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## **Patent law of the Republic of Kazakhstan**

The Law of the Republic of Kazakhstan of 16 July, 1999 # 427

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#### **Chapter 1. General provisions**

##### **Article 1. Basic definitions used in this Law**

The following basic definitions are used in this Law:

1) “the exclusive right” means a property right of the patent owner to use the industrial property subject matter in any manner at his sole discretion;

2) “bulletin” means an official periodical on the protection of industrial property subject matter;

2-1) “Eurasian application” means an application filed in accordance with the Eurasian Patent Convention of 9 September 1994;

3) “intellectual property subject matter” means the results of intellectual activity and the means of ascertainment of participants in economic turnover, goods, works, and services;

4) “titles of protection” include innovation patents, patents for inventions, industrial design patents and utility models patents granted in conformity with this Law;

5) **excluded by the Law of the RK of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication);**

6) “license contract” means a contract under which the patent owner (the licensor) grants another party (the licensee) the right to temporarily use the industrial property subject matter in a particular manner;

7) “industrial property subject matter” means inventions, utility models and industrial design;

7-1) official industrial property subject matter – inventions, utility models, industrial designs created by an employee in the performance of his duties or specific tasks of the employer;

8) The Paris Convention means Paris Convention for the Protection of Industrial Property of March 20, 1983, with all further amendments and supplements.

9) “patent owner” means an owner of the title of protection;

10) “conditions of patentability” mean requirements provided for by this Law for the grant of legal protection for industrial property subject matter;

11) “patented industrial property subject matter” means an industrial property for which a title of protection has been granted;

12) “patent attorneys” means the citizens of the Republic of Kazakhstan, which in accordance with the legislation of the Republic of Kazakhstan have the right to represent individuals and legal entities to the authorized body and expert agency;

13) “international application” means an application filed under the Patent Cooperation Treaty of 19 June 1970.

**Footnote. Article 1 as amended by the Law of the Republic of Kazakhstan of 02.03.2007 # 237 (the act is entered into force since the day of its official publication); as amended by the laws of the Republic of Kazakhstan of 10.07.2012 # 34-V (the act is entered into force since the day of its official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

## **Article 2. Relations governed by the Patent Law**

1. This Law shall regulate property and property related personal non-property relations, arising in connection with the creation, legal protection and use of industrial property subject matter.

2. Protection of other intellectual property subject matter (e.g. selection inventions, topographies of integrated circuits, trademarks, service marks, appellations of origin and other) shall be regulated by other legislative acts.

## **Article 3. Scope of Application of this Law**

1. The provisions of this Law shall apply to industrial property subject matter, the titles of protection for which have been granted by the authorized body, as well as to industrial property subject matter, the patents for which have been granted under international treaties to which the Republic of Kazakhstan is party.

2. If an international treaty ratified by the Republic of Kazakhstan establishes rules other than those which are contained in this Law, the rules of the international treaty shall be applied.

**Footnote. Article 3 is introduced changes by the Law of the Republic of Kazakhstan 9 July, 2004 # 586.**

#### **Article 4. State authorized body in the sphere of protection of inventions, utility models, and industrial designs**

1. The state authorized body in the field of protection of inventions, utility models, and industrial designs (hereinafter referred to as “the authorized body”) is a state body, authorized by the Government of the Republic of Kazakhstan and exercising the state regulation in the field of protection of inventions, utility models, and industrial designs.

2. The competences of the authorized body include:

- 1) participation in the implementation of the state policy in the field of legal protection of inventions, utility models, and industrial designs;
- 2) granting the titles of protection for inventions, utility models, and industrial designs;
- 3) controlling the activities of individuals and legal entities that use industrial property subject matter;
- 4) drawing up the protocols and considering the administrative cases, imposing the administrative sanctions;
- 5) performing other powers provided for by this Law, other laws of the Republic of Kazakhstan, and acts of the President of the Republic of Kazakhstan and the Government of the Republic of Kazakhstan.

**Footnote. Article 4 as amended by the Law of the Republic of Kazakhstan of 09.07.2004 # 586; ); as amended by the laws of the Republic of Kazakhstan of 05.07.2011 # 452-IV (the act is entered into force since 13.10.2011).**

#### **Article 4-1. State monopoly in the field of protection of inventions, utility models, and industrial designs**

1. The activities on receipt and examination of the applications for inventions, utility models and industrial designs, on preparation of the documents for the grant of the titles of protection, on publication of the particulars of the grant of the protection titles, on exercising the functions in maintenance of the titles of protection in force, on examination of documents for the cession of the titles of protection and the right to acquire them, as well as of licensing (sublicensing) contracts, on maintenance of the State register of inventions, utility models, and industrial designs, including the receipt of applications claiming to the conventional priority after the established deadlines; the transfer of an international application into national phase; the formal examination; the substantive examination in addition for each independent claim in excess of one; the extension and restore of the time limits of furnishing the response to the request of examination and payment; the conversion of the application for an invention application or for utility model application; the consideration of an application involving the applicant; the extension of the time limits for submitting the translations of application documents in Kazakh and Russian languages; the extension of deadlines for submitting the requested documents for each month up to twelve months from the date of expiry of the deadline, the renewal of the time limits for the submission of translation; making the amendments to the application materials, the title of protection, the state register of inventions, utility models, and industrial designs; making the same-type amendments; processing, checking and sending the international and Eurasian applications, carrying out the state-of-art search so as to assess the patentability of an invention, utility model and industrial design; granting an author's authentication document and its appendix as well as the duplicates; maintaining in force, the extension and restore of the validity of the title of protection and publication of data relating to maintaining in force, extension and restore of the deadlines of the title of protection; receiving an application for registration of the examination of franchising contract in respect of one and a group of industrial property subject matter; publication of data relating to the registration of contracts; the examination of additional agreements;

receiving an application for submitting an open license; providing a statement from the state register of inventions, utility models, and industrial designs; realization and publication of printed and electronic sources; examination of pledge agreements; shall fall into the state monopoly and shall be performed by the expert agency, established by the decision of the Government of the Republic of Kazakhstan in the legal form of the republican state enterprise with self-management rights.

2. The activities, technologically related to the activities of the expert agency are:

1) making a copy of the application (priority document), copies of application materials, copies of cited documents, presenting the certificates, statistical data on the titles of protection;

2) transfer and confirmation of payments.

