

## ARTICLE

Please contact us:

**Bolotov & Partners LLP**

Almaty, Kazakhstan, 050008

60 Auezov Street, 4<sup>th</sup> floor, Almaty Residence business center

+7 (727) 357 23 80

info@BolotovIP.com

www.BolotovIP.com

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### Trademark: Disclaimer



Saule  
Kulzhambekova  
Partner,  
Patent attorney

Presently many Kazakh entrepreneurs file trademark registration applications themselves, without involving specialists in this field. In fact, filing for trademark registration is a straightforward procedure however difficulties arise at a later stage, after a trademark has been registered.

Upon receiving a decision on the registration of a trademark, the decision may contain a clause called “Disclaimer” and a non-specialist, unfortunately, will not understand what this word means in the context of a trademark. The applicant is informed that the a trademark is protected as a whole, however the words indicated in the Disclaimer do not receive independent legal protection. The applicant, upon hearing that a trademark has been granted protection, often agrees with the decision and receives a certificate of registration with a disclaimer of certain elements of a trademark, thus not obtaining the full expected protection.

Later, when entering the market, the trademark owner tries to protect it and prohibit third parties from using a trademark without the owner’s consent, and here an

unpleasant surprise arises. In response to a claim, infringers inform the trademark owner that the owner does not have exclusive rights to a particular element of a trademark that they are using, and therefore the trademark owner cannot prohibit their use of it.

A trademark can consist of (1) protectable elements with high distinctive capacity, (2) elements with weak distinctive capacity, and (3) elements that describe the goods and do not have distinctive capacity. The last two points may fall under the “Disclaimer” clause. A disclaimer is the exclusion from protection of any word or element of a trademark, and all elements falling under the Disclaimer are in free use, that means anyone can use them.

Often, indications of colors (red, blue, green and etc.) and words like royal, (королевский), “царский” (tsarist) fall under Disclaimer, but these words are not always unprotectable. For example:

- 1) 2007 – a trademark “Королевский шарм” (Royal Charm) was registered under registration number 23399 for goods in Inter.Class 30 with a disclaimer of “Королевский” (Royal), meaning that, in essence, protection was granted only to the word “charm”.
- 2) 2008 – a trademark “Королевский десерт” (Royal Dessert) was registered under registration number 27219 for goods in Inter.Class 30 with full protection of a trademark without a disclaimer of the word “Королевский” (Royal).

These examples show that in the first case, the owner did not pay due attention to the Disclaimer clause and essentially received weak legal protection. In contrast, in the second case, the owner defended their rights and obtained full protection of a trademark without any disclaimers and the right to prohibit the use of a trademark and designations similar to it to the point of confusion, including those similar to the element “Королевский” (Royal).

Recently, we have seen an increase in requests from

trademark owners due to infringers using an element of their registered trademark, and it turns out that this very element is under Disclaimer. Consequently, the trademark owner cannot prohibit third parties from using it. Sometimes, trademarks are registered in which almost all elements of a trademark fall under Disclaimer, however a trademark is protected as a whole. In these cases, it is enough for an infringer to change one element to differ from the registered trademark and freely use it. It is very difficult to challenge such violations, since when proving the similarity of trademarks, courts and law enforcement agencies take into account that a trademark, in principle, has no exclusive protection for any element of a trademark or for a specific disputed element of a trademark. As a result, the trademark owner suffers losses, and the reputation of a trademark is sometimes damaged.

**In connection with the foregoing**, we recommend that upon receiving a decision on the registration of your trademark containing a *Disclaimer* clause, do not rush to agree with the decision, but consult with specialists in the field of trademark protection and enforcement. It is possible that a specialist will help you obtain full protection for your trademark without a Disclaimer.