

Kazakhstan

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1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Republican State Enterprise on the right of economic management, i.e., the National Institute of Intellectual Property (NIIP) of the Ministry of Justice of the Republic of Kazakhstan (Ministry of Justice).

1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant trade mark legislation is the following:

- 1) the Civil Code of the Republic of Kazakhstan dated December 27, 1994, No. 268-XIII;
- 2) the Law of the Republic of Kazakhstan of July 26, 1999, No. 456 On Trademarks, Service Marks, and Appellation of Origin (Law On Trademarks); and
- 3) Order No. 1340 of the Minister of Justice of the Republic of Kazakhstan dated August 29, 2018, registered with the Ministry of Justice on September 24, 2018, No. 17414 On Approval of the Rules for Registration of Trademarks and Appellations of Origin in the State Register of Trademarks and the State Register of Appellations of Origin, forms of certifications and issuance of titles of protection and their duplicates, termination of registration and invalidation.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

The following designations can be registered as a trade mark:

- 1) graphic;
- 2) verbal;
- 3) letter;
- 4) numerical;
- 5) volumetric and other designations or combinations of designations allowing goods and services of certain parties to be distinguished from similar goods and services of other parties.

2.2 What cannot be registered as a trade mark?

Several types of designations are not eligible for registration as a trade mark; for example, those that consist solely of designations that are not distinctive, particularly those that:

- 1) have entered into common use for marking goods (services) of a particular kind;
- 2) are generally accepted symbols and expressions;
- 3) indicate the sort, quality, quantity, character, purpose, and value of goods as well as the place and time of their manufacture or distribution;
- 4) are international unpatentable names of pharmaceutical products; or
- 5) have a direct descriptive connection with the goods or services that they are used to mark.

This also applies to designations that reproduce armorial bearings, flags, and symbols, abbreviated and full names of international organisations 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.

A third group of designations that cannot be registered as trade marks or their elements includes those that:

- 1) are false or capable of misleading concerning a product or its manufacturer, service, or person providing a service, as well as names of geographical objects that may be misleading concerning the place of production of the product;
- 2) formally indicate the real place of manufacture of a good but give a wrong impression regarding the origin of the 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 expressions such as “of kind”, “of sort”, “like” and others; or
- 4) are contrary to public interests, humanity, and morality principles.

2.3 What information is needed to register a trade mark?

To register a trade mark, an electronic application should be submitted with all necessary information and materials. The application must relate to one trade mark and contain:

- a request for an examination of the designation indicating the applicant, as well as his location or place of residence;
- characteristics of the designation, such as its colour, translation or transliteration, an indication of three-dimensionality, the presence of sounds, smells, holographic elements (if applicable), an indication in Times New Roman standard black font (if applicable), and an indication of unprotected elements or collective applicants (if applicable);
- claimed designation; and
- a list of goods and/or services by the International Classification of Goods and Services (Nice Classification).

The application must be accompanied by:

- a copy of the document confirming the payment for the examination; and
- a copy of the power of attorney in the case of applying through a representative.

Depending on the characteristics of the trade mark, the application may also be accompanied by the following documents:

- the charter of a Collective trade mark (in the case of applying for a Collective trade mark), including the name of the organisation authorised to register the Collective trade mark in its name, the purpose of registration, the list of entities entitled to use the mark, the list and uniform qualities or other characteristics of goods and services that will be designated by the mark, conditions for and a procedure for monitoring its use, and liability for violation of the provisions of the charter of the mark;
- a description of the composition of the substance, the formula of the chemical compound, and other information; and
- permission from the authorised body to use symbols, etc.

2.4 What is the general procedure for trade mark registration?

- 1) Applying for trade mark registration:
 - 1.1) Registration of an application in the information system – from 3 to 14 calendar days (exact terms are not specified).
- 2) Conducting an examination of an application for registration of a trade mark:
 - 2.1) Preliminary examination – within one month from the date of application.
 - 2.2) Full examination – within seven months from the date of application.
- 3) Final conclusion includes the expert organisation's decision on registration, partial registration, or refusal to register a trade mark.
- 4) Issuance of a certificate of registration or partial registration of a trade mark – within 10 working days from the date of filing an application from the service recipient.

2.5 How is a trade mark adequately represented?

The designation must be submitted in PNG format with a minimum size of 945px × 945px (8cm × 8cm, 300dpi). The specified format also applies to alphabetic or verbal trade marks, in which case they must be submitted as an image containing the alphabetic or verbal trade mark.

2.6 How are goods and services described?

The Nice Classification is used to describe goods and services while filling out the trade mark registration application. The authorised body provides an opportunity to select up to three classes of the Nice Classification within the minimum mandatory fee payable at the time of filing the application. A surcharge is stipulated for each subsequent class of the Nice Classification.