3. Prices of goods (works, services) produced and (or) sold by the subjects of state monopoly shall be set by the authorized body in agreement with antimonopoly agency.

**Footnote.** Was completed with article 4-1 according to the Law of the RK of 9 July, 2004 # 586; as amended by the Law of the Republic of Kazakhstan of 10.07.2012 # 34-V (the act is entered into force in ten calendar days after its first official publication); as amended by the laws of the Republic of Kazakhstan of 29.09.2014 # 239-V (the act is entered into force in ten calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).

#### **Article 5. Legal protection of the industrial property subject matter**

1. The rights on invention, utility model, and industrial designs shall be protected by patent.

2. An utility model patent shall be granted based on the results of examination of the application for utility model patent.

A patent for an invention or industrial design shall be granted after the formal examination and substantive examination of the application.

Patent shall certify the priority, authorship and exclusive rights to the industrial property subject matter.

3. A patent for an invention shall be valid for twenty years from the date of filing the application.

In respect of inventions relating to medicinal products, pesticide (chemical), which requires obtaining permits in the order prescribed by the legislation of the Republic of Kazakhstan on permissions and notifications, the period of validity of the exclusive right and a patent proving it may be extended at the request of the patent owner, but not more than five years. The specified period is extended by the time elapsed from the filing date of the patent for the invention before the date of the first authorization to use the invention for less than five years.

A patent for a utility model shall be valid for five years from the date of filing the application. Its validity can be extended upon the request of the patent owner for not more than three years.

An industrial design patent shall be valid for fifteen years from the date of filing the application. Its validity can be extended upon the request of the patent owner for not more than five years.

Procedure for extending the term of a patent for an invention, utility model and industrial design shall be established by the authorized body.

4. The scope of the legal protection conferred by a title of protection for an invention or utility model shall be determined by the claims, and the scope of the legal protection conferred by an industrial design patent shall be determined by sum of its essential features as shown on the representations of the article and outlined in the list of the industrial design's essential features. The description and drawings may be used to interpret the claims of an invention or utility model.

The effect of a protection document granted for a method for obtaining a product shall apply to the product directly obtained by this method.

Therewith, unless proven otherwise, a new product shall be considered as obtained by the protected method.

5. The right to be granted a title of protection, the rights arising from the registration of the application, the right to possess the title of protection and the rights under the title of protection may be transferred in whole or in part to another person.

6. No legal protection shall be granted under this Law for the industrial property subject matter that has been declared secret by the State. The procedure for handling the secret industrial property subject matters are to be determined by the authorized body.

**Footnote. Article 5 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 02.03.2007 #237 (the act is entered into force since the day of its official publication); of 12.01.2012 # 537-IV (the act is entered into force in ten calendar days after its first official publication); of 29.09.2014 # 239-V (the act is entered into force in ten calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

## **Chapter 2. Conditions of patentability of industrial property subject matter**

### **Article 6. Conditions of patentability of inventions**

1. An invention shall be granted legal protection if it is new, involves an inventive step and capable of being industrially applicable.

An invention shall be deemed new if it is not anticipated by prior state of art.

An invention shall involve an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

The state of the art shall consist of any kind of information published anywhere in the world, and made available to the public, before the priority date of the invention.

When the novelty of an invention is being determined, the state of the art shall also include, upon the condition of their earlier priority, all applications filed in the Republic of Kazakhstan by other applicants for inventions and utility models (except for the revoked ones), and inventions and utility models that have been patented in the Republic of Kazakhstan.

An invention shall be deemed industrially applicable if it can be used in industry, agriculture, public health and other sectors of the economy.

2. Such technical solutions of any field that relate to the product (a device, substance, microorganism strain, the culture of plant cells or animals), method (the process of affecting a material object using material resources), as well as the application of known product or process for a new purpose, or the use of a new product for a particular purpose shall be protected as an invention.

3. The following shall not be recognized as patentable inventions:

- 1) discoveries, scientific theories and mathematical methods;
- 2) methods of organization and management of economy;
- 3) symbols, schedules, rules;
- 4) rules and methods of performing the mental activities, conducting the games;
- 5) computer software and algorithms;
- 6) projects and plans for structures, buildings, territories;
- 7) proposals concerning solely the outward appearance of manufactured articles;
- 8) proposals that are contrary to public interest, humanitarian principles or morality.

4. Public disclosure of information, relating to the invention, by the author (applicant) or any person having obtained the information directly or indirectly from them, including the demonstration of an invention as an exhibit at an official or officially recognized international exhibition organized in the state-party to the Paris Convention, shall not be deemed as affecting the patentability of the invention, if the application for the invention was filed within six months after said disclosure of information or displaying it at the exhibition. The burden of proof of the foregoing shall be on the applicant.

**Footnote. Article 6 as amended by the laws of the Republic of Kazakhstan of 02.03.2007 # 237 (the act is entered into force since the day of its official publication); of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication).**

#### **Article 7. Conditions of patentability of utility model**

1. An utility model include the technical solutions in any field related to the product (device, substance, strain of a microorganism, plant or animal cell culture), method (the process of affecting a material object using material resources), as well as the application



of known product or process for a new purpose, or the use of a new product for a particular purpose, except for diagnostic, therapeutic and surgical methods for treatment of humans or animals.

A utility model shall be granted a legal protection if it is new and capable of being industrially applicable.

A utility model shall be new if the sum of its essential features is not anticipated by prior state of art.

The state of the art shall include any kind of information published anywhere in the world and made available to the public, before the priority date of the claimed utility model, concerning the instruments of similar function, as well as on condition of their earlier priority submitted in the Republic of Kazakhstan, applications filed for inventions and utility models (except for the revoked ones), and inventions and utility models of similar function that have been patented in the Republic of Kazakhstan.

A utility model shall be considered industrially applicable if it can be practically used.

2. Public disclosure of information, relating to the utility model, by the author (applicant) or any person having obtained the information directly or indirectly from them, including the demonstration of a utility model as an exhibit at an official or officially recognized international exhibition organized in the state-party to the Paris Convention, shall not be deemed as affecting the novelty of the utility model, if the application for the utility model was filed within six months after said disclosure of information or displaying it at the exhibition. The burden of proof of the foregoing shall be on the applicant.

