

## ARTICLE

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## **Patents for inventions and utility models. Part 1.**



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Patents in Kazakhstan are granted for inventions, utility models, industrial designs and selection achievements. Each of these objects is of interest; each with its own features belongs to its own field of protection and protection of scientific, engineering and selection developments and design solutions.

In Kazakhstan both national and regional patents issued by the Eurasian Patent Office (Moscow, Russian Federation) are valid. Patents for inventions and industrial designs can now be obtained under Eurasian protection but other objects are not so far protected. Both national patents and Eurasian patents, without going into too much detail, give the same degree of protection to patented objects.

Inventions and utility models are requested most often; however applicants often do not know the difference between these objects and which object to choose for patenting.

**An invention** is a technical solution that is new and industrially applicable and which involves an inventive step and can be granted legal protection.

- An invention is new if it is not known from the prior art. That means no patent has been granted in any country in the world and it has not been published anywhere - neither in the media, nor in scientific or other magazines or on websites.

- An invention has an inventive step if it is not obvious to a person skilled in the art. In other words, there is creativity in the development and not merely logic and obvious but not yet realized solutions.

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- An invention is industrially applicable if it can be used in industry, agriculture, health care or other sectors.

**A utility model** is a technical solution that is merely new and industrially applicable and also can be granted legal protection. The *inventive step* criterion does not apply to utility models.

In general, it is easier and cheaper to patent a utility model in Kazakhstan than an invention, as the examination of applications for utility models is not as strict as for inventions. For utility models it takes about six months or more from filing an application until issuance of a patent for utility model while for an invention, the term is about a year and a half.

However the term of protection for a utility model is also shorter: only eight (8) years (five (5) years with the possibility to extend the registration for another three (3) years), while a patent for an invention is granted for twenty (20) years from the date of application and can in some cases be extended for up to five (5) more years.

In each case, we discuss with applicants the purpose of a patent and choose the subject matter and determine the most effective way of protecting it.

Which is better to apply for registration, an invention or a utility model? For inquiring minds who want a more detailed, though incomplete explanation, here is a table below, in order to use it you need to understand the purpose of patenting.

This is for:

- Protection of your rights. A patent gives its owner a monopoly on the use of a development, a right to prohibit others from doing the same thing without permission. This is probably the most complex type of patent and requires detailed analysis, careful drafting of the claims and description. Usually the preparation of applications for such patents is both lengthy and expensive. For me, US patents are the master standard in this case. They can easily be hundreds of pages long and have dozens of claims. To be honest, I do not know how to prepare such patents, and to file a full-fledged application in the US, you have to engage US patent specialists and pay them a fortune.

- Government grants. Often applicants/entrepreneurs do not care about good protection, however need to comply with the requirements of the grantor, who usually do not check the quality of a patent, but follow the policy of issuing grants to “match the set of documents submitted”. This patent is usually much simpler.

- Marketing purposes. “Our products are manufactured using patented technology! (Patent RK No. \*\*\*\*\* since \*\*\*\*\*.)” Sounds nice and can really speak about the unique features of a product.

-A thesis defence. The essence and comprehensiveness of the defence is not so important, but it is important that the list of publications includes patents. Without detracting from the importance of such publications, I would like to point out that such patents are by no means always upheld after the thesis defence. Although, the publication also achieves the goal of scientific and technological progress - other developers, engineers and researchers get the information they need to move forward.

- Yourself and for future generations. It is nice and educative just to have a patent. Let everyone know!

Who knows about other purposes, please let us know! Thank you in advance.

When you have decided at least for yourself what the purpose of patenting is, you need to determine exactly what scope of protection you want to be granted and that scope provided by a patent should be determined by its most important part that are the claims or the invention or utility model.

