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Kazakhstan

INTELLECTUAL PROPERTY

Contributor

Legalmax Law Firm

legalmax

Kamshat Yerkinalikyzy

Associate | k.yerkinalikyzy@legalmaxlaw.com

Galina Vorozheikina

Associate | galina.vorojeikina@legalmaxlaw.com

This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in Kazakhstan.

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KAZAKHSTAN

INTELLECTUAL PROPERTY



1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

a) Patent Office of Kazakhstan accept applications for inventions, utility models, industrial designs and selections inventions:

b) Trademark Office of Kazakhstan accept applications for trademarks, service marks, geographical indications and appellations of origin.

Design, word, digital, three-dimensional and other designations or their combinations, allowing to distinguish the goods and services of one person from similar goods or services of another person, may be registered as a trademark. A trademark can be registered in any color or color combination.

c) Trademark Office of Kazakhstan accept also applications for different types of copyrights and integrated circuit topography.

2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of

registered rights in appropriate circumstances?

An invention patent is valid for twenty years from the date of application with the possibility for extension for term of five years.

A selection invention for plant varieties is valid for twenty-five years, for animal breeds for thirty years, for grape varieties, tree decorative, fruit and forest crops, including their rootstocks for thirty-five years from the date of application. The term of the patent may be extended at the request of the patent holder, but not more than ten years.

A utility model patent is valid for five years from the date of application with the possibility for extension for term of three years.

A patent for an industrial design is valid for ten years from the date of application with the possibility for extension with the total validity period of the patent not exceeding twenty-five years from the date of filing the application.

Trademark is valid for ten years from the date of application with the possibility for extension for term of additional ten years without maximum term.

The extension of each intellectual property rights is processed by filing the request with the local Trademark and Patent Office of Kazakhstan.

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

(a) Patents

The first owner is the inventor and patent owner. The rights for patent created under employment agreement are agreed by a special agreement.

The first owner of a plant variety right is the person who bred or discovered and developed the variety. The right can be assigned.

(b) Trademarks

The first owner of a registered trademark is the entity in whose name it is registered. For trademarks created in the course of employment, regulations in the employment contract may apply.

(c) Copyrights

The first owner of is its creator. Where a copyright is developed by an employee in the execution of his/her duties or following the instructions given by the employer, the right to copyrights shall vest in the employer, unless otherwise provided by contract.

The first owner of an integrated circuit topography is its creator. Where an integrated circuit topography was developed by an employee in the execution of his duties or following the instructions given by his employer, the right to the topography shall vest in the employer, unless otherwise provided by contract.

4. Which of the intellectual property rights described above are registered rights?

Inventions, utility models, industrial designs, selections inventions, trademarks, service marks, geographical indications, appellations of origin, copyrights and integrated circuit topography are registered rights in Kazakhstan.

5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

Inventions, utility models, industrial designs, selections inventions, trademarks, service marks, geographical indications, appellations of origin and integrated circuit topography can be applied for registration by an individual or juridical entity. Copyrights can be filed only by an individual.

The application for registration of these intellectual property rights should be filed with the expert organization created by the decision of the Government of the Republic of Kazakhstan in the organizational and legal form of the republican state enterprise under the law of economic management – the National Institute of Intellectual Property. The applications are filed in accordance with Laws regulated each type of intellectual property rights.

6. How long does the registration procedure usually take?

The term of registration takes the period stipulated by the Laws regulated each type of intellectual property rights.

The term of registration takes:

- 14-16 months for invention and design;
- 8-9 months for utility model and trademarks.

7. Do third parties have the right to take part in or comment on the registration process?

Opposition procedure is stipulated by the Law only for registration process of trademarks. Any interested person can file opposition against registration of the applied designation as a trademark to the expert organization within one month from the date of publication of the information about the application.

8. What (if any) steps can the applicant take if registration is refused?

An applicant can file opposition against refusal on registration of his intellectual property rights within the period of three months. Oppositions are filed with the bodies stipulated by the Laws regulated each type of intellectual property rights.

9. What are the current application and renewal fees for each of these intellectual property rights?

Payments of official tariffs for registration of intellectual property rights are carried out according to approved prices for work and services provided by the Republican State Enterprise “National Institute of Intellectual Property” of the Republic of Kazakhstan.

