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July 2023

Expert talks about lawyers and patent attorneys working together



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Yuri Bolotov, a copyright professional spoke about the joint work of lawyers and patent attorneys, Zakon.kz reported.

The re-registration of Soviet IPOs (intellectual property objects) into Kazakhstani IPOs and registration of new Kazakhstani IPOs were the main focus in the field of patents and trademarks in the early years of creation of an independent system of protection and enforcement of intellectual property (hereinafter - IP) in Kazakhstan. Further, in parallel with the registration of IPOs, there were disputes related to the establishment and existence of rights and then to infringement of these rights. In the very beginning they were fairly simple cases, however over time they became more complicated, the infringers became more experienced in committing infringements and began to build quite complex infringement schemes and infringements were more difficult to fight from year to year.

New intellectual property objects such as well-known trademarks have emerged and new ways of enforcing rights through customs and departments of justice have emerged. Court and other types of dispute resolutions became more frequent.

The legal services also develop and expand together with the constant development of the system of intellectual property rights protection and enforcement, in many cases lawyers handle intellectual property rights protection cases themselves alongside with patent attorneys and IP lawyers specializing in IP.

At the same time, the role of specialists and patent attorneys is increasing in complicated disputes. In IPR disputes, a professional knowledge of the details of both national and international law is a must and the ability to both see and apply in practice the provisions of the Madrid Agreement on the International Registration of Marks, the Trademark Law Treaty (TLT), the Patent Cooperation Treaty (PCT), the Eurasian Patent Convention and of course the Paris Convention for the Protection of Industrial Property, among others are important. Those provisions that can be applied directly and those that need to be developed and enshrined at the national level must be taken into account.

Lawyers and legal advisers who rarely encounter IP disputes and find some difficulties in navigating the narrow field of IP, and patent attorneys are not always fluent in procedural rules. Courts in IPR-related disputes overwhelmingly engage IP specialists to provide opinions and explanations on the subject matter of the dispute, where each party recommend and try to engage *its own specialist* and frankly speaking the opinions of the specialists engaged by the parties not always coincide.

As our firm works exclusively in the field of intellectual property, it is difficult to compare the frequency of involvement of narrow specialists in other areas of law; nevertheless IPR seems to stand out and is characterized by a very high frequency of such involvement of specialists.

As it is customary in many countries, that the division between “solicitors” and “barristers” is clear, between those who carry out case analyses and prepare opinions, the substantive part of documents, and those who take such work to court.

Based on our practice, we would mention the following are the most frequent requests that our specialists receive.

Trademarks

- Conducting independent comparative analyses of the similarity of trademarks, designations and product packaging;
- Examination of the relationship between trademark rights and copyright;
- Examination of conflicts in trademark and trade name rights;
- Review of trademark use issues;
- Analysis of risks and chances when filing an unfair competition claim, what documents are required to prove unfair competition.

Patents to inventions, utility models and industrial designs

- Disputes relating to possible patent infringement where it is necessary to compare the claims to the subject matter used (embodied in goods, methods of their production, application and etc.);
- Disputes relating to invalidation of registrations or restoration of invalidated patents. Issues of novelty and inventive step are often addressed, issues of industrial applicability are not frequent;
- Service inventions and disputes relating to alleged unfair registration by employees or former employees of companies.

These are not all issues that arise, but are perhaps the most common. Not all of them are brought to the court and expert opinions are needed for pre-court reviews, for parties to understand emerging or existing risks and to improve the existing system for protecting and defending company IPRs.

It is certainly interesting to see the development of the system of IPR protection and enforcement.

We hope to see further development of cooperation between solicitors and barristers and that joint work between patent attorneys and professional lawyers will become more frequent both during court proceedings and out-of-court settlement stages and we are ready to work with both solicitors and barristers.

We believe that almost all IPR specialists and patent attorneys are willing to help and either alone or together with barristers to handle cases at all stages of preparation and examination.

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