8) trademark, service mark (hereinafter - the trade mark) - mark registered in accordance with this Act, or protected without registration by virtue of international

treaties in which the Republic of Kazakhstan participates, which serves to distinguish the goods (services) of one natural or legal person from homogeneous goods (services) of other legal or natural persons;

9) the use of a trademark or appellation of origin - the use of a trademark or appellation of origin for the goods and in rendering services for which they are protected, and (or) their packaging, manufacturing, use, importation, possession, offering for sale, sale of goods with a designation of a trademark or appellation of origin, use in billboards, advertising, printed materials and other business documentation as well as other introduction into civil circulation;

10) the owner of the trademark or the right to use the appellation of origin - a legal person or individual, having the exclusive right to the trademark or the exclusive right to use the appellation of origin in accordance with this Act;

11) the appellation of origin - a designation that represents or include the name of a country, region, settlement, locality or other geographical object as well as an indication derivative from that name which has become known as the result of its use in relation to the good the special properties, quality, reputation or other characteristics of which are exclusively or essentially attributable to its geographical origin, including natural and human factors;

12) the collective trademark - a trademark of an association or any other union of legal persons and (or) individual entrepreneurs (hereinafter - the union) that is used for designation of produced or sold goods (services) that have common qualitative or other characteristics.

**Article 2. Legislation of the Republic of Kazakhstan on Trade Marks, Service Marks and Appellations of Origin**

1. Legislation of the Republic of Kazakhstan on trade marks, service marks and appellations of origin shall consist of the Civil Code, the present Law and any other regulatory legal acts of the Republic of Kazakhstan

2. When international treaty ratified by the Republic of Kazakhstan establishes other rules than those contained in the present Law, then the rules of the international treaty shall apply.

**Article 3. The Authorised State Body in the Sphere of Protection of Trade Marks, Service Marks and Appellations of Origin**

1. The authorised state body (henceforth — the authorised body) is the state body appointed by the Government of the Republic of Kazakhstan and exercising the state regulation in the sphere of protection of trademarks, service marks and appellations of origin.

2. The scope of the authorised body shall be as follows:

1) participation in the implementation of the state policies in the sphere of legal protection of trade marks, service marks, appellations of origin;

2) registration of trademarks and appellations of origin;

2-1) determination of the procedure for recognition of a trade mark as well-known;

2-2) determination of the procedure for registration of appellations of origin and (or) granting the right to use appellations of origin;

2-3) approval of the application form for registration of the agreement on the transfer of trademark rights;

2-4) approval of the application form for registration of a license agreement or sub-license agreement to use a trademark, agreement of complex entrepreneurial license and pledge agreement;

3) supervision of activities of physical persons and legal entities using trademarks, appellations of origin, service marks;

4) compilation of protocols and handling of administrative violation cases, imposition of administrative punishments;

5) performance of other powers provided for by this Law, other laws of the Republic of Kazakhstan, acts of the President of the Republic of Kazakhstan and Government of the Republic of Kazakhstan.

**Article 3-1. State monopoly in the field of trademarks, service marks, appellations of Origin**

1. The following activities shall refer to state monopoly and shall be carried out by expert organization set up by the Government of the Republic of Kazakhstan in the legal form of the republican state enterprise: acceptance and examination of applications for registration of trademarks, service marks and appellations of origin; examination of contracts on transfer of rights for trademarks, service marks, license (sublicense) agreements; maintenance of the State registers of protected trademarks, service marks and appellations of origin, including acceptance of application for registration of a collective trademark; formal examination; amendments and corrections to the application materials; allocation of a trademark application according to classes at the initiative of the applicant; conversion of an application for a trade mark into collective trademark and vice versa; acceptance of the international application under the Madrid Agreement; preparation of the list of goods and services in accordance with the international classification of goods and services; preparation and transfer of an application to amend the international application; examination of an application additionally for each class beyond three; urgent examination not earlier than six months from the filing date; consideration of objections to the decision of provisional refusal of registration; extension of the deadline for filing objections to the decision of examination for each month; extension of the response to the request for each month; restoration of the missed term for response to the request of payment, an objection by the applicant; publication of the information on registration; amendments into the state registers of protected trademarks, service marks and appellations of origin; extension of the term for registration of the right to use an appellation of origin, registration of the trademark and additionally for each class beyond three; publication of information on the extension; examination of the pledge agreement, agreement on complex entrepreneurial license in respect of one or group of objects of industrial property; examination of supplementary agreements and publication of information on registration of contracts; issuance of extracts from the state registry; preliminary search of designation in the database of trademarks and designations applied for registration in respect of indicated classes of goods and services; implementation and publication of printed and electronic publications.

2. The activities technologically related to the activity of expert organization include:

- 1) certification of a copy of the application (priority document);
- 2) confirmation of payment.

3. The prices for goods (works, services) produced and (or) sold by the state monopoly entity shall be established by the authorized body in coordination with the competition authority.

## **CHAPTER 2. LEGAL PROTECTION AND TERMS OF TRADE MARK REGISTRATION**

### **Article 4. Legal Protection of Trade Marks**

1. The legal protection of trade marks in the Republic of Kazakhstan shall be granted on the basis of their registration in accordance with the procedure as established in the present Law, as well as without registration by force of international treaties of the Republic of Kazakhstan.

2. The legal protection of trade marks may be granted to legal entities or physical persons.

3. The right to trade mark shall be certified by note on registration in the State register of trade marks of the Republic of Kazakhstan and confirmed by the extract from the State register of trade marks of the Republic of Kazakhstan.

4. The owner of trade mark shall have the exclusive right to use and dispose of the trade mark owned by it with respect to goods and services indicated in the certificate. Nobody can use the trade mark protected in the Republic of Kazakhstan without the consent of the owner.

### **Article 5. Designations Registered as Trade Mark**

1. As a trade mark there may be registered graphic, wordy, letter forms, numerical, volume and any other designations or their combinations which allow to distinguish goods and services of certain entities from similar goods or services of other entities.

2. The trade mark may be registered in any colour or combination of colours.

### **Article 6. Absolute Basis Which Exclude Registration of Trade Mark**

1. There shall not be allowed the registration of trade marks which exclusively consist of designations which do not have the distinctive ability;

- 1) those which are in general use for the designation of goods and services of certain type;
- 2) those which are generally accepted symbols and terms;
- 3) those which indicate the type, quality, quantity, feature, designation, value of goods, as well as to the place and time of their production or selling;
- 3-1) those which represent international non-patented names of pharmaceutical products;

4) having direct descriptive and (or) associated connection with the goods or services for the marking of which it is used.

The indicated designations may be used as non-protected elements of trade marks when they do not occupy a dominant position.

2. There shall not be registered as trade marks the designations which reproduce the state emblems, flags and emblems, abbreviated or full names of international organisations and their coats of arms, flags and emblems, official control, guarantee and hallmarks, seals, Olympic symbolism, decorations, and any other signs of distinction, as well as designations which are alike to the extent of confusion.

Such designations may be used as non-protected elements where a mark does not consist exclusively of them or where the approval exists for their use from the appropriate competent authority or their owner.

3. There shall not be allowed the registration as trade marks or their elements of the designations:

1) which are false or may mislead with respect to goods or its manufacturer, including the names of geographical objects which may mislead with respect to the place of manufacturing of goods;

2) which formally indicate to the true place of manufacturing of goods, but give the erroneous presentation that goods originate from other territory;

3) which represent themselves or contain the names of geographical objects identifying mineral waters, wines or strong alcohol drinks for designation of such goods not originating from said place, as well as when the translation is used or designation is accompanied by such expressions as «type», «in style of» or the like;

4) which contradict in its contents to the public order, principles of humanity and morality.

