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Preventive measures against trademark infringements



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Our national system of intellectual property protection and enforcement is almost 30 years old!

In the beginning, the main target was to re-register the trademarks of the former Soviet Union, the registration of trademarks of both national and foreign companies started intensively in Kazakhstan.

Then as time went by, infringements appeared. These infringements included counterfeiting, illegal import of goods produced for other countries (parallel importation), use of designations confusingly similar to the registered trademarks.

I would like to draw your attention to the increasing number of attempts to register designations similar to already registered trademarks and increasing number of cases of attempts to cancel similar trademarks not timely detected during registration. Cases of such very similar trademark registrations are unfortunately not uncommon, causing substantial issues for trademark owners.

Pursuant to the legislation, once a trademark is registered and published, information about its registration is supposed to be available to all, however not everyone looks at the official trademark bulletins! Not many people are aware of the existence of a registered similar trademark until it has begun to be used. At that point, it turns out that the trademark has already been registered for more than five years and there is no way to challenge it on similarity.

What to do? To cancel it on non-use, however use has begun and pursuant to the legislation it is no longer possible to challenge the registration of the trademark. There remains a ground for cancellation of registration

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based on the possibility of misleading consumers or unfair competition, but this requires serious evidence gathering with considerable expense and it is not certain that the court shall accept it and rule in favor of the owner of the earlier trademark registration, as unfair competition disputes are both complex and costly.

This could have been avoided if the owner had been concerned in time to protect his trademark not only against counterfeit goods, but also against the registration of similar trademarks in the name of the third parties.

The cheapest and most effective way of protection is to monitor not only published registered trademarks but also trademark applications where the procedure for granting legal protection is much simpler and more efficient.

Such monitoring will help to remove unwanted trademarks at an early stage

and through a simple procedure, without resorting to lengthy and costly court proceedings later on.

Since we started publishing applications (October 2018), we have prepared and submitted more than 20 warning letters, resulting in 90% of the letters being granted and similar trademarks being refused registration at the examination stage.

This gives trademark owners:

1. cost savings - resolving this issue at the examination stage is several times cheaper than the procedure for challenging an already registered trademark in pre-trial proceedings and then in court;
2. advantage in time – a trademark is not yet registered and not used, the entire procedure takes place at the stage of examination and review of the application itself for a similar trademark;
3. avoidance of conflicts in the future - a trademark based on confusing similarity may be revoked by law within five years from the date of registration. If this deadline is missed, the registration of a trademark shall be very difficult to revoke in the future and shall require more effort and expense.

The trademark owner may decide how often monitoring can be carried out on a weekly, monthly or quarterly basis, but in our view, it is worth

doing it either by yourself or through trained professionals.

Source: <https://www.zakon.kz/6005820-preventivnye-deistviia-protiv-narushitelei-prav-na-tovarnye-znaki.html>