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Unprotected elements of a trademark



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Pursuant to the definition given to a trademark any designation that can serve for distinguishing goods and services of one company from homogeneous goods and services of other companies can be registered as a trademark.

That means that if a designation is original and pursuant to criteria of protectability does not contradict to the provisions of the legislation in that case such designation can function for identifying goods and producers of homogenous goods.

The designations shall not be subject to registration as trademarks if they indicate to type, features, quality, quantity, place of production or in other words the designations which are descriptive concerning goods that they relate to. Such designations shall be considered as unregistrable and can be used in a trademark if they do not play dominating role in it. As descriptive designations mainly represented on the labels applied for registration as combined trademarks, below we are going to discuss level of admissibility of unprotected elements on the labels.

Generally a label contains a name of a product or in other words indicates to type (kind) of a product: butter, milk, alcoholic beverages, tobacco products and etc. Type of a product and its features are indicated in accordance with requirements of state standards related to labels.

However pursuant to the provisions of the Law of the Republic of Kazakhstan "On Trademarks, Service Marks and Appellations of Origin of

Goods?" (hereinafter "the Law") information related to product is considered as not bearing distinctive ability and is not considered when registering a trademark.

Under the requirements of the Law information related to a product should not be represented on foreground of a label that means should not occupy dominating position.

Accordingly if a type of a product such as "VODKA", "BREAD" and "CIGARETTES" shall be indicated on the label in a large print, such designation shall be refused for registration pursuant to Article 6.1 of the Law.

The name of a product on the label should be accompanied by original fantasy name that shall serve for distinguishing this product from homogenous products of other producers. In particular, this original name of a product in fact is registered as a trademark. Examples of indication type names and fantasy names of products: dairy butter "Solnyshko", vegetable oil "3 zhelaniya", mayonnaise "Aroma", vodka "Poltina", cigarettes "Sovereign" and etc.

In the process of development of economy and extensive use of the same trademarks by different producers in relation to homogenous products we can observe their transformation into generic names. That means that trademarks are used for distinguishing certain type of a product. It is explained by the fact that the consumer perceives this trademark as indication to a type of product without association it with the name of a specific producer. Such examples of transformation into generic names are "xerox", "au de Cologne".

Recently we observe such tendency when widely known trademarks are used without indication of their producers. Names of alcoholic beverages such as "vermouth", "Cahors wine" and "Cadarka" also transferred to the category of type of products. The above names of beverages are given in the encyclopedic dictionaries and reference books as names of certain kinds of wine. Consequently, pursuant to the provisions of the Law these designations can be represented in the trademarks as unprotected elements provided that they do not play dominating role in such trademarks.

When considering designations applied in relation to medical (pharmaceutical) preparations the examination is conducted not only in relation to their compliance with provisions of Articles 5 and 6 of the Law but also as to the presence of elements that are in the international register

of unpatentable medical preparations. In case when applied designation reflects the name of medical preparation that is in the register as for certain medicament purposes such designation shall be refused for registration as a trademark. When examining designations that contain unprotected elements while assessing domination factor not only visual but also perceptual features are taken into account. The simplest way for taking a decision is the fact of registration with disclaimer. In such case unprotected elements are represented in the registration by way of enumeration of digital, letter and word elements.

If a trademark is a word designation that due to semantics can be considered as unprotected but is drafted in original print manner such designations can be registered with disclaimer of a word designation. At this a trademark shall be considered as figurative and its semantic meaning shall not have distinguishing capability.

As an example of a trademark that consists exclusively from unprotected elements we can cite trademark "AQUA PARK", that is drafted in memorable figurative manner and was registered in relation to services connected with entertainment. The trademark was registered in general with disclaimer of a word designation "AQUA PARK" that was considered as unprotected element.

Unprotected elements are connected grammatically and have descriptive feature in relation to services particularly in such combination of words and consequently these words are disclaimed in such combination and not separately.

[Gulzhikhan Nauruzova - Magazine "Intellectual Property of Kazakhstan", 2005](#)