#### **Article 7. Other Basis for Denying the Registration of Trade Mark**

1. The designations shall not be subject to registration as trade marks which are similar or alike to the degree of confusion:

1) with trade marks registered in the Republic of Kazakhstan and protected under international agreements with earlier priority in the name of other entity with respect to homogeneous goods and services or identical trade marks of the same entity with respect to the same goods and services;

2) with acknowledged as well-known trade marks in the Republic of Kazakhstan with respect to any types of goods and services;

3) with designations submitted for the registration with earlier priority in the name of other entity with respect to homogeneous goods and services (except for those which are recalled) or identical designations of the same entity with respect to the same goods and services;

4) with appellations of origin protected in the Republic of Kazakhstan in relation to any goods, unless they can be incorporated as unprotected element of a trademark registered in the name of the person authorized to use this appellation of origin, if registration of a trademark is executed for the same good for individualization of which appellation of origin is registered.

Registration of a designation as a trademark in relation to homogenous goods or services, confusingly similar to any of the trademarks referred to in subparagraphs 1), 2)

and 3) of the first part of this paragraph is subject to the granting of the trademark owner's consent.

2. There shall not be registered as trade marks the designations which reproduce:

1) industrial samples protected in the Republic of Kazakhstan in the name of other entities, subject to their earlier priority;

2) names of works of literature, science and art known in the Republic of Kazakhstan at the date of submission of the application, known works of arts and their parts in violation of copyrights;

3) surnames, names, pseudonyms and their derivatives, portraits and facsimile in violation of personal nonmaterial rights of those persons and their heirs or legal successors, and also when these designations represent the property of history and culture of the Republic of Kazakhstan – without authorisation of the relevant competent body.

#### **Article 8. Submission of Application**

1. An application for a trademark shall be submitted to an organisation of experts by one applicant.

2. An application for a collective trademark shall be submitted in the name of association in accordance with the consent of its participants to use the collective trade mark.

3. Applications may be filed in the form of an electronic document, certified by digital signature.

#### **Article 9. Requirements to Application for Registration of Trademark**

1. An application shall be related to one trade mark.

2. An application shall be presented on the standard blank, and it shall contain the following:

1) a request for the performance of an expert evaluation of an appellation with the name of the applicant, as well as his location or place of residence;

2) designation applied;

3) the list of goods and (or) services in accordance with the International classification of goods and services.

3. The following shall be attached to the application:

1) a document confirming the payment for services of an organisation of experts with regard to carrying out an expert examination. Amount of remuneration shall be established in accordance with the legislation of the Republic of Kazakhstan;

2) power of attorney, in the case of record-keeping through the representative;

3) the charter of a collective trademark (where an application is submitted for a collective trademark), including the name of an organisation authorised to register a given collective trademark in its name, the purpose of the registration of that trademark, the list of the entities having the right to use that mark, the list and uniform properties or other parameters of the goods and services that will be designated with the collective trademark, the conditions of its use, the procedure for the supervision of its use, the liability for violation of the provisions of the charter of the collective trademark.

4. The application and documents attached to it shall be submitted in Kazakh or Russian language. When the documents are submitted in another language, the applicant shall submit within one month their translation into Kazakh or Russian languages.

5. The date of submission of the application shall be established by the date of receipt by the the organisation of experts of the application which meets the requirements of paragraph 2 of the present Article, in the event that said documents were submitted at different times, — on the basis of the date of receipt of the last document submitted.

6. Procedure of preparation, processing and consideration of the application for a trademark is established by the authorized body.

**Article 10. Priority of Trade Mark**

1. The priority of the trade mark shall be established based on the date of submission of the application to the organisation of experts.

2. The priority of a trade mark may be established based on the date of the first submission of the first (first) application (applications) for the trade mark in the member-state of the Paris convention for the protection of industrial property, as well in an international or regional organisation (convention priority) stipulated by it, when the submission of an application to the organisation of experts was carried out within six months from the indicated date. When seeking the convention priority, the applicant shall indicate the number of the first application, the date and country of its submission and attach the certified copy of the first application.

3. The priority of trade mark placed at exhibits of the officially recognised international exhibitions may be established by the date of the beginning of open demonstration of the exhibit (exhibition priority) if the submission of the application to a trademark to an organisation of experts has been carried out within six months from the indicated date.

4. An applicant who wish to make use of the convention or exhibition priority shall be obliged to indicate it and submit the relevant documents confirming the legality of such requirement, when submitting the application for the trade mark or within two months from the date of the receipt of the application by the organisation of experts.

5. In the case of division of the application, the priority with respect to each of application shall be established by the date of the priority of the first application.

Priority with regard to separate applications shall be determined on the basis of the date of priority of the original application of the same applicant, and in where there is the right to establish an earlier priority on the basis of the original application — on the basis of the date of that priority, unless at the date of the submission of the separate application the original application was revoked and unless it is deemed to be revoked and the submission of the separate application was carried out prior to the adoption of a decision on the original application.

6. The multiple priority of a trademark with regard to different goods shall be established on the basis of a petition of the applicant where there are several applications from the applicant with regard to one designation for different goods.

### **CHAPTER 3. EEXPERT EXAMINATION OF TRADE MARKS**

#### **Article 11. The Procedure for Performance of Expert Examination**

1. An expert examination shall be carried out by the organisation of experts by stages:

1) preliminary expert examination– within one months from the date of the receipt of the application in the course of which the contents of the application, the existence of needed documents are checked in accordance with requirements as established by Articles 5 and 9 of the present Law. As a result of the examination applicant within ten working days shall be sent a notice of acceptance of the application for review or termination of proceedings.

2) full expert examination- within nine months from the date of submission of the application in the course of which the compliance of the designation sought with requirements is checked as established by Articles 6 and 7 of the present Law.

3) upon the written request of the applicant, subject to additional payment, the examination of a trademark application shall be carried out earlier than the time limits specified in subparagraph 2) of this paragraph, but not earlier than six months from the date of filing.

2. At any stage of the expert examination the organisation of experts shall have the right to require additional materials which must be presented within three months from the date of sending the request to the applicant.

In the case of failure of the applicant to submit the additional materials within the established deadline or petition to extend the indicated deadline, the record-keeping shall be terminated, and the application shall be considered revoked.

#### **Article 12. Decision on Results of Expert Examination**

1. Based on the results of preliminary examination, the applicant within 10 working days shall be informed either about the acceptance of the application for review, assignment of an appropriate number, filing date and priority date, or the refusal to accept the application for consideration in the form of a reasoned opinion.

Within ten working days expert organization shall send to the authorized body its expert opinion about the registration, partial registration or refusal of registration, issued based on the results of full examination. Expert opinion on the preliminary refusal of registration shall be sent to the applicant within ten working days.

2. The applicant may within three months from the date of receipt of preliminary decision on complete examination to provide a reasoned objection based on results of which the expert organization within three months from the date of receipt of objection shall make a final conclusion.

3. Based on the results of a complete examination the authorized body shall, within fifteen working days, register the trademark or refuse registration. The decision to register may apply to the entire list of products and services or to its parts.

4. The decision to register a trademark prior to its introduction into the state register of trademarks may be reviewed in connection with the discovery of an application with earlier priority.



5. Based on the decision of the authorized body for registration of a trademark applicant within three months from the date of receipt of notification with the positive opinion of the expert organization shall pay the state fee for registration of a trademark, as well as payment for the expert organization actions for publication of information on registration .

In case of failure to provide documents confirming payment of the state fee for registration of a trademark and payment for the expert organization actions for the publication of information on registration, registration of trademark shall not be carried out and the corresponding application for a trademark shall be considered as withdrawn.

