

## ARTICLE

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## **Utility models in the Republic of Kazakhstan and the Russian Federation: similarities and differences**



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*This article describes the features of utility models as an item of intellectual property in Kazakhstan and Russia, presents the similarities and differences in the legislation of these countries and describes the requirements for patenting of utility models, procedures, timing and fees in both countries.*

The fast development and dynamic renewal of modern technologies, in particular, in the field of electronics, information, digital technologies, pharmacology, medicine and others require a rapid response to changing commercial and economic demands/interests of the consumer market in a competitive environment and their legal protection.



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A utility model is one of the intellectual property items for which a patent may be obtained, just as for an invention and an industrial design. In comparison to the invention, the procedure for patenting a utility model is less stringent, more simple, less time-consuming, cheaper, however the validity life of a utility model patent is less.

The issuance of the title document to a utility model is not provided in all countries. For example, in CIS and Baltic countries, there is no protection for utilities models in Turkmenistan, Latvia and Lithuania. In Kazakhstan and the Russian Federation a utility model may be patented in the National Institute of Intellectual Property (Kazpatent) and in the Federal Institute of Industrial Property (Rospatent). There are similarities and a number of differences in the legislation of these countries.

A utility model patent issued in both Kazakhstan and Russia certifies priority, copyright and exclusive right and protects only in the territory of a given country.

The exclusive right is the right of the patent owner to manufacture, use, sell, distribute, store, and prohibit others from using it without the patent owner's permission. The scope of legal protection of a utility model is defined by its claims.

The exclusive right to use the protected utility model is granted to the patent owner during the period of validity of the title of protection:

-In the territory of the Republic of Kazakhstan from the date of publication in the official gazette of information on the granting of the title document;

- In the Russian Federation, from the date of filing an application for a patent with the relevant authority in the field of Intellectual Property.

The exclusive right of the patent owner may have a number of limitations, if actions of the third parties are aimed at: use of the product or method on vehicles temporarily or accidentally located in the country; conduct of research works and experiments on the product and method; use under emergency circumstances, with notification of the patent owner and payment of appropriate compensation; use for personal purposes without profit; single production of medicines in pharmacies on prescriptions of doctors[1].

The exclusive right of the patent owner shall be infringed upon unauthorized manufacture, application, importation, storage, offer for sale, sale and other introduction into business of a product created with the use of a utility model patent, application of a protected process or introduction into circulation of a product manufactured with a protected process.

In the Republic of Kazakhstan, a utility model shall be deemed as having been used by a competitor if its product contains, or makes use of, every feature of the patent owner's independent claim or an equivalent feature which is known in the relevant technical field. In the Russian Federation, a utility model will be recognized as used in a competitor's product if the product contains each feature of the independent claim of the patent owner's utility model [1, 2].

According to the Article 7.1 of the Republic of Kazakhstan Patent Law, a utility model includes technical solutions in any field relating to: a product (a device, substance, microorganism strain, cell culture of plants or animals); method (process of performing actions over material object by means of material means); application of a known product or method for a new purpose or a new product for a certain purpose, except for diagnostic, therapeutic and surgery methods for treatment of humans and animals [1].

Unlike in Kazakhstan, in the Russian Federation the concept of a utility model is limited and according to the Article 1351.1 of the Civil Code of the Russian Federation, the utility model is

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a technical solution that concerns only the device [2]. A utility model patent in the Russian Federation is intended to protect any improvement, improvement of a device, design of machines, their mechanisms, parts, units or tools.

A device is characterized by the presence of the following features: structural elements, their interrelation and mutual disposition, form and parameters of elements or device, material of device manufacturing and atmosphere.

Objects not protected as utility models in the Republic of Kazakhstan and the Russian Federation are: discoveries, scientific theories, mathematical methods; methods of organization and management of the economy; rules, schedules, symbols; programs for computers and algorithms; projects and layouts of structures, buildings, territories; proposals relating only to the appearance of products; proposals that contradict the public order to the principles of humanity and morality. The patentability of a utility model is not affected by the public disclosure of the utility model, provided that the application for a utility model is filed not later than six months from the date of its disclosure or placement on an exhibition [1, 2].

In both Kazakhstan and Russia, a utility model is patentable if it is new and industrially applicable. The criterion of *inventive step* is not required for a utility model, which is similar to the patenting of a utility model in both countries.