2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Pursuant to Article 5 of the Law On Trademarks, other designations or combinations thereof may also be registered as a trade

mark. Other designations include volumetric, holographic, sound, olfactory, and other designations. Furthermore, there is a list of additional requirements that need to be met for these designations to be registered as a trade mark.

If protection of a volumetric trade mark is requested, besides the image of the general form of this designation (schematic, photographic, or made in a graphic editor using computer hardware), images of various types of volumetric trade marks in views providing a complete picture of the claimed designation and/or its verbal description shall be presented.

If protection of a holographic trade mark is requested, then several images clearly revealing the holographic effect (the observed reflections of images, changes in brightness and contrast), holographic designations from various directions perpendicular and at an angle above and below the perpendicular direction shall be attached to the application. If, in the holographic designation, the image of objects changes, then an image of each object shall be represented.

If protection of a sound trade mark is requested, the application shall be accompanied by its musical notation and soundtrack on a digital medium. If part of a musical work is declared for registration, it is necessary to indicate the name of the work and its author, as well as documents confirming the consent of the author to use his intellectual property.

If protection of an olfactory trade mark is requested, a description of the composition of the substance, the formula of the chemical compound, and other information characterising the source of smell, as well as a sample of the proposed designation, shall be submitted.

Designations that cannot be reproduced in the application form shall be attached as an appendix.

If registration of a varying mark is requested, then a designation shall be attached to the application, consisting of one or several still or changing images reflecting the change. If the submitted image or images do not show a change, additional images and/or verbal descriptions explaining the change shall be presented.

If registration of a colour mark is requested, a designation shall be provided that represents the colour itself or a combination of colours without contours, and the image of such a sign should consist of a sample of colour(s).

If registration of a positional sign is requested, then an image of such a sign shall be attached to the application, which should consist of one type of sign indicating its location on the product. If necessary, an indication of the object is provided, for which protection is not requested, and a description explaining the location of the mark in relation to the goods. The unprotected part of the image is filled with dotted lines.

If registration of a light mark is requested, then a general view of the designation and description of the sequence and duration of the luminescence of signals and/or light symbols and their characteristics shall be attached to the application.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Current legislation does not explicitly require the submission of evidence or information confirming the use of a trade mark for its initial registration or renewal. However, Article 19 of the Law On Trademarks establishes the obligation of the trade mark owner to use it, place it on goods, use it in advertisements, signs, letterheads, etc. In case of violation of this obligation and failure to use the trade mark in connection with its non-use during the last three years, any interested third party has the right to challenge the registration in court.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A trade mark registered under the laws of the Republic of Kazakhstan shall be granted legal protection throughout the territory of Kazakhstan.

2.10 Who can own a trade mark in your jurisdiction?

In accordance with Paragraph 10 of Article 1 of the Law On Trademarks, the trade mark owner may be both a legal entity and an individual, including foreign companies or citizens. It is also worth noting that an applicant can also be an individual entrepreneur, i.e., a citizen of the Republic of Kazakhstan, who carries out personal, independent entrepreneurial activities, but does not form a legal entity.

2.11 Can a trade mark acquire distinctive character through use?

Generally, and according to Article 6 of Law On Trademarks, registering designations that do not have distinctiveness is not permitted. However, the same Article establishes an exception that such designations may be registered as a trade mark if, at the date of filing the application, they have acquired distinctiveness as a result of wide use. Distinctiveness refers to characteristics that allow goods or services of one manufacturer to be distinguished from similar goods or services of other manufacturers.

2.12 How long on average does registration take?

On average, registering a trade mark takes about eight-and-a-half to nine months. Legislation provides for the following deadlines: one month for a preliminary examination; seven months for a full examination; and 10 working days for issuance of a certificate of trade mark registration. In addition, the procedure may be slightly delayed due to technical issues: registration in the information system; sending the necessary applications or requests; and payment of state fees, etc.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost for trade mark registration is about 100,000 KZT. This includes filing an application for registration of a trade mark with the selected one to three classes under the Nice Classification. For each additional class, as well as for making changes to the application, an additional fee is charged.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

An application for trade mark registration can be submitted in two ways:

- By submitting an online application through the NIIP Personal Account: <https://newcab.kazpatent.kz>. In this case, all necessary documents are provided electronically or in the form of scanned documents.
- By submitting the application on paper through the NIIP office in Astana. In this case, all necessary documents are provided in paper and original form.

2.15 Is a Power of Attorney needed?

A power of attorney must be attached if the application is not submitted personally by the trade mark owner but by a representative or patent attorney.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

A power of attorney from a legal entity, including a foreign company, may be issued in written form on the company's letterhead (if any), and with the obligatory affixing of the company seal. If the company does not use a seal, and if the power of attorney is issued on behalf of an individual, including a foreign company, then the power of attorney is subject to compulsory notarisation.

If a power of attorney is notarised in the member countries of the 1993 Minsk Convention, it is not subject to additional legalisation or apostille. When a power of attorney is notarised in countries party to the Hague Convention, it must be apostilled, or consular legalisation in other countries.