6. In case of disagreement with the conclusion of examination rendered in accordance with paragraph 2 of this Article, the applicant may file an objection on the expert opinion to the authorized body within three months from the date of its issuance. The objection shall be considered by the Appellate Council within four months from the date of its receipt.

#### **Article 13. The Rights of Applicant**

An applicant shall have the right:

- 1) to recall the application at any stage of the expert examination;
- 2) to participate in the consideration of issues arising in the course of the expert examination of the application;
- 3) to append, clarify or amend materials of the application not changing them in essence before the completion of the full expert examination;
- 3-1) petition for the division of an application at each stage of its consideration prior to the completion of the expert examination with distribution of the goods and services listed in the original application, between the divided applications;
- 4) to petition on the extension of the established deadlines for submission of the response to the request or submission of the objection, but not more than for six months;
- 5) to petition on the restoration of the missed deadlines, but not more than for two months from the day of expiration of the missed deadline;
- 6) to peruse opposed materials;
- 7 ) to apply for the suspension of proceedings in connection with appeal submitted to the Appellate Council;
- 8 ) to apply for assignment of rights to receive a trademark, service mark to another person without conclusion of a contract.

### **CHAPTER 4. TRADE MARK REGISTRATION**

#### **Article 14. State Register of Trade Marks**

1. Information on registration of trade mark shall be entered to the state Register of Trade Marks upon payment of services of expert organization for registration of trade mark.

2. The following shall be entered to the State Register of Trade Marks:

- 1) picture of trade mark;
- 2) information on its owners;
- 3) the number and date of registration of trade mark;

- 4) indication to collective trade mark;
- 5) list of goods (services) with respect thereto the trade mark is registered;
- 6) the number and date of submission of the application to the organisation of experts;
- 7) country, number and date of submission of the first application when the convention priority is established;
- 8) any other information related to the registration of trade mark, including information on the transfer of the right to a protected trademark.

2. The State Register of Trade Marks shall be generally available. Pursuant to the petition of the interested parties the organisation of experts shall submit an extract from the State Register of Trade Marks.

3. The owner of a trademark shall be obliged to notify the expert organisation on any amendments concerning the registration, including information on change of his name/surname or patronymic (if available), place of residence as well as reduction of the list of goods (services ) in respect of which trademark is registered.

4. During one month from the date of submission of application on amendments and relevant payment an expert organisation shall amend the State Register as specified in paragraph 3 of this Article, as well as rectify mistakes of technical nature.

Applicant shall be sent notification within two months from the date of amendments made into the State Register of Trade Marks.

#### **Article 15. Term of Effect of Registration**

1. Registration of trade mark shall be effective during ten years from the date of submission of the application.

2. The term of effect of the registration of trade mark may be extended each time for ten years pursuant to the owner's petition to be submitted during the last year of its effect. Information on the extension of the term of effect of the registration shall be entered to the State Register of Trade Marks during one month period.

3. The deadline for the submission of the petition, as indicated in paragraph 2 of the present Article, may be restored pursuant to the owner's application submitted within six months after expiration of the effect of registration.

#### **Article 16. Publication of Information on Registration**

Information related to the registration of trade mark entered to the State Register of Trade Marks, as well as subsequent amendments associated with the registration shall be published by the organisation of experts in the bulletin and internet web-site during two month period after their entering into the State Register of Trade Marks.

Information on owners of a collective trademark shall be additionally entered into the State Register of Trade Marks.

#### **Article 17. Terms of Repeated Registration of Trade Marks**

The trade mark identical or similar to a degree of confusion to trade mark whose term of effect of validity has expired may not be registered in the name of person other than the former owner within one year from the date of termination of the effect of the registration.

**Article 18. Extract from the State Register of Trade Marks**

1. Extract from the State Register of Trade Marks shall certify the fact of registration of the trade mark, its priority, the exclusive right of the owner to the trade mark with respect to goods (services) indicated in the State Register of Trade Marks.
2. The authorised body shall establish the form of the extract.

**Article 18-1. The acknowledgement of a trademark as well-known.**

1. Trademark registered in the Republic of Kazakhstan or protected under international treaties, as well as designation used as a trademark without a legal protection in the Republic of Kazakhstan, but acquired a reputation in the Republic of Kazakhstan due to its active use shall be acknowledged as well-known in the Republic of Kazakhstan.

Application of natural or legal persons for the acknowledgement of a trademark as well known in the Republic of Kazakhstan is considered by the commission of the authorized body on the acknowledgement of a trademark as well known.

Within two months from the date of application the authorized body examine the presence of the necessary documents stipulated by the legislation of the Republic of Kazakhstan, notify the applicant of the acceptance of the application for review and publish information about it on the internet resource for information and possible disagreement from third parties that must be sent to the authorized body.

After expiration of three months from the date of publication application and annexed materials confirming that mark is well-known shall be considered by the authorized body. After expiration of the indicated term authorized body within three months period shall review the application.

Applicant has the right to make corrections, additions and clarifications to the application materials before completion of its review.

If there is disagreement from third parties, the applicant shall be sent relevant notification, response to which the applicant must provide before the results of consideration of the application.

Regulation on the Commission on acknowledgement of a trademark (service mark) as well known in the Republic of Kazakhstan shall be approved by the authorized body.

Upon results of consideration of application the Commission of the authorized body shall take decision on acknowledgement of trademark as well-known or decision to refuse such acknowledgement, which shall be sent to the holder of a trademark within ten working days from the date of the decision.

If factual information submitted by applicant confirm the date when the mark has become well-known, other than that specified in the application, the trademark can be recognized as well known on the factual date.

Information about the factual acknowledgement of trade mark as well-known is confirmed by opinion poll of consumers, which is conducted by an independent organization at the territory of the Republic of Kazakhstan. The opinion poll should cover the city of republican significance, the capital, and at least five cities of regional importance. The total number of respondents in one locality must be at least a hundred people.

The decision to refuse acknowledgement of a trademark as well known shall be made, if it is defined that:

- 1) information is insufficient for acknowledgement of trademark as well-known;
- 2) there is a trademark which is identical or confusingly similar to the trademark of an applicant, protected or declared in the name of another person in respect of similar goods, with a an earlier priority.

Commission decision of the authorized body referred to in Paragraph 4 of this paragraph may be appealed in court.

2. Well known trademarks shall be protected in accordance with provisions of this Law for the trademarks.

3. Legal protection of well known trademarks shall be terminated:

- 1) in connection with the expiration of registration;
- 2) in connection with the entry into force of the court decision on annulment of the decision of Commission of the authorized body on acknowledgement of a trademark as well known.

4. Based on the acknowledgement of a designation or trademark as well-known, relevant information shall be included into the State Registry of Trade Marks of the Republic of Kazakhstan.

Term of validity of acknowledgement of trade mark as well-known at the request of the owner and presentation of data confirming the well-known status of a trademark shall be extended for further ten years.

Information about registration of a well known trademark, its owner and any future changes relating to such registration shall be included into the State Register of well known trademarks and published in the Gazette.

## **CHAPTER 5. USE OF TRADE MARKS**

### **Article 19. Terms of Trade Mark Use**

1. The owner of the trade mark shall be obliged to use the trade mark.

2. Entrepreneurs who conduct intermediary activity shall have the right, subject to the consent of manufacturer, to use their own mark on sold goods together the trade mark of the manufacturer of goods, and also to place it instead of the trade mark of the manufacturer.

3. Owners of the collective trade mark may together with the collective trade mark to use their own trade marks on goods manufactured by them.

4. Any interested party may submit to the authorised body the objection against the registration of trade mark in connection with its non-use continuously during ~~five~~ three years from the date of registration or three years preceding the submission of the objection. The objection may relate to all or part of goods indicated in the certificate, and it must be considered by the appellate council within six months deadline from the date of its receipt.

