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Utility model in the Republic of Kazakhstan is an interesting intellectual property object (Comparison with utility models in the Russian Federation)¹



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As in Russia, along with inventions and industrial designs, utility models in Kazakhstan (hereinafter - UM) are one of the intellectual property objects for which a patent can be granted. UM are closer to inventions, a patent protects the substance, not the form as in the case of industrial designs. Unlike inventions, the procedure for patenting a utility model is simpler, faster and cheaper (there is no examination for inventive step), however the validity term of UM patent is shorter.

Not all countries provide a protection document for a utility model. However, in Kazakhstan and in Russia a utility model can be patented in Kazpatent (National Institute of Intellectual Property) and Rospatent (FIPS), respectively. There are both similarities and differences in such patenting in the legislations of these countries.

As in the case of other intellectual property objects, the authors of a utility model are individuals whose intellectual labor created the utility model, and both individuals and legal entities can be the applicants and subsequent patent owners.

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In both countries, a utility model application may be transformed into an invention application (and vice versa) prior to the issuance of expert opinion related to the application.

In the Republic of Kazakhstan (hereinafter also referred as RK), the concept of utility model is almost identical to the concept of invention. In accordance with the Patent Law of the Republic of Kazakhstan, a utility model includes technical solutions in any field relating to:

- a product (device, substance, microorganism strain, culture of plant or animal cells);
- a method (a process of performing actions on a material object with the help of material means);
- use of a known product or method for a new purpose or a new product for a specific purpose, except for diagnostic, therapeutic and surgical methods of treatment of humans or animals.

Unlike Kazakhstan, in the Russian Federation (hereinafter also referred as RF) the concept of utility model is much narrower and, according to the Civil Code of the RF, it is a technical solution relating only to a device. A utility model patent in the Russian Federation is intended to protect any upgrade, enhancement of a device, machine designs, their mechanisms, parts, aggregates or implements. A device is characterized by the following features: structural elements, their interrelations and interposition, forms and details of elements or device and materials used for a device.

In Kazakhstan and Russia, novelty and industrial applicability are taken into account when considering patentability of a utility model. The presence of the criterion of inventive step in a technical solution for a utility model is not required. The scope of legal protection of a utility model is determined by its claims, which are provided in the application materials.

In the Republic of Kazakhstan utility model application, unlike the Russian application may cover one or several objects of protection, and with observance of the requirement of unity of the utility model. That means it is necessary that one object is intended for obtaining, realization, use of another object or several objects of the same kind, however all objects should have the same technical result. For example, a substance or a device and a process for obtaining it, or a process and device for carrying it out, or a process and a substance for use in a process, options. In the Russian Federation an application for a utility model relates only to one object of protection, which exists to fulfill one technical purpose and it is also required to observe the unity of utility model.

In order to determine the novelty of a utility model, both in the Republic of Kazakhstan and in the Russian Federation, all essential features in an independent claim being in a causal relationship with the technical solution to be achieved are taken into account. The essential features must not be known from the information that became publicly available before the priority date. A utility model is recognized as industrially applicable when it can be manufactured and used in modern industry, agriculture, other branches of economy or social

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sphere and if the application gives a specific purpose of a utility model or a specific purpose follows from the name of claims of a utility model.

The requirements to the utility model application materials in both the Republic of Kazakhstan and the Russian Federation are almost identical. The terms of examination of the application in Kazakhstan and Russia are also approximately the same and it takes to examine the application materials about 5-6 months in Kazakhstan and 6-9 months (and sometimes a little more) in Russia.

The procedure for patenting a utility model in Kazakhstan and in Russia consists of several steps. Two initial steps: preliminary information search and preparation of application materials are carried out by the applicant or a patent attorney. The patent office conducts examination of the application. The difference is that in the Republic of Kazakhstan there is a one-stage examination of the utility model application, while in the Russian Federation there is a two-stage examination and includes formal examination and if it is positive and after payment of the relevant fee, the substantial examination is conducted.

Without going into details, the steps of patenting a utility model can be specified as follows:

1. conducting a preliminary information search to examine the prior art and determine novelty, identifying analogs, drafting the claims and indicating key features to maximize protection;
2. drafting the description, claims, abstract, filling in the application form, paying the application fee and forwarding the application materials for registration, and receiving a document indicating the priority date and application number;
3. at the stage of formal examination the availability of the necessary documents and compliance with the requirements to their execution, including the requirements to the unity of the utility model, the correctness of classification according to the International Patent Classification, the correctness of payment for filing the application are checked;
4. substantive examination in the Russian Federation includes patent search, verification of patentability conditions, utility model unity requirements, verification of sufficiency of disclosure of essence in the application documents, verification of utility model claims.

During the examination of the application in the Republic of Kazakhstan, the availability of documents and compliance with the requirements thereto, the establishment of the priority date, the possibility of attributing the utility model to the objects protected as utility models, and the unity of the utility model are checked. Compliance of the utility model with the conditions of patentability is not checked, and the patent is granted at the risk and responsibility of the applicant.

