

## **On Trademarks, Service Marks and Appellation of Origin**

Law of the Republic of Kazakhstan of July 26, 1999 No. 456

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

### **Chapter 1. General provisions**

#### **Article 1. Basic definitions used in this Law**

The following basic definitions are used in this Law:

1) exclusive right means a property right of the owner to use the trade mark or the appellation of origin by all means at his own discretion;

1-1) marks that are confusingly similar means similar signs or symbols that differ in single elements and are associatively perceived by the consumer as identical;

1-2) identical trademarks means signs and symbols that coincide in all elements;

1-3) goods or services of the same kind means goods or services performing the same function and relating to the same kind (sort) that may cause by consumer the idea of being produced by the same manufacturer in case of using the identical or similar trademarks;

2) bulletin means an official periodical on the protection matters of trademarks and appellations of origin;

3) geographical indication means an indication identifying goods that originate in the certain territory, region or area;

4) well-known trademark means a sign used as a trademark or a trademark itself acknowledged as well-known by virtue of the international agreements to which the Republic of Kazakhstan is a party, by decision of the competent authority or court based on evidences of interested parties;

4-1) Madrid Agreement means Madrid Agreement Concerning the International Registration of Marks of April 14, 1891;

5) applicant means a legal entity or an individual who filed an application for registration of the trademark or for registration and granting right to use the appellation of origin;

6) patent attorneys means citizens of the Republic of Kazakhstan who are entered to represent individuals and legal entities in the competent authority and expert organization under the legislation of the Republic of Kazakhstan;

6-1) Singapore Treaty means Singapore Treaty the Law of Trademarks, of March 27, 2006;

7) International Classification of Goods and Services means a classification confirmed by the Nice Agreement of June 15, 1957 with subsequent amendments and additions;

8) trademark, service mark (hereinafter – trademark) means a sign registered according to this Law or protected without registration by virtue of the international agreements to which

the Republic of Kazakhstan is a party, serving to distinguish goods (services) of certain legal entities or individuals from goods (services) of the same kind of other legal entities or individuals;

9) use of trademark or the appellation of origin means the use of trademark or appellation of origin on goods and service delivery for which they are protected, and (or) on their packaging thereof, manufacture, appliance, import, storage, sale offer, distribution of goods designated by the trademark or the appellation of origin, use on signs, in advertising, printed materials or other business documentation as well as any other ways of putting them into civil circulation;

10) owner of the trademark or of the right to use the appellation of origin means an individual or a legal entity with an exclusive right in trademark or exclusive right to use the appellation of origin under this Law;

11) appellation of origin means a designation which constitutes or contains the name of the country, region, population center, area or any other geographical indication as well as any indication derivative of such name and became famous as a result of using it in relation to the good which special characteristics, quality, reputation or other characteristics are connected with its geographical origin including the specific environmental conditions and (or) human factor;

12) collective trademark means a trademark of association (union) or other group of legal entities and (or) individual entrepreneurs (hereinafter – the Association) serving to designate the manufactures or distributed goods (services) with the common qualitative or other characteristics.

Footnote. Article 1 as amended by the Law of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); as amended by the laws of the Republic of Kazakhstan of 10.07.2012 No. 34-V (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **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 the Civil Code of the Republic of Kazakhstan, this Law and other laws and regulations of the Republic of Kazakhstan.

2. Where the international agreement ratified by the Republic of Kazakhstan sets other rules than those laid down by this Law the rules of such international agreement shall be applied.

Footnote. Article 2 as amended by the Law of the Republic of Kazakhstan of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 3. Authorized government body in the field of protection of trademarks, service marks, appellations of origin**

1. The authorized government body (hereinafter – the Authorized body) is the government body determined by the Government of the Republic of Kazakhstan that performs the government regulation in the field of protection of trademarks, service marks, appellations of origin.

2. The competence of the authorized body includes:

1) the participation in the implementation of the state policy in the field of legal protection of trademarks, services marks and appellations of origin;

2) registration of trademarks and appellations of origin;

2-1) determination of the procedure for acknowledgement the trademark as well-known;

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

- 2-3) approval the form of application for registration of the trademark assignment agreement;
- 2-4) approval the form of application for registration of the license agreement, the sublicense agreement on use of trademark, the agreement of integrated business license and the security and pledge agreement;
- 3) control the activity of individuals and legal entities using the trademarks, appellations of origin, service marks;
- 4) making reports and considering the cases of administrative violation, imposition of administrative penalties;
- 5) exercise of other powers stipulated herein or by other laws of the Republic of Kazakhstan, acts of the President of the Republic of Kazakhstan and the Government of the Republic of Kazakhstan.

Footnote. Article 3 as amended by the Law of the Republic of Kazakhstan of 09.07.2004 No. 586; as amended by the laws of the Republic of Kazakhstan of 02.03.2007 No. 237 (the act shall be entered into force since the day of its official publication); of 05.07.2011 No. 452-IV (the act shall be entered into force since 13.10.2011); of 12.01.2012 No. 537-IV (the act shall be entered into force in ten calendar days after its first official publication); of 07.04.2015 No

. 300-V (the act shall be entered into force in ten calendar days after its first official publication);

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

1. The activities on accepting and expertise of the applications for registration of trademarks, service marks and appellations of origin, on carrying out expertise of the agreements on trademarks, service marks assignment, of the license (sublicense) agreements, on maintenance of the state register of the protected trademarks, service marks and appellations of origin including the acceptance of application for registration of the collective trademark; carrying out the formal expertise; making amendments and corrections in the application materials; selecting the application on trademark in classes initiated by the applicant; transforming the application on trademark to the collective trademark and on the contrary; accepting the international application according to Madrid Agreement; preparing the list of goods and services according to the international classification; transferring, processing the application on making amendments in the international application; carrying out the expertise of the application additionally for every grade higher than three; urgent and accelerated carrying out of full expertise not earlier than six months from the date of applying; considering the objections against the decision on the advance renunciation in registration; extension of time for filing an objection on decision of expertise for every month; extension of time for query answer for every month; revival of an expired time for query answer, payment, filing an objection by the applicant; publishing information about registration; making amendments in the state registers of protected trademarks, service marks and appellations of origin; extension of the validity of registration on right to use the appellation of origin, registration on trademark and additionally for each grade higher than three; publication of information regarding extension; carrying out the expertise of security and pledge agreement, agreement of granting the complex business license in regard to one or group of industrial property objects; the expertise of additional agreements and publishing information about the agreements registration; giving extracts from the state register, notes; fulfilling the preliminary search of designation in the data base of trademarks and designations applied for registration in regard to mentioned kinds of goods and services with presentation of search report; distribution and publication of printed and electronic editions shall refer to the state monopoly and be carried out by the expert organization established by the decision of the Republic of Kazakhstan in the legal form of republic state entity on the right of economic

management.

2. The activities technologically connected with the activity of the expert organization include:

- 1) certification of application copies (priority document);
- 2) transfer credit and payments confirmation.

3. Prices on goods (works, services) produced and (or) distributed by the entities of the state monopoly shall be set by the authorized body in coordination with the competition authority.

Footnote. Chapter 1 was completed with Article 3-1 according to the Law of the Republic of Kazakhstan of 09.07.2004 No. 586; 1 as amended by the Law of the Republic of Kazakhstan of 10.07.2012 No. 34-V (the act is entered into force since the day of its official publication); as amended by the laws of the Republic of Kazakhstan of 07.04.2015 No.300-V (enters into force in ten calendar days after its first official publication).

## **Chapter 2. Legal protection and terms for registration of trademark**

### **Article 4. Legal protection of trademarks**

1. The legal protection of trademarks in the Republic of Kazakhstan shall be granted on the basis of their registration in accordance with the procedure established by this Law as well as without registration in virtue of the international agreements of the Republic of Kazakhstan.

2. The legal protection of trademarks shall be granted to the individuals and the legal entities.

3. The right in a trademark shall be certified by the entry about registration in the State register of trademarks of the Republic of Kazakhstan and confirmed with the extract from the State register of trademarks of the Republic of Kazakhstan.