The proof of the use of the trade mark shall be considered its use on goods for which it was registered, and (or) their packing owner of the trademark or person to whom such right is granted on the basis of an agreement for the reassignment of rights to a trademark in accordance with paragraph 2 of Article 21 of this Law. Manufacture, importation, storage, offering for sale, sale of goods with the trademark, its use in

advertising, billboards, printed publications, on official letterhead, a business document, the transfer of trademark rights or demonstration at exhibitions held in the Republic of Kazakhstan, as well as other introduction into civil circulation shall be recognized a use of the trademark.

Confirmation of use of a trademark which are submitted by its owner must refer to the period of time specified in the objection.

When deciding the issue on the termination of the effect of registration of the trade mark in connection with its non-use, the proofs submitted by the owner that the trade mark was not used due to the circumstances which were beyond his control, shall be taken account of.

5. Owners of trademarks which are identical or similar to a degree of confusion with a well-known trademark and registered prior to the recognition of the trademark as well-known, shall retain the right to subsequently use them for a period established by the authorised body, but for not longer than seven years.

7. Use of the trademark by others on goods that have been put into circulation in the territory of the Eurasian Economic Union by the right holder or with his consent shall not be a violation of the exclusive rights to the trademark.

#### **Article 20. Warning Marking**

The owner of the certificate of the trade mark may place near the trade mark the warning marking in the form of Latin letter ®, or wordy designations «тауар танбасы», «товарный знак» or «зарегистрированный товарный знак» indicating that the used designation is the trade mark registered in the Republic of Kazakhstan.

#### **Article 21. Assignment of the Right to Trade Mark**

1. The exclusive right to the trade mark with respect to all goods and services or any part of them indicated in the certificate may be assigned under the contract by the owner to other person.

The assignment of the right to trade mark shall not be allowed when it may cause the confusion with respect to goods or its manufacturer.

The assignment of the right to trade mark, including its assignment under the contract or in accordance with the procedure for the legal succession must be registered by the authorised body.

2. The right to the use of the trade mark may be assigned by the owner of the trade mark (licensor) to the other person (licensee) under the licensing agreement with respect to all goods and services or any part of them indicated in the certificate

The licensing agreement which allows to the licensee to use the trade mark must contain the condition that the quality of goods or services shall not be lower than the quality of goods and services of the licensor and that the licensor shall have the right to conduct the supervision of the implementation of this condition.

When the effect of the right to trade mark is terminated the effect of the licensing agreement shall be terminated.

The assignment of the right to the trade mark to other person shall not entail the termination of the licensing agreement.

3. The agreement on assignment of right to a trade mark, license agreement, agreement on complex entrepreneurial license and pledge agreement must be concluded in writing and be registered with the authorised body. Non-observance of the written form and requirements of the registration shall entail the invalidity of the agreement.

Registration of assignment agreement on trademark or license agreement shall be based on examination of the materials made by expert organization.

The provisions on registration of license agreements shall be applied to order of registration of sub-license agreements and additional agreements to already registered agreements unless otherwise provided by legislation of the Republic of Kazakhstan.

In order to register agreement on assignment of right to a trade mark, license agreement, agreement on complex entrepreneurial license and pledge agreement application in the relevant form must be submitted to the expert organization.

The application shall be accompanied by:

1) The original contract in quadruplicate, equipped with a title page. Each copy of the contract stitched, sealed with a paper seal, on which shall be recorded the number of sheets tied together and numbered; there are the stamp and signature of both parties or authorized persons on both sides.

Submission of materials for license agreement registration must be carried out no later than six months from the date of signing the contract.

Notarized copies of the contract may be submitted instead of original contract;

2) Power of Attorney in the case of an application through a patent attorney or other representative;

3) document confirming payment of state duty;

4) document confirming payment of services of expert organization.

Payment is due upon filing an application or within one month from the date of receipt of the application. In case of failure to provide document confirming payment within one month period the application is recognized as not submitted.

National applicants of license agreement, except for the above documents, shall provide the solution of the management bodies of the licensor (sub-licensor) on the conclusion of the contract and providing the authority to sign the contract to the head of the organization if applying on behalf of the legal person.

National applicants of assignment agreement, except for the above documents, shall provide the solution of the management bodies of the owner of the protection document or exclusive rights, general meeting of the founders or shareholders on the conclusion of the contract and providing the authority to sign the contract to the head of the organization.

Application and other required documents shall be submitted in Kazakh and Russian. Foreign names and the names of legal entities must be indicated in the Kazakh and Russian transliteration. If the documents are submitted in another language, the application shall be accompanied by notarized translation into Kazakh and Russian.

The application must relate to one agreement on assignment of right to a trade mark, license agreement, agreement on complex entrepreneurial license and pledge agreement. Individuals living outside the Republic of Kazakhstan, or foreign legal entities submitting materials of the contract to the authorized body on their own behalf, shall exercise the rights relating to the registration of the contract through a patent attorney of the Republic of Kazakhstan.

Natural persons of the Republic of Kazakhstan, temporarily residing abroad, shall exercise the rights relating to the registration of the agreement without a patent attorney in case of indication of the address for correspondence within the territory of the Republic of Kazakhstan.

Examination and registration of agreements on assignment of right to a trade mark, one of the parties to which is a natural or legal person of a foreign state - party to the Singapore Treaty, shall be carried out in accordance with the provisions of the Singapore Treaty.

4. Expert organization after the submission of a list of documents for registration by the applicant within fifteen working days from the date of receipt of application shall carry out the preliminary examination of received documents, during which required documents and compliance with the requirements set for them shall be verified. In the absence of document confirming payment of the examination in materials attached to the application of the contract, the applicant shall be billed for payment. In this case, the dates shall be calculated from the date of receipt of payment to expert organization.

Substantive examination shall be held based on the accepted materials of assignment agreement on a trademark or license agreement within twenty days in accordance with the legislation of the Republic of Kazakhstan.

5. Reasons that prevent registration of an assignment agreement on a trademark and a license agreement that can be eliminated:

1) termination of the registration of a trade mark in respect of which the contract is concluded, but there is the possibility of its recovery;

2) obligations taken on previously signed contracts that prevent submission of licenses for the use of industrial property item;

3) provisions in the contract that are contrary to the civil legislation of the Republic of Kazakhstan and the ratified international agreements;

4) incomplete set of documents or the documents submitted do not meet the requirements of current legislation of the Republic of Kazakhstan.

6. In case of violation of the requirements for registration of documents or the presence of the grounds specified in paragraph 5 of this article that prevent registration of the contract, but that can be eliminated, expert organization shall send a request to the applicant with a proposal within three months from the sending date to submit the missing or corrected documents or make the necessary changes and additions. In this case, terms of the examination referred to in paragraph 4 of this Article shall be calculated from the date of submission of the missing or corrected documents.

7. Expert organization shall make a determination to refuse to register an assignment agreement on a trademark or a license agreement under the following grounds:

1) termination of the validity of registration of a trade mark, for which the contract is concluded, and there is no possibility of recovery;

2) failure to provide all the necessary materials and information required by paragraph 6 of this article within three months;

3) the parties do not have necessary rights to conclude a contract;

4) there is no licensee's powers in the licensing agreement for the registration of the sub-license agreement and there is a lack of a license agreement, approved by authorized body.

Within two working days after the conclusion is made the expert organization shall send it to the authorized body stating the reasons for refusal.

8. In case of positive result of the examination the expert organization within five working days shall send to the authorized body conclusion that there is no reason preventing the registration of an assignment agreement on a trademark or a license agreement.

The decision on registration or refusal to register an assignment agreement on a trademark or a license agreement shall be accepted by the authorized body within five working days from receipt of the expert organization opinion.