3. No legal protection shall be granted to the subject matter specified in the paragraph 3 of article 6 of this Law.

**Footnote. Article 7 as amended by the Law of the Republic of Kazakhstan of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

## **Article 8. Conditions of patentability of industrial designs**

1. 1. Art and design products of industrial or small-scale artisan industry that determines the appearance of the product relates to the industrial design. Industrial design

shall be granted legal protection if it is new, original. An industrial design is new if the sum of its essential features, reflected in images of products and listed in the list of essential features of the industrial design is not known from information in the public domain in the world before the priority date of the industrial design. When establishing the novelty of an industrial design takes into account previously filed in the Republic of Kazakhstan by others unrevoked applications for identical designs, as well as patented in the Republic of Kazakhstan industrial designs (from the date of priority). Industrial design recognizes the original if its essential features determine the creative nature of the product's characteristics.

2. The following solutions shall not be recognized as patentable industrial designs:

- 1) solutions that are determined exclusively by the technical function of an article;
- 2) solutions that relate to architectural works (with the exception of minor architectural forms) and industrial, hydraulic and other stationary structures;
- 3) **excluded by the Law of the RK of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication);**
- 4) solution that relate to subject matter of unstable shape such as liquids, gaseous and dry substances and the like;
- 5) articles that are contrary to the public interest, humanitarian principles or morality.

3. Public disclosure of information, relating to the industrial designs, by the author (applicant) or any person having obtained the information directly or indirectly from them, including the demonstration of an industrial design as an exhibit at an official or officially recognized international exhibition organized in the state-party to the Paris Convention, shall not be deemed as affecting the patentability of the industrial designs, if the application for the industrial design was filed within six months after said disclosure of information or displaying it at the exhibition. The burden of proof of the foregoing shall be on the applicant.

**Footnote. Article 8 as amended by the Law of the Republic of Kazakhstan of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official**

publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).

### **Chapter 3. Authors and patent owners**

#### **Article 9. Author of industrial property subject matter**

1. An individual whose creative work resulted in industrial property subject matter shall be recognized as the author thereof.

2. Where an industrial property subject matter results from joint creative work of two or more individuals, those persons shall be recognized as the joint authors thereof. The conditions for exercising author's rights shall be determined by an agreement between them.

Individuals shall not be recognized as joint authors where they have not made a personal creative contribution to the industrial property subject matter, but have simply given the author technical, organizational or material assistance or helped him in securing the legal rights in the industrial property subject matter or in using it.

3. The authorship right shall be an inalienable personal right and shall enjoy the protection interminably.

4. Excluded by the Law of the RK of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).

5. Authors of the most important and widely used inventions can be presented for the title of "Distinguished Inventor of the Republic of Kazakhstan". Rules for granting the title "Distinguished Inventor of the Republic of Kazakhstan" are determined by the authorized body.

Footnote. Article 9 as amended by the Law of the Republic of Kazakhstan of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication); of 29.09.2014 # 239-V (the act is entered into force in ten calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).

#### **Article 10. Patent owner**

1. A title of protection shall be granted to:

- 1) the author (or authors) of the industrial property subject matter;
- 2) the employer in cases provided for by paragraph 2 of this article;
- 3) their successor (or successors) including the assignee (or assignees);
- 4) the beneficiaries provided for in this paragraph jointly subject to agreement between them.

2. The right to obtain a title of protection for service industrial property subject matter shall belong to the employer, unless otherwise provided for in the contract between him and the employee.

3. The right to obtain a title of protection for invention, utility model and industrial design, shall belong to the author where the invention, utility model and industrial design created by him is not associated with the performance of his personal duties or specific tasks received from the employer, but with the use of information as well as technical and other means of the employer, unless otherwise provided for by the contract between the author and employee.

In the event when a service industrial property subject matter results from joint creative work of two or more persons, which include a person who is not an employee of the employer, the right of such person in respect of the service industrial property subject matter shall be defined by the contract concluded with the said employer, and other authors.

In the event that the service industrial property subject matter are created by authors as a result of joint work of two or more employers on the basis of an agreement, the rights of the employers for the said service industrial property subject matter shall be determined by the agreement between them.

4. In the event of creating a service industrial property subject matter an author is to notify in writing the employer about the said fact within one month from the date of revealing by him a created industrial property subject matter.

Notifications are to be signed by the author (or authors) and shall contain the following information:

- 1) the author's family name, first name and patronymic (if any), and his occupation;

- 2) the name of the service subject of industrial property;
- 3) the conditions and place of its creation, the intended use;
- 4) a description that has been drawn up fully enough and is capable of revealing an invention, defining its category and assessing the applicability of an industrial property subject matter in the employer's activities.

The employer shall be obliged to accept and register the notification filed by the author about the creation of the service industrial property subject matter on the date of submission, and the authors shall be notified in writing in this regard.

If the description and other information required for the registration of application are not sufficient, the employer shall have the right to request from the employee additional materials about the service industrial property subject matter, which are to be provided within one month from the date of receipt of such request. In this case, the deadline specified in paragraph 7 of this article shall be suspended and resumed upon receipt of the requested information.

5. If an employer has not been notified by the employee of the service industrial property subject matter for which the employer has the right to be granted a title of protection, the deadline specified in paragraph 7 of this article shall begin from the date when the employer became aware of its creation.

If the fact of creation of the service industrial property subject matter is found by an employer he shall be obliged to notify in writing the author. Therewith, if the right to be granted a title of protection for service industrial property subject matter belongs to the employer, the employer shall notify the author of launching the application, and the author shall, upon the request of the employer, provide in writing additional information required to process an application for a service industrial property subject matter, as well as the list of authors.

6. In the event that the employer failure in obtaining a title of protection for a service industrial property subject matter after filing an application or to maintain the title of protection in force he shall timely notify the author in writing about it and free give the author the right to be granted a title of protection or the received title of protection.

7. Where the employer, within four months after having been notified by the author, fails to file an application, fails to assign his rights to file an application to another person, and fails to notify the author of his decision to keep the industrial property subject matter secret, the author shall have the right to be granted a title of protection. In this case, the employer has the priority right to use the corresponding industrial property subject matter in own production under contract with the patent owner.