Official fees are published at the official website of the National Institute of Intellectual Property at the following link:

https://qazpatent.kz/sites/default/files//ceny_-_rus._variant_2022_eng.pdf

10. What are the consequences of a failure to pay any renewal fees and what (if any)

steps can be taken to remedy a failure to pay renewal fees?

Failure to pay the renewal fees in time will lead to a loss of rights for intellectual property. The renewal fees can be paid within a grace-period of 6 months from the renewal due date for trademarks paying additional fee for restoration of the registration.

11. What are the requirements to assign ownership of each of the intellectual property rights described above?

To assign ownership for inventions, utility models, industrial designs, selections inventions, trademarks, service marks, geographical indications owner and assignee should conclude an assignment deed and record it with the National Institute of Intellectual Property for national registrations and record special form with WIPO for international registrations.

Copyright ownership is not transferrable.

12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Recordation of assignment deed is obligatory in Kazakhstan which is registered with the Expert organization of Republic of Kazakhstan for national registration and with WIPO for international registrations. The exclusive right to the trademark may be registered in relation to all goods (services) or parts of them. Failing to record the assignment deed will lead to cancelation of registration due to its non-use.

13. What are the requirements to licence a third party to use each of the intellectual property rights described above?

To record a license with a third party to use the rights for inventions, utility models, industrial designs, selections inventions, trademarks, service marks, geographical indications owner and licensee should conclude license agreement and record it with the National Institute of Intellectual Property.

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the

consequence of failing to register?

The owner has the right to transfer to a third party the right to the intellectual property rights on the basis of a license agreement. Recordation of license is obligatory in Kazakhstan which is registered with the Expert organization of Republic of Kazakhstan. This applies to patents, utility models, trademarks. Failing to record the license will lead to cancelation of registration due to its non-use.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

According to the legislation of Kazakhstan, exclusive rights are vested solely in the rights holder, and when necessary, the rights holder can grant the right to enforce these rights through a power of attorney, including to the licensee.

16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

Regarding inventions, utility models, industrial designs there are criminal sanctions for disclosure without the consent of the author or applicant of the essence before the official publication of information, attribution of authorship or coercion to co-authorship or illegal use of the Patent.

Unlawful actions are considered as Illegal use of the objects of copyright and attribution of authorship or compulsion to co-authorship.

Concerning trademarks, criminal sanctions are for illegal use of someone else's trademark or similar designations for similar goods and services.

17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.

The legislation of the Republic of Kazakhstan establishes three types of legal liability for the infringement of

exclusive rights: administrative, criminal, and civil.

Administrative responsibility

Trademarks: Administrative liability is provided for the illegal use of someone else's trademark.

The guilty person is obliged to pay a fine up to 600 USD.

Criminal liability

Trademarks: In Kazakhstan, criminal penalties are provided for illegal use of someone else's trademark or similar designations for similar goods and services;

In particular, criminal liability occurs only in the case of damage in the amount of more than 15 000 USD. The penalty is a fine of 600 USD, correctional labor, community service for up to 80 hours or arrest for up to 20 days.

Copyright: The norms of the Criminal Code of the Republic of Kazakhstan establish penalties for the illegal use of copyright objects, transfer or manufacture of counterfeit for the purpose of sale or attribution of authorship or coercion to co-authorship.

The guilty person is obliged to pay a fine up to 520 USD or correctional labor or community service for up to eighty hours.

Inventions, utility models, industrial designs:

Criminal penalties are provided for disclosure without the consent of the author or the applicant of the essence of the Patent before the official publication of information about them, attribution of authorship or coercion to co-authorship or illegal use of above-mentioned objects are criminally punishable act.

The guilty person may be punished by a fine in the amount of 650 USD and depending on the nature of the offense, in some cases with restriction of liberty up to 6 years.

Civil liability

Trademark: Civil liability for violation of trademark for unlawfully use a trademark.

Inventions, utility models, industrial designs: unauthorized manufacture, application, import, storage, as well as the use of a protected method or the introduction into civil circulation of a product manufactured directly by a protected person is recognized as a violation of the exclusive right of the patent owner.