2.17 How is priority claimed?

Priority shall be determined by the filing date of application to the expert organisation.

There is also a possibility of establishing a Convention or exhibition priority. The Convention priority shall be established if the first application for registration of a trade mark was filed in a member country of the Paris Convention for the Protection of Industrial Property (Paris Convention), and if the application to the expert organisation of Kazakhstan was made no later than six months from the date of the first application.

Exhibition priority shall apply if the trade mark design has been displayed at officially recognised international exhibitions. The priority can be applied only if the application for registration in Kazakhstan was submitted no later than six months from the start date of the open display.

2.18 Does your jurisdiction recognise Collective or Certification marks?

Kazakhstan legislation recognises the protection of Collective trade marks but does not protect Certification marks as a means of individualisation of goods or services. A Collective trade mark is understood as a trade mark of an association (union) or other association of legal entities and/or individual entrepreneurs serving to designate goods (services) produced or sold by them that have common qualitative or other characteristics.

Certification marks and the procedure for their application to goods are regulated by legislation in the field of standardisation and certification, including the Law of the Republic of Kazakhstan On Technical Regulation. According to said legislation, the declaration of conformity (Certification mark) is a designation used to inform buyers about the passage of products and services through the procedures of confirmation of compliance with the requirements established by technical regulations and/or national standards. Marks of conformity shall be applied manufacturers, importers, or sellers after obtaining a relevant certificate. Representation of declarations of conformity shall be established by national standards and shall not be protected as a unique trade mark.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

In accordance with Article 6 of the Law On Trademarks, absolute grounds for refusal of registration as a trade mark is the filing for registration:

- 1) designations lacking distinctiveness or consisting only of elements that:
 - are in common use for the designation of goods (services) of a certain type;
 - are generally accepted symbols and terms;
 - indicate the sort, quality, quantity, character, purpose, and value of goods as well as the place and time of their production or marketing;
 - represent international unpatentable names of pharmaceutical products; and
 - have a direct descriptive relation with the goods or services for which they are used;
- 2) designations that reproduce armorial bearings, flags, and symbols, abbreviated or full names of international organisations, 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 them;
- 3) designations that are false or may mislead with respect to goods or their manufacturer, service, or person rendering the service, as well as the names of geographic objects, which may mislead with respect to the place of manufacturing of the goods;
- 4) designations that formally indicate the true place of manufacturing but give the erroneous idea that the goods originate from other territories;
- 5) designations that represent or contain the names of geographic objects, identifying mineral waters, wines, or spirits for the designation of such goods not originating from that place, and also if the translation is used or the designation is accompanied by expressions such as “of kind”, “of sort”, “like” or similar; and
- 6) designations contradicting public interests, principles of humanity, and morality.

3.2 What are the ways to overcome an absolute grounds objection?

Designations that reproduce armorial bearings, flags, symbols, etc., may be used as unprotected elements if the designation does not consist solely of them and if the appropriate authorised body or their owner or inheritor provides consent.

Designations that are not distinctive can be used as unprotected elements of a trade mark if they do not take the dominant place. They may also be registered as a trade mark if, at the date of filing, the sign has acquired distinctiveness as a result of use.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

In case of refusal of or partial registration, the applicant has the right, within three months from the date of receiving a preliminary expert opinion, to submit a reasoned objection. If the final opinion is also a refusal decision, the applicant can object in the same manner within three months of receipt.

3.4 What is the route of appeal?

A reasoned objection to a preliminary expert opinion on refusal or partial registration is submitted to the expert organisation. Based on a reasoned objection, the expert organisation makes a final decision within three months.

In response to the final decision of the expert organisation, the objection is sent directly to the Appeals Board of the Ministry of Justice. The objection shall be considered within four months, but the term may be extended by up to three months. To consider the objection, a meeting of the Appeals Board panel is appointed, which is also attended by the applicant, the owner (copyright holder), independently or through representatives, and a representative of the expert organisation that conducted the examination.

Based on the results of the meeting, the Appeals Board shall make one of the following decisions:

- satisfaction of the objection;
- partial satisfaction of the objection;
- refusal to review the objection; or
- refusal of satisfaction of the objection.

