

## LEGAL ALERT

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### ANALYSIS OF AMENDMENTS TO INTELLECTUAL PROPERTY LEGISLATION



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On 20 June 2022 the Law of the Republic of Kazakhstan No. 128-VI On Entering Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan on Improvement of Legislation in the Field of Intellectual Property and State-Guaranteed Legal Aid was signed and will be effective from 21 August 2022.

This Law amends the Civil Code of the Republic of Kazakhstan, the Law on Copyright and Related Rights, the Law on the Protection of Selection Achievements, the Patent Law, the Law on Trademarks and certain other acts.

We propose to highlight the most significant amendments.

#### Trademarks Law



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The name of the Trademarks Law has been changed to the Law on Trademarks, Service Marks, Geographical Indications and Appellations of Origin of Goods.

#### 1. Trademarks

According to the amendments and in accordance with the rules of the Paris Convention for the Protection of Industrial Property, the Law adds that designations without distinctiveness may be registered as a trademark if, at the date of filing the application, the designation has acquired distinctiveness in the result of its use.

The deadline for submission of the translation of documents is increased

Saule  Partner, Patent Attorney	up to 2 (two) months, previously the deadline was 1 (one) month.  The term for preliminary examination is increased up to 1 (one) month, earlier it was 10 (ten) business days.
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The possibility of filing an opposition to published applications has been introduced, however the time limit for filing of an objection is given unreasonably short and it is only 1 (one) month, while the examination of the application is carried out within 7 (seven) months. The applicant is notified of the opposition filed and the applicant has 3 (three) months to reply to the opposition.

The term for amending the State Register of Trademarks was reduced to 10 (ten) business days, while previously the term was 1 (one) month. Also the term for notification of the applicant on the introduced amendments was reduced to 5 (five) business days, while previously the term was 2 (two) months.

The proof of use of the trademark in a domain name is added as an evidence of the use of a trademark.

## 2. Geographical Indications and Appellations of Origin of Goods

Previously, the Law only disclosed the concept of “geographical indication” and did not establish a legal regulation in relation to that object. The amendments provide a geographical indication almost the same legal protection as for appellations of origin of goods.

The legislator supplemented the concept of “geographical indication” as a designation that identifies goods originating from the territory of a geographical object, a certain quality, reputation or other features of which are to a large extent related to its geographical origin.

The concept of “appellation of origin” was clarified in terms of the name of the geographical object, namely, it may be a designation that represents either a modern or historical, official or unofficial, full or abbreviated name of the geographical object.

Pursuant to the amendments, if for the geographical indication the implementation of at least one stage of production of a product on the territory of the geographical object is sufficient, then for the appellation of origin of goods it is necessary to implement all the stages of production of a product, which has a significant effect on the formation of its characteristics and properties.

The term of the right to use a geographical indication is established in the same way as for an appellation of origin - for 10 (ten) years from the date of filing of an application.

The right to use a geographical indication, as well as the right to use an appellation of origin, may be granted to a number of several individuals or entities, either jointly or independently, producing goods in a given geographical object.

Article 27 of the Law on Trademarks is supplemented with designations which are not registered as geographical indications and designations of origin:

- 1) previously registered as geographical indications and appellations of origin in respect of goods of the same kind;
- 2) identical or similar to a designation previously registered in the name of another person, if the use of such geographical indication and such appellation of origin of goods is capable of misleading consumers about the goods and producer.

The procedure for filing an application for the registration of a geographical indication is similar to that for the registration of an appellation of origin; however the following should be also submitted:

- when describing the characteristics of the goods, the source material used for the production of the goods, physical, chemical, microbiological, organoleptic or other characteristics, which are largely determined by its geographical origin must be included;
- a description of the method of production of the goods, as well as information about the conditions of storage and transportation, if this has a significant effect on the formation and preservation of the characteristics of the goods;
- information confirming the right to carry out activities to produce goods, if it is provided for by the legislation of the Republic of Kazakhstan.

An application for an appellation of origin shall additionally contain a description of special characteristics of goods and other features, including the source material used for its production, physical, chemical, microbiological, organoleptic or other characteristics, which are exclusively or mainly determined by natural conditions and (or) human factors characteristic for the given geographical object.

The term for the examination of the application was significantly increased from 30 (thirty) business days, now it shall be within 3 (three) months from the date of filing.

The publication of information on applications for geographical indication and appellation of origin has been introduced, similarly to the publication of trademark applications.

The possibility of filing an opposition to the published application was introduced, however within a very short period of time - within 1 (one) month from the date of publication of an application. The applicant is notified of the opposition filed within 5 (five) business days and has 1 (one) month to reply to the opposition.

An application for a geographical indication may be converted into an application for an appellation of origin and vice versa.

Registration of a geographical indication, like an appellation of origin, is valid for indefinite period of time provided that the characteristics of the goods which are substantially related to their geographical origin or appellation of origin are retained.

