

## ARTICLE

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## **Eurasian patents – alternative opportunities – Filing and Prosecution in Kazakhstan**

[filing and prosecution through Eurasian Patent Attorneys from the member-states of Eurasian Patent Convention]



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The Eurasian Patent Office (the “EAPO”) issue Eurasian patents for an invention that are new, has an inventive step and is industrially applicable, as well as for an industrial designs that are new and original in its substantial features. The Eurasian patent for invention is valid in the territory of eight member countries of the Eurasian Patent Convention (the “Convention” or “EAPC”), namely, Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Russian Federation, Tajikistan and Turkmenistan. The Eurasian industrial design patent is valid in the territory of six countries, which are Armenia, Azerbaijan, Kazakhstan, Kyrgyzstan, Russia and Tajikistan.

EAPO is located in Moscow, Russia and most patent applications have been filed through the Russian patent attorneys.

However, EAPC provides for possibility to file the patent applications and do all paperwork through the patent offices of member-states of EAPC and qualification of Patent Attorneys of these states as Eurasian Patent Attorneys.

Currently due to impose of sanctions on the Russian Federation and Belarus such a possibility of filing applications for Eurasian patents for inventions and industrial designs through patent attorneys from other countries become extremely important, and among other reasons is associated with restrictions related to document



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exchange and possibility of payment of official fees to EAPO.

The table below provides a number of Eurasian patent attorneys in the countries of EAPC.

Country	Number of the Eurasian patent attorneys
Azerbaijan	5
Armenia	3
Belarus	32
Kazakhstan	28 <sup>1</sup>
Kyrgyzstan	1
Russian Federation	536
Tajikistan	2
Turkmenistan	3
Total:	636

The table shows that if Russia and Belarus are excluded, Kazakhstan is the most developed in providing such services. Unfortunately, not all Kazakhstani Eurasian patent attorneys can communicate in English (the same applies to attorneys from the other countries of the Convention), but their number is growing.

Attractiveness of national patent applications filed directly in each of these countries is now also increasing. First of all it is Kazakhstan, followed (in alphabetical order) by Azerbaijan, Armenia, Kyrgyzstan, Tajikistan and Turkmenistan, and while Kazakhstan is normally always the first choice and the gateway to the other at least Central Asian countries, the consequence of filings in the other countries depend on the industry of interest.

In addition to the level of economic development and investment climate, Kazakhstan’s attractiveness is also explained by the simpler application procedure and absence of the language restrictions. For example<sup>2</sup>:

- in Kyrgyzstan and Tajikistan, although the Russian language is widely used along with national languages, it is still necessary to

<sup>1</sup> As to the best of our knowledge, in the near future the number of patent attorneys from Kazakhstan will considerably increase

<sup>2</sup> <https://bolotovip.com/publication/requirements-for-the-language-of-documents-and-the-procedure-for-filing-documents-with-the-patent-offices-of-the-cis-countries-and-the-eurasian-patent-office/>

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submit translations of some documents exclusively into the national language;

- in the patent offices of Azerbaijan and Armenia, the filing and paper work related to the applications are carried out only in the national languages;

- in Tajikistan and Turkmenistan, it should be taken into account that in addition to the Russian and national languages, applications and requests must be also submitted in the English language.

Consequently, when filing an application is done through Kazakhstan, all documents can be filed in the Russian language, which is also the official language of the Eurasian Patent Office, that requires only one translation into the Russian language. This is not to say that the importance of Eurasian patents is diminished - we are only referring to the technical side of obtaining Eurasian patents due to sanctions.

In accordance with the Patent Regulations, the Eurasian application

- can be submitted in writing on paper or in electronic form;

- an application filed in electronic form shall correspond in content to a paper application and shall be equal in its legal power to a paper application;

- in the case of an invention, shall contain: an application, a description of the invention, claims, drawings and other materials if they are necessary for understanding the nature of the invention or industrial design, an abstract and other necessary materials;

- in the case of an industrial design, shall contain: an application, a set of images, a description of an industrial design, a three-dimensional digital model (if desired), drawings and other materials if necessary to explain the industrial design, and other necessary materials.

The application shall be accompanied by proof of payment of procedural fee and with a power of attorney if the application is submitted by the applicant's representative.

Consideration of the application includes two stages, which are the following:

- formal examination of the submitted documents. At this stage, a search is conducted and the application is published;
- substantial examination of the application. After completion of the substantial examination, the patent is granted and published.

In general, it takes approximately two years from the filing of an application to granting of the patent for invention; in case of an industrial design it takes from four to six months.

The term of a patent for invention is twenty years, for some categories of inventions there is a possibility to extend the protection for up to five years that is up to twenty five years in total.

The term of validity of an industrial design patent is five years, with the possibility of its further fourfold prolongation for five years, but the total term of protection of an industrial design does not exceed twenty five years.

It should be noted that the described possibilities of working through patent attorneys of any member-state of the Convention are also convenient for other actions with Eurasian patents - keeping in force, transfer of rights, participation in patent disputes, in which (and I am proud to say it!) our firm is among the first in Kazakhstan. Of course, transfer and acceptance of the rights to continue paper work to and from another representative can be made at any time, and now it is often the case that new Eurasian applications are filed through patent attorneys of Kazakhstan, Armenia, Azerbaijan, Kyrgyzstan and Tajikistan and paperwork is transferred from the Russian patent attorneys patent attorneys of other countries.