8. Neither party in order to secure their rights in respect of the service industrial property subject matter shall be entitled to file an application to be granted a title of protection before the expert agency unless has notified of this the other party.

9. 9. The size, terms and procedure for payment of remuneration to the author for a service invention, utility model or industrial design shall be determined by agreement between him and the employer. If it is impossible to measure the contribution of the author and the employer in the creation of a service invention, utility model or industrial design, size, terms and procedure for payment of remuneration to the author shall be determined by legislative acts of the Republic of Kazakhstan.

**Footnote. Article 10 as amended by the Law of the Republic of Kazakhstan of 10.07.2009 # 179-IV (order of enforcement see Article 2 of the Law); as amended by the laws of the Republic of Kazakhstan of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication); of 31.10.2015 # 382-V (the act is entered into force in ten calendar days after its first official publication).**

#### **Chapter 4. The exclusive right to use industrial property subject matter**

##### **Article 11. The exclusive right and obligations of patent owners**

1. The exclusive right to use at his discretion the protected industrial property subject matter shall belong to the patent owner.

The patent owner shall exercise the exclusive right to use the protected industrial property subject matter during the validity of title of protection from the date of publication in official bulletin the information on granting the title of protection.

2. The use of industrial property subject matter shall be deemed to include the manufacture, use, import, and offer for sale, sale, and any other form of distribution for

commercial purposes or stocking for above purposes of products containing the industrial property subject matter, and the use of the protected method.

A protected invention or utility model shall be deemed used in a product, and a protected method shall be deemed applied, if the product contains or the process involves every essential feature of the invention or utility model stated in an independent claim, or an equivalent feature known as such in this art at the date of start of the use.

A using of protected method of preparing the product shall be deemed the introduction into civil circulation or storage of product manufactured for this purpose directly made by virtue of this method.

A protected industrial design shall be deemed used in an article, if such article contains all essential features of the industrial design, appeared in the representations of the article and listed in the list of essential features of the industrial design.

3. A patent owner shall be required to use industrial property subject matter.

The relations in regards the use of industrial property subject matter, the title of protection for which belongs to two or more persons, shall be determined by the agreement between them. Where no such agreement exists, each of the patent owners shall be entitled to use the patented industrial property subject matter at his discretion, but shall not have a right to grant a license on the title of protection or assign the title of protection to another person without the consent of other owners.

A patent owner shall have the right to use a warning sign indicating that the industrial property subject matter is patented.

4. In the event that an industrial property subject matter has failed be continuously used by the patent owner and his refusal to conclude a license agreement on reasonable commercial terms and conditions within ninety calendar days from the date of the request, any person may apply to the Court to grant him a compulsory non-exclusive license, if the industrial property subject matter has not been continuously used since the first publication of the particulars of the grant of the title of protection for industrial property subject matter during any three years preceding the date of the filing of such application. If the patent owner fails to prove that the non-use is caused by valid reasons, the court shall grant the

said license determining the scope of the use, and terms, the amount and procedures of payment. The amount of payment shall not be lower than the market value of the license to be determined in accordance with the established practice.

Compulsory non-exclusive license is also issued in the following cases:

- 1) the need to ensure national security or protection of public health;
- 2) patent owner abuse his exclusive rights, promotion or abusement of such exclusive rights by another person with his consent.

Assignment in accordance with the provisions of this paragraph, a compulsory non-exclusive license to use the invention relating to semiconductor technology, allowed solely for its non-commercial use in State and public interests or modify provisions which judicially recognized violating the requirements of legislation of the Republic of Kazakhstan in the field of competition.

Any compulsory non-exclusive license shall be issued primarily to meet the needs of the domestic market of the Republic of Kazakhstan, except in cases where such a license is requested for the medicinal product or manufacturing process of the medicinal product for the purposes of the export of patented medicine or medicine, obtained through the patented process in the territory, where is no or insufficient manufacturing facilities, in accordance with the international treaties ratified by the Republic of Kazakhstan.

The person to whom a compulsory license was granted may assign the right to use the industrial property subject matter to another person only in consort with the enterprise that uses the said subject matter.

The effect of a compulsory license may be avoided by court in the event that the circumstances that caused the grant of such license cease to exist.

5. The patent owner who cannot use the industrial property subject matter without infringing the rights of the owner of another title of protection for the industrial property subject matter who has declined an offer to conclude a license contract on commercially acceptor terms, shall have the right to recourse to the court requesting the grant of compulsory non-exclusive license to use the industrial property subject matter in the territory of the Republic of Kazakhstan.



If the patent owner who cannot use the industrial property subject matter without infringing the rights of the owner of another title of protection proves that the industrial property subject matter represents important technical achievement with significant economic advantages over the industrial property subject matter of the owner of the other title of protection, the court may decide to grant him a compulsory non-exclusive license.

While granting the said compulsory license, the court shall determine the scope of use of the industrial property subject matter, the title of protection for which belongs to another person, the terms, amount and procedures of payment. The amount of payment shall not be lower than the market value of the license to be determined under the established practice.

The right to use the industrial property subject matter acquired on the basis of this provision may be transferred only together with the title of protection granted for the industrial property subject matter in connection with which such right was granted.

In the event that the compulsory license, as provided hereunder, is granted, the patent owner for a title of protection, the right to use of which was granted on the basis of such license, shall also be entitled to get a license for the use of the dependent invention, in respect of which a compulsory license was granted.

6. The patent owner may assign the granted title of protection to any individual or legal entity. The assignment agreement shall be obligatory registered with the authorized body.

The assignment agreement for the title of protection shall be registered based on the results of the examination of materials by the expert agency.

To register the assignment agreement, an application of the set form shall be submitted to the expert agency.

The application shall be accompanied by:

1) four copies of the original assignment agreement, the subject of which are homogeneous industrial property subject matter, provided with a cover sheet. Each copy of the contract shall be sewn, fastened with a paper seal, on which the quantity of laced and numbered sheets is to be indicated, and the stamp and signature of authorized persons of either parties or the applicant are to be affixed.

Notarized copies of the agreement can be submitted instead of the original ones;

2) power of attorney in case the application is filed through the patent attorney or other representative;

3) document certifying the payment of state due.

National applicants shall, complementary to the abovementioned documents, also provide the decision of the governing bodies of the owner of the title of protection or the exclusive rights, the decision of general meeting of founders or shareholders for the conclusion of the agreement and empowering the head of the enterprise to sign the contract.