The decision to refuse the satisfaction of the objection may be further appealed in court.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

Article 7 of the Law On Trademarks provides for other grounds for refusal of registration:

- 1) Designations that are identical or similar to the point of confusion:
 - trade marks registered in the Republic of Kazakhstan and protected by international treaties with an earlier priority in the name of another person with respect to homogeneous goods or services, or identical trade marks of the same person with respect to the same goods or services;
 - well-known trade marks in the Republic of Kazakhstan with respect to any goods and services;
 - designations that are applied for registration with an earlier priority in the name of another person with respect to homogeneous goods or services, or with identical designations of the same person with respect to the same goods or services; and
 - appellations of origin of goods protected in the Republic of Kazakhstan with respect to any goods.
- 2) Designations that reproduce:
 - industrial designs protected in the Republic of Kazakhstan in the name of other parties, subject to their earlier priority;
 - names of famous works of literature, science, and art, known works of art and their fragments in violation of the copyright, known in the Republic of Kazakhstan as of the date of filing the application;
 - surnames, names, pseudonyms, and derivatives thereof, portraits, and facsimiles in violation of personal non-property rights of such persons, their heirs or successors, and also if these designations represent the historical and cultural heritage of the Republic of Kazakhstan without permission from the appropriate authorised body; and
 - the heritage of history and culture of the Republic of Kazakhstan in the absence of approval by the authorised body in the field of culture.

4.2 Are there ways to overcome a relative grounds objection?

Designations that are confusingly similar or identical to trade marks that are in the process of registration or are already registered and protected in the territory of Kazakhstan, i.e., well-known trade marks, may also be registered with the written consent of the owner of the existing trade mark.

Names or portraits of third parties as well as historical and cultural treasures may be registered as trade marks with the relevant consent.

Appellations of origin of goods protected in the Republic of Kazakhstan in respect of any goods can be included as a non-protected element of the trade mark registered in the name of the owner of the right to use this appellation if the registered goods and services of the appellation coincide with the goods and services of the registered trade mark.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

In case of refusal to register a trade mark, the applicant shall have the right to file a reasoned objection within three months from the date of receipt of the preliminary opinion on refusal. In the event that the final opinion also contains a decision of refusal, the applicant shall be entitled to appeal in the same manner within three months from the date of receipt of the final opinion.

4.4 What is the route of appeal?

Please see the answer to question 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

Article 23 of the Law On Trademarks sets out the following grounds for opposing registration:

- 1) Trade mark registration may be opposed and declared invalid in whole or in part during the term of validity if it has been carried out in violation of the requirements establishing absolute and relative grounds for refusing the registration of a trade mark. At the same time, in the case of challenging the registration of a trade mark due to its confusingly similar or identical nature in relation to the then-protected or well-known trade marks, the right to oppose is only given for a period of five years from the date of registration of the opposed trade mark.
- 2) Trade mark registration may be opposed and invalidated in whole or in part during the term of validity if it has been made in the name of the representative of the owner of an identical or confusingly similar trade mark in one of the countries party to the Paris Convention without authorisation of the latter.
- 3) Trade mark registration may be opposed and recognised as invalid in whole or in part if the trade mark is identical or similar to the extent of confusion in respect of homogeneous goods or services with the trade name of another person, the exclusive right to which arose in the Republic of Kazakhstan before the priority date of the trade mark.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

The following can oppose trade mark registration:

- 1) Any interested person shall be entitled to file an opposition against a trade mark registration on the grounds mentioned in point 1) of question 5.1 above with the authorised body.
- 2) An opposition against trade mark registration on the grounds mentioned in point 2) of question 5.1 above can be filed with the authorised body by the owner of the trade mark registered in one of the member countries of the Paris Convention.
- 3) An objection to trade mark registration on the grounds mentioned in point 3) of question 5.1 above may be filed with the authorised body by a legal entity whose firm name is identical or confusingly similar to a trade mark registered in respect of homogeneous goods or services.

5.3 What is the procedure for opposition?

Objection against trade mark registration shall be drawn up and sent to the Appeals Board. An objection shall be considered by the Board within six months from the date of receipt. A person who files an objection, as well as the owner (copyright holder) of the trade mark, shall have the right to participate in the consideration of the dispute.

6 Registration

6.1 What happens when a trade mark is granted registration?

After the expert organisation's positive decision on the registration of a trade mark, the applicant shall submit an application for including the trade mark in the Register and issuance of the certificate. Thereafter, the details of the trade mark shall be entered into the State Register of Trademarks, the certificate of the trade mark shall be issued, and the details of the certificate shall be published in the bulletin.

6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's exclusive rights in respect of a trade mark shall commence on the date of registration in the State Register of Trademarks.

6.3 What is the term of a trade mark?

Legal protection of a trade mark is granted for 10 years with a possibility of further extension.

6.4 How is a trade mark renewed?

The validity period of a trade mark registration may be renewed for 10 years every time. In order to exercise this right, the trade mark owner must make a request during the last year of the trade mark's validity. The number of renewals is not limited.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes, an individual has the right to register the transfer of exclusive rights to a trade mark under an assignment agreement. The assignment agreement must be concluded in writing and registered with the authorised body.

7.2 Are there different types of assignment?

The trade mark owner is given the right to transfer either the whole or part of the exclusive rights to the trade mark. In either case, such transfer is effected through the conclusion of an assignment agreement.

7.3 Can an individual register the licensing of a trade mark?

Yes, a licence agreement may be concluded with an individual and registered on their behalf. The licensing agreement must be concluded in writing and registered with the authorised body.