4. The owner of the trademark shall have the executive right to use and dispose the trademark he owns in regard to the goods and services specified in the certificate. No one may use the trademark protected in the Republic of Kazakhstan without the consent of owner thereof.

Footnote. Article 4 as amended by the Law of the Republic of Kazakhstan of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

### **Article 5. Designations registered as a trademark**

1. Graphic, verbal, letter, numerical, three-dimensional and other designations or combinations of designations allowing to distinguish goods and services of certain parties from similar good and services of other parties may be registered as a trademark.

2. Trademark can be registered in any color or color combination.

### **Article 6. Statutory grounds for refusal of registration of a trademark**

1. It is not allowed to register the trademarks consisting solely of the designations that are not distinctive, in particular:

- 1) entered into common use for marking goods (services) of the particular kind;
- 2) are generally accepted symbols and expressions;
- 3) indicate the sort, quality, quantity, character, purpose, value of goods as well as place and time of their manufacture or distribution;

- 3-1) are international unpatentable names of pharmaceutical products;
- 4) excluded by the Law of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication);
- 5) excluded by the Law of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication);
- 6) have the direct descriptive connection with goods or services that they are used to mark;
- 7)-13) excluded by the Law of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication);

The mentioned designations may be used as unprotected elements of a trademark if they do not take the dominated place.

2. The designations reproducing armorial bearings, flags and symbols, abbreviated and full names of international organizations and their official signs, flags and symbols, hallmarks of control, warranty or assay, stamps, Olympic logos, awards and other honorary signs as well as designations that are confusingly similar to such signs may not be registered as trademarks.

Such designations may be used as unprotected elements if the designation does not consist only of them and if there is consent of the appropriate authorized body or their owner thereof.

3. The registration of designations as trademarks or their elements is not allowed if they:

- 1) are false or liable to mislead regarding the good or its manufacturer including the names of geographic locations liable to mislead regarding the place of good manufacture;
- 2) formally indicate the real place of good manufacture but give a wrong impression regarding the origin of good from another territory;
- 3) constitute or contain the names of geographic locations identifying mineral waters, wines or spirits, for marking such goods not originating from this place as well as if the translation is used or the designation is accompanied by the expressions like “of kind”, “of sort”, “like” or others;
- 4) contrary to the public interest, humanity and morality principles.

Footnote. Article 6 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No . 586; of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 7. Other grounds for refusal of registration of a trademark**

- 1. The designations may not be registered as trademarks that are identical or confusingly similar to:
  - 1) trademarks registered in the Republic of Kazakhstan and protected by virtue of the international agreements with the earlier priority in the name of the third party in regard to the goods or services of the same kind or with the identical trademarks of the same party in regard to the same goods or services;
  - 2) trademarks acknowledged well-known in accordance with the established practice in the Republic of Kazakhstan in regard to any kind of goods and services;
  - 3) designations in respect of which an application for registration was filed with the earlier priority in the name of the third party in regard to the goods or services of the same kind (except revoked ones) or with the identical designations of the same party in regard to the same goods or services;
  - 4) excluded by the Law of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication);
  - 5) appellation of origin protected in the republic of Kazakhstan in regard to any goods

unless they may be incorporated as unprotected elements of the trademark registered in the name of the owner of right to use this appellation of origin if the trademark registration is made in regard to the same goods for ascertainment of which the appellation of origin was registered .

Registration of designation as a trademark in regard to goods or services confusingly similar to any of trademarks mentioned in sub-paragraphs 1), 2) and 3) of part one of this paragraph is subject to the consent of the trademark owner.

2. Designations shall not be registered as trademarks if they reproduce:

1) industrial designs protected in the Republic of Kazakhstan in the name of other parties on condition of their earlier priority;

2) (is excluded)

3) names of works of literature, science and art, known pieces of art and their fragments widely known in the Republic of Kazakhstan as of the date of filing an application when violating the copyrights;

4) surnames, forenames, pen-names and their derivatives, portraits and facsimiles when violating personal non-property rights of these individuals, their heirs or successors as well as if these designations form part of the historical and cultural heritage of the Republic of Kazakhstan and are reproduced without permission of the appropriate authorized body.

Footnote. Article 7 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No . 586; of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 8. Filing of application**

1. The application for a trademark to the expert organization shall be filed by one applicant.

2. The application for a collective trademark shall be filed on behalf of the association in accordance with the agreement of its participants on use of the collective trademark.

3. Application may be filed as an electronic document certified with the digital signature.

Footnote. Article 8 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No . 586; of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 9. Requirements for application on registration of trademark**

Footnote. Article 9 of the title as amended by the laws of the Republic of Kazakhstan of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication);

1. Application shall relate to one trademark only.

2. Application shall be submitted on the standard form and shall contain:

1) the request for expertise of designation specifying the applicant as well as his location or residence;

2) the designation in respect of which the application is filed;

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

Goods and Services.

3. Application shall be accompanied by:

- 1) proof of payment for services of an expert organization for the expertise. The amount of payment shall be set in accordance with the legislation of the Republic of Kazakhstan;
- 2) power of attorney in case of record-keeping activities through the representative;
- 3) statute of the collective trademark (in case of filing an application for the collective trademark) including the name of organization authorized to register the collective trademark in its name, purpose of the trademark registration, list of the parties that have right to use the trademark, list and sole characteristics or other characteristics of goods and services which will be marked with the collective trademark, terms of use, use control procedure, responsibility violation of statute provisions of the collective trademark.
4. The application and the annexed documents shall be submitted in Kazakh or Russian language. If the documents are submitted in other language the applicant shall submit their translation into Kazakh or Russian language within one month period.
5. The filing date of an application shall be the date when expert organization received an application that meets requirements of paragraph 2 of this Article; in case that the mentioned documents were not submitted simultaneously the date shall be the date when the last of the submitted documents was received.
6. The procedure of compilation, preparation and pendency of application for the trademark shall be established by the authorized body.

Footnote. Article 9 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No . 586; of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 10. Priority of trademark**

1. The priority of trademark shall be determined by the filing date of application to the expert organization.
2. The priority of trademark may be determined by the filing date of the first application (applications) for trademark in a country - member to the Paris Convention for the protection of industrial property as well as in the international or regional organization provided for in it (Convention priority) if the filing of application to the expert organization was made within six months of the mentioned date. When claiming for the convention priority the applicant shall indicate number, date and country of filing of the first application and attach its certified copy.
3. The priority of trademark placed on the showpieces displayed at the officially recognized international exhibitions may be determined by the date of the open display of the showpiece at the exhibition (exhibition priority) if filing of the application for trademark to the expert organization is made within six months of the mentioned date.
4. The applicant wishing to exercise the right of convention or exhibition priority shall state this fact and submit the relevant documents confirming the legitimacy of this claim on filing an application for trademark or within two months of the date when the expert organization has received the application.
5. In case of a divided application the priority for each application is determined by the priority date of the first application.  
The priority for the divided applications is determined by the priority date of the original application of the same applicant; in case there is a right to determine the earlier priority by the original application the priority is determined by the date of this priority if as of the date of filing the divided application the original application is not revoked and not considered as revoked and the divided application was filed before rendering the decision on the original application.
6. The multiply priority of trademark in regard to different goods shall be determined upon the request of the applicant if several his applications for the designation in regard to various goods are available.

Footnote. Article 10 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

### **Chapter 3. Trademark examination**

#### **Article 11. Examination procedure**

1. The examination of application shall be carried out by the expert organization gradually:

1) preliminary examination shall be carried out within a period of one month of the date when application was received in order to verify the application content, the presence of the necessary documents in accordance with the requirements established in the articles 5 and 9 of this Law. As a result of this examination the applicant within ten working days receives notification whether the application was accepted for pendency or the procedure was terminated;

2) full examination shall be carried out within the period of nine months of the date of filing an application in order to verify the compliance of applied designation with the requirements established in articles 6 and 7 of this Law.

3) upon the written request of the applicant subject to the additional payment the examination of application for trademark shall be carried out earlier than the terms indicated in sub-paragraph 2) of this paragraph but not earlier than six months from the date of filing an application.

2. At any stage of the examination the expert organization has right to request the additional materials that shall be submitted within three months of the date of sending the request to the applicant.