The application and other required documents shall be in Kazakh or Russian languages. Foreign names and names of legal entities are to be indicated in Kazakh and Russian transliteration. If the documents are submitted in other language, the application shall be accompanied by their notarized translation into Kazakh and Russian languages.

The application shall relate to a single assignment agreement.

Individuals residing outside the republic of Kazakhstan, or foreign legal entities, filing an application with the authorized body on their own behalf, shall exercise their rights in regards the registration of the agreement via patent attorneys registered in the Republic of Kazakhstan.

Citizens of the Republic of Kazakhstan temporarily outside, exercise the rights associated with the registration of the agreement, without a patent attorney if specifies the address for correspondence within the territory of the Republic of Kazakhstan.

7. The expert agency shall, after the submission of documents for registration by the applicant, within fifteen business days from the date of receiving the application, carry out the preliminary examination of the documents in order to check for the availability of required documents and observe whether the conditions have been complied with; and where the assignment agreement of the protected document confirming the payment lacks for the examination, the applicant will be invoiced for payment. In this case, the specified deadline shall run from the date of receipt of payment to expert agency.

Based on the materials of the assignment agreement submitted for consideration, the substantive examination shall be carried out within twenty days, during which the materials of the assignment agreement are to be analyzed in accordance with current legislation of the Republic of Kazakhstan.

8. Following are the grounds impeding the registration of the assignment agreement, which may be eliminated:

- 1) no payment was made for the maintenance the title of protection in force;
- 2) the assignment agreement contains provisions contrary to the civil legislation of the Republic of Kazakhstan and international treaties, ratified by the Republic of Kazakhstan.

9. In case of failure to comply with the requirements for execution of documents or existence of grounds, referred to in paragraph 8 of this article, which impede the registration of the assignment agreement but may be eliminated, an inquiry shall be sent to the applicant by the expert agency suggesting that the missing or corrected documents be sent or the necessary amendments be made within three month from the date of request. In this case, the deadline of the substantive examination referred to in paragraph 7 of this article shall be calculated from the date of submission of missing or corrected documents.

10. The expert agency shall deliver an opinion to refuse the registration of the agreement for the following grounds:

- 1) termination of the title of protection, in respect of which the agreement is to be concluded;
- 2) failure to timely, within three months, submit a response to the request of the expert agency;
- 3) lack of all required data and documents in the response.

The expert agency shall, within two business days after delivering an opinion, send this opinion to the authorized body indicating the reasons for such refusal.

11. In case of a positive result, the expert agency shall, within five business days, send to the authorized body an opinion that no reason exists that impede the registration of the assignment agreement.

The authorized body shall take a decision to register or refuse the registration of the assignment agreement within five business days from the receipt of the opinion of expert agency.

12. After taking the decision to register the agreement the authorized body shall:

1) affix on the front page of the agreement the stamp about its registration indicating the date and the number of registration;

3) make the particulars of the agreement to the registry of contracts;

4) send two copies of the registered agreement and the annex to the title of protection to the correspondence address indicated in the application;

5) send three copy of the registered agreement with the opinion enclosed to the expert agency so as to publish the particulars of agreement registration.

Expert organization for registered agreements prepares annex to the title of protection for the industrial property subject matter in respect of which the agreement is concluded, send two copies of the registered agreement and annex to the title of protection to the address for correspondence, indicated in the application, published in the Bulletin of information on registered agreements, in particular the number and date of registration of the agreement, name and full information about the parties to the agreement, subject of the agreement, duration of the agreement, and the territory where the agreement shall effective. Two copies of the agreement shall be deposited in the authorized body and expert agency respectively, and shall be the check copies.

Any person may get an abstract from the register of registered assignment agreements that relate to the information on the registered assignment agreements open to the publication.

Familiarization with the text of the agreement as well as obtaining its abstract may be allowed for the third parties only with the written consent of the parties to the agreement.

If the authorized body, based on the opinion of the expert agency, makes a decision to refuse the registration of the assignment agreement, the documents under consideration along with the decision on refusal shall be returned to the address indicated in the application.

13. The assignment agreement for the title of protection shall enter into force on the date of their registration with the authorized body.

14. A title of protection for industrial property subject matter and/or the right to obtain the title of protection may be inherited or acquired by succession.

15. The patent owner shall be required to pay the prescribed annual maintenance fee, in effect on the date corresponding to the date of application.

The first payment for the maintenance of the title of protection in force shall be made within two months from the date of publication of the particulars on the grant of the title of protection and includes payment for previous years, starting from the date of application.

**Footnote. Article 11 as amended by the Law of the Republic of Kazakhstan of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication); as amended by the laws of the Republic of Kazakhstan of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication); of 27.10.2015 # 365-V (the act is entered into force in ten calendar days after its first official publication).**

## **Article 12. Acts not recognized as infringements on the executive right of the patent owner**

The following shall not constitute acts infringing the executive right of the patent owner:

1) the use in the construction or in the operation of transportation vehicles of foreign countries (river and marine, air, automobile and space crafts) of a product, incorporating a protected industrial property subject matter, provided that such transportation vehicles are located in the Republic of Kazakhstan temporarily or accidentally and that the said product is used solely for the needs of transportation vehicle. Such acts shall not constitute an infringement of the exclusive right of the patent owner that relate to the transportation vehicles belonging to the individuals and legal entities of foreign countries granting similar right to individuals and legal entities of the Republic of Kazakhstan;

2) conducting scientific research or scientific experiment on a product, incorporating a protected industrial property subject matter, if the purpose of such scientific research or experiment is not obtaining the income;

3) the use of such product in extreme situations (natural disasters, catastrophes, and dramatic accidents), provided that the patent owner is notified as soon as possible and paid a commensurate compensation;

4) the use of such product for private, family, domestic or other non-commercial purposes, if the purpose of such use is not obtaining the income;

5) in urgent cases, one-time production in pharmacies, based on the prescriptions;

6) import into Republic of Kazakhstan, the use, offer for sale, selling, any other form of distribution for commercial purposes or stocking for above purposes of products containing the industrial property subject matter, if such product has been earlier distributed for commercial purposes in the Republic of Kazakhstan by the patent owner or by another person, authorized by the patent owner.