It must be highlighted that not everything can be patented. Non-protectable subject matter or what cannot be patented, is

- discoveries, scientific theories and mathematical methods;
- methods of organization and management of the economy;
- annotation symbols, schedules and rules;
- rules and methods of performing mental operations, conducting games;

- computer programs and algorithms as such;
- designs and layouts of structures, buildings and territories;
- proposals relating only to the appearance of products;
- proposals contrary to public order and the principles of humanity and morality.

If you have one of these listed above, you will have to think about how to convert it into patentable subject matter or, as a last resort, try to register only the copyright.

So now in the table below we will review patents for inventions and utility models, compare their properties and mention the mutual conversion.

No.	Feature	Invention	Utility model
1.	What is it?	A technical solution that is new and industrially applicable and which involves an inventive step.	A technical solution that is new and industrially applicable.
2.	What is a technical solution?	New if not known from the prior art.  Inventive step if not obvious to a person skilled in the art.  Industrial applicability if it can be used in industry, agriculture, health care or other branches of industry.	New if a combination of its essential features is not known from the prior art.  Commercially applicable if it can be practically used.

3.	Protectable and then protected objects	<p>Products (a device, substance, micro-organism strain, plant or animal cell culture);</p> <p>Methods (processes of performing actions on a material object using material means);</p> <p>The use of a known product or process for a new purpose or a new product for a particular purpose.</p>	The objects of a utility model are the same as those of an invention, except for diagnostic, therapeutic and surgical ways of treating humans or animals.
4.	Term of protection – term of validity of a patent	<p>A patent for an invention is valid for 20 years from the date of application, subject to payment of annual maintenance fee.</p> <p>In the case of an invention relating to a medicinal product, pesticide for which an authorization is required, the patent may be extended, however not for more than 5 years.</p>	A utility model patent is valid for 5 years from the date of application. It may be extended on application by the patent owner, however not for more than 3 years.
5.	Patenting procedure	A patent is granted following a formal examination and a substantive examination. Substantive examination includes a patent information	A patent is granted on the basis of the results of the examination without checking whether the patentability conditions of industrial applicability and world

		search and examination for compliance with the conditions for patentability. First a formal examination is carried out, then a substantive examination and, if everything is in order, then an opinion on the granting of a patent is issued. Once the fee has been paid, the patent is granted. The examination period for a patent application is approximately 1.5 years or more.	novelty are met. After payment of official fee, the patent is granted. Currently, the examination period for a utility model application is about a year or more.
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Now after referring the table you can decide on what to choose. A utility model is not always suitable for grants, it has a shorter period of protection, but a patent can be obtained much faster and is difficult to challenge. For unfair applicants there is a possibility to patent the solution already known in other countries, and this patent can be challenged, but you will lose a lot of time to go through all the courts (and in this time, a patent for an already known product or method will give an opportunity to prohibit the use of this solution), nerves and money. Cases of such disputes in Kazakhstan, although not frequent but are regular and in our opinion their number is growing.

If you have selected one of these objects, both before and during the examination stage and before the National Institute of Intellectual Property issues an opinion on registration (or a final refusal of registration), you may convert the invention application into a utility model application and vice versa. This is done for various reasons. In our practice, unfortunately, there has not been a case where a utility model application has been converted into an invention application. However, *conversions invention into utility model* did take place and as a rule, in cases when the invention application did not meet all the necessary criteria or there were risks that there would be difficulties in registration or long correspondence with the experts. In many cases we did such conversion even before the application was filed.

A patent is valid for a limited period of time and must be maintained annually for the duration of the patent. In other words, an official fee must be paid each year at a certain time. If the maintenance fee for a Kazakhstan patent is not paid on time, the patent expires. It is not possible to pay in advance for all years of a patent validity.

If, for some reason, the patent is not renewed in time, the patent is legally deemed to have expired. However, if less than three years have elapsed since the last payment of the annual maintenance fee, the patent may still be restored; if it is not restored the patent expires irrevocably.

Some questions related to use of a patent will be discussed in the second part of this article.