9. After the decision on registration of a contract authorized body shall:

1) stamp on the front page of the contract on its registration with the date of registration and its registration number;

2) include information about the contract in the register of registered contracts;

3) send three copies of registered contract with the conclusion to the expert organization to publish information on the registration of the contract.

Expert organization with regard to agreement on assignment of right to a trade mark, license agreement, agreement on complex entrepreneurial license and pledge agreement shall send two copies of registered agreement to address given in the application, and publish in the Gazette information on registered contracts, in particular, number and date of registration of the contract, name and full details of the parties of the contract, subject matter of the contract, term of the contract and contract territory. Two copies of the contract shall be kept in the authorized body and expert organizations, respectively, and shall be control copies.

Expert organization on registered contracts shall publish in the Gazette information on registered contracts, including number and date of registration of the contract, the name or full details of the contracting parties, the subject of the contract, validity of the contract, the territory of the contract.

Any person may obtain an extract from the register of registered contracts that are open for publication.

Introduction of third parties with the text of the contract, and obtaining statements from it shall be allowed only with the written consent of the contracting parties.

In case if an authorized body made the decision to refuse registration of the assignment agreement on a trademark and the license agreement on the basis of the conclusion of the expert organization documents of the considered contract with the decision to refuse to register shall be returned to the address specified in the application.

10. The agreement on assignment of right to a trade mark, license agreement, agreement on complex entrepreneurial license and pledge agreement shall take effect from the date of their registration by the authorized body.

#### **Article 22. The Assignment of the Right to Trade Mark in Reorganisation of Legal Entity in the Form of Division**

In the division of a legal entity the right to the trade mark shall be transferred to the newly established legal entity to which the manufacturing of goods or services is transferred.

In the case of retention with each of the newly established legal entities of part of manufacturing of goods or services for which the trade mark is registered, the new legal entities shall be recognised as co-owners of the trade mark in the case of their consent.



## **CHAPTER 6. TERMINATION OF REGISTRATION VALIDITY OF A TRADE MARK**

### **Article 23. Challenging the Registration of Trade Mark**

1. The registration of the trade mark may be challenged and recognised as invalid fully or partially during the entire term of effect, if it was carried out in violation of requirements as established Articles 6 and 7, except for subparagraphs 1) – 3) of paragraph 1 of Article 7 of the present Law or during five years from the date of registration of trade mark if it was carried out in violation of requirements as established by subparagraphs 1) – 3) of paragraph 1 of Article 7 of the present Law.

2. Any interested party may on the basis as indicated in paragraph 1 of the present Article submit to the authorised body an objection against the registration of trade mark.

The objection against the registration of trade mark shall be considered by the appellate commission within six months from the date of its receipt. A person who filed the objection, as well as the owner of trade mark shall have the right to participate in the consideration of the dispute.

### **Article 24. Termination of Effect of Registration of Trade Mark and Recognition of it as Invalid**

1. The effect of the registration of trade mark shall be terminated:

1) in connection with the expiration of the term of its effect stipulated in Article 15 of the present Law.

2) in connection with termination of business activity or death of a physical person, liquidation of a legal entity – owner of the trade mark;

3) on the basis of an application in writing for the refusal from it of the owner of trade mark;

4) in the case of the non-use of trade mark in accordance with paragraph 4 of Article 19 of the present Law;

5) in the case of registration of identical or similar goods to the extent of confusion of the name of the place of goods' origin in accordance with paragraph 5 of Article 19 of the present Law.

2. The registration of trade mark shall be recognised as invalid fully or partially pursuant to the decision of the appellate council or the court under the basis as indicated in paragraph 1 of Article 23 of the present Law.

3. The organisation of experts shall introduce to the State Register of Trade Marks the entry on annulment of the trade mark in connection with the termination of its effect or recognition it as invalid.

## **CHAPTER 7. LEGAL PROTECTION AND REGISTRATION REQUIREMENTS FOR APPELLATIONS OF ORIGIN**

### **Article 25. Legal Protection of Appellations of Origin**

1. The legal protection of appellations of origin in the Republic of Kazakhstan shall be granted on the basis of their registration in accordance with the procedure as

established in the present Law, as well as by force of international treaties of the Republic of Kazakhstan.

2. The exclusive right of the use of appellation of origin may be granted to one or several business entities, that manufacture in said geographical object the goods whose special properties are exclusively, or mainly are associated with the geographic environment, including natural conditions, and (or) human factors.

3. The state registration of the name of a geographical object as an appellation of origin, which is located in a foreign country shall be allowed if the name of this object is protected as such in the country of origin. The owner of an exclusive right to use the indicated name of the appellation of origin may be a person whose right to use such name is protected in the country of origin.

**Article 26. The designations registered as appellations of origin**

1. As an appellation of origin can be registered contemporary or historical, formal or informal, full or abbreviated name of the country, region, locality, district or other geographical area, as well as a designation derived from this name, and their combination with the species name of the product.

2. Designation, although representing or containing the name of a geographical object, but included in the Republic of Kazakhstan in general use as the common name for certain type of product not related to the place of its production shall not be recognized as appellation of origin.

**Article 27. Designations not Registered as appellations of origin**

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

1) which represent in itself the names of geographical object capable to confuse with respect to the place of manufacturing of goods;

2) which formally indicate to the true place of manufacturing of goods, but give the erroneous conception that the goods originate from other territory.

3) which contain the geographical indications not associated with the place of manufacturing of goods.

**Article 28. Submission of an Application for the Appellation of Origin and Obtaining the Right to Use Appellation of Origin**

Applications for the appellation of origin and obtaining the right to use the appellation of origin (henceforth — application) shall be submitted to the organisation of experts.

**Article 29. Requirements to Application**

1. The application shall be related to one appellation of origin.

2. The application shall be presented on the standard blank and it shall contain the following:

1) the request for conducting an expert examination of an appellation and (or) for obtaining the right to appellation with the mention of the applicant (applicants) as well as its (their) location or place of residence;

- 2) designation sought;
- 3) type of goods;
- 4) description of special properties of goods;
- 5) indication of the place of manufacture of goods (boundaries of the geographic object).

3. If a geographic area, which name is claimed as an appellation of origin, is in the territory of the Republic of Kazakhstan, the application shall be accompanied by the conclusion of the local executive body that the applicant manufactures goods within the geographical area, special features, quality, reputation or other characteristics of which mainly determined by the geographical natural conditions and (or) human factors.

The application for the granting the exclusive rights on the previously registered appellation of origin, in the territory of the Republic of Kazakhstan, shall be accompanied by the conclusion of the authorized body that the applicant produces a product within the geographical area with specific properties stated in the State Register of Appellations of Origin of the Republic of Kazakhstan.

If a geographic area, which name is claimed as an appellation of origin, is outside the Republic of Kazakhstan, the application shall be accompanied by proof of the applicant's right to the claimed appellation of origin.

The application is also accompanied by proof of payment for services of expert organization for the examination. The amount of payment determined in accordance with the legislation of the Republic of Kazakhstan.

In the case of proceedings through a representative, the application is attached Power of Attorney.

4. An application and documents attached to it shall be submitted in the Kazakh or Russian language. When documents are presented in other language, then the applicant shall be obliged within one months from the date of submission of application present its translation into the Kazakh or Russian language.

5. Requirements to compilation, formulation and consideration of applications shall be established by the authorised body.

## **CHAPTER 8. EXPERT EXAMINATION OF APPELLATIONS OF ORIGIN**

### **Article 30. The Procedure for Conducting an Expert Examination**

1. The organisation of experts shall within six months from the date of submission of the application conduct the expert examination in the course of which its compliance with requirements established in Articles 26, 27 and 29 of the present Law is reviewed.

