

## ARTICLE

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**October 2022**

### **HOW TO PROTECT YOUR FAMOUS NAME (one more additional way)**



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Let's imagine or maybe someone without any fantasies is already a media personality or a well-known individual in other fields of activity. You have crowds of admirers, millions of followers, an army of fans and a mass of wannabees. Your name, nickname, initials or a special symbol are familiar to a huge audience of all ages. Nowadays popularity is perfectly commercialized so it becomes a tidbit for unfair individuals. What does it mean? Quite often someone appears who tries to draw attention to their product or activity at the expense of one's popularity. It is good if it is agreed. However what to do if it is not? How do you protect your fair and well-known name from such attacks?

It must be understood that an individual's name, given at birth or changed in accordance with the law, may not be used without the owner's consent. The law provides not only prohibition, but also stipulates compensation for the unlawful use of a name. However, if the name becomes part of a brand that is used to label goods or services, you should already be concerned about its legal protection as a trademark. In this case, the name is protected not only by the Civil Code of the Republic of Kazakhstan, but also by the Law of the Republic of Kazakhstan On Trademarks, Service Marks, Geographical Indications and Appellations of Origin. In particular, this law prohibits the registration of trademarks reproducing surnames, names, nicknames and their derivatives in violation of personal non-property rights of these persons, their heirs or legal successors.

It appears that only the owner of a name can obtain legal protection as a trademark. It should be noted that this restriction applies specifically to famous persons, and known to a wide

range of consumers. The third party will be refused in the registration of someone else's popular name as a trademark without permission.

However, if by a happy coincidence, your passport details coincide with the name of a celebrity, you are also entitled to get trademark protection of that name. Furthermore, as the owner of such a registered trademark, you are also entitled to dispose of it at your discretion: to use it, to authorize a third party to use it or even to assign the rights to a trademark. In this case, the law does not provide limitations: if I, as Kolya Kokin, have registered the same trademark, confirming my identity, to assign the rights to this trademark to a third party no additional confirmation is required, the expression of intention of the parties is enough.

Registering one's name as a trademark is not a modern trend. For example, in the fashion and beauty industry, personal names as trademarks have been around for a long time and are quite common. Nowadays, the field of use of "first name" trademarks has considerably expanded: catering, training, services in various directions, entertainment and consumer products. Such trademarks are registered to individuals or sole proprietors - the direct holders of these names, or to legal entities, where the name of the founder, manager or other persons involved can be taken as the basis of a trademark. A well-known name may also be incorporated in his trademark by a third party by agreement with an individual in question.

It is also important to understand that now not only passport names are being actively promoted, many individuals are known under nicknames in social networks, this cannot even be called a nickname, but the need to protect such personal identification is also very high. As soon as such names become a commercial entity, they need to provide protection, alternatively, registration as a trademark.

The distinctiveness of trademark protection is that not only unauthorized use of exactly the same name, but also those designations which are intentionally changed but perceived as identical, will be considered as an infringement of right. For instance, there is a famous initials of a world famous athlete, whose performances are watched by the whole world. However there is also someone who wants to draw attention to his service and uses the same letters with minor changes in the advertisement, saying that it is not the same. In this case the term of "confusing similarity" applies. That is, infringers may distort the name to prove the coincidence, but the consumer will ultimately perceive such a trademark as a reference to a specific well-known personality. It turns out that a trademark allows you to protect the right owner from such tricks of unfair businessmen both at the stage of registration of such deceptive trademarks and when using them, proving the fact of infringement in court.

The specific nature of a trademark is such that it is only protected in relation to those products which have been claimed at the time of registration. To put it simply, you indicate in the application for registration that you want to protect a trademark for an aircraft, the use by a third party of this designation for droppers is no longer considered as an infringement of your trademark. In other words, it turns out that even having secured your well-known name by registering it as a trademark, you cannot foresee all areas of its use by competitors. Moreover, the law also obliges you to use a trademark. And if you, for example, indicated in an application for registration of goods (services) for which a trademark is not used, a third party

is given the opportunity to revoke this registration for those goods and services due to non-use. How to deal with such a situation?

The main thing is not to panic. The law gives the third parties the right to cancel an unused trademark under certain conditions. Such individuals have to prove their interest. Most often, these are persons who also claim trademark protection but are prevented from registering with an earlier priority. Moreover, there is a certain period of time after which a trademark may be cancelled due to non-use. This is either three years from the date of registration of a trademark, or at a later date, three years preceding the date of filing a trademark invalidation claim. In other words, in order to invalidate a trademark, you not only have to prove that it has not been used for a sufficiently long period, but also find arguments as to why that particular individual is entitled to claim invalidation of a trademark. With name trademarks, this is much more difficult to do, but there are always exceptions if, for example, it is not a full name, a pseudonym where the underlying words are quite common and etc. However that is not the end of it either. What can be done in such cases?

Not long ago, a trademark bearing the name of a popular artist was recognized as well-known in Kazakhstan. This has shown that this option of legal protection for a famous name as a brand can provide protection for other famous people as well.

The advantage of legal protection for a well-known trademark is that it is protected for any goods and services, even those that have not yet been invented by mankind, due to its proven fame. So, in whatever field a similar designation is used, this would be regarded as an infringement of the rights of the owner of a well-known trademark. It is not possible to invalidate for non-use of a well-known trademark, such registration can be canceled only through a court, to prove that it was made unlawfully. This is also quite problematic, as a decision on the recognition of a trademark as well-known is made by an independent commission, which, after careful study of materials proving the wide popularity of a trademark comes to the conclusion of its high status of common knowledge.

The procedure for the recognition of a trademark as well-known is different from the usual trademark registration, which is assessed for distinctiveness and similarity with already existing or applied for registration of trademarks. Recognition of a trademark as well-known requires proof of its celebrity, including proof of its recognition through a survey of consumers of various age groups. If your popularity is such that you will be recognized by both young and old, then the likelihood of getting a high result in the survey for a positive decision of the independent commission is very high. One disadvantage, the high price of such a survey as it is required to conduct a survey among not less than one hundred people in eight cities in Kazakhstan. But even this is not a problem, if infringement of a popular name or a well-known designation is at stake, whose reputation has been built up over the years.

It should be understood that not only a passport name but also an abbreviation, initials, nickname, pseudonym, a special symbol or the name of a creative or scientific group can be recognized as a well-known trademark. Of course, the law provides certain requirements and procedures for this procedure, and without expert advice in this area it will be difficult to assess your chances of obtaining the desired result.

How to protect your name and, apart from everything else, use it for commercial purposes is up to you, we in our turn offer another way of dealing with this issue.