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Contact us:

■ **Bolotov & Partners LLP**
Almaty Residence BC, 6 floor
60 Auezov St., Almaty 050008
Republic of Kazakhstan
+7 (727) 357 23 80
info@BolotovIP.com
www.BolotovIP.com

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Overview of trademark protection in the countries of Central Asia



Zhanat
Nurmagambetov

Partner

This article briefly analyses the legislation of countries in Central Asia such as Kazakhstan, Kyrgyzstan, Uzbekistan, Tajikistan and Turkmenistan in relation to the possibility to enforce trademark rights.

Despite the fact that the legislation of all above five countries is more or less similar in terms of trademark protection, there are certain differences both in theory and in law enforcement practice.

In general, violations of trademark rights, except for the rarer violations, are the same: import or production and sale of fake goods (bearing the third party's trademarks or confusingly similar designations), parallel import, illegal use of trademarks in advertising, including on the Internet, in signboards, in printed materials, and also through cybersquatting (registration of domain names identical or similar to the third party's trademarks).

The remedies for such violations are also similar in all of the above-mentioned countries - pre-trial, civil, administrative and criminal. Customs protection could be singled out separately, but apart from Kazakhstan, in the other four countries the customs authorities do not initiate cases of administrative offences in the result of suspension of release of goods with trademarks, so customs protection is essentially just a measure to secure a relevant court decision.

Pre-trial protection in these countries differs little and includes correspondence with the infringer through cease and desist letters, as well as direct negotiations with the infringer to stop the illegal use of trademarks. In addition, trademark owners can educate whole groups of potential infringers, for example, through market vendors or through

media coverage, about the possible consequences of illegal use of trademarks. In addition trademark owners can educate administrative and law enforcement officials on how to distinguish genuine and fake goods. Finally, pre-trial remedies can include domain name blocking, provided by registrars in all countries.

All five countries also provide **for civil liability**. The civil liability issues are regulated directly by the Civil Codes (the CC) of all the countries, and the Trademark Laws (the Law). The names of the laws may differ from country to country, but the essence remains the same - regulation of registration, licensing, termination of registration, as well as enforcement of rights to trademarks. For example, in Kazakhstan, liability is provided jointly under Article 1032 of the CC, as well as Articles 4, 43 and 43-1 of the Law; in Kyrgyzstan, liability is provided jointly under Article 1113 of the CC and Article 3 of the Law; in Uzbekistan under Articles 1107 and 1107-1 of the CC and Article 26 of the Law; in Tajikistan under Articles 1137, 1137(1) of the CC and Articles 6 and 35 of the Law; in Turkmenistan under Articles 1066, 1067, 1068 of the CC and Articles 35 and 37 of the Law. Although there are slight differences in what trademark owners can claim in their lawsuits, such as compensation for the use of trademarks as an alternative to damages, what is common is the obligation of the infringer to stop the violation and compensate the trademark owner for the damages incurred.

The issues of civil enforcement in all of these countries are the same, namely the long process of accepting the statements of claim and securing evidence. The issue of long time limits is particularly acute when customs authorities suspend the release of goods bearing the third party's rights to a trademark and the short time limit of just 10 days must be met. In some countries, such as Uzbekistan, the court accepts the statement of claim and institutes civil proceedings within 10 days, and thus the suspension period may expire before the court accepts the statement of claim. In terms of securing evidence, courts are entitled to take such measures, however from a purely practical point of view, applying such measures, such as seizure of fake goods in the possession of a market seller rarely ends in success.

Administrative liability is not provided in all countries. Thus, there is no administrative liability in Kyrgyzstan only for trademark infringement, although it is provided for such an act as unfair competition, including illegal use of means of individualization. In other countries there is administrative liability for unlawful use of the third party rights to trademark or similar designations. In Kazakhstan, for example, the justice and state revenue authorities are responsible for initiating administrative offence cases in this category of cases, while in the case of unfair competition the competition protection and development authorities are responsible. In Uzbekistan, administrative liability is imposed on infringers of trademark rights on the basis of administrative reports drawn up by the Department for Struggle against Economic Crimes under the General

Prosecutor's Office of Uzbekistan, as well as by the Agency for Intellectual Property and the anti-monopoly authorities. In Tajikistan, the legislation provides for the authority to draw up administrative reports by internal affairs bodies, as well as by anti-monopoly authorities. In Turkmenistan, the legislator entrusts similar functions only to the prosecuting authorities.

In all countries where administrative liability for trademark violation exists, the sanction of the relevant articles provides for fines as well as confiscation and further destruction of goods that are the subjects of violation that means containing an illegal image of a trademark and imported into the country without the consent of the trademark owner.

In relation to **criminal liability** for the illegal use of a trademark, it is not provided only in the Criminal Code of the Republic of Uzbekistan. In other countries - Kazakhstan, Kyrgyzstan, Tajikistan and Turkmenistan - criminal liability for the illegal use of trademarks is provided. The law enforcement agencies that conduct preliminary investigations in this category of cases have been also identified. Thus, in Kazakhstan these offences are investigated by economic investigation bodies, in Kyrgyzstan - by the Financial Police (abolished at the time of writing of the present article), in Tajikistan and Turkmenistan - by internal affairs bodies.

Finally, **customs protection** is available in all five countries. However, it has its own features and in some countries administrative barriers hinder effective customs protection. For example, only in Kazakhstan customs authorities (or more precisely, state revenue authorities) are empowered by law to initiate administrative offence proceedings for illegal use of the third party's trademark (initially expressed in the import of goods bearing the third party's trademark). Administrative barriers include such examples as the lengthy (at least 3 months) consideration of any appeals by the right owners in Kyrgyzstan. In Tajikistan, in order to be included in the customs register of intellectual property, the right owner has to pay a deposit of approximately US \$ 32,000 per trademark to the state budget, which makes customs protection inaccessible for many right owners. In Turkmenistan, despite the existence of a customs register in the country's regulations, no such register is actually maintained and no entry of trademarks or other intellectual property objects is made in practice. As for Uzbekistan, Article 388 of the Customs Code of Uzbekistan provides for the need to submit an additional application to the customs authorities, in which the right owner required to request the adoption of customs protection measures; in other words, the mere inclusion of a trademark into the customs register shall not result in the suspension of the release of goods by the customs authorities. At the same time, the biggest barrier is that the same Article 388 provides for the content of such a statement, which should provide information on the producer, exporter, importer or consignee, possible place and date of movement of goods across the customs border, specifics of transportation and type of packaging, location

of goods or planned destination of goods with violated trademark rights. It is not easy, if at all possible, for the right owner to obtain such an information, and failure to provide this information results in the refusal to take customs protection measures and the suspension of the release of goods.

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