A utility model is new if a combination of its essential features is not known from the prior art. The state of the art as regards a utility model includes any information that has become generally available throughout the world before the priority date of the utility model as well as, subject to an earlier priority date, all applications for patents for utility models and inventions (other than withdrawn ones) and utility models and inventions of the same purpose patented in the respective country. In the Russian Federation, the state of the art shall also include applications for industrial designs filed prior to the priority date in the Russian Federation, and the Republic of Kazakhstan shall also include information on the use of the same means for the same purpose in the territory of the country.

A utility model shall be deemed industrially applicable when it may be produced and used in modern industry, agriculture, other sectors of the economy or social sphere and if a specific purpose is indicated in the application or follows from the name or claims of the utility model, if the indicated purpose is actually implemented and if there are known means and methods that allow to implement the utility model.

In Kazakhstan, a utility model application, unlike the Russian application, may cover one or more protected subject matter, however with the requirement of unity of a utility model. That is, it is necessary that one object is intended for receiving, implementing, using another or several objects of the same type, however with the same technical result (variants). For example, a substance or device and a process for producing it, or a process and device for carrying it out, or a process and a substance for use in a process. In a utility model application

in the Russian Federation, only one object of protection that exists for performing a single technical task may be prescribed; the unity of the utility model is also required.

The requirements for utility model application materials in both the Republic of Kazakhstan [3] and the Russian Federation [4] are almost the same and include:

- An application for a utility model patent with an indication of the authors, the applicant, their location. The authors of a utility model are individuals whose intellectual work resulted in the creation of the utility model. The applicant or applicants may be both individuals and legal entities;

- a description, including the IPC index, the title of the utility model, the area of technology to which the utility model pertains, the state of the art, a disclosure of the utility model, a list and a brief description of the drawings (for Russia, including a three-dimensional model of the device), and an example of the utility model;

- a claim of a utility model, expressing its essence, including a set of essential features, subject to the unity of the utility model, based on the description (relating to one technical solution in the Russian Federation);

- abstract, i.e. a short summary of the description including the name, scope, essence of the utility model, technical result explained in the claims, while preserving all the essential features of the independent claims;

- drawings, diagrams, pictures, necessary for understanding the essence of the utility model;

- a document of payment for the filing and registration of the application for a utility model;

- a power of attorney for the patent attorney or the applicant's representative.

The filing date of the utility model application in the Republic of Kazakhstan and the Russian Federation shall be the date of receipt by Kazpatent or Rospatent of the application, containing a utility model patent application, a description and drawings, or, if the said documents are not filed simultaneously, the date of receipt of the last of the filed documents.

Examination of the utility model application in the Republic of Kazakhstan is held within four months from the date of filing, the maximum term of examination of the utility model application on the merits in the Russian Federation is nine months from the date of completion of formal examination [3,5].

The procedure for patenting a utility model in Kazakhstan and in Russia conditionally consists of several stages. In the beginning, the applicant or patent agent shall conduct a preliminary

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information search, prepare application materials and file the application with the patent office. After the acceptance and registration of the application by the patent office, an examination of the application is carried out. The difference is that in the Republic of Kazakhstan there is a one-stage examination of the utility model application, while in the Russian Federation there is a two-stage examination - a formal examination and, if it is positive and after payment of the relevant fee a substantive examination of the application is carried out.

The sequence of patenting a utility model in the Republic of Kazakhstan and their brief description:

- the applicant or his patent representative shall conduct a preliminary information search in order to draw up a qualitative application, to study the state of the art and determine the novelty, to identify analogues, to draw up claims and indicate key features to ensure the maximum degree of protection;

- drafting by the applicant or his patent representative of the description, claims, abstract, filling out an application for filing an application for a utility model, payment of the filing fee and forwarding the application materials for registration with the patent office and obtaining a document with the priority date and application number;

- conducting an examination of the application by Kazpatent, that includes checking the presence of documents and compliance with the requirements for them, the establishment of priority date, the possibility of assigning a utility model to the objects protected as utility models, checking the unity of the utility model. Verification of the compliance of the utility model with the conditions of patentability shall not be performed and the patent shall be granted at the risk and responsibility of the applicant. If the examination is positive, the expert authority shall decide whether to grant a utility model patent [3].

The procedure for utility model patenting in the Russian Federation consists of the same first two stages as in the Republic of Kazakhstan, and the two-step examination of the utility model application is as follows:

1. the formal examination of the application is carried out by Rospatent experts, who check the availability of necessary application documents, availability of payment for the application, observance of the requirements to the application documents, including the requirements to the utility model unity, correctness of classification in accordance with the IPC;

2. substantive examination in the Russian Federation includes a patent search, examination of the patentability conditions, requirements to the unity of the utility model, examination of sufficiency of disclosure of the essence in the application documents, examination of the claims of the utility model [4].