**Footnote. Article 12 as amended by the Law of the Republic of Kazakhstan of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication); of 27.10.2015 # 365-V (the act is entered into force in ten calendar days after its first official publication).**

### **Article 13. Right of prior use and provisional legal protection**

1. Any individual, who, before the priority date of the industrial property subject matter and independently of the author, had conceived and was using in good faith in the territory of the Republic of Kazakhstan a similar solution, or was making the necessary preparations for such use, shall have the right to proceed with that use free of charge, provided that the scope thereof is not extended (right of prior use).

The right of the prior use may only be transferred to another person together with the enterprise, where the use of similar solution or the necessary preparations for use have been made.

2. Any individual, who, after the priority date of the protected industrial property subject matter but before the date of publication of the particulars of the granted patent for

invention, industrial design or the utility model patent, had started the use of the industrial property subject matter, shall, at the request of the patent owner, stop such use. The said person shall not be required to compensate the patent owner for damages sustained in the result of such use.

3. The industrial property subject matter displayed as an exhibit at an official or officially recognized international exhibition shall enjoy provisional legal protection during the period between the date of its display and the date of first publication of the particulars of the granted title of protection, provided that an application for the protection of the industrial property subject matter has been filed within six months from the date of its display at the exhibition.

4. Any individual using the industrial property subject matter during the period set forth in paragraph 3 of this article shall, after the grant of the title of protection, pay compensation to the patent owner. The amount of compensation is to be determined by agreement between the parties.

The parties may terminate the case by settlement agreement or the agreement relating to the settlement of the dispute (conflict) in the mediation procedure, which shall be signed by the parties and approved by the Court.

**Footnote. Article 13 as amended by the Law of the Republic of Kazakhstan of 09.07.2004 #586; of 02.03.2007 #237 (the act is entered into force since the day of its official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

#### **Article 14. Grant of the right to use industrial property subject matter**

1. Any individual other than the patent owner, wishing to use the industrial property subject matter, shall be required to obtain the authorization of its owner on the basis of a license contract.

2. Under a license contract the patent owner may grant to the licensee the following:

1) the right to use the protected property subject matter, while the licensor retains all the rights deriving from the title of protection, including the right to grant licenses to third parties (an ordinary non-exclusive license);

2) the right to use the industrial property subject matter, where the licensor retains the said right but is not entitled to grant licenses to third parties (an exclusive license);

3) the right to use the industrial property subject matter, while the licensor retains neither the right to use the subject matter and is not entitled to grant licenses to third parties (a full license).

A license shall be deemed to be non-exclusive unless the license contract directly specifies the type of a license.

3. A contract (a sublicense contract) for granting the right to use the industrial property subject matter to another person (the sub licensee) may only be concluded if provided for so in the license contract.

The licensee shall be responsible before the licensor for any act performed by the sublicensee with regard to the protected industrial property subject matter unless otherwise provided for in the license contract.

4. A license contract and sublicense contract for the use of the protected invention, utility model or industrial design shall be concluded in writing and shall be obligatory registered with the authorized body. Failure to comply with the written form or registration requirement entails the invalidity of the contract.

A license contract shall be registered upon the results of the examination of the materials by the expert agency.

The order of registration of the license contracts shall be applied for the registration of the sublicense contract, as well as additional agreement to it, unless otherwise provided for by the legislation of the Republic of Kazakhstan.

4-1. To register the license agreement, an application of the set form shall be submitted to the expert agency.

The application shall be accompanied by:

1) four copies of the original contract, provided with a cover sheet. Each copy of the contract shall be sewn, fastened with a paper seal, on which the quantity of laced and numbered sheets is to be indicated, and the stamp and signature of either parties or authorized persons of both parties are to be affixed.



Materials shall be submitted no later than six months from the date of signing the contract.

Notarized copies of the contract can be submitted instead of the original ones;

2) power of attorney in case the application is filed via the patent attorney or other representative;

3) document certifying the payment of state due.

National applicants shall, complementary to the abovementioned documents, also provide the decision of the governing bodies of the licensor (sublicensor) for the conclusion of the contract and empowering the head of the enterprise to sign the contract in case the application is filed on behalf of the legal entity.

The application and other required documents shall be in Kazakh or Russian languages. Foreign names and names of legal entities are to be indicated in Kazakh and Russian transliteration. If the documents are submitted in other language, the application shall be accompanied by their notarized translation into Kazakh and Russian languages.

The application shall relate to a single license contract.

Individuals residing outside the republic of Kazakhstan, or foreign legal entities, filing an application with the authorized body on their own behalf, shall exercise their rights in regards the registration of the contract via patent attorneys registered in the Republic of Kazakhstan.

The citizens of the Republic of Kazakhstan, temporarily residing abroad, shall exercise their rights in regards the registration of the contract without patent attorneys if indicate the correspondence address within the territory of the Republic of Kazakhstan.

4-2. The provisions provided for in paragraphs 7-12 of article 11 of this Law shall be applied while registering the license contracts.

A license contract (sublicense contract) shall enter into force from the date of its registration with the authorized body.

5. The patent owner may file with the authorized body an application that he undertakes to grant the right to use his industrial property subject matter to any interested party (open license).

Any person wishing to obtain the said open license shall be required to enter into a contract of payments with the patent owner, obligatory registering such contract with the authorized body. Any dispute relating to the terms and conditions of the contract shall be settled in court.

The application of the patent owner on granting the right to an open license is not subject to revocation and shall be valid within three years from the date of publication of the particulars of the application in the bulletin. Within the said period the maintenance fee shall be reduced by 50 percent as from the year following the year of publication of the particulars on open license.

In case of concluding a license contract, the maintenance fee shall be paid full from the year following the year of concluding such contract.

6. In force majeure situations the Government of the Republic of Kazakhstan may authorize the use of the protected industrial property subject matter without the consent of the patent owner, provided that the owner is immediately informed and is paid a commensurate compensation. Any dispute relating to the amount of compensation shall be settled by court.

**Footnote. Article 14 as amended by the Law of the Republic of Kazakhstan of 09.07.2004 # 586; of 12.01.2012 # 537-IV (the act is entered into force in ten calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

### **Article 15. Infringements of the exclusive right of the patent owner**

1 Any individual or legal entity using the protected industrial property subject matter in a manner contrary to the provisions of this Law shall be deemed to be infringing the exclusive right of the patent owner (the infringer of the title of protection).

