



TAGBERGENOVA Alma
Kazakhstan Patent & Trademark Attorney
Managing Partner of Agency of Intellectual Property



AGENCY OF INTELLECTUAL PROPERTY
65, Kazibek Bi str., Office 403, Almaty 050000, Kazakhstan
Tel: +7 (727) 2727709, 2611847
Fax.: +7 (727) 2503538
e-mail: tagberg@asdc.kz
www.intellectual.kz

Registration of Trademarks in Kazakhstan

Summary of the article

In accordance with the Law of the Republic of Kazakhstan “On Trademarks, Service Marks and Appellation of Origin” the procedure of a mark registration is conducted in two stages. At the first stage a preliminary examination is conducted within 2 months. The second stage is a substantive examination which is carried out within 12 months. Marks are examined for identity and confusing similarity with preliminary registered marks. Marks are also examined for distinctiveness. If by the result of the substantial examination a decision on registration of the mark is issued, the fee for a certificate issuance is paid. The fee for certificate publication and registration in Republic of Kazakhstan is united. The mark is recorded in the State Register of Marks and published afterwards. The approximate term for receiving certificate is 20 -24 months. A certificate is granted for 10 years from the date of the filing of the application and the term may be extended for the next 10 years. For the term extension it is necessary to file a request together with appropriate fee confirmation document within 12 months preceding the expiration date.



EURASIAN PATENT ATTORNEY

MODANGUL M. TAGBERGENOVA, Dipl.-Chem.

PATENT AND TRADEMARK ATTORNEYS OF KAZAKSTAN

MODANGUL M. TAGBERGENOVA, Dipl.-Chem.

ALMA T. TAGBERGENOVA, Dipl. - Eng., Lawyer

NAILYA YE. KASABEKOVA, Dipl.-Eng.

Trademark Registration in Kazakhstan

Article

In Kazakhstan the trademark examination is a verifying system, i.e. examination is conducted by Kazakhstan Patent Office.

And the trademark may be avoided for similarity after its registration only.

The principle of registration for the first application is applicable for Kazakhstan.

The rights for trademark arise with moment of trademark registration, and claim may arise by third-part right infringement, if owner have registered trademark only.

In accordance with the Law of the Republic of Kazakhstan “On Trademarks, Service Marks and Appellation of Origin” the procedure of a mark registration is conducted in two stages.

At the first stage a preliminary examination is conducted within 2 months of the relevant filing date, in order to verify the contents of the application, the presence of the required documents, their compliance and payment. If all documents were presented, a notification on admission of the trade mark (service mark) application to examination is issued.

The second stage is a substantive examination which is carried out within 12 months thereafter. Marks are examined for identity and confusingly similarity with marks previously registered trademarks. Marks are also examined for distinctiveness. If by the result of the substantial examination a decision on registration of the mark is issued, after that the fee is paid for issue of a certificate within three months after the issuance date of the decision. The fee for publication and registration of certificate in Republic of Kazakhstan is united. The mark is recorded in the State Register of Marks and published afterwards.

If examiner considers a mark is not distinctive, or confusingly similar to any previously registered or pending trademark, the Patent Office issues a provisional refusal to register the mark. In such case, the applicant is given three months to respond to such refusal. If the examiner fails to find arguments for protection convincing or sufficient Patent Office issues final refusal to the application concerned.

The final refusal may be opposed in the Board of Appeals within three months after the issuance date of the final refusal.

Kazakhstan law allows multi-class applications and admits disclaimers.

The trademark certificate is granted for 10 years from the date of the filing of the application and the term may be extended for the next 10 years. For the term extension it is necessary to file a

request together with appropriate fee confirmation document within 12 months preceding the expiration date.

It is not required to prove the use of the trademark and there is no authority controlling the use of trademarks. The trademark use problem may only arise if an interested third party appears.

Such interested party may file a cancellation request in respect of a trademark registration with the Patent Office in case the mark has not been used within three years after the registration date or in the three years preceding the filing date of the request.

The use of a trademark on goods for which it is registered and/or on the packaging thereof by the trademark owner or a person whom such right is granted on the basis of the assignment agreement for the trademark shall be deemed to constitute exploitation of the trademark. The use of the trademark in advertising, in printed publications, on official headed paper, on signs or in connection with the display of goods at exhibitions that take place in the Republic of Kazakhstan may be considered as the exploitation thereof. The evidences of the trademark use provided by his owner should be dated from the period of time specified in the objection.

Documents required for filing a trade mark application in Kazakhstan:

- 1) reproduction of the trademark (20 copies, by size 8x8 cm);
- 2) applicant's name, country/state of incorporation and address;
- 3) list of goods and services and international classes, if known;
- 4) an original Power of Attorney signed by the applicant with indication of full name and position of a signer. A Power of Attorney has to be stamped with the seal of the relevant company (We think, any stamp of a company will be enough). Notarization or legalization is not required. This document may be submitted to the Kazakhstan Patent Office within two months from the application filing date;
- 5) a certified copy of the priority application (in case of claiming the conventional priority). A copy of the priority application should be certified by the Patent and Trademark Office. Notarization or legalization of the copy of the priority application is not required. This document may be submitted to the Kazakhstan Patent Office within two months from the application filing date.

TAGBERGENOVA Alma
Kazakhstan Patent & Trademark Attorney