In case of failure to submit by the specified time the additional materials or the request to extend the specified time the procedure shall be terminated and the application shall be considered as revoked.

Footnote. Article 11 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

#### **Article 12. Decisions on the results of examination**

1. According to the results of the preliminary examination the applicant shall be informed within ten working days about either acceptance of application for consideration, assignment of relevant number, determination of filing and priority date or refusal to accept the application for consideration in the form of a reasoned opinion.

Within ten working days the expert organization sends to the authorized body the expert opinion on registration, partial registration or registration refusal given according to the results of the full examination. The expert opinion on registration refusal shall be sent to the applicant within ten working days.

2. The applicant has right to submit the reasoned objection within three months of the date when the preliminary opinion of the full examination was sent to him following the consideration of which the expert organization shall hand down the final opinion within three months of the date when the objection was received.

3. According to the results of the full examination the authorized body makes decision either to register the trademark or to refuse the registration within fifteen working days. The Decision on registration may relate to the entire list of goods and services or to the part of it.



4. The decision to register the trademark before its filing in the State Register of Trademarks may be reviewed due to the fact of identification of application with the earlier priority.

5. Based on the decision of the authorized body on registration of the trademark the applicant carries out the payment of the state duty for registration of the trademark as well as the payment for the expert organization activity on publishing information about the registration within three months of the date when the notification on the positive opinion of the expert organization was received.

In case of failure to submit by the applicant according to the established procedure the proof of payment of the state duty for the registration of the trademark and for the expert organization activity on publishing information the registration of trademark shall not be made and the corresponding trademark application shall be considered as revoked and the procedure shall be terminated.

6. In case of disagreement with the expertise opinion handed down in accordance with the paragraph 2 of this Article the applicant may file an objection against the expertise opinion to the authorized body within the period of three months of the date of sending thereof. The objection shall be handled by the Appeal Board within the period of four months of the date of its receipt.

Footnote. Article 12 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; as amended by the laws of the Republic of Kazakhstan of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

### **Article 13. Rights of the applicant**

The applicant has the right to:

- 1) revoke the application at any stage of examination;
- 2) participate in treating the questions arising in the course of examination of the application;
- 3) complete, specify or correct the materials of the application without changing them substantively until the end of full examination;
  - 3-1) request for dividing the application at any stage of its consideration until the end of examination arranging goods and services listed in the original application between the divided applications;
- 4) apply for extension of the time limit for submitting an answer for request or filing an objection but not for longer than six months;
- 5) apply for restoration of the expired time limit but not later than two months from the expiration of the missed time limit;
- 6) get acquainted with the material cited against his application;
- 7) apply for the suspension of procedure due to filing an objection to the Appeal Board;
- 8) apply for the assignment of right to receive trademark, service mark to another party without concluding the agreement.

Footnote. Article 13 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Chapter 3. Registration of the trademark**

### **Article 14. State Register of Trademarks**

1. Information regarding registration of trademark shall be entered in the State Register at the moment of paying for services of the expert organization and state duty for registration

of trademark.

The following information shall be entered in the State Register of Trademarks:

- 1) image of the trademark;
- 2) information about its owners;
- 3) number and date of registration of the trademark;
- 4) reference to the collective trademark;
- 5) list of goods (services) in regard to which the trademark is registered;
- 6) number and date of applying to the expert organization;
- 7) country, number and date of filing the first application where the conventional priority is established;
- 8) other information concerning the registration of the trademark including information about the assignment of right in protected trademark.

2. The State Register of Trademarks shall be public. Upon the request of the interested parties the expert organization provides an extract from the State Register of Trademarks.

3. The owner of the trademark must inform the expert organization of all changes concerning registration including information about changing his surname, forename or father's name (if relevant), residence or name and location as well as shortening the list of goods ( services) in regard to which the trademark is registered without changing the registration substantively.

4. The expert organization enters the changes specifies in paragraph 3 of this Article as well as changes to correct the technical mistakes in the State Register of Trademarks within one month of the date of request for changes and compliant payment.

Within two months of the date of entering the changes in the State Register of Trademarks the notification on filing the appropriate changes shall be sent to the applicant.

Footnote. Article 14 as amended by the laws of the Republic of Kazakhstan of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 15. Term of the registration**

1. The term of the registration of the trademark shall be ten years starting from the date of application.

2. The term of the registration of the trademark shall be extended every time for ten years upon the request of owner applied during the last year of its validity. Information concerning the extension of validity of the registration shall be entered in the State Register of Trademarks within one month of the request date.

3. The time limit filing the request specified in paragraph 2 of this Article may be restored upon the application of owner filed within six months of expiry of the registration validity.

Footnote. Article 15 as amended by the laws of the Republic of Kazakhstan of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 16. Publication of information concerning registration**

The information concerning the registration of trademark filed in the State Register of Trademarks as well as the further changes concerning the registration shall be published by the expert organization in the bulletin within two months and on its web-site immediately following their entering in the State Register of Trademarks.

Information about the owners of the collective trademark shall be entered additionally in the State Register.

Footnote. Article 16 as amended by the laws of the Republic of Kazakhstan of 09.07.2004

No. 586; of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 17. Terms of re-registration of trademark**

The trademark that is identical or confusingly similar to the trademark which registration has expired may not be registered in the name of a person other than the previous owner for a period of one year from the date of termination of the trademark registration.

The specified condition shall be also applied in case when the owner of the trademark has refused it before expiry of registration term.

Footnote. Article 17 as amended by the laws of the Republic of Kazakhstan of 02.03.2007 No. 237 (the act is entered into force since the day of its official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 18. Extract from the State register of trademarks**

1. Extract from the State Register of Trademarks confirms the registration of trademark, its priority, exceptional right of owner of the trademark in regard to the goods (services) specified in the State Register of Trademarks.

2. The extract form shall be established by the authorized body.

Footnote. Article 18 as amended by the laws of the Republic of Kazakhstan of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

### **Article 18-1. Acknowledgement of trademark as well-known**

1. The trademark registered in the territory of the Republic of Kazakhstan or protected by virtue of the international agreements as well as the designation used as a trademark without its legal protection in the Republic of Kazakhstan but gained the general recognition as a result of active use may be acknowledged as a well-known trademark in the Republic of Kazakhstan.

Application of individuals and legal entities on acknowledgement the trademark as well-known in the Republic of Kazakhstan shall be handled by the commission of the authorized body on acknowledgement the trademark as well-known.

Within two months of the date of filing an application the authorized body verifies the presence of necessary documents established by the legislation of the Republic of Kazakhstan, informs the applicant about admission of application to the examination and publishes information about it on the web-site for familiarization and possible assignment to the authorized body in case of disagreements from the third parties.

Upon the expiry of three months from the date of publication the application and the annexed materials confirming well-known status of the trademark are considered by the authorized body. Upon the expiry of the specified time limit the authorized body carries out the examination of the application within three months.

The applicant has right to make corrections, additions and specifications in the materials of the application till the end of the examination.

In case of disagreement from the third parties the relevant notification shall be sent to the applicant the response to which the applicant party shall submit before the opinion according to the results of examination of the application is given.

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

According to the results of examination of the application by the commission of the

authorized body the decision to acknowledge the trademark as well-known or the decision to refuse the acknowledgement shall be made; the decision shall be sent to the owner of the trademark within ten working days of a moment that the decision was made.

If the actual data submitted by the applicant confirms that the mark became well-known on other date than specified in the application the trademark can be acknowledged as well-known since the actual date.

Information concerning the actual acknowledgement of the trademark as well-known shall be confirmed with the results of consumer survey which shall be conducted by the specialized independent organization in the territory of the Republic of Kazakhstan. The survey shall cover the city of republican status, the capital and not less than five cities of regional status. The total number of the respondents in one locality shall be not less than one hundred people.

Decision to refuse the acknowledgement of the trademark as well-known shall be made if it was ascertained that:

- 1) information to acknowledge the trademark as well-known is not sufficient;
- 2) there is a trademark which is identical or confusingly similar to the trademark of the applicant protected or declared in the name of other party in regard of similar goods with the priority earlier than the date that the applicant requests to acknowledge its trademark as well-known.