Protection is not granted to utility models recognized by the state as secret. If Kazakh patent has doubts as to whether the development belongs to state secrets, an interdepartmental commission on classified industrial property objects (hereinafter - the Commission) is established with the invitation of specialists of the relevant state bodies, whose competence includes classification of the relevant industrial property object. If the development is recognized as secret, it is denied registration and becomes the property of the state. If not, patenting procedure is followed in standard mode.

A utility model patent issued in both Kazakhstan and Russia certifies the priority, the right of authorship and the exclusive right of the patent owner (the right to produce, use, sell, distribute, store, and the right to prohibit others from using without the patent owner's permission) and to determine the fate of that patent. A patent is valid only in the territory of the country of patenting - Russian patents are not valid in Kazakhstan and vice versa.

The rights of the patent owner in our countries have a number of limitations, for example, if the actions of the third parties are aimed at:

- use of a product or method on vehicles temporarily or accidentally located in the territory of the country,
- research work and experiments on the product or method,
- use under extraordinary circumstances, with notification of the patent owner and payment of appropriate compensation,
- personal use without profit,
- one-time production of medicines in pharmacies on prescriptions of doctors,
- if a product or method was previously introduced into business in the territory of the country by a patent owner or the third party with the authorization of a patent owner.

There are differences in terms of validity of title documents in Kazakhstan and Russia: the term of validity of utility model patent in Kazakhstan is 5 years from the date of filing of the application with the possibility to extend this term to 3 years (8 years in total), utility model patent in Russia is valid for 10 years without the right to extend this term.

The fees for filing and registration of the application, for substantive examination (only in Russia), for granting and publication of the patent, for maintenance of a title document for legal entities in Kazakhstan and Russia are given in the table below (it does not include fees for restoration of the missed term, extension, transformation of application and some others).

No.	Name of the fee	The fee in the Republic of Kazakhstan in KZT for legal entities	Name of the fee	The fee in Russia, in RUB	The fee in Russia in KZT (exchange rate 4,77 KZT per RUB)
1	For acceptance of the utility model application and its examination	16450,56	For registration and formal examination of the utility model application	1400+ 700 (for each claim over 10)	6 680,09+3 340,05
2	-	-	Substantial examination	2500	11 928,73
3	For publication and issuance of the title document	33253,92	For registration and publication of the title document in digital form	3000	14 314,48
4			For issuance of the title document in hard copy	2000	9 542,99
5	Maintenance fee for 1-2-3 years	Every year 16450,56	Maintenance fees (per year) 1-2 / 3-4 / 5-6 / 7-8 / 9-10	800/1700/2500 /3300/4900 annually	3 817,19/8 111,54/ 11 928,73/ 15 745,93/23 380,32, annually
6	Maintenance fee for 4-8 years	Every year 47855,36			

Protection of rights.

In the Republic of Kazakhstan, a utility model will be recognized as used by competitors if their product has and their method applies each feature of an independent claim or an equivalent feature known in the prior state of the art.

In the Russian Federation, a utility model will be recognized as used in a competitor's device if it contains each feature of an independent claim of a utility model.

Thus, a utility model patent is protected as an object of patent law in both Kazakhstan and Russia, the patentability criteria are industrial applicability and novelty, and however there are a number of differences in the patenting procedure.

The legislation of the Republic of Kazakhstan covers a much broader list of objects of a utility model, they are the same as for an invention - these are products, methods, and their use for a new purpose. In the Russian Federation, the objects of a utility model include only devices, their modification and improvement.

In Kazakhstan, several utility model objects can be covered and patented in one application if they form a single inventive concept, while in Russia it is only one object.

The procedures for examination of a utility model application also differ. In the Republic of Kazakhstan, only formal examination of the application is carried out, there is no verification of compliance of a utility model with the conditions of patentability, and the patent is granted at the risk and responsibility of the applicant. In the Russian Federation, the application is subject to substantive examination.

The latter is a very important and essential difference - in Kazakhstan it is possible to patent works already known in other countries, while the procedure of patent revocation within the framework of court proceedings is both costly and lengthy. During the whole period of court proceedings, the patent owner retains the "right to prohibit" the use of a utility model protected by a patent, including with the help of law enforcement bodies. Of course, revocation of patents is also possible in Russia, but the patents are issued after substantive examination and the number of unfair registrations is significantly limited.

Summing up the above, I would like to note in relation to Kazakhstan that if there is no need to protect a development for a period of more than 8 years (for example, earlier patenting of new developments is expected or the life of this object is not expected to be long), if it needs to be patented quickly, a utility model is a good alternative to an invention. A utility model can substitute for an invention when applying for grants, to make products more attractive when "they are patented". Unfortunately, the lack of substantive examination opens opportunities for unfair competitors, the fight against them is difficult and time-consuming, however it is possible to take preventive measures and patent your developments and avoid possible blocking of business activity through unfair patenting.