A utility model application can be transformed into an invention application in both countries by filing a request prior to the issue of the examination report on the application.

There are differences in terms of validity of protection documents in these countries. Subject to payment of annual maintenance fees, the term of a utility model patent in the Republic of Kazakhstan is 5 years from the date of filing, the term of a patent in the Republic of Kazakhstan can be extended for 3 years on request of the patent owner, a utility model patent in the Russian Federation is valid for 10 years without the right for extension.

The fees for filing and registration of an application, for substantive examination (in the Russian Federation), for the grant and publication of a patent and for maintenance of a document of protection for legal entities in the countries are given in Tables 1 and 2. The tables do not include fees for renewal, transformation and other fees.

Table 1

Tariffs/fees for patenting a utility model application in force in the Republic of Kazakhstan and in the Russian Federation at the moment of publication of the article [6,7]

№	Name of the fee	Fee in the Republic of Kazakhstan	Name of the fee	Fee in the Russian Federation	
				Rubles	KZT <sup>1</sup>
1	Acceptance of application and conducting examination of utility model application	16450,56	Registration and formal examination of the application	1400+ 700 (for each claim over the ten)	8162+4801 (for each claim over the ten)
2	-	-	Substantial examination	2500	14575
3	Publication and issuance of the title document	33253,92	Registration and publication of the title document in digital form	3000	17490
4	-	-	Issuance of the patent in hard	2000	11660

			copy		
Comment: 1 KZT exchange rate is 5,83 Russian Rubles					

Table 2

Tariffs/fees for the maintenance of utility model patents in Kazakhstan and the Russian Federation at the moment of publication of the article [6,7]

№	Maintenance fee for each year	Annual fee for each year	Maintenance fee for each year	Fees in the Russian Federation	
		KZT		Rubles	KZT <sup>1</sup>
1	1,2,3 years	16450,56	1÷2 years	800	4664
2	4÷8 years	47855,36	3÷4 years	1700	9911
4			5÷6 years	2500	14575
5			7÷8 years	3300	19239
6			9÷10 year	4900	28567
Comment: 1 KZT exchange rate is 5,83 Russian Rubles					

**Thus**, a utility model patent is protected as an item of patent law in both Kazakhstan and Russia, and the conditions of patentability are industrial applicability and novelty, however there are a number of differences in the patenting procedure in these countries.

Thus, the objects of a utility model in accordance with the legislation of Kazakhstan are the same objects as for the invention: products, methods, use for a new purpose, and in Russia the objects of a utility model include only devices and their improvement.

In Kazakhstan, you may patent several utility model objects in one application if they form a single inventive concept; in Russia, only one object may be patented.

The procedures for the examination of applications for utility models differ. In Kazakhstan, only a formal examination of the application is carried out, there is no verification of the conformity of the utility model with the patentability conditions, and the patent is granted at the risk and responsibility of the applicant, whereas in Russia the substantive examination is carried out upon payment of the relevant fee.

There are differences in the term of validity of a title document, in Kazakhstan a utility model patent is valid for 5 years and can be extended for up to 3 years and in Russia a utility model patent is valid for 10 years without a right of extension.

**Sources:**

1. Patent Law of the Republic of Kazakhstan No.427 dated 16.07.1999 (amended as of 25.06.2020)
2. Civil Code of the Russian Federation - Part Four (amended as of 11.06.2021)
3. Rules for examination of applications for selection achievements, industrial property, trademarks and appellations of origin, registration of integrated circuit topologies, Republic of Kazakhstan, No. 1349 dated 29.08.2018 (amended as of 08.12.2020)
4. Rules for drafting, filing and reviewing documents that are the basis for legally significant actions for state registration of utility models, and their forms, Russian Federation, No. 746 dated 10.11.2020
5. Administrative regulations for the provision of the state service for state registration of a utility model and the issuance of a utility model patent, duplicate of the utility model patent by the Federal Service for Intellectual Property, Russian Federation, No. 164 dated 14.12.2020
6. Prices for works and services provided by the Kazakh Patent Office No. 254 as of 23.12.2020
7. Regulation for patent or other fees for legal actions related to a patent for invention, utility model and industrial design, Russian Federation, No. 941, amended as of 17.06.2021.