The decision of the commission of the authorized body specified in the fourth part of this Paragraph may be appealed to court.

2. The well-known trademark shall be granted the legal protection provided by this Law for the trademark.
3. The legal protection of the well-known trademarks shall be terminated:
  - 1) due to the expiry of the registration term;
  - 2) due to entry into force the court decision to cancel the decision of the commission of the authorized body on acknowledgement the trademark as well-known.
4. Based on the acknowledgement the designation or the trademark as well-known specified in paragraph 1 of this Article the corresponding information shall be entered in the State Register.

The term of acknowledgement of the trademark as well-known shall be extended for the next ten-year period upon the request of its owner and upon submitting the information confirming well-known status of a trademark.

Information concerning registration of well-known trademark, its owner and further changes concerning to such registration shall be entered in the State Register of well-known trademarks and published in the bulletin.

Footnote. Chapter 4 is completed by Article 18-1 according to the Law of the Republic of Kazakhstan of 09.07.2004 No. 586; as amended by the laws of the Republic of Kazakhstan of 12.01.2012 No. 537-IV V (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Chapter 5. Use of the trademark**

### **Article 19. Conditions of use of the trademark**

1. The owner of the trademark shall be obliged to use the trademark.
2. The entrepreneurs conducting intermediary activity have right subject to the manufacturer's consent to use their mark on the goods distributed by them along with the trademark of the manufacturer of the good as well as to place it instead of the trademark of the manufacturer.
3. The owners of the collective trademark may use their own trademarks along with the collective trademark on the goods manufactured by them.
4. Any interested party may file an objection to the authorized body for cancellation of

registration of the trademark due to its non-use continuously during three years following the date of registration or three years preceding the date of filing an objection. Objection may concern all or part of the goods specified in the certificate and shall be handled by the Appeal Board within six months of the date of its receipt.

The evidence of use of the trademark shall be its use on the goods which it was registered for and (or) on their package by the trademark owner or by the person who has this right pursuant to the trademark assignment agreement in accordance with paragraph 2 of article 21 of this Law. Manufacture, import, storage, sale offer, distribution of good with trademark designation, use in advertising, signs, printed materials, on headed papers, other business documentation, trademark assignment or exhibiting the goods in the Republic of Kazakhstan as well as any other ways of putting them into civil circulation may be considered the use of the trademark.

The evidences of use of the trademark submitted by its owner shall concern to the period of time indicated in the objection.

When making a decision on termination of registration of the trademark due to its non-use the evidences submitted by the owner that the trademark was not used because of circumstances beyond his control should be taken into consideration.

5. Excluded by the Law of the Republic of Kazakhstan of 12.01. 2012 № 537-IV (the act is entered into force in ten calendar days after its first official publication).

6. The owners of the trademarks that are identical or confusingly similar to the well-known trademark and registered before the trademark was acknowledged as well-known reserve the right for their subsequent use during the period established by the authorized body but not longer than seven years.

7. It shall be not considered to be infringement of the exclusive right in trademark if other parties use this trademark in regard of goods that were legally put into civil circulation in the territory of countries – members of the Eurasian Economic Union by the trademark owner or with his consent.

Footnote. Article 19 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; of 02.03.2007 No. 537-IV (the act is entered into force since the day of its official publication); of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 20. Warning marking**

The owner of the trademark certificate may place the warning trademark looking like the Latin letter R or verbal marks “tauartanbasy” (“тауартанбасы”), “trademark” (“товарный знак”) or “registered trademark” (“зарегистрированный товарный знак”) near the trademark indicating that the used designation is the registered trademark in the Republic of Kazakhstan.

## **Article 21. Trademark assignment**

1. The exclusive right on the trademark in regard to all goods and services specified in the certificate or only part of them may be contractually assigned by the owner to another party.

Trademark assignment shall not be allowed if it may cause false suggestion about the good or its manufacturer.

The trademark assignment including its assignment under the contract or by way of succession shall be registered in the authorized body.

2. The right to use the trademark may be granted by the trademark owner (licensor) to another person (licensee) in regard to all goods and services specified in the certificate or only part of them under the terms of license agreement.

The license agreement allowing the licensee to use the trademark shall contain the condition stating that the quality of goods and services shall not be lower than the quality of goods and services of the licensor and that the licensor has right to monitor the implementation of this condition.

Upon termination of right in trademark the license agreement is also terminated. The trademark assignment to another person shall not entail the termination of the license agreement.

3. The trademark assignment agreement, the license agreement, the agreement of integrated business license, the trademark security and pledge agreement shall be concluded in writing and registered in the authorized body. Failure to comply with the written form and the registration requirements shall entail the nullity of agreement.

Registration of the trademark assignment agreement, the license agreement, the agreement of integrated business license, the security and pledge agreement shall be made according to the results of examination of the materials carried out by the expert organization.

Regulations on the registration of license agreements shall be applied to the procedure of registration of sublicense agreements, additional agreements to the registered contracts unless otherwise provided for by the legislation of the Republic of Kazakhstan.

For registration of the trademark assignment agreement, the license agreement, the agreement of integrated business license, the security and pledge agreement the application in the specified form shall be submitted to the expert organization.

The application shall enclose:

1) the originals of agreement on the objects of the industrial property of the same kind, in four copies, with the front page. Each copy of the agreement shall be bound, under the paper seal which contains the record about the number of bounded and numbered pages, the stamp and the signature imprint of both parties or of the authorized persons of both parties shall be allocated.

For the license agreements the materials for registration shall be applied not later than six months from the date of agreement.

The notarized copies of the agreement may be submitted instead of originals of the agreement;

2) power of attorney in case of filing an application through a patent attorney or other representative;

3) proof of payment of the state duty.

4) proof of payment for the services of the expert organization.

The payment shall be made upon filing an application or within one month of the date of application receipt.

In case of failure to submit the proof of payment within one month the application is considered unfiled.

For the license agreements the national applicants in addition to the above mentioned documents shall submit the decision of the administrative body of the licensor (sublicensor) on entry into the agreement and authorization for execution of the agreement by the head of the enterprise in case of applying on behalf of the legal entity.

For the assignment agreement the national applicants in addition to the above mentioned documents shall submit the decision of the administrative body of the owner of the protection document or the exclusive rights, the general meeting of founders or shareholders on entry into the agreement and authorization for execution of the agreement by the head of the enterprise.

The application and other necessary documents are submitted in Kazakh and Russian languages. Foreign names and names of the legal entities shall be stated in Kazakh and Russian transliteration. If the documents are submitted in other language the application shall enclose their notarized Kazakh and Russian translation.

The application shall relate to one trademark assignment agreement, license agreement, agreement of integrated business license, security and pledge agreement, or additional agreement.

The individuals living outside the Republic of Kazakhstan or foreign legal entities submitting the materials of agreement to the authorized body in their own name exercise rights

for registration of the agreement through the patent attorneys of the Republic of Kazakhstan. The citizens of the Republic of Kazakhstan temporary being abroad exercise rights for registration of the agreements without patent attorney on condition of indicating the address for service within the territory of the Republic of Kazakhstan.

Examination and registration of the assignment agreements where one of the parties is the individual or the legal entity of the foreign country – member of the Singapore Treaty shall be made according to the provisions of the Singapore Treaty.

4. The expert organization after submitting by the applicant the list of documents for registration carries out the preliminary examination of the submitted documents within fifteen working days of the date of application receipt in order to verify the presence of all necessary documents and the compliance with the established requirements; in case there is no proof of payment for examination among the agreement materials attached to the application the applicant shall be issued an invoice. In this case the period begins to run from the receipt date of payment in the expert organization.

Based on the submitted materials of trademark assignment agreement or license agreement the substantive examination shall be carried out within twenty days' period in the course of which the examination of materials of trademark assignment agreement or license agreement shall be carried out in accordance with the current legislation of the Republic of Kazakhstan.