An unauthorized manufacturing, utilization, importation, stocking, offering for sale, sale and any other distribution for commercial purposes of products incorporating the protected industrial property subject matter, and the use of the protected method or the distribution for commercial purposes of a product obtained directly through such method

shall be deemed to constitute an infringement of the exclusive right of the patent owner (infringement of the title of protection).

A new product shall be deemed to have been manufactured by a protected method unless proved contrary.

2. The aggrieved patent owner shall be entitled to demand that:

1) cease the infringement of the title of protection;

2) the infringer compensate the owner the damages sustained, including moral damage, from the date of first publication of particulars of the grant;

3) recover the owner the amount of profits derived from the unauthorized use of the protected industrial property subject matter, in lieu of compensation for damage sustained from the date of first publication of particulars of the grant of the title of protection;

4) the infringer pay the owner compensation in an amount from 10 000 to 50 000 thousand the monthly calculated index provided for by the legislation. The amount of compensation shall be determined by court in lieu of compensation for damages sustained or payment of the derived profits;

5) the infringing products that have been commercialized or stocked for commercial purposes as well as materials that have been especially used for infringing of the title of protection, from the date of first publication of particulars of the grant;

6) information on the infringement, including the particulars of the owner of the infringed right, be published as a mandatory requirement.

3. Requirement to the infringer of the title of protection may also be claimed by the license holder unless otherwise provided for in the license contract.

**Footnote. As amended by the Law of the Republic of Kazakhstan of 9 July, 2004 # 586.**

## **Chapter 5. Procedure of obtaining title of protection**

### **Article 16. Filing of application for the grant of a title of protection**

1. An application for the grant of a title of protection shall be filed with the expert agency by a person entitled to obtain the title in accordance with paragraph 1 of article 10 of this Law (hereinafter referred to as “the applicant”).

An application may be filed as an electronic document certified by digital signature.

2. The application for the grant of the title of protection shall be written in the Kazakh or Russian language. Other elements of the application may be written in Kazakh, Russian or in other languages. In the event that the elements of the application are written in a language other than the Kazakh or Russian, the application shall be accompanied by a Kazakh or Russian translation of those elements. The required translation is to be submitted within two months following the receipt by the expert agency of the application containing elements written in another language. This term may be extended for a period not exceeding two months subject to payment of the prescribed fee.

If the applicant fails, within the prescribed time limit, to submit the required translation, the application shall be deemed not to have been filed.

3. The authorized body or the expert agency shall not allow the access to the application to third parties prior to the publication of the particular of the grant of title of protection unless the applicant requests or authorizes or the criminal prosecution on court requires so.

**Footnote.** Article 16 as amended by the Law of the Republic of Kazakhstan of 09.07.2004 # 586; of 02.03.2007 #237 (the act is entered into force since the day of its official publication); of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).

### **Article 17. Application for the grant of a title of protection for an invention**

1. The application for the grant of a title of protection for an invention (hereinafter referred to as “the invention application”) shall relate to one invention only or a group of invention so linked as to form a single inventive concept (unity of invention requirement).

2. The invention application shall contain the following:

1) the request for the grant of a title of protection, indicating the names of the author (or authors) and the person (or persons) in whose name the grant of a title of protection is sought, and the addresses of their residences or places of business;

2) the description, disclosing the invention in sufficient detail for it to be carried out by a specialist in the field;

3) the claims, stating the essential features of the industrial property subject matter. The claims shall be clear and adequate, and shall be fully supported by the description;

4) the drawings and other materials, where indispensable for the understanding of the disclosure;

5) the abstract;

6) a power of attorney if the application is filed via a representative;

7) (excluded - of 2 March, 2007 # 237).

The invention application shall be accompanied by proof of payment of the prescribed fee, including a fee for carrying out a formal examination at the appropriate rate, and a document confirming the grounds for a reduction of its amount, which may be either submitted together with the application or within two months following the date of its receipt. This term may be extended for a period not exceeding two months subject to payment of the prescribed fee.

If the applicant fails, within the prescribed time limit, to submit a document containing proof of payment of the prescribed fee, the application shall be deemed not to have been filed.

3. The filing date of an invention application shall be determined by the date of receipt by the expert agency of the elements referred to in paragraphs 1), 2) and 4) of the first part of paragraph 2 of this article, and where the specified elements have not been submitted simultaneously, the filing date shall be determined by the date of receipt of the last element.

4. The procedure for drafting, processing and review of the invention application, making entries in the State register of inventions of the Republic of Kazakhstan, as well as the granting of a title of protection shall be determined by the authorized body.

**Footnote. Article 17 1 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 # 586; of 2 March, 2007 #237 (the act is entered into force since the day of its official**

publication); of 12.01.2012 # 537-IV (the act is entered into force in ten calendar days after its first official publication).

### **Article 18. Application for the grant of a patent for a utility model**

1. The application for the grant of a patent for a utility model (hereinafter referred to as “the utility model application”) shall relate to one utility model only or to a group of utility models so linked as to form a single creative concept (unity of utility model requirement).

2. The utility model application shall contain:

1) the request for the grant of a patent, indicating the names of the author (or authors) of the utility model and the person (or persons) in whose name the grant of a patent is sought, and the addresses of their residences or places of business;

2) the description, disclosing the claimed utility model in sufficient detail for it to be made;

3) the claims, stating the essential features of the utility model and fully supported by the description;

4) the drawings;

5) the abstract;

6) a power of attorney if the application is filed via a representative.

The utility model application shall be accompanied by proof of payment of the prescribed fee, or by proof certifying the exemption from the prescribed fee which may be either submitted together with the application or within two months following the date of its receipt. This term may be extended for a period not exceeding two months subject to payment of the prescribed fee.

If the applicant fails, within the prescribed time limit, to submit a document containing proof of payment of the prescribed fee, the application shall be deemed not to have been filed.

3. The filing date of a utility model application shall be determined by the date of receipt by the expert agency of the application for the grant of a patent for a utility model, stating the name and forename (and the middle name if any) or the official name of the applicant, the description, the claims and drawings, and where the specified elements have

not been submitted simultaneously, the filing date shall be determined by the date of receipt of the last element.