7.4 Are there different types of licence?

Any transfer of rights to use a trade mark is concluded by a licensing agreement. The law distinguishes only the agreement of an integrated business licence agreement (franchising), which provides for the transfer of a set of exclusive rights to another person to conduct business activities. All other types of licensing agreements, the terms and conditions of which are not directly stipulated by law, are concluded between the parties in a dispositive form, taking into account the provisions of the law, where the parties have the right to designate the scope of rights, term, territory of granting and other conditions.

7.5 Can a trade mark licensee sue for infringement?

The copyright holder shall have the right to sue for infringement unless that right is limited or prohibited by a licence agreement concluded with the trade mark owner.

7.6 Are quality control clauses necessary in a licence?

Yes, the licence agreement must contain a condition that the quality of the goods (services) by the licensee will not be lower than the quality of the goods (services) by the owner (copyright holder) of the trade mark.

7.7 Can an individual register a security interest under a trade mark?

Yes, an individual has the right to pledge his trade mark property rights as security for the performance of his obligations to the creditor.

7.8 Are there different types of security interest?

Civil legislation of Kazakhstan provides for the following types of security for obligations: forfeit; pledge; guarantee and surety;

advanced payment; withholding; guarantee fee; and security fee. However, exclusive rights to a trade mark may only be used as a pledge.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

There is no such revocation procedure in Kazakhstan law. It is possible to invalidate registration following the procedure described in question 9.2 below; however, an application trade mark registration may be revoked by the applicant at his discretion at any stage of the examination before completion of registration of the trade mark.

A trade mark application may also be considered revoked due to the applicant's failure to respond to the demands of the expert organisation. For example, the expert organisation shall be entitled at any stage of the examination of the application to request the submission of additional materials within three months. If the material is not submitted within that time limit and no request for an extension is made, the application will be deemed revoked and the proceedings will be discontinued.

Furthermore, the application will be considered revoked if the applicant fails to pay for the registration of the trade mark and the issue of the certificate within three months from the date of receipt of the final decision on the registration or partial registration of the trade mark. It is worth noting that the applicant is responsible for notifying the authorised body of the payment made, i.e., he must not only pay the fee but also send a document confirming the payment.

8.2 What is the procedure for revocation of a trade mark?

In order to revoke the application, the applicant shall prepare a free-form request for revocation, which shall be sent to the expert organisation as part of the current application. In the case of electronic record-keeping, the application shall be sent to the applicant's personal account, whereas, in the case of paper record-keeping, it shall be submitted to the clerical office of the authorised body.

When the application is revoked at the decision of the expert organisation due to the applicant's failure to comply with the requirements for submission of additional information or payment, the applicant shall be notified accordingly.

8.3 Who can commence revocation proceedings?

As described above, revocation of a trade mark application can be initiated by the applicant (or his representative, if the application is submitted by proxy) or the expert organisation in case of breach of the requirements to submit additional information or payment.

8.4 What grounds of defence can be raised to a revocation action?

Intellectual property law does not provide for a procedure for appealing against a decision to invalidate a registration. The applicant is entitled to apply for protection and restoration of his rights to the judicial authorities of Kazakhstan in accordance with the applicable procedures.

8.5 What is the route of appeal from a decision of revocation?

The Appeals Board shall not examine objections to a decision of the expert organisation to revoke a trade mark application. Therefore, an appeal against such a decision will be executed by court proceedings. First, a complaint must be filed to a higher authority – in this case, the Ministry of Justice. Then, if the authorised body does not satisfy the requirements of the complaint, a lawsuit is filed to the administrative court to appeal the decision of the state authority.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

A trade mark registration shall be invalidated in whole or in part on the same grounds as may be opposed under section 5 above:

- 1) if the registration has been made in breach of the requirements laying down the absolute and relative grounds for refusing the registration of a trade mark; or
- 2) when it has been made in the name of the representative of the owner of an identical or confusingly similar trade mark in one of the countries party to the Paris Convention, without permission from the latter.
- 3) if a trade mark is identical or confusingly similar in respect of homogeneous goods or services with the company name of another entity, the exclusive right to which has arisen in the Republic of Kazakhstan before the date of priority of the trade mark.

9.2 What is the procedure for invalidation of a trade mark?

The procedure begins with an objection against the registration of a trade mark as described in question 5.3 above. The decision to invalidate a trade mark registration is taken by the Appeals Board or a court.

In the case of satisfaction of the objection, the expert organisation shall enter into the State Register of Trademarks the record on annulment of the trade mark registration in connection with recognition of its invalidity and publish the information in the bulletin and place it on its website. In the case of partial invalidation of a trade mark registration for certain goods or services, the expert organisation shall enter into the State Register of Trademarks the record on annulment of the trade mark registration for these goods or services, publish the information on annulment in the bulletin and place it on its website.

