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Oppositions at the Stage of Examination of the Trademark Application



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In 2018 Article 11.1 was introduced into the Trademarks Law which provided publication of information on a trademark application after completion of formal examination.

Usually in many countries information on the application is published so an interested party can file an opposition to the trademark registration at the application stage. Unfortunately, these amendments have not detailed such a procedure so this possibility was not regulated by the legislation.

In this connection after publication of information on trademark applications, many trademark owners forwarded to the National Institute of Intellectual Property (further “Kazpatent”) warning-letters informing that they had prior rights to the claimed designation or confusingly similar designation. Such warning-letters were taken into account by Kazpatent however the applicant for the questioned trademark was unable to present his arguments and comments to such warning letters.

Finally, in August 2022, the Trademarks Law was amended so any interested party now can file an opposition to the claimed designation within one month of the date of publication of information related to the application. The established period for filing of an opposition is short, but still there is a possibility to formally file an opposition to a trademark registration at the stage of its examination.

The opposition should contain the evidence of arguments provided in the opposition, a power of attorney if the opposition

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filed through a patent attorney, and a profof payment of a fee for examination of the opposition.

Within five working days of receipt of the opposition, Kazpatent shall forward a notification to the trademark applicant with a copy of the opposition and a notice of acceptance of the opposition for examination. The trademark applicant has the right to file response to the opposition within three months of the date of issue of the notice.

Unfortunately, the applicant who filed the opposition is not notified of the results of examination of a trademark application. So he can only find out whether the trademark has been registered or not only once the information on the trademark is available in the database of registered and published trademarks on the official website of Kazpatent, and it is not always convenient.

Currently after 18 months since the date of the last amendment to the Trademarks Law, it is safe to say that the number of oppositions at the application stage is continuously increasing. And it is good, because preventing a trademark registration at the application stage reduces the load of the Board of Appeals of the Ministry of Justice and courts. Also, there is a possibility of pleadings, as now the applicant has the right to argue and challenge the opposition.

Our practice shows that approximately 70% of oppositions are satisfied. If a trademark is nevertheless registered, any interested party has the right to challenge the registration (as well as regular refusals to register a trademark) with the Board of Appeals of the Ministry of Justice of the Republic of Kazakhstan. We will describe this procedure in the next article.

We recommend to take an advantage of the possibility of filing an opposition at the application stage to protect your intellectual property and business. Certainly, in order to be able to do so timely, it is important to monitor the publications of trademark applications and not to miss the established deadlines which cannot be extended. Often, the chances of preventing a trademark registration at the application stage are higher than filing an opposition when the trademark has already been registered. Please feel free to contact us for assistance with the monitoring and filing of such oppositions.