

LEGAL ALERT

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New methodology of forensic examination of intellectual property objects



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In recent years, the importance of opinions of specialists and licensed experts in the field of intellectual property has significantly increased, especially expert opinions related to determining the identity and similarity of trademarks (hereinafter also TM) and unregistered designations. Such opinions are in demand, first of all, during court proceedings related to disputes on infringement of the rights of trademark owners and during the resolution of disputes regarding refusals to register trademarks.

There are two approaches that are mainly used to compare designations: (i) the *standard* approach based on the instructions for examination of applications for registration of TM conducted by the National Institute of Intellectual Property of the Ministry of Justice of the Republic of Kazakhstan (NIIP) and (ii) the method based on product examination of the Forensic Expertise Centre of the Ministry of Justice of the Republic of Kazakhstan.

In both the first and second cases, the methods are not without certain limitations in their application or are controversial. In the course of court proceedings, the opinion was repeatedly expressed that the NIIP methodology is an internal document intended only for analyzing designations submitted for registration and cannot be extended to any other approaches to comparing, for example, already registered TM with designations

in use allegedly infringing those trademarks. In the second case, the comparison of goods as a whole, and not just the trademarks applied to them, has been repeatedly criticized, although the latter is the actual subject of the dispute.

As stated on 4 May 2024 on the website Zakon.kz, the Ministry of Justice of the Republic of Kazakhstan has prepared an addition to the List of types of forensic examinations conducted by forensic examination bodies and expert specialties (<https://www.zakon.kz/pravo/6433184-novyiy-vid-sudebnoy-ekspertizy-budut-provodit-v-kazakhstane.html>).

Now this list will be added by forensic examination of intellectual property objects and forensic examination of means of individualization for similarity of these means.

It is assumed that the forensic examination will be done under new methodology which will eliminate the existing drawbacks of product examination, however, unfortunately, the draft of this new methodology is not yet in the public access, we hope that one day it will be published. If you are interested in this methodology, please let us know and we will share it to you as it becomes public.