9.3 Who can commence invalidation proceedings?

Invalidation of a trade mark registration is preceded by an objection procedure that can be initiated by interested individuals or owners of similar registered marks listed in question 5.2 above.

9.4 What grounds of defence can be raised to an invalidation action?

The strategy of the defence will depend on the grounds used to invalidate the trade mark registration. For example, if the registration is challenged by the owner of another similar trade mark, it is possible to order an expert analysis of the similarity of signs as a defence. Otherwise, the parties shall use any remedies permitted by the general legislation of the Republic of Kazakhstan.

9.5 What is the route of appeal from a decision of invalidity?

The procedure of objection to the decision of the expert organisation is as described in question 3.4 above. The decision to refuse to satisfy the objection of the Appeals Board may be further opposed in court.

This procedure takes place at the Specialized Interdistrict Administrative Court of Astana. Claims for challenging shall be filed with the administrative court within one month from the date of delivery of the decision or the date of notification. In case of disagreement with the decision of the administrative court, the parties may file an appeal to the judicial collegium for administrative cases of the court of Astana through the Specialized Interdistrict Administrative Court within two months from the date of the final decision. Thereafter, the decision of the appeal instance court may be challenged in cassation proceedings within one month from the date of delivery of the judicial act of the appeal instance in final form.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Protection of trade mark rights is possible through administrative and criminal courts, depending on the infringer and the amount of damage caused, as well as through civil courts to recover infringed rights, damages, etc.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

When applying to civil courts, compliance with the pre-trial procedure is mandatory. The pre-trial procedure usually takes the form of negotiations and claim letters outlining the parties' claims. The court needs to establish that the litigant has taken all measures to resolve the dispute through negotiation. In practice, a settlement can take a couple of weeks, but the exact timing and length of the settlement will be determined by the parties, e.g., in the contract or claim letters.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so, on what basis in each case?

The court does not divide its decision into interlocutory and final judgments as part of the proceedings. The court issues a decision in final form that the parties cannot challenge in this hearing, but it can be appealed to a superior court in an appeal procedure.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so, how?

Each party shall use such evidence as it considers relevant to the dispute. The court may also demand evidence on its own initiative. The parties do not have an independent right to request any materials or documents from the other party in this way, but either party may request the court to do so. In order to do so, a party must justify why the requested document cannot be provided by itself, why it must be in the possession of the

other party, and what importance it has for the resolution of the dispute. If the court agrees with the position and request, it shall request the required evidence from the other party.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Legislation establishes that evidence is legally obtained information on facts based on which the court can justify or refute the parties' claims and defences, as well as other circumstances relevant to the correct examination and resolution of the case. Evidence includes explanations by the parties, witness statements, material and written evidence, audio and video recordings, etc.

The questioning of witnesses in court takes place one at a time in the courtroom, with the court asking the questions first, followed by all other participants in the proceedings, starting with the person who requested the summoning of that witness. The court may ask questions at any time. The term "cross-examination" does not exist in our legislation.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, the court is obliged to suspend the proceedings if it is not possible to hear the case until the resolution of another case pending in civil, criminal, administrative, or administrative infractions proceedings. The court is not obliged to suspend the proceedings until a decision has been made by an intellectual property office.

10.7 After what period is a claim for trade mark infringement time-barred?

In civil trade mark disputes, the general limitation period of three years applies from the date on which a person knew or should have known of the infringement of his rights. It is worth noting that the court is obliged to admit the dispute even if the limitation period has expired, but, if any party requests to apply the limitation period, the court is obliged to discontinue consideration of the case.

10.8 Are there criminal liabilities for trade mark infringement?

Yes, the criminal law of Kazakhstan provides for penalties for unlawful use of another's trade mark or similar thereto to the extent of confusion with similar goods or services. Criminal liability arises in case of causing major damage to the owner or right holder – over 200 MCI (approx. 1,500 USD) for an individual and over 2,000 MCI (approx. 15,000 USD) for a company. The monthly calculation index (MCI) is set for each year; in 2023, it will be approximately 7.5 USD. If the offender voluntarily compensates the damage caused, he is exempt from criminal liability, but only in the case of a primary offence.

If the offence committed does not exceed the major damage limits set above, the offender is subject to administrative liability in the form of a fine.

10.9 If so, who can pursue a criminal prosecution?

In most cases, it is the law enforcement agencies themselves

that initiate criminal proceedings for this type of offence. In addition, the copyright holder also is eligible to file a criminal complaint.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There is no expressly written provision in Kazakhstan law containing a legal mechanism of protection against unauthorised threats to commence proceedings for trade mark infringement. However, under Kazakhstan law, the aggrieved party is entitled to seek damages for the actual loss of time in unwarranted claims. Legislation against unfair competition may also be invoked. The concept of unfair competition includes infringement of legitimate interests of a person engaged in similar business activities, as well as of consumers.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Where a trade mark infringement claim is brought, the parties have the right to request an analysis of the trade marks in question as to whether they are confusingly similar.