5. The grounds preventing registration of trademark assignment agreement or license agreement that can be eliminated:

1) termination of the registration of the trademark in regard to which the agreement was concluded but there is a possibility to renew it;

2) obligations assumed under the agreements concluded earlier which prevent issuing license on use of industrial property object;

3) provisions in the agreement contradicting with the civil legislation of the Republic of Kazakhstan and with the ratified international agreements;

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

6. In case of violation of the requirements for the documents processing or grounds specified in paragraph 5 of the this Article which prevent the registration of agreement but can be eliminated the expert organization sends to the applicant the suggestion request to submit the missed or corrected documents or make necessary changes or additions within three months of the date of sending. In this case the terms of the substantive examination specified in paragraph 4 of this Article begin to run from the date when the missed or corrected documents were submitted.

7. Subject to the following grounds the expert organization hands down an opinion to refuse the registration of trademark assigning agreement or license agreement:

1) termination of the registration of the trademark in regard to which the agreement was concluded and there is no possibility to renew it;

2) failure to submit within three months' period all necessary materials and information specified in paragraph 6 of this Article;

3) lack of necessary rights of the parties to conclude the agreement;

4) lack of the licensee's authorities in the license agreement to register the sublicense agreement and lack of license agreement registered in the authorized body.

Within two working days after handing down an opinion the expert organization sends this opinion with reasons of refusal to the authorized body.

8. When the result of examination is positive the expert organization sends to the authorized body the opinion on absence of grounds preventing registration of trademark assignment agreement or license agreement within five working days.

The decision on registration or refusal of registration of the trademark assignment agreement or the license agreement shall be made by the authorized body within five working days of the date of receipt of the expert organization opinion.

9. After making a decision on registration of agreement the authorized body:

1) stamps the Chapter page of the agreement with the date of registration and the

registration number;

2) makes entry about the agreement in the Register of registered agreements;

3) sends three copies of the registered agreement with the opinion to the expert organization for publishing information about the agreement registration.

Expert organization on the registered license agreements, the trademark assignment agreements, the integrated business license agreements, the security and pledge agreements sends two copies of the registered agreement to the correspondence address specified in the application and publishes information about the registered agreements in the bulletin, particularly number and date of agreement registration, names and full data of the agreement parties, agreement subject, duration of the agreement, territorial limits of the agreement.

Two copies of the agreement shall be kept in the authorized body and in the expert organization correspondingly and shall be the control copies.

Any person may receive the extract from the Register of registered agreements open for publishing.

Familiarization of the third parties with the text of the agreement as well as getting extract from it shall be allowed only with the written consent of the agreement parties.

In case that the authorized body makes a decision to refuse the registration of the trademark assignment agreement and license agreement based on the opinion of the expert organization the documents of the reviewed agreement together with the decision to refuse the registration shall be returned to the address specified in the application.

10. Trademark assignment agreement, licensed agreement, agreement of integrated business license, security and pledge agreement shall enter into force on the date of their registration in the authorized body.

Footnote. Article 21 as amended by the laws of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 22. Trademark assignment when the legal entity is reorganized in the form of demerger**

When the legal entity is demerged the trademark shall be assigned to the newly established legal entity to which the production of goods and services is transferred.

In case that each newly established entity keeps part of production of goods and services for which the trademark is registered the new legal entities shall be acknowledged as the trademark co-owners with their consent.

Footnote. Article 22 as amended by the laws of the Republic of Kazakhstan of 9 July, 2004 No. 586.

## **Chapter 5. Termination of the trademark registration**

### **Article 23. Contestation of trademark registration**

1. Registration of the trademark may be contested and nullified completely or partially at any time during its term if it was made in violation of the requirements established by articles 6 and 7 excluding subparagraphs 1) – 3) of paragraph 1 of article 7 of the Act or within five years of the trademark registration date if it was made in violation of the requirements established by subparagraphs 1) – 3) of paragraph 1 of article 7 of this Law.

2. Any interested person may file an objection to the authorized body against the trademark registration based on the grounds specified in paragraph 1 of this Article.

Objection against the trademark registration shall be handled by the Appeal Board within



six months of the date of its receipt. The individual filed an objection as well as the owner of the trademark have right to participate in the dispute consideration.

Footnote. Article 23 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 No. 586.

#### **Article 24. Termination of the trademark registration and its nullification**

1. Registration of the trademark shall be terminated:

- 1) due to expiry of its term provided for by Article 15 of this Law;
  - 2) due to termination of the business activity or death of the individual, liquidation of legal entity – owner of the trademark;
  - 3) based on the written application by the trademark owner on refusal of it;
  - 4) in case of non-use of the trademark according to paragraph 4 of Article 19 of this Law
- ;
- 5) Is excluded by the Law of the RK of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication).

2. Trademark registration shall be nullified completely or partially by the decision of the Appeal Board or court on the grounds specified in paragraph 1 of Article 23 of this Law.

3. Expert organization makes an entry in the State Register of Trademarks concerning the cancellation of the trademark registration due to its termination or nullification.

Footnote. Article 24 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

#### **Chapter 7. Legal protection and terms of registration of appellation of origin**

##### **Article 25. Legal protection of appellation of origin**

1. Legal protection of appellation of origin in the Republic of Kazakhstan shall be granted on the basis of their registration in accordance with the procedure established by this Law as well as by virtue of the international agreements of the Republic of Kazakhstan.

2. The exclusive right to use the appellation of origin can be granted to one or several business entities producing in this geographical location goods the special characteristics of which are related, exclusively or mainly, with the geographical area including environmental conditions and (or) human factors.

3. The state registration of the geographical indication as appellation of origin which is located in the foreign state shall be allowed if the name of this indication is protected as such appellation in the country of origin of good. The owner of the exclusive right to use the appellation of mentioned origin may be only the individual whose right to use such appellation is protected in the country of origin of good.

Footnote. Article 25 as amended by the laws of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

##### **Article 26. Designations registered as appellations of origin**

1. Contemporary or historical, formal or informal, full or abbreviated name of country, region, population center, area or other geographical location as well as designation derivative from such name and their combination with the generic name of the good may be registered as an appellation of origin.

2. The designations which are or contain the name of geographical location but entered in the Republic of Kazakhstan into common use as designations of the specific kind of good not related to the place of its production are not acknowledged as an appellation of origin.

Footnote. Article 26 as amended by the laws of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication).

## **Article 27. Designations not registered as appellations of origin**

The designations may not be registered as appellations of origin if they:

- 1) are names of the geographical locations that may mislead as of the place of production of the good;
- 2) formally indicate the real place of production of the good but give the false impression that the good originates from another territory;
- 3) contain the names of geographical locations not related to the place of production of the good.

Footnote. Article 27 as amended by the laws of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication).

## **Article 28. Filing an application for appellation of origin and granting the right to use the appellation of origin**

The application for appellation of origin and granting of right to use the appellation of origin (hereinafter – Application) shall be filed to the expert organization.

Footnote. Article 28 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 No. 586.

## **Article 29. Requirements for the application**

1. Application shall relate to one appellation of origin only.
2. Application shall be submitted on a standard form and shall contain:
  - 1) request to carry out examination of the name and (or) to grant the right for the name where the applicant (applicants) as well as his (their) location or residence shall be indicated;
  - 2) designation in regard to which the application is filed;
  - 3) kind of the good;
  - 4) description of the specific characteristics of the good;
  - 5) indication of the place of good manufacture (limits of geographical location).

3. If the geographical location which name is applied as appellation of origin is located in the territory of the Republic of Kazakhstan the application shall include the opinion of the local executive authority that the applicant produces the good within the borders of the mentioned geographical location and the special features, quality, reputation or other characteristics of this good are mainly determined by the environmental conditions and (or) human factors typical for this geographical location.

The application for granting the exclusive right for the registered earlier appellation on origin located in the territory of the Republic of Kazakhstan shall include the opinion of the authorized body that the applicant manufactures within the borders of this geographical

location the good that has the special features specified in the State register of appellations of origin of the Republic of Kazakhstan.

If the geographical location which name is applied as appellation of origin is located outside the Republic of Kazakhstan the document confirming the applicant's right for the requested appellation of origin shall be attached to the application.

The proof of payment for service of the expert organization on carrying out the examination shall also be attached to the application. Amount of payment shall be established in accordance with the legislation of the Republic of Kazakhstan.

In case of records management through the representative the power of attorney shall be attached to the application.

