

## ARTICLE

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### Going to invest in Kazakhstan? 10 important rules to protect your IP



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1. Availability of prior rights. Check whether your trademarks have been duly registered in Kazakhstan and whether the same or confusingly similar trademarks have not been registered in the names of third parties. If the latter registrations have been done, your products or services will be under the threat of attacks of the trademarks holders.
2. Registration. In order to protect your trademarks and patents you have to register them with NIIS. Not registered trademarks and patents are not protected.
3. IP Audit. If you hold a big portfolio of trademarks and patents we recommend to make its audit and compare whether what you believe is registered is indeed registered in Kazakhstan and verify and if necessary correct record in the Registry of the National Institute for Intellectual Property of Ministry of Justice of Kazakhstan (“NIIS”). It is necessary for future records of license or franchise agreements, for filing claims with courts and in many other cases.
4. Kazakhstan is “First to File” and not “First to Use” country. Register your trademarks as soon as you decide to come in the market and do not start your business without the proper registrations, otherwise it is possible that somebody else will register your trademarks here.
5. Territory. Even if your trademarks are famous in your country but not registered in Kazakhstan or not officially recognized as well-known, they are not protected. There is no general registration of trademarks in the Eurasian Union of five states (Armenia, Belarus,

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- Kazakhstan, Kyrgyzstan and Russia). Russian trademarks and patents are not valid in Kazakhstan.
6. Licensing of trademarks and patents. Conclude trademark and patent license agreements with your Kazakhstani partners. It is not always feasible, but from the point of view of IP rights protection makes sense. Also it allows easier resolving questions with the tax authorities if they decide that your partners gain a profit by free use of your trademarks or patents (unjust enrichment). Lack of a trademark license agreement can be an issue with antimonopoly authorities if they consider same prices at all your partners as an anticompetitive behavior.
  7. Franchising. If you issued or obtained a Master Franchise (providing also for the rights to trademarks or patents) for the territory of several countries including Kazakhstan, before giving a sub-Franchise to a Kazakhstan company you must register the Master Franchise Agreement in Kazakhstan. If it has not been done, the agreements are deemed to be not concluded. The consequent sub-Franchise Agreement shall also be registered. The same rules apply in the other Republics of the Central Asia of CIS and CIS generally. Certainly, the trademarks and patents listed in the franchise agreements must be protected in the countries of question.
  8. Enforcement of rights. Before establishing your business here take a look at possibly available infringements of your rights and try to “clean” the market. We did it many times for our clients and before their cafes or shops opened we had assisted in finding and elimination from the market confusingly similar or identical names of the shops and cafes of third parties who infringed the corresponding trademark rights.
  9. Evaluation. If you wish to invest your IP in the charter capital of your own company or joint venture in Kazakhstan, you and your Kazakhstani partner can evaluate the such input yourselves if its value does not exceed US \$136,000 (estimation for beginning of 2020). If the value is bigger, you need to appoint an independent evaluator.
  10. Patent Attorney. Any foreign company or individual who wishes to register trademarks or patents in Kazakhstan can do so only through a registered trademark & patent attorney. Choose the right one, that’s us! :) ! We will be happy to assist you with all IP and not only IP cases in “Any-Stan” in our region.

[Refer to these Rules and receive 10% discount on all our services!](#)