Furthermore, the party against whom the unfair competition action is brought has the right to seek redress afterward for the infringed rights and damages resulting from the unfair competition action.

11.2 What grounds of defence can be raised in addition to non-infringement?

During litigation, the court will pay attention to which of the persons using the trade mark had the earlier right to use it and whether it was lawfully introduced into the trade turnover in the territory of Kazakhstan.

12 Relief

12.1 What remedies are available for trade mark infringement?

The owner or copyright holder turns to the civil courts in order to restore violated rights and freedoms, usually to recover losses, damages, etc. In practice, this is the most popular and effective way of protecting one's rights, as administrative and criminal courts work only to punish the offender. Full protection can be achieved by going to an administrative or criminal court to establish the culpability of the offender, and then going to the civil courts to recover damages and restore the rights and liberties of the injured party.

12.2 Are costs recoverable from the losing party and if so, how are they determined and what proportion of the costs can usually be recovered?

The court shall reimburse the party in whose favour the judgment is rendered to the other party all court costs incurred in the case. If the claim is partially satisfied, the costs shall be awarded to the plaintiff in proportion to the court's satisfaction of the claim and to the defendant in proportion to the part of the claim that was refused by the plaintiff.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

While the judgment of the court of first instance can be appealed, legislation expressly establishes that the judgment, correct on the merits, cannot be cancelled on formal grounds alone. Violation or incorrect application of substantive or procedural law can constitute grounds for cancellation of the judgment only if this violation has caused or could have caused the misjudgment.

13.2 In what circumstances can new evidence be added at the appeal stage?

The appeal court evaluates and considers evidence that was submitted as part of the first instance proceedings. New evidence shall be admitted if the appeal court finds that the impossibility to submit it earlier was due to valid reasons, if the person was not called to participate in the case in the first instance, or if a request was made in the first instance for its examination and/or retrieval but was not granted. Persons submitting evidence to the appeal court must state the manner in which it was obtained and the circumstances in which it was required.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and if so, how quickly are such measures resolved?

The Law On Trademarks stipulates that goods and their packaging on which a trade mark or confusingly similar designations are placed without the owner's consent are recognised as counterfeit. Counterfeit goods and their packaging, as well as all tools and materials used for their manufacture, shall be withdrawn from circulation and destroyed by a court decision. The owner has the right to demand the removal from counterfeit goods of its trade mark or signs similar to the point of confusion.

When importing goods, customs authorities have the right to suspend the release of goods bearing trade marks that are not included in the Customs Register of Intellectual Property Objects for Kazakhstan or in the Single Customs Register of IP Objects of the Eurasian Economic Union (EAEU). The suspension takes place without the request of the owner or copyright holder when signs of trade mark infringement are detected if information on the owner or representative is available in the territory of Kazakhstan.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Trade marks are protected based on their registration. The exception to this rule is the protection of trade marks in the territory of Kazakhstan without registration by virtue of international treaties.

15.2 To what extent does a company name offer protection from use by a third party?

The name of a company, once registered, is recognised as its trade name, and is also used as a distinctive feature of the goods

and services on the market. The owner of a company name is granted the exclusive right to use the trade name. It is possible to protect one's trade name by opposing and invalidating the registration of a trade mark that is identical or confusingly similar in respect of homogeneous goods or services to the trade name of the company, priority for the use of which came before the priority of the trade mark.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The title of a film or book may also be protected by copyright as a result of creative activity. Under Kazakhstan law, protection of intellectual property objects is granted to the results of intellectual creative activity (copyright, patent law, etc.) and means of ascertainment of participants of civil rights turnover (trade marks, appellations of origin of goods, etc.).

16 Domain Names

16.1 Who can own a domain name?

A domain name can be registered in the name of an individual or a legal entity (registrant).

16.2 How is a domain name registered?

In order to register a domain name, a registrant's application shall be sent to the registrar, which shall contain the name, period, and purpose of domain name registration, as well as information on four contacts, i.e., registrant, administrative, technical and financial contact with personal data of these contacts attached. The application shall be reviewed within three business days of acceptance.

16.3 What protection does a domain name afford *per se*?

Domain name registration serves purely technical purposes; the domain name is not an object of intellectual property and does not provide for special legal protection, such as a ban on the use of similar names or signs on the market. A registered domain name only gives rights to its use on the internet.

Kazakhstan's judicial practice contains disputes where a domain name owner and a trade mark owner are parties, and the subject matter is an infringement of exclusive rights to a trade mark in the form of the use of a similar or identical domain name. The court in a dispute focuses on the priority of the trade mark, the date of registration of the domain name, and the coincidence of the goods and services of the trade mark owner and the domain name, and examines whether third parties have been misled about the production of goods or services. Such disputes still lack uniform practice due to the unclarified status of the domain name in the Republic of Kazakhstan.