The Patent Owner, has the following rights:

- To recover the income received by the infringer of the Patent, instead of compensation for losses;
- Payment of compensation by the infringer of the Patent.

Department Justice of the Republic of Kazakhstan

On the basis of the application, the judicial authorities draw up protocols on cases of administrative offenses, officials of the judicial authorities, including those authorized to issue a decree on the confiscation of an object that was the subject of an administrative offense.

As a result, the Judicial Body has the authority to issue a resolution on prevention, imposition of an administrative fine, confiscation of an object, deprivation of a permit or suspension of its operation, suspension or prohibition of activity.

Agency for Protection and Development of Competition of the Republic of Kazakhstan.

In cases where there is an imitation of a trademark, as well as the possibility of misleading consumers, one of the means of legal protection of trademark rights may be filing an application with the Antimonopoly authority in respect of violation of antimonopoly legislation.

Based on the results of consideration of the application and other case materials, the Antimonopoly Authority issues an order to eliminate violations.

18. What is the length and cost of such procedures?

The term of consideration of civil and administrative cases in the court of first instance is usually 3-4 months. As for the terms of consideration of applications, it usually takes from 1 to 2 months in the Department of Justice and the Antimonopoly authority. Criminal case, is considered within 1-2 months.

19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.

In Kazakhstan, disputes related to intellectual property are handled by the following types of courts:

Specialized administrative courts: These courts deal

with cases involving intellectual property violations that fall under administrative offenses. They make decisions on imposing administrative fines and sanctions in cases of infringement of copyright, trademarks, and other aspects of intellectual property.

Specialized economic courts: These courts address civil disputes related to intellectual property as well as criminal disputes. This includes lawsuits for rights protection, regulation of licensing relationships, as well as compensation for damages in cases of intellectual property rights infringement and copyright infringement.

All proceedings consist in the sequential passage of the following main stages:

Filing the Claim: The process begins when the plaintiff submits a statement of claim or petition to the relevant court. This document outlines the plaintiff's demands and the basis for the legal action.

Preliminary Hearing: In some cases, a preliminary hearing may be held to discuss procedural matters and clarify any initial issues. It usually takes 20-30 minutes and usually via video.

Court Hearings: The court conducts hearings where both parties present their arguments, evidence, and witnesses.

Mediation: The court may suggest or require mediation to encourage the parties to reach a settlement.

Deliberation and Judgment: The judge reviews the evidence, arguments, and legal provisions before making a decision. The judgment usually issued immediately after the hearing.

Appeal

The appeal, the prosecutor's petition filed through the court that issued the decision. An appeal, a prosecutor's petition may be filed within one month from the date of the final decision.

Judicial acts of local and other courts that have entered into legal force, in case of non-compliance with the appeal procedure for their appeal, may be reviewed in cassation by the Supreme Court.

20. What customs procedures are available to stop the import and/or export of infringing goods?

Including intellectual property objects in the Customs Register is effective if counterfeit goods are

imported/exported to Kazakhstan from any country but not the member of Eurasian Economic Union.

Trademark may be registered with the Customs Register for a period indicated by the right holder, but not more than **2 years**.

Once a suspected shipment is detected by customs, the latter suspend the shipping and sends written notification the right holder's representative.

The right holder is given **10 business days** for reaction to the notification:

- 1) to issue letter on release of suspended goods;
- 2) to initiate proceedings against illegal import and destroy the goods based on court's decision;

21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

No

22. What options are available to settle intellectual property disputes in your jurisdiction?

In and out-of-court settlements

23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

The owner or their representative must provide evidence that can establish the unauthorized manufacturing, usage, import, storage, offering for sale, sale, or other introduction into civil circulation of a product created using a protected industrial property object.

24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the

parties, and/or parties' expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

a) In Kazakhstan, when necessary, a court may involve an impartial party possessing specialized knowledge and skills to participate in judicial proceedings as an expert. The purpose of this involvement is to assist in the collection, examination, and evaluation of evidence by providing consultations (explanations) and aiding in the application of scientific and technical means.

b) Civil litigation operates on an adversarial basis, where the involved parties vie against each other for the court's verdict in their favor, setting boundaries on collaboration. Nevertheless, the court possesses the authority to require the disputing parties to engage in transparent contention and unveil all evidence pertinent to the case, both beneficial and detrimental to their positions. The refusal of the alleged party to the dispute to provide documents may be the basis for applying to the court in order for it to oblige the party to the dispute to provide documents, even if the case has not been initiated.