4. The application and the attached documents shall be submitted in Kazakh or Russian language. If the documents are submitted in other language the applicant shall submit their translation into Kazakh or Russian language within one month of the date of filing.

5. The requirements for compilation, preparation and consideration of application shall be established by the authorized body.

Footnote. Article 29 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; of 02.03.2007 No. 537-IV (the act is entered into force since the day of its official publication); of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication); of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Chapter 8. Examination of appellation of origin**

### **Article 30. Examination procedure**

1. The expert organization within six months of the date of filing an application shall carry out the examination in order to verify its compliance with the requirements established by articles 26, 27 and 29 of this Law.

2. At any stage of the examination the expert organization has right to request the additional materials which shall be submitted within three months of the date of sending the request to the applicant.

In case of failure by the applicant to submit the additional materials by the specified time or the request to extend the specified time the procedure shall be terminated and the application shall be considered as revoked.

Footnote. Article 30 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 No. 586.

### **Article 31. Decisions on the results of examination**

1. According to the results of examination the authorized body makes the relevant decision:

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

2. The applicant has right to submit a reasoned objection with request to reconsider the examination decision within three months of the date of sending him the decision on refusal to register the application.

In case of disagreement with the new examination decision the applicant may file an objection under the procedure established by paragraph 6 of Article 12 of this Law.

Footnote. Article 31 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

## **Article 32. Rights of the applicant**

While carrying out the examination of appellation of origin the applicant shall be granted rights specified in Article 13 of this Law.

## **Chapter 9. Registration and granting the right to use appellation of origin**

### **Article 33. Procedure of conducting the State register of appellations of origin**

1. The expert organization enters the appellation of origin, number and date of the registration, description of the special features of good, information about all owners of right to use the appellation of origin indicating their place of residence (location), number and date of filing an application and all subsequent changes of the above mentioned information as well as other information related to the registration in the State register of appellations of origin.

2. The owner of right to use the appellation of origin must inform the expert organization about the changes concerning the registration information. The entry about changes shall be made by the expert organization in the State register of appellations of origin.

3. The State register of appellations of origin is public. Upon the request of the interested parties the expert organization provides an extract from the State register of appellations of origin.

Footnote. Article 33 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; as amended by the Law of the Republic of Kazakhstan of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication).

### **Article 34. Terms of registration of appellation of origin and right to use the appellation of origin**

1. The registration of the appellation of origin remains in force without limit of time on condition of keeping the specific features of good produced in the territory of the mentioned geographical location.

2. The term of the right to use the appellation of origin is for ten years from the date of filing an application to the expert organization.

3. The term of the right to use the appellation of origin shall be extended every time for ten years upon the request of owner applied during the last year of its term on condition of keeping the specific features of good in regard to which the appellation of origin was registered.

4. The request on extending the term of the right to use the appellation of origin shall be submitted simultaneously with the opinion of the relevant authority in accordance with Article 29 of this Law. Information about extending the term of the registration shall be entered in the State register of appellations of origin and in the certificate.

5. The motion period established in paragraph 3 of this Article may be restored upon the

application of owner filed within six months of expiry of the term of registration.

Footnote. Article 34 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 No. 586.

### **Article 35. Publication of the information on the registration**

Information concerning the registration of appellation of origin and granting the right to use appellation of origin as well as subsequent changes shall be published by the expert organization in the bulletin immediately following their entering in the State register of appellations of origin.

Footnote. Article 35 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 No. 586.

### **Article 36. Right to use the appellation of origin**

1. Extract from the State register of appellations of origin confirms the fact of registration of the appellation of origin and the exclusive right of owner to use it in regard to the good specified in the State register of appellations of origin.

2. Form of the extract shall be established by the authorized body.

Footnote. Article 36 as amended by the Law of the Republic of Kazakhstan of 07.04.2015 No . 300-V (enters into force in ten calendar days after its first official publication).

## **Chapter 10. Use of the appellation of origin**

### **Article 37. Conditions of use of the appellation of origin**

1. The owner of the right to use the appellation of origin has the exclusive right to use it.

2. The appellation of origin may not be used without registration if is identical or confusingly similar to the registered appellation of origin in regard to the goods of the same kind.

3. The appellation of origin may not be used if it is or contains the appellations of origin identifying mineral waters, wines or spirits, for marking the goods not originating from this place as well as if the real place of origin is indicated or the translation is used or the designation is attended by the expressions like “of kind”, “of sort”, “like” or others.

4. The alienation, other transactions of assignment of right to use the appellation of origin and granting right to use the appellation of origin based on the license agreement shall not be allowed.

Footnote. Article 37 as amended by the Law of the Republic of Kazakhstan of 12.01.2012 No . 537-IV (enters into force in ten calendar days after its first official publication).

### **Article 38. Warning marking**

The owner of right to use the appellation of origin may place near the appellation of origin the warning marking looking like the Latin letter R or verbal designations “tauarshygarylğanjerdyn tirkelgenatauy” (“тауаршығарылғанжердын тіркелгенатауы”), “registered appellation of origin” (“зарегистрированное наименование места происхождения товара”) or “reg. AOG” (“рег. НМПТ”).

## **Chapter 11. Termination of legal protection of the appellation of origin**

### **Article 39. Contestation of registration of the appellation of origin and (or) granting the right to use the appellation of origin**

1. The registration of the appellation of origin and (or) granting the right to use the appellation of origin may be contested and nullified if it was made in violation of the requirements established by Articles 26, 27 and 29 of this Law.

2. The registration of the appellation of origin and (or) granting the right to use the appellation of origin may be contested and nullified within five years of the date of publication of the information about the state registration of the appellation of origin in the official bulletin if the use of the appellation of origin is able to mislead the consumer about the good or its manufacturer due to the trademark with earlier priority as well as the general recognition in the Republic of Kazakhstan as a result of the active use.

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

The objection shall be handled in accordance with the procedure and terms established by paragraph 2 of Article 23 of this Law.

Footnote. Article 39 as amended by the Law of the Republic of Kazakhstan of 12.01.2012 No . 537-IV (enters into force in ten calendar days after its first official publication).

### **Article 40. Termination of the registration of the appellation of origin and of the right to use the appellation of origin and their nullification**

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

1) due to disappearance of the representative conditions in the said geographical location and failure to produce the good with the characteristics specified in the State register of appellations of origin in regard to the reviewed appellation of origin;

2) due to the termination of the legal protection of the appellation of origin in the country of origin.

2. The right to use the appellation of origin of goods shall be terminated:

1) due to the expiry of its term specified in Article 34 of this Law;

2) due to loss of the special features of the good specified in the State register of appellations of origin in regard to the reviewed appellation of origin;

3) upon the request of the owner of the right to use the appellation of origin filed to the authorized body;

4) upon the liquidation of the legal entity or termination of business activity of the individual – 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 the appellation of origin shall be nullified by the decision of the Appeal Board or court on the grounds specified in paragraph 1 of Article 39 of this Law.

4. The expert organization makes an entry in the State register of appellations of origin concerning the nullification of the registration of the appellation of origin and (or) the right to use the appellation of origin upon their termination or nullification.

Footnote. Article 40 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 No. 586.

## **Chapter 12. Protection of the rights of owners of the trademarks and the rights to use the appellations of origin**

### **Article 41. Appeal Board**

1. Appeal Board is the subdivision of the authorized body on pre-trial examination of the objections filed in accordance with paragraph 6 of Article 12, paragraph 4 of Article 19, paragraph 2 of Article 23, paragraph 2 of Article 39 of this Law. The regulation on the Appeal Board shall be established by the authorized body.

1-1. Pre-trial dispute examination of the objections specified in paragraph 1 of this Article shall be mandatory.

2. The following objections may be filed to the Appeal Board:

1) against the decision of the authorized body (the opinion of the expert organization) on refusing the trademark registration including refusing the trademark registration based on the results of the examination of the designation applied in accordance with paragraphs 1, 2 of Article 5 of Madrid Agreement;

2) against the decision of the authorized body on refusal the registration and (or) granting right to use the appellation of origin;

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

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

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

The objections specified in subparagraphs 1) and 2) of this paragraph shall be filed by the applicant or his assignee directly or through the representative.

