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How to recognize a trademark as well-known in Kazakhstan



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At first glance, everything is simple there is a trademark, which thanks to active use, large sales volume and wide advertising campaigns has become widely known among consumers and that is all to be a well-known trademark. However only a few number of trademarks can be recognized as well-known.

What is recognizing a trademark as well-known?

The main and most important thing is protection in relation to all goods and services. As you already know from the article on registration of trademarks, a common trademark has legal protection only with respect to those goods and services that were claimed when applying for registration. For really well-known trademarks, there is a rather big issue with the exploitation of their promoted brand by manufacturers who try to use someone else's popularity in other areas.

Of course, you can spend a significant amount and register a trademark for all 45 classes of the ICGS. BUT! Even such an extensive list of goods and services, which currently contains the latest and most perfect edition of the International Classifier, cannot cover all types of products. Besides almost every year new types of goods and services appear on the market, anyone cannot keep up with it too. Nevertheless, the legal protection of a well-known trademark is such that, being recognized as generally known for a

certain type of goods or services, then its protection extends to any goods or services.

There is one more unpleasant fact: if you do not use a simple trademark in relation to any goods or services, then any interested person has the right to cancel such registration with respect to these goods or services. THIS IS EXCLUDED FOR A WELL-KNOWN TRADEMARK. Regardless of the goods and services for which a well-known trademark is used, the right to it shall be violated with any copying on any product.

Now, let's discuss the procedure for the recognition of a trademark as well-known.

Stage 1. Conduct a sociological survey on the subject of popularity of a trademark.

The poll should be conducted among at least seven hundred respondents, one hundred people in seven cities of Kazakhstan with obligatory coverage of the population of the cities of Astana and Almaty. The survey results shall show how known a trademark among respondents aged over 18 years, whether consumers connect this trademark with a certain type of goods or services, how long they know this trademark and whether they are consumers of products bearing this trademark.

The results of the survey shall determine exactly whether there is a chance to recognize the trademark as well-known, or it is necessary to invest in the promotion of the brand.

Stage 2. Preparation of the application for recognition of a trademark as well-known.

The Law defines only general recommendations when preparing an application, which must prove the popularity of a trademark. This documentary evidence of the active use of a trademark, the statistics of sale volumes, data on the average annual number of consumers, information on advertising costs and confirmation of its intensity, etc. The provided materials should really demonstrate that the trademark owner has made considerable efforts to popularize his brand, and the trademark is really known so that when it is used by other producers in any area, the consumer shall be misled. It is necessary to underline that for each trademark an individual amount of data is formed, since the scope of use,

the audience of customers, the purpose of goods and services for which the trademark was used are quite different. The main purpose is to evidence that the trademark is well-known.

The application is forwarded to the Ministry of Justice of the Republic of Kazakhstan. The information on the submitted application is published in the official source, currently it is the website of the Ministry of Justice, so that all interested persons could provide their motivated arguments against the possible recognition of such trademark as well-known. After three months from the date of publication, a meeting of the Commission for the Recognition of a Trademark as Well-Known must be appointed.

Stage 3. Defending evidence about the popularity of a trademark.

The relevant Commission considers materials on the recognition of a trademark as well-known. This Commission also accepts and reviews the objections of third parties against the recognition of a trademark as well-known. In the event that any of the applicant's arguments, in the opinion of the members of the Commission, are not convincing enough, or the materials of third parties objecting to the recognition of a trademark as well-known, require additional consideration and preparation of answers, the meeting of the Commission can take place in several stages, a decision shall be made to recognize a trademark as well-known or to refuse recognition. Pursuant to the legislation the decision of the Commission can be appealed in the Court.

Stage 4. Registration of a well-known trademark.

If the Commission decides to recognize a trademark as well-known, the date from which a trademark is recognized as well-known shall be established, a trademark is assigned a serial number and subject to the payment of state fee, a trademark is entered in the State Register of Well-Known Trademarks. Appropriate data is published in the official bulletin Industrial Property. An extract from the State Register is issued as a supporting document. The validity period for the registration of a well-known trademark is ten (10) years from the date of its recognition as well-known.

As practice shows, the procedure for recognizing a trademark as well-known from six months to a year.

The extension of the validity of a well-known trademark is made on the basis of the filed application and the payment of the state fee.

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