2. In the course of the expert examination the organisation of experts shall have the right to request additional materials which must be submitted within three months from the date of submission of the request to the applicant.

In the case of a failure of the applicant to submit within the established deadline additional materials, or petition on the extension of the indicated deadline, the record-keeping shall be terminated, and the application shall be considered revoked.

**Article 31. Decisions on Results of Expert Examination**

1. Upon the results of the expert examination the authorised body shall adopt the relevant decision:

- 1) on the registration of the appellation of origin, and (or) granting the right to use the appellation of origin;
- 2) on the refusal to register the appellation of origin, and (or) granting the right to use the appellation of origin.

2. The applicant shall have the right, within three months from the day of forwarding to him the decision on the refusal to register, to submit a motivated objection with the request on the revision of the decision of the expert examination.

In the case of disagreement with repeatedly adopted decision of the expert examination, the applicant may submit the objection in accordance with the procedure as stipulated in paragraph 6 of Article 12 of the present Law.

**Article 32. The Rights of the Applicant**

In the performance of the expert examination of the appellation of origin the applicant shall be granted the rights indicated in Article 13 of the present Law.

**CHAPTER 9. THE REGISTRATION AND GRANTING THE RIGHT TO USE APPELLATION OF ORIGIN**

**Article 33. The Procedure for the Maintenance of the State Register of Appellations of Origin**

1. Appellations of origin, number and date of registration, description of specific properties of the goods, information on all owners of the right to use the appellation of origin with indication of their place of residence (address), number and dates of submission of the applications and all subsequent amendments in that information, as well as other information pertaining to the registration shall be entered by expert organisation into the State Register of Appellations of Origin.

2. The owner of the right to use the appellation of origin shall be obliged to notify the organisation of experts of changes concerning registration information. The entry on amendments shall be included by the expert organisation into the State Register of Appellations of Origin.

3. The state register of appellations of origin shall be public. Pursuant to the petition of interested parties the expert organisation shall provide extracts from the State Register of the Appellations of Origin.

**Article 34. Terms of Effect of Registration of the Appellation of origin and the Right to Use the Appellation of origin**

1. Registration of the appellation of origin shall be in effect for an indefinite period of time, subject to the retention of the special properties of goods manufactured in the territory of the indicated geographical object.

2. The right to use the appellation of origin shall be effective during ten years from the date of submission of the application to the organisation of experts.

3. The term of effect of the right to use the appellation of origin shall be extended every time for ten years pursuant to the owner's petition submitted during the last year, subject to the retention of the special properties of goods with respect thereto the name of the place of goods' origin is registered.

4. The petition on the extension of the term of effect of the right to use the appellation of origin shall be submitted simultaneously with the conclusion of the authorised body in accordance with Article 29 of the present Law. Information on the extension of the term of effect of the registration shall be entered to the State Register of Appellations of Origin, and to the certificate.

5. The deadline for the submission of a petition as established in paragraph 3 of the present Article shall be restored pursuant to the application of the owner submitted within six months after the expiration of the term of effect of the registration.

#### **Article 35. Publication of Information on Registration**

Information related to the registration of the appellation of origin and granting the right to use the appellation of origin, as well as subsequent amendments shall be published by the organisation of experts in the bulletin immediately after their entering to the State Register of Appellations of Origin.

#### **Article 36. Right to Use the Appellation of origin**

1. Extract from the State Registry of Appellations of Origin shall certify the fact of registration of the appellation of origin and the exclusive right of the owner to use it with respect to goods indicated in the State Registry of Appellations of Origin.

2. The form of the certificate shall be established by the authorised body .

### **CHAPTER 10. THE USE OF THE APPELLATION OF ORIGIN**

#### **Article 37. Terms of Use of the Appellation of origin**

1. The owner of the right to use the name of the appellation of origin shall own the exclusive right of its use.

2. It shall not be allowed to use without registration the name of geographical object which is identical to or similar to the extent of confusion with the registered appellation of origin with respect to homogeneous goods.

3. It shall not be allowed to use the appellation of origin which represent or contain the name of geographical object identifying mineral waters, wines, or strong alcohol drinks, for the designation of such goods not originated from said place, even though in this respect the actual place of origin of goods is indicated, or the translation is used, or the designation is accompanied by expressions «of kind», «of type», «in the style of» or the like.

4. There shall not be allowed alienation, other transactions involving the assignment of the right to use the appellation of origin and granting the right to use the appellation of origin on the basis of licensing agreement.

**Article 38. Warning Marking**

The owner of the right to use the appellation of origin may place near the appellation of origin the warning marking in the form of Latin letter ®, or wordy designations «тауар шығарылған жердин тиркелген атауы», «зарегистрированное наименование места происхождения товара», or «рег. НМПТ».

**CHAPTER 11. TERMINATION OF VALIDITY OF THE LEGAL PROTECTION OF THE APPELLATION OF ORIGIN**

**Article 39. Contesting registration of an appellation of origin and (or) the right to use the appellation of origin**

1. Registration of the appellation of origin and (or) the right to use the appellation of origin may be challenged and invalidated if it was made in violation of the requirements stipulated by Articles 26, 27 and 29 of this Act.

2. Registration of the appellation of origin and (or) right to use an appellation of origin may be challenged and invalidated within five years from the date of publication of information on state registration of an appellation of origin in the official gazette, if the use of an appellation of origin could mislead consumers as to the true identity of the good or its manufacturer due to the existence of an earlier in time trademark which had become renown in Kazakhstan due to its active use.

3. Any interested person may on grounds specified in paragraphs 1 and 2 of this Article shall apply to the authorized body objection to registration of appellation of origin and (or) the right to use the appellation of origin.

The objection must be considered in the manner and term prescribed by paragraph 2 of Article 23 of this Act.

**Article 40. Termination of Effect of Registration of the Appellation of Origin and the Right to Use the Appellation of Origin and Recognition Them as Invalid**

1. The registration of the appellation of origin shall be terminated in the following cases:

1) in connection with disappearance of conditions specific for said geographical object and impossibility to manufacture goods with properties indicated in the State Register of the Appellations of Origin with respect to said appellation of origin;

2) in connection with the termination of the effect of legal protection of the appellation of origin in the country of origin.

2. The effect of the right to use the appellation of origin shall be terminated in the following cases:

1) in connection with the expiration of the term of its effect stipulated in Article 34 of the present Law.

2) in connection with the loss by goods of specific properties indicated in the State Register of the Appellations of Origin with respect to said appellation of origin;

3) on the basis of an application of the owner of the right to use the appellation of origin submitted to the authorised body;

4) in the liquidation of a legal entity or termination of business activity of a physical person – owner of the right to use the appellation of origin.

3. The registration of the appellation of origin, and (or) granting the right to use appellation of origin shall be recognised as invalid pursuant to the decision of the appellate council, or the court under the basis as indicated in paragraph 1 of Article 39 of the present Law.

4. The organisation of experts shall introduce to the State Register of the Appellations of Origin the note on annulment of the registration of the appellation of origin, and (or) the right to use the appellation of origin in connection with the termination of their effect or recognition them as invalid.

## **CHAPTER 12. THE PROTECTION OF THE RIGHTS OF OWNERS OF TRADEMARKS AND RIGHTS TO USE APPELLATIONS OF ORIGIN**

### **Article 41. Appellate Council**

1. The Appellate Council shall be a specialized structural subdivision of the authorized body for the pre-court consideration of disputes with respect to objections raised in accordance with paragraph 6 of Article 12, paragraph 4 of Article 19, paragraph 2 of Article 23 and paragraph 2 of Article 39 of the present Law. The Regulations concerning the Appellate Council shall be approved by the authorized body. 1-1. Pre-court examination of disputes referred to in paragraph 1 of this Article shall be binding.