The objections specified in subparagraphs 3)-5) of this paragraph shall be filed by any interested person directly or through the representative.

The objection shall be filed to the authorized body in writing in Kazakh or Russian language directly or sent by mail. The materials attached to the objection shall be submitted in Kazakh and Russian languages.

If the objection is filed by facsimile or by email it shall be confirmed with the original hard copy within one month of the date of receiving the objection.

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

Missed time limit for filing objections specified in subparagraph 1) and 2) of the first part of this paragraph shall be restored upon the request of the applicant within the period established by this Law. Such request shall be submitted with the objection to the Appeal Board .

3. In case of filing an objection through a patent attorney or another representative the power of attorney shall be submitted in Kazakh and Russian languages; if the power of attorney is submitted in any other (foreign) language it shall be translated to Kazakh and Russian languages and the translation shall be notarized. The original of the notarized power of attorney shall be attached to the objection materials or it shall be submitted together with the copy to the secretary of the Appeal Board for confirmation of notarization.

4. The filed objection shall be handled at the meeting of the Appeal Board within the period established by this Law. Time limit for objection consideration may be extended upon the request of the individual who filed an objection as well as of the owner of the protection document but not longer than for six months from the expiry date of the time limit set for consideration of the objection.

5. The individual filed an objection, the owner of the trademark or the right to use the appellation of origin has right to challenge the decision of the Appeal Board in court within six months of the decision date.

Footnote. Article 41 as amended by the Law of the Republic of Kazakhstan of 12.01.2012 No . 537-IV (enters into force in ten calendar days after its first official publication); of

07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication); of 31.10.2015 No. 378-V (the act is entered into force since 01.01.2016).

#### **Article 41-1. Grounds for refusal to consider an objection in the Appeal Board**

The objection shall be refused to be considered if:

- 1) the objection is not subject to consideration in the Appeal Board;
- 2) the objection is not signed or is signed by the person who is not authorized to sign it;
- 3) the objection is filed out of the set time limit and the possibility to extend or restore the time limit is lost;
- 4) the deficiencies related to the requirements for form, content or procedure of filing an objection are not eliminated by the applicant within the established period of time.

Under the above-listed circumstances the notification shall be sent to the individual who filed an objection that the received objection cannot be admitted for examination and shall be considered as unfiled.

The person who filed an objection or his representative may revoke the filed objection before announcement of the decision of the Appeal Board.

Footnote. The Law was completed with article 41-1 in accordance with the Law of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication).

#### **Article 41-2. Consideration of objection at the meeting of the Appeal Board**

1. The objection shall be considered at the meeting of the Appeal Board composed of at least five its members. Before the beginning of the dispute consideration the confidentiality of the personal composition of the Appeal Board shall be ensured.

For handing down an opinion the representatives of the scientific organizations and the experts in the appropriate field may be invited to the meeting of the Appeal Board.

2. The Appeal Board has right to change the time of the meeting when:
  - 1) it is impossible to consider an objection at the meeting due to absence of any of the persons enChaptered to participate in consideration of the objection;
  - 2) the parties shall submit the missing additional documents (evidences) for making a decision on the merits;
  - 3) upon the request of the parties.
3. Individuals participating in the consideration of the objection have right to:
  - 1) familiarize themselves with the case materials, make extracts, request and receive their copies;
  - 2) present the evidences;
  - 3) participate in the examination of the evidences;
  - 4) make questions to the participants of the appeal process;
  - 5) file an application;
  - 6) give oral and written explanations to the members of the Appeal Board;
  - 7) present arguments and reasons on all questions arising in the course of consideration of the objection;
  - 8) object against requests, arguments and reasons of other persons involved in the case.
4. Upon the resolution of the dispute the Appeal Board makes a decision on the merits. The decision shall be made by the simple majority of votes of the Appeal Board members.

In case of a tie the Chairman of the Appeal Board meeting shall have the casting vote.

As a result of the consideration of the objection the following decisions shall be made:



- 1) on allowance of objection;
- 2) on partial allowance of objection;
- 3) on postponing the time of consideration of the objection;
- 4) on refusal to allow an objection.

5. Within ten working days of the decision date the Appeal Board shall prepare and send to the parties the decision of the Appeal Board. The decision of the Appeal Board shall be set down in writing and shall consist of introductory, descriptive, reasoning and operative parts.

The decision of the Appeal Board shall be signed by all members of the Appeal Board. Footnote. The

Act was completed with article 41-2 according to the Law of the RK of

12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication).

## **Article 42. Settlement of the disputes**

1. The following disputes are subject to judicial consideration:

- 1) on legality of registration of the trademark or the appellation of origin;
- 2) on violation of the exclusive rights of the owner for the trademark or the right to use the appellation of origin;
- 3) on conclusion and implementation of license agreements for use of the trademark;
- 3-1) on legality of acknowledgement the trademark as well-known;
- 4) other disputes related to the protection of rights arising from the registration. 1-1. The applications on decision of the authorized body specified in paragraph 2 of

Article 41 of this Law shall be brought into court after considering the relevant objections in the Appeal Board.

2. The expert organization publishes information about changes concerning the registration based on the opinion of the court.

Footnote. Article 42 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 No. 586; of 07.04.2015 No. 300-V (enters into force in ten calendar days after its first official publication); of 31.10.2015 No. 378-V (the act is entered into force since 01.01.2016)

## **Article 43. Liability of legal entities and individuals for violation of laws on trademarks and appellations of origin**

1. An unauthorized putting of trademark or appellation of origin or designations confusingly similar to them into civil circulation in regard to goods and services of the same kind and in case of well-known trademark – in regard to any goods and services shall be considered as a violation of the exclusive right of owner for trademark or right to use the appellation of origin.

An unauthorized use of trademark or appellation of origin in the public telecommunication networks (Internet and others) shall be also considered as a violation of the exclusive right of owner for trademark or right to use the appellation of origin

2. For using the protected trademark or appellation of origin as well as designation confusingly similar to them for goods of the same kind in violation of the requirements provided by this Law the guilty persons shall be liable in accordance with the laws of the Republic of Kazakhstan.

Footnote. Article 43 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 No. 586.

#### **Article 44. Responsibilities of the person violated the rights of owner of the trademark or the right to use the appellation of origin**

The person using illegally the trademark or the appellation of origin or the designation confusingly similar to them shall be obliged to:

- 1) terminate the violation and indemnify the losses incurred to the owner of trademark or right to use the appellation of origin;
- 2) destroy the good, the good package on which the illegally used trademark, appellation of origin or designation confusingly similar to them is placed except the original goods with the trademark placed by the possessor of right. If it is necessary for the public benefit to introduce the goods into circulation one shall be obliged to delete the illegally used images of trademark, appellation of origin or designation confusingly similar to them from the good and its package;
- 3) delete the trademark or the designation confusingly similar to it from the materials that attend the works or services i.e. from the documents, advertisement, signs.

Footnote. Article 44 as amended by the laws of the Republic of Kazakhstan of 27.10.2015 No.365-V (enters into force in ten calendar days after its first official publication).

### **Chapter 13. Concluding provisions**

#### **Article 45. State duty**

The activity of the authorized body on registration of trademarks and appellations of origin, registration of well-known trademark, registration of agreements, attestation of patent attorneys and issuing the certificate on registration of patent attorney shall be subject to payment of the state duty in accordance with the tax legislation of the Republic of Kazakhstan.

Footnote. Article 45 as amended by the Law of the Republic of Kazakhstan of 07.04.2015 No . 300-V (enters into force in ten calendar days after its first official publication).

#### **Article 46. Patent attorneys**

1. The voting citizen of the Republic of Kazakhstan having his residence in its territory , with high education and work experience in the field of intellectual property at least for four years who passed an attestation and was registered in the authorized body in the field of intellectual property may qualify for the patent attorney.

For attestation of the candidates for the position of the patent attorney the authorized body establishes the attestation commission from among the staff of the authorized body and the expert organization. The minimum number of members of the attestation commission shall be not less than five employees.

