

ARTICLE

Please contact us:



Bolotov & Partners LLP

Almaty, Kazakhstan, 050008

60 Auezov Street, 6th floor, Almaty Residence business center

+7 (727) 357 23 80

info@BolotovIP.com

www.BolotovIP.com

May 2023

Renewal of a trademark registration



Managing partner,
Patent attorney,
Member of the
Chamber of legal
advisers

It is known that trademarks registration is valid in Kazakhstan for a period of 10 years from the date of application for registration. For the same period of time, trademarks are recognized as well-known; however the validity period starts from the date when a trademark is recognized as a well-known trademark.

After the expiry of the 10-year period, both a trademark and a well-known trademark can be extended for a further 10 years. Some trademarks, especially trademarks of large international companies are renewed many times, having been in the marketplace for decades. This can happen to your companies and the trademarks of your companies already, perhaps for the benefit of your heirs and successors.

During 10-year period some trademarks become out of date, they start to be used in a modified form, new designations are introduced, and some trademarks stop being used or lose their meaning and are simply abandoned. In some cases, trademarks are lost along with the liquidation of a company, although some of them could probably be sold to the interested parties.

In the latter case, nothing needs to be done, the designations will lose their trademarks or well-known trademark status, but they may need to be maintained, renewed to prevent the third parties from registering them in their names or simply using them may mislead the consumers about the producer of goods and services.

However, what happens if the validity of a trademark is not extended? In short, the following:

- the right to prohibit the third parties from using these trademarks and very similar trademarks is lost;
- the third parties will be able to register these trademarks in their own names and prohibit a trademark owner from using them;
- If the goods of other producers are on the market even with old trademarks of a trademark owner, consumers will still connect them to be “old” trademark owners and if the products with these trademarks are not of good quality, trademark owner’s new products will not be treated so well either.

It is necessary to renew active and used trademarks. Such renewals shall support company’s position at the market, prevent these trademarks from being registered in the name of the third parties and shall assist in fighting against trademark rights infringements.

New trademarks need to be registered, modified trademarks should be reviewed, analyzed and decided whether or not to apply for their registration separately.

As shown earlier, in some cases, especially after rebranding, it is required to extend the validity of registrations and these trademarks that are no longer used.

In any case, trademark portfolio should be reviewed from time to time; any issues that arise are subject to discussion with the experts.

Generally renewal procedure may be initiated in the last year of registration validity and with the payment of a fee increased by 50% within a year of the end of the term of protection of the trademarks.

The renewal procedure is fairly straightforward, all stages including payment of the official fee can be done online, if specialist assistance is required, a power of attorney from the applicant will be required, which can also be submitted online when renewing, and the renewal itself usually takes 10 working days.

As part of our corporate service and taking care of our client-oriented cooperation we remind our clients of the need to renew registrations. Sometimes, companies which registered trademarks themselves or through other firms also ask us to keep track of renewal deadlines (and some other deadlines too).

In any case, it is recommended to review and analyze your portfolio of registered trademarks from time to time, including to understand what to do for improving the promotion of your products, protecting your rights and for further developing of your company.