16.4 What types of country code top-level domain names (ccTLDs) are available in your jurisdiction?

The top-level domain name in Kazakhstan ends in .KZ and/or .KAZ, allocated by international organisation ICANN for use in the interests of the Republic of Kazakhstan.

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Disputes relating to top-level domain names and violations of the procedure for registration of domain names shall be considered in accordance with the general procedure by the civil courts of the Republic of Kazakhstan. There are no special procedures or special ways of resolving such disputes.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

In 2022, the law was amended to allow the registration of a trade mark covered by the exclusive grounds for refusal due to lack of distinctiveness if it has nevertheless acquired distinctiveness due to long-term use. The law has thus been brought in line with the provisions of the Paris Convention.

Furthermore, the period of preliminary examination of an application was increased from 10 working days to one month, but the period for amending an existing trade mark in the Register of Trademarks was reduced; the procedure now takes 15 working days instead of three months.

Another notable change is the addition of evidence of the owner's use of his trade mark: from 2022, the conclusion of a trade mark assignment agreement or its use in a domain name will also be considered the use of the trade mark along with its use on letterheads, signs, etc.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Decision No. 7527-21-00-2/8855 of the Specialized Interdistrict Economic Court of Almaty dated December 20, 2021 analyses the infringement of rights by the owner of a domain name of a similar trade mark owner. The plaintiff, a Russian company, has had exclusive rights to use the Conte trade mark in Kazakhstan since 2007. The plaintiff went to court upon discovery of the domain name "www.conte.kz", which had been registered to a Kazakhstan company since 2010. The court did not consider sufficient the defendant's arguments that the company did not produce goods or services within the claimant's registered classes of the Nice Classification, although the protection of exclusive rights usually always focuses on homogeneous goods and services. Instead, the court examined the documents and held that the defendant's knowledge of the plaintiff's activities and products was sufficient to establish wilful infringement of the exclusive rights of the trade mark owner. The court held that the parties had a prior agreement to sell products from the plaintiff to the defendant as a reason why the defendant could use the domain name to mislead customers.

Decision No. 7194-21-00-4/43 of the Specialized Interdistrict Administrative Court of Astana dated September 24, 2021 contains a remarkable assessment of consumer misrepresentation as a ground for invalidation of trade mark registration. The parties were two Russian door manufacturing companies. The plaintiff company had manufactured and supplied doors to

several countries since 2001, including Kazakhstan as of 2019. The defendant company, which had similar but not as extensive operations, registered an identical trade mark in Kazakhstan, and the plaintiff was subsequently refused international registration in Kazakhstan. The plaintiff went to court, arguing that the defendant was aware of the well-known door manufacturer and had deliberately registered the name in its name in order to mislead consumers. The court upheld the plaintiff's position, despite the opposing pro-defendant position of the Appeals Board and the expert organisation. The court stated that the absence of a similar trade mark in Kazakhstan is not the only key aspect of trade mark examination. The expert organisation should have carried out a broader analysis and considered that the defendant must have been familiar with the plaintiff's business, with similar activities, and even with the same partners and counterparties.

Also noteworthy is Judgment No. 2a-9465/2022 of the Judicial Board of Civil Cases of the Almaty City Court (appeal instance) dated November 8, 2022. The appellate judicial panel considered an appeal by the plaintiff, who disagreed with the first instance decision in favour of the defendant in a case for invalidation of trade mark registration. The plaintiff argued that the defendant had infringed its exclusive rights as the owner of the image by registering a trade mark identical to the aforementioned image with the intent of misleading purchasers. The dispute arose from a situation where the image was used as a copyrighted object, i.e., without any registration or finding in the State registry. At the same time, a similar trade mark was later registered that was almost identical to the designation but had a stronger basis for protection: a registration and a certificate on its side. The court did not establish sufficient legal grounds for full recognition of the plaintiff's authority as the copyright holder over the custom-made logo, so the first and appellate instances upheld the position of the defendant, the owner of the trade mark.

17.3 Are there any significant developments expected in the next year?

Currently, there are no draft amendments to trade mark law expected for 2023 or 2024.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The main enforcement trend for 2022 is the focus on international trade mark protection, including within the EAEU as a single customs territory. This is due to a dramatic market change in terms of imports/exports in certain countries, and the importation of many products under Kazakhstan brands or through Kazakhstan distributors into neighbouring countries.

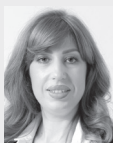
Regarding practice, it is also worth noting cases relating to trade mark misappropriation suits by first-priority registration, including taking into account different jurisdictions. Unfair competitors misappropriate trade marks by filing a registration application if the true owner, for whatever reason, has not yet reached this stage. Judicial practice in this matter is not uniform but tends to pay attention not only to registration data, priority of the application, or uniqueness according to registers, but also to the business relationship of the parties, the market, and general recognisability and uniqueness of the designation in Kazakhstan.



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