Attestation of the candidates for the position of the patent attorney shall be carried out by the authorized body at least once a year as applications from candidates for the position of the patent attorney come in.

According to the results of the attestation the attestation commission makes a decision on attestation or refusal for attestation of the candidate. The form of the decision of the attestation commission shall be established by the authorized body.

The decision of the attestation commission may be appealed to the court within three months of the date of making such decision.

The candidate who successfully passed the attestation exam for the position of the patent attorney receives the certificate of the patent attorney the form of which shall be established

by the authorized body.

The state duty established by the tax law of the Republic of Kazakhstan shall be collected for attestation of the candidates for the position of the patent attorney and for issuing the certificates.

2. The following persons shall not be allowed to pass attestation for the position of the patent attorney:

1) those who are prohibited to run a business activity in accordance with the laws of the Republic of Kazakhstan;

2) those who are employees of the authorized body and the lower organizations as well as their close relatives, husband (wife);

3) those who have an outstanding or unexpunged conviction for the commission of crimes according to the procedure established by law;

4) those who were excluded from the register of patent attorneys in accordance with this

Law.

3. Activity of the patent attorney shall be suspended upon the protocol resolution of the attestation commission:

1) based on the application of the patent attorney filed to the attestation commission;

2) for the period of reference to the group of individuals who are prohibited to run a business activity in accordance with the laws of the Republic of Kazakhstan as well as group of the employees of the authorized body and the lower organizations;

3) in order to clarify the circumstances specified in subparagraph 2) and 6) of paragraph 1 and in paragraph 5 of Article 46-2 of this Law.

In the case specified in subparagraph 3) of this paragraph the activity of the patent attorney shall be suspended till the attestation commission makes the relevant decision within three months.

Activity of the patent attorney shall be resumed by the protocol resolution of the attestation commission if the grounds caused the suspension of his activity were eliminated.

4. The patent attorney as a representative of the applicant performs activities related to conducting the cases with the authorized body and the expert organization on matters of legal protection of objects of the intellectual property. Conducting the cases with the authorized body and the expert organization may also be performed by the applicant and (or) the trademark owner directly.

The individuals living outside the Republic of Kazakhstan or foreign legal entities exercise their rights of the applicant, the owner of trademark, service mark and appellation of origin as well as the interested person in the authorized body and its organizations through the patent attorneys.

Individuals domiciling in the Republic of Kazakhstan but being temporary abroad may exercise their rights of the applicant, the owner of trademark, service mark and appellation of origin as well as the interested person without patent attorney when the correspondence address within the boards of the Republic of Kazakhstan is indicated.

5. The information that a patent attorney receives from the grantor due to performance of his assignment shall be considered as confident upon compliance with the requirements provided by the legislation of the Republic of Kazakhstan on the protection of official and commercial secrets.

Footnote. Article 46 as amended by the laws of the Republic of Kazakhstan of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication).

#### **Article 46-1. Rights and responsibilities of the patent attorney**

1. Patent attorney is entrusted to perform on behalf of the applicant (individual or legal entity), the employer concluded with him the employment contract or the individual concluded with him or with his employer the civil-law contract the following activities:

1) counseling on the matters of protection of intellectual property right, acquisition or assignment of intellectual property rights;

2) performing of works on issuance or execution of applications on registration of trademarks, service marks and appellations of origin on behalf and under instructions of customer, grantor, employer;

3) interaction with the authorized body and (or) the expert organization on the matters of protection of rights for trademarks, service marks and appellations of origin including correspondence, preparation and filing an objections against the decisions of examination, participation in the meetings of the expert board of the expert organization;

4) assistance in drawing up, reviewing and subsequent sending of the license (sublicense) agreements and (or) the assignment agreements to examination.

2. The authorities of patent attorney shall be ascertained by the certificate.

3. In case if the patent attorney submits the copy of power of attorney on conducting the case related to filing of applications for trademarks (service marks) and appellations of origin and (or) obtaining the protection documents as well as filing an objection to the Appeal Board the patent attorney shall be obliged to submit the original of the power of attorney to the expert organization or the authorized body consequently within three months of the moment of filing the mentioned application or objection. After authentication the original of the power of attorney shall be returned.

If the power of attorney was drawn up in foreign language its notarized translation to Kazakh and Russian language shall necessarily be submitted.

4. The patent attorney shall be obliged not to accept instructions if he represented or counseled on this case the persons whose interests contradict with the interests of those who filed the request of case conduction or participated in another way in the consideration as well as if the official who is a close relative of the patent attorney, husband (or wife) and his (her) close relative participates in the consideration.

Footnote. The Act was completed with article 46-1 according to the Law of the RK of 12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication).

#### **Article 46-2. Revocation and nullification of the certificate of the patent attorney**

1. The patent attorney shall be excluded from the register of patent attorneys upon the decision of the attestation commission:

1) based on the personal application filed to the attestation commission;

2) upon the loss of citizenship of the Republic of Kazakhstan or upon relocation and permanent residence outside the territory of the Republic of Kazakhstan;

3) in case of break in the professional activity of the patent attorney for more than five years;

4) upon entry of judgement of conviction into legal force according to which the patent attorney is convicted of committing a crime;

5) in the event of death of the patent attorney or declaration his as missing or dead;

6) in case the patent attorney was acknowledged as incapable or partially capable.

2. In case of excluding the patent attorney from the register upon the grounds specified in subparagraphs 4), 5) and 6), the certificate shall be nullified by the decision of the attestation commission. Information about the certificate nullification shall be updated in the register of patent attorneys.

3. In cases specified in subparagraphs 1), 2) and 3) of paragraph 1 of this Article the certificate of the patent attorney shall be revoked by the decisions of the attestation commission based on the application of the patent attorney himself or the third parties who have grounds for that.

The patent attorney excluded from the register on the grounds of subparagraphs 1) and 2)

paragraph 1 of this Article may be registered again as a patent attorney without repeated passing of the qualification examination on condition of eliminating the grounds caused his exclusion from the register and filing an application to the attestation commission within three years of the date of publication of the decision on excluding from the register. The attestation commission establishes the fact of termination of the grounds specified in subparagraphs 1) and 2) of paragraph 1 of this Article basing on the submitted documents.

4. The patent attorney excluded from the register of patent attorneys loses his right to conduct the activity of patent attorney from the date of entering the information about this and the certificate on his registration as a patent attorney shall be revoked or nullified.

5. In case of unconscientious performance by the patent attorney of his duties established by this Law the authorized body forms the Appeal Board containing the odd number of employees of the authorized body.

The Appeal Board shall be recognized as the collegial body and reviews the complaints of the individuals and (or) the legal entities on the activities of the patent attorneys representing their rights and legally protected interests which they argue that were made in violation of the applicable legislation.

The persons who made a complaint against the activities of the patent attorney and the patent attorneys in regard to whom such complaints were made have right to participate in the meeting of the appeal commission.

As a result of complaint consideration the appeal board recommends to the authorized body to refer to court the statement of claim on nullification the certificate of the patent attorney or makes one of the following decisions:

- 1) to postpone the consideration of the complaint due to lack of evidence or until the circumstances that contribute to making the unprejudiced decision are clarified;
- 2) to refuse the complaint.

The decision of the appeal board shall be made by the simple majority of votes and shall be drawn in minutes. The decision of the appeal commission may be appealed in court.

The regulation on the appeal commission shall be established by the authorized body. Footnote. The

Act was completed with article 46-2 according to the Law of the RK of

12.01.2012 No. 537-IV (enters into force in ten calendar days after its first official publication).

#### **Article 47. Registration in foreign countries**

1. The legal entities and the individuals of the Republic of Kazakhstan have right to register the trademark in foreign countries or make its foreign registration.

The application on the foreign registration of the trademark shall be filed through the expert organization.

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

Footnote. Article 47 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 No. 586.

#### **Article 48. Rights of foreign individuals, foreign legal entities and stateless individuals**

Foreign individuals, foreign legal entities, stateless individuals have rights and responsibilities provided by this Law on the same footing as the legal entities and the individuals of the Republic of Kazakhstan unless otherwise provided for by the legislation of the Republic of Kazakhstan.

*The President  
of the Republic of Kazakhstan*