The following grounds have been added for termination of the right of use:

- 1) loss by the right holder of the right to carry out activities to produce goods with special properties, quality, reputation and other characteristics;

2) loss by a foreign legal entity, foreigner or stateless person of the right to a given geographical indication and appellation of origin in the country of origin of goods.

### **Law on Copyright and Related Rights**

A condition has been added under which the use of a work without the consent of the author or right holder and without payment of royalties is permitted, in particular: reproduction without revenue to educational organizations of selected articles and low-volume works legally published and provision of copies thereof to students and teachers for examinations, classroom instruction and self-study in the quantities required for this purpose.

The amendments mainly refer to collective property rights management organizations (CMOs):

- 1) in the case of the transfer of authority for collective management of property rights to several organizations managing property rights on a collective basis, the delegated authority must differ in terms of scope and/or territory and/or areas of management;
- 2) Forms for reporting to the CMO by users have been added: reports shall be submitted in writing or in the form of an electronic document;
- 3) The CMO is obliged to:
  - place on the website information on agreements concluded with users, including indication of the name of a user, location, as well as the date of conclusion of an agreement.
  - enter into agreements on mutual representation of interests with organizations managing property rights on a collective basis in Kazakhstan;
  - notify the authorized body in writing or in electronic form of the time and place of the general meeting at least 10 (ten) business days before the date of the meeting and ensure access to it.
  - publish the auditor's report and the results of the audit, together with the relevant financial statements on its website within 1 (one) month of approval, which must be made publicly available to rights holders for a period of 5 (five) years.
  - A CMO is not entitled to be accredited for 2 (two) years from the date of the decision by the authorized body to refuse accreditation;
  - the certificate of accreditation may be withdrawn, inter alia, in case of application of remuneration rates to authors, performers and phonogram producers below the minimum remuneration rates established by the Government of the Republic of Kazakhstan.

### **Patent Law of the Republic of Kazakhstan**

The term of validity of a design patent is reduced to 10 (ten) years, which can be extended to 5 (five) years each time, however the total duration of a patent must not exceed 25 (twenty five) years from the date of application.

Patents for inventions are also not granted for:

- 1) methods of cloning human beings and human's clone;

- 2) methods of altering the genetic integrity of human germline cells;
- 3) the use of human embryos for commercial, military and industrial purposes.

A document confirming payment of the filing fee for an invention application may be submitted within 2 (two) months from the date of receipt of the application, previously the application and a document confirming payment had to be filed together as required by the Article 17 of the Patent Law. Previously, such opportunity was available only in case of filing the application for a utility model and an industrial design.

The consequences of invalidation of a title of protection document have been changed: now in such case a new patent shall be granted for the remaining protected subject matter; after 21 August 2022, the amended title of protection documents shall continue to be valid under the same numbers.

According to the amendments, an industrial design, if it meets the requirements of novelty and originality, may also be protected without registration for 3 (three) years from the date when it was first made public in the Republic of Kazakhstan.

Unregistered industrial design:

- (1) is deemed to be new if no identical design has been made publicly available before the date on which the unregistered design was first made public. Unregistered design shall not be deemed to have been made public if it was disclosed only to a third party under specified or implied conditions of confidentiality;
- (2) infringed rights may be protected in a court;
- 3) rights may be held by the same persons as those for registered industrial designs;
- (4) the owner has the right to prevent acts of use where the disputed use is a consequence of copying his unregistered design. It is not considered to be a consequence of copying an unregistered design if it has arisen in the result of independent work on another design by an author who may reasonably be considered not to have knowledge of the disclosed design.

### **Patent Attorneys**

According to the amendments, persons who have completed at least 1 year of training at the Chamber of Patent Attorneys are also allowed to be certified as patent attorneys.

The powers of a patent attorney when handling cases related to filing an opposition with the Board of Appeals shall be confirmed only by the original power of attorney; previously a copy was sufficient. A translation of the power of attorney may be submitted in one of the languages: Kazakh or Russian, previously it was necessary to submit it in both languages.

A patent attorney may be excluded from the register by the decision of the qualification board, including on the basis of complaints of individuals and/or legal persons, as well as submissions from the chamber of patent attorneys. Previously, the qualification board only recommended applying to the court with an application.

### **The Law of the Republic of Kazakhstan on Protection of Selection Achievements**

The time limit for the preliminary examination of selection achievements was reduced to 1 (one) month from the date of submission of the application. Previously, the preliminary examination was conducted within 2 (two) months, however it could be started after 2 (two) months from the date of filing of an application.

The period of filing of missing documents or corrected materials at the request of the expert organization was extended from 2 (two) to 3 (three) months.

The notification on the results of the preliminary examination shall be forwarded within 5 (five) business days, while previously the term was 10 (ten) business days.

A decision to refuse to examine an application following the results of the preliminary examination is also forwarded within 5 (five) business days, while previously the time limit was 1 (one) month.

The information on the applications shall be published within 5 (five) business days, earlier it was 1 (one) month.

The time limit for issuing a decision on granting a patent for a selection achievement, as well as for forwarding a notification thereon to the applicant was reduced from 10 (ten) to 5 (five) business days.