2. The following objections may be filed to the Appellate Council:

1) on the decision of the authorized body (the conclusion of the expert organization) to refuse to register a trademark, including the refusal to register a trademark made on the results of the examination of declared designation, in accordance with paragraphs 1 and 2 of Article 5 of the Madrid Agreement;

2) the decision of the authorized authority to refuse registration and (or) the right to use the appellation of origin;

3) the registration of a trademark, including in accordance with paragraph 6 of Article 5 of the Madrid Agreement;

4) the registration and (or) the right to use the appellation of origin;

5) the registration of a trademark due to its non-use.

The objection provided by subparagraph 1) and 2) of this paragraph, shall be supplied by the applicant or his successor, either directly or through a representative.

The objection provided by subparagraph 3) -5) of this paragraph shall be supplied by any interested person, either directly or through a representative.

Objection shall be submitted to the authorized body in written form in Kazakh and Russian, either directly or by mail. The materials attached to the objection shall be submitted in Kazakh and Russian.

If an objection is filed by facsimile or e-mail, it must be confirmed to the original hard copy no later than one month from the date of receipt of such objections.

The objection shall be filed within the terms established by this Law.

Missed deadline for objections by the applicant provided by subparagraph 1) and 2) of this paragraph may be re-established upon application filed by the applicant within the terms established by this Act. The application shall be submitted simultaneously with an objection to the Appellate Council. 3. In the case of filling an objection by a patent agent or other representative a power of attorney shall be submitted in Kazakh

and Russian; if a power of attorney shall be submitted in other (foreign) language, power of attorney shall be translated into Kazakh and Russian and notarized. The original of notarized power of attorney shall be attached to the objections materials or it shall be submitted together with a copy to the Secretary of the Appellate Council to confirm notarization.

4. Objection shall be considered at the board meeting of the Appellate Council within the term prescribed by this Law. This term may be extended at the request of the person who filed the objection and the patentee, but not more than for six months from the date of expiry of the deadline for the consideration of objection.

5. A person filed an objection and the patentee have the right to appeal against the decision of the Appellate Council within six months from the date of the decision.

**Article 41-1. Grounds for refusal to consider objection in the Appellate Council**

1. Acceptance of objection for consideration shall be refused if:

- 1) an objection according the legislation of the Republic of Kazakhstan is not subject to consideration in the Appellate Council;
- 2) an objection is not signed or signed by a person not having an authority to sign it;
- 3) an objection is submitted with the violation of the specified term and the possibility of its extension and re-establishment is lost;
- 4) an applicant within the prescribed period did not comply with requirements for content and procedure for submission of objection.

In case of the presence of these circumstances the person submitted the objection shall be notified that an objection shall not be taken into consideration and shall be considered as not submitted.

A person submitted an objection or his representative may withdraw an objection before the announcement of the decision of the board of the Appellate Council.

**Article 41-2. Consideration of objection at the board meeting of the Appellate Council**

1. Consideration of the objection shall be carried out at the board meeting of the Appellate Council consisting of not less than five members. Prior to the start of the dispute consideration the confidentiality of the members of the board of Appellate Council must be provided.

To provide conclusions at the board meeting of the Appellate Council representatives of scientific organizations and specialists of appropriate profile may be invited.

2. Board of the Appellate Council shall have the right to postpone the meeting in case of:

- 1) inability to consider the objections at this meeting due to the absence of any of the persons entitled to take part in the consideration of objections;
  - 2) need to submit the missing or additional documents (evidence) for a decision-making by parties;
  - 3) the request of the parties.
3. Individuals participating in the consideration of objection have a right to:
- 1) become familiar with the case, make extracts, order and receive copies thereof;
  - 2) present evidence;
  - 3) participate in examination of the evidence;



- 4) question the participants of Appellate process;
  - 5) make a petition;
  - 6) give oral and written explanations to the members of the Board of Appellate Council;
  - 7) present their arguments and views on all issues arising during the consideration of objections to the issues;
  - 8) oppose the petitions, arguments and views of others involved in the case.
4. In order to resolve a dispute the Board of Appellate Counsel shall make a decision.

Decision shall be taken by a simple majority vote of the Board members of Appellate Council. When votes are equal the Chairman's vote of the board meeting of the Appellate Council shall be decisive.

Upon consideration of objections the following decisions shall be made:

- 1) satisfy the objections;
  - 2) partially satisfy the objections;
  - 3) postpone consideration of objections;
  - 4) dismiss the objection.
5. Within the ten working days from the date of the decision the Board of Appellate Council shall prepare and send the decision to the parties of the Appellate Council. The decision of the Appellate Council shall be in writing and shall consist of an introduction, descriptive part, reasoning and conclusion.

The decision of the Appellate Council shall be signed by all members of the Board of Appellate Council.

#### **Article 42. Consideration of Disputes**

1. The following disputes shall be subject to consideration in a judicial procedure:

- 1) concerning the lawfulness of the registration of trade mark or appellation of origin;
- 2) concerning the violation of the exclusive right of the owner of the trademark or the right to use the appellation of origin;
- 3) concerning the conclusion and implementation of licensing agreements for the use of trademark;
- 3-1) concerning the legitimacy of recognition of a trademark as well-known;
- 4) other disputes associated with the protection of rights ensuing from the registration.

1-1. Applications for decision of the authorized body referred to in paragraph 2 of Article 41 of this Law must be submitted to the court after consideration of the relevant objections by the Appellate Council.

2. The organisation of experts on the basis of the court decision shall carry out the publication of information on amendments related to the registration.

**Article 43. Responsibility of Legal Entities and Physical Persons for Violation of Legislation on Trademarks and Appellations of Origin**

1. The unauthorised introduction into civil circulation of a trademark or appellations of origin or appellations similar to it to a degree of confusion with regard to homogeneous goods and services, and in the case of a well-known trademark — with regard to any goods and services, shall be recognised as violation of the exclusivity right of the owner of a trademark or right to use the appellation of origin.

Also, unauthorised use of a trademark or appellation of origin in publicly available telecommunication networks (internet etc.), shall be recognised as violation of the exclusivity right of the owner of the trademark or the right to use the appellation of origin.

2. For the use of protected trademark or the appellation of origin, as well as the designation similar with it to the extent of confusion for homogeneous goods with violation of requirements of the present Law the guilty persons shall bear the responsibility in accordance with the laws of the Republic of Kazakhstan.

**Article 44. Liability of a Person who Violated the Rights of the Owner of Trademark or the Right to Use the Appellation of origin**

Any person unlawfully using trademark or appellation of origin or confusingly similar designation shall be bound:

1) discontinue infringement and compensate damages to the owner of a trademark, or the owner of right to use an appellation of origin;

2) destroy goods and packaging bearing illegal trademark, appellation of origin or confusingly similar designation, except of original goods with trade mark placed by right holder himself. In those cases where introduction of such goods into circulation is necessary for social purposes, - destroy illegally used image of a trademark, appellation of origin or confusingly similar designation from goods and its packaging;

3) remove trademark or confusingly similar designation from materials that accompany fulfillment of works or services, including from documentation and advertisements.

**CHAPTER 13. CONCLUDING PROVISIONS**

**Article 45. The State Duty and Payment for Actions of An Expert Organisation**

For performance by the authorised body of actions on registration of trade marks and appellations of origin, registration of well-known trade mark, registration of agreements, attestation of patent agents and issuance of certificate on registration of patent agent the state duty shall be collected in accordance with the tax legislation of the Republic of Kazakhstan.

**Article 46. Patent Agents**

1. Legally capable citizen of the Republic of Kazakhstan who permanently resides in its territory, with higher education and work experience in the field of intellectual

property not less than four years, certified and registered by the authorized body in the field of intellectual property shall be a patent agent.