25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

Every party participating in the case is responsible for substantiating the facts upon which it bases its claims and arguments. A party involved in the case, unable to independently acquire essential evidence, retains the privilege to file a motion with the court, requesting the acquisition of said evidence from another individual, whether or not they are involved in the case.

Cross-examination in criminal cases is available in the Kazakh judicial system.

26. What defences to infringement are available?

Possible defences encompass a range of options as follow:

- including demonstrating non-infringement, absence of similarity;
- establishing prior use before registration,
- proving non-use,

- challenging the validity of intellectual property rights
- private use.

27. Who can challenge each of the intellectual property rights described above?

Any interested party can challenge intellectual property rights.

28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

Trademarks: Registration of a trademark may be challenged and invalidated in whole or in part during the entire validity period if it is made in the name of a representative of the owner of an identical or confusingly similar trademark in one of the participating countries of the Paris Convention for the Protection of Industrial Property. Also, registration of a trademark may be challenged and invalidated in whole or in part if the trademark is identical or confusingly similar in respect of similar goods or services with the brand name of another person, the exclusive right to which in the Republic of Kazakhstan arose earlier.

Copyright: Cancellation of information from the Register is made at the request of the author and on the basis of a court decision.

Patents for inventions, utility models, industrial designs: Patents are invalidated in whole or in part on the basis of a court decision. More details in section 29.

29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?

Trademarks

A trademark certificate may be invalidated on absolute and relative grounds both in a pre-trial procedure by applying to the Appeal Board of the Ministry of Justice.

Any interested person can challenge the registration of a trademark in court due to its non-use for three years. At the same time, an interested person means a person whose rights and legitimate interests have been

violated.

Patents

The validity of a patent may be challenged in full or in part of its legal protection at any time on the following grounds:

- non-compliance of the protected object of industrial property with the conditions of patentability;
- insufficient disclosure of the essence of the invention in the application materials;
- the presence in the claims or in the totality of essential features of an industrial design of features that were absent in the original application materials.

The validity of a patent may be challenged by applying Appeal Board of the Ministry of Justice. Pre-trial consideration of these objections is mandatory.

30. Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?

The potential for issuing a compulsory license is outlined in Article 11 of the Republic of Kazakhstan's Patent Law. The decision to grant a compulsory license in Kazakhstan is addressed by the court through legal proceedings.

31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

The available courses of action in the event of intellectual property rights infringement are as follows:

- Termination of the illegal use of the trademark;
- Compensation to the trademark owner for the

losses incurred;

- Removal of a designation confusingly similar to the trademark of the copyright holder from the remnants of counterfeit goods.
- The offender may be fined
- Confiscation of goods containing an illegal image of a trademark or designations similar to it to the extent of confusion
- Destruction of copies of counterfeit goods
- Brought to responsibility in the form of correctional labor or community service for up to eighty hours, or arrest for up to 20 days

32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?

The expenses that can be recovered from the party found at fault are typically determined either through a court assessment or by calculating the profits obtained by the infringing party. Reimbursement for court-related expenditures is feasible solely when such costs have been prepaid and substantiated with proper documentation. The expenses associated with the execution of legal decisions encompass legal fees incurred for guiding the enforcement process and collaborating with official enforcement agents.

33. The Unified Patent Court ("UPC") [came into] [will come into] existence in certain European states on 1 June 2023, as did the introduction of European patents with unitary effect ("unitary patents"). Have industry-specific trends developed in your country in terms of the number of patent applicants seeking unitary patent protection and/or enforcing European patents or unitary patents before the UPC?

N/A

Contributors

Kamshat Yerkinalikyzy
Associate

k.yerkinalikyzy@legalmaxlaw.com



Galina Vorozheikina
Associate

galina.vorojeikina@legalmaxlaw.com