In order to certificate candidates as patent agent the authorized body forms Certification Commission from the staff of the authorized institution and expert organization. The minimum number of members of the certification committee shall be not less than five employees.

Certification of candidates as patent agent shall be conducted by the authorized body at least once a year upon receipt of applications from candidates to the patent agent.

As a result of certification Certification Commission shall make a decision to certify or deny certification of the candidate. The form of decision of Certification commission shall be approved by the authorized body.

The decision of Certification commission shall be appealed in court within three months from the date of decision.

Successful candidates of qualification examination shall receive a certificate of patent agent, in accordance with the form set by the authorized body.

State duty for the certification of candidates for patent agents and issue of the certificate shall be determined by the tax legislation of the Republic of Kazakhstan.

2. The following persons shall not be accepted for certification of candidates for patent agents:

- 1) those who in accordance with the legislation of the Republic of Kazakhstan are not allowed to be engaged in entrepreneurial activities;
- 2) employees of the authorized body and its subordinate organizations, as well as their close relatives, spouse;
- 3) those who has a conviction;
- 4) those who are excluded from the register of patent agents in accordance with this Law.

3. Activity of a patent agent shall be suspended by the protocol decision of the Certification Commission:

- 1) based on the application of a patent agent submitted to the Certification commission;
- 2) for the period referring to persons who in accordance with the legislation of the Republic of Kazakhstan are prohibited from engaging in entrepreneurial activity, including the staff of the authorized body and its subordinate organizations;
- 3) in order to clarify the circumstances provided by subparagraphs 2) and 6) of paragraph 1 and paragraph 5 of Article 36-2 of this Law.

In the case provided by subparagraph 3) of this paragraph, the activity of a patent agent shall be suspended for three months until the decision is taken by the Certification Commission.

The activity of a patent agent shall be resumed by the protocol decision of the Certification Commission in the case if the shortcomings caused by the suspension of its activities are removed.

4. Patent agent as a representative of the applicant or patentee shall carry out activity related to the conduct of business with the authorized body and the expert organization on the legal protection of intellectual property. Conduct of business with the authorized body and the expert organization may also be carried out by the applicant and (or) the patent owner himself.

Natural persons who reside beyond the territory of the Republic of Kazakhstan, or foreign legal entities shall exercise the rights of the applicant and patentee as well as the rights of the interested person in the authorized body and its organization through patent agents.

Natural persons who permanently reside in the Republic of Kazakhstan, but are temporarily situated beyond its territory, may exercise the rights of the applicant, patentee, as well as the rights of the interested person without a patent agent, specifying an address for the letter exchange within the Republic of Kazakhstan.

5. Information which a patent agent receives from the trustor in connection with the performance of his/her instructions shall be recognized as confidential subject to condition of compliance with the requirements of the legislative acts of the Republic of Kazakhstan on confidential information or other secrets protected by the law.

#### **Article 46-1. The rights and obligations of a patent agent**

1. A patent agent shall be entitled to carry out to the benefit of the applicant (individual or legal entity), the employer concluded an employment contract with him, or a person concluded with him or his employer a civil contract, the following activities:

1) advise on the protection of intellectual property rights, acquisition or transfer of intellectual property rights;

2) preparation of applications for inventions, utility models and industrial designs on behalf of the customer, principal, employer;

3) interaction with the authorized body and (or) expert organization for the protection of rights for inventions, utility models and industrial designs, including letter exchange, preparation of the objections for the decision of examination, participation in meetings of the advisory council of experts organization;

4) assist in the preparation, consideration and onward dispatch for examination of licensing (sublicensing) agreements and (or) contracts of assignment.

2. Powers of patent agent attorney shall be certified by a power of attorney.

3. If patent agent submits a copy of power of attorney to conduct of businesses related to the filing of applications for inventions, utility models and industrial designs, and (or) receipt of protection documents, as well as filing an objection to the Appellate Council within three months from the date of this application or objection patent agent shall be obliged to submit the original power of attorney, respectively, to the expert organization and the authorized body. After confirming the authenticity of the original power of attorney must be returned.

If the power of attorney is made in a foreign language, its notarized translation into Kazakh and Russian must necessarily be represented.

4. A patent agent shall be obliged not to accept a commission in cases if earlier he represented or advised persons whose interests are contrary to the interests of the person requesting the conduct of business, and if the case involves an official, who is closely related to a patent agent, her/his husband (wife), and (or) his (her) close relative.

#### **Article 46-2. Revocation and cancellation of certificate of patent agent**

1. A patent agent shall be excluded from the register of patent agents by the decision of certification commission:

- 1) on the basis of personal application submitted to the Certification Commission;
- 2) upon termination of citizenship of the Republic of Kazakhstan or permanent residence outside the Republic of Kazakhstan;
- 3) in the event of interrupt of professional patent agent activity for more than five years;
- 4) upon the entry into force of a judgment of conviction, by which the patent agent was convicted of committing a crime;
- 5) in the case of the death of a patent agent or his recognition as missing or declared dead;
- 6) in the event of acknowledgement of a patent attorney as legally incompetent.

2. In the case of exclusion of patent agent from the register of patent agents on the grounds specified in subparagraphs 4), 5) and 6) of paragraph 1 of this Article, the certificate shall be canceled by the decision of certification commission. Information about the cancellation of the certificate shall be entered in the register of patent agents.

3. In the cases specified in subparagraphs 1), 2) and 3) of paragraph 1 of this article, certificate of a patent agent shall be revoked by the decision of certification commission based on the application of the patent agent or the third party.

Patent agent, excluded from the register on the grounds of subparagraphs 1) and 2) of paragraph 1 of this Article may be re-registered as a patent agent without re-passing a qualifying examination, in case of the termination of reasons of exclusion from the registry, and application to the Certification Commission within three years from the date of publication of the decision to remove from the registry. Certification Commission according to the documents submitted shall establish the fact of termination of the grounds specified in subparagraphs 1) and 2) of paragraph 1 of this article.

4. Patent agent, excluded from the register of patent agents, shall lose the right to pursue activities of a patent agent and a certificate of his registration as a patent agent shall be revoked or canceled.

5. In the case of unfair performance by patent agent of his duties, prescribed by this Law, the authorized body shall form the Appellate Commission, which shall consist of an odd number of members of the authorized body.

The Appellate Commission shall be a collegial body, and investigate complaints of natural and (or) legal entities representing the actions of their rights and legitimate interests of patent agents, committed, according to them, in violation of applicable legislation.

As a result of a complaint Appellate Commission shall recommend the authorized body to refer to court a lawsuit to annul a certificate of patent agent or make one of the following decisions:

- 1) postpone consideration of the complaint due to lack of evidence or to clarify the circumstances that contribute to making objective decisions;
- 2) dismiss the complaint.

Decision of appellate commission shall be made by simple majority vote and registered in the minutes. Decision of appellate commission may be appealed in court.

The regulation of the Appellate commission shall be established by the authorized body.

**Article 47. Registration in Foreign Countries**

1. Legal entities and physical persons of the Republic of Kazakhstan shall have the right to register the trademark in foreign countries, or perform its international registration.

An application for international registration of trademark shall be submitted through the organisation of experts.

2. The registration of the appellation of origin in foreign countries shall be carried out after its registration and obtaining the right to use this appellation of origin in the Republic of Kazakhstan.

**Article 48. The Rights of Foreigners, Foreign Legal Entities and Stateless Persons**

Foreigners, foreign legal entities, stateless persons shall enjoy the rights and bear obligations stipulated by the present Law on a par with legal entities and physical persons of the Republic of Kazakhstan, unless otherwise stipulated by legislative acts of the Republic of Kazakhstan.

**President of the Republic of Kazakhstan**

**N. Nazarbaev**