4. The procedure for drafting, processing and review of the utility model application, making entries in the State register of utility models of the Republic of Kazakhstan, as well as the granting of a title of protection shall be determined by the authorized body.

**Footnote. Article 18 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 02.03.2007 # 237 (the act is entered into force since the day of its official publication); of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

### **Article 19. Application for the grant of an industrial design patent**

1. The application for the grant of an industrial design patent (hereinafter referred to as “the industrial design application”) shall relate to one industrial design only or to a group of industrial designs so linked as to satisfy unity of industrial design requirement.

2. The industrial design application shall contain:

1) the request for the grant of a patent, indicating the names of the authors of the industrial design and the persons in favor of whom the grant of a patent is sought, and the addresses of their residences or places of business;

2) a set of representations of the article or layout, giving a full and detailed perception of outward appearance of the said design (or designs) and capable of reproduction;

3) **(excluded - of 2 March, 2007 # 237);**

4) the description of the industrial design including the list of its essential features;

5) a power of attorney if the application is filed via a representative.

The industrial design application shall be accompanied by proof of payment of the prescribed fee, or by proof certifying the exemption from the prescribed fee which may be either submitted together with the application or within two months following the date of its receipt. This term may be extended for a period not exceeding two months subject to payment of the prescribed fee.

If the applicant fails, within the prescribed time limit, to submit a document containing proof of payment of the prescribed fee, the application shall be deemed not to have been filed.

3. The filing date of an industrial design application shall be determined by the date of receipt by the expert agency of the request for the grant of a title of protection for an industrial design, stating the name and forename (and the middle name if any) or the official name of the applicant, the description, the layout of the article, and where the specified elements have not been submitted simultaneously, the filing date shall be determined by the date of receipt of the last element.

4. The procedure for drafting, processing and review of the industrial design application, making entries in the State register of utility models of the Republic of Kazakhstan, as well as the granting of a title of protection shall be determined by the authorized body.

**Footnote. Article 19 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 02.03.2007 # 237 (the act is entered into force since the day of its official publication); of 12.01.2012 # 537-IV (the act is entered into force in ten calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

#### **Article 20. Priority of industrial property subject matter**

1. The priority of industrial property subject matter shall be determined by the filing date of the industrial property application that is determined in accordance with paragraph 3 of article 17, paragraph 3 of article 18 and paragraph 3 of article 19 of this Law.

2. Priority may be determined by the filing date of the first application in any state party to the Paris Convention, and with any international or regional organization specified in the Paris Convention (hereinafter referred to as “Convention priority”) if the invention application or the utility model application has been filed with the expert agency within 12 months, and in the case of the industrial design application – within six months from the said date. If, for reasons beyond the control of the applicant, an application seeking



Convention priority failed to be filed within the prescribed period, such period may be extended for not more than two months.

The applicant wishing to make use of Convention priority shall make a declaration to that effect to be submitted to the expert agency when filing the application or within two months following the date of receipt of the application by the expert agency, and shall attach thereto a copy of the first application or shall furnish it no later than six months from the date of receipt of the application by the expert agency. The applicant shall lose the right for Convention priority if he fails to provide the said document. In this case, priority shall be determined by the date of filing with the expert agency of the application.

3. Priority may be determined by the date of receipt of additional documents if they are submitted by the applicant as a separate application, provided that it has been filed within three months following the date of receipt by the applicant of a notification from the expert agency to the effect that the additional data cannot be taken into consideration since they are recognized as modifying the essence of the claimed solution, and on condition that as of the date of filing the separate application, the application, containing the said additional data, has not been revoked and has not been recognized as revoked.

4. Priority may be determined by the date of filing by the same applicant, with the expert agency, of the earlier application, disclosing the industrial property subject matter, not revoked or deemed revoked as of the date of filing of the application, given that the application, for which such priority is sought, is filed not later than within twelve months from the filing date of the earlier invention application and six months from the filing date of the utility model application or industrial design application. In such case, the earlier application shall be deemed to have been revoked.

Priority may not be established for the filing date of an application, on which earlier application had been sought.

5. Priority of the industrial property subject matter under a divisional application shall be determined by the date of the filing by the same applicant with the expert agency of the initial application, disclosing the said industrial property subject matter, and in the presence of the right to get earlier priority under the initial application – for the priority

date, given that the divisional application was filed before a final decision refusing the grant under the initial application has been taken and cannot be further contested, or where a decision to grant has been taken by the expert agency in respect of the initial application, before the date of registration of the industrial property subject matter in the State register of the Republic of Kazakhstan.

6. Priority may be established on the basis of several earlier applications or additional data thereto, in compliance with conditions, provided for respectively in paragraphs 2-5 of the present article.

7. Where it is found that the same priority date is claimed for similar industrial property subject matter, priority shall be established in respect of the application having a proven earlier mailing date, or where the mailing date coincide, of the application having an earlier registration number at the expert agency.

**Footnote. Article 20 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 12.01.2012 # 537-IV (the act is entered into force in ten calendar days after its first official publication).**

#### **Article 21. Correction of the application on the applicant's initiative**

1. An applicant shall have the right to make amendments or clarifications in the application documents without changing the essence of the claimed industrial property subject matter, as well as changes concerning the marking of the applicant when transfer a right for grant of title of protection title, by filing a petition in the expert organization prior to the decision to that effect.

The applicant shall not be charged a fee for making the said changes within two months from the date of receipt of the application.

2. Change of applicant, in case of change of his name, as well as correction of technical errors in the application documents, may be done prior to the date of registration of industrial property subject matter in the State register given that the necessary payment has been made.

**Footnote. Article 21 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 02.03.2007 # 237 (the act is entered into force since the day of its**

official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).

## **Article 22. Examination of invention applications**

1. Upon receipt of application the expert agency shall verify the presence of the required documents provided for in subparagraphs 1), 2) and 4) of the first part of paragraph 2 of article 17 of this Law, and the compliance with the prescribed conditions thereto and shall determine the filing date of the application. If the application does not meet the requirements provided for in subparagraphs 1), 2) and 4) of the first part of paragraph 2 of article 17 of this Law, and the conditions prescribed thereto, the expert agency shall notify the applicant of the said fact and shall suggest that the missing and (or) corrected documents (data) be submitted within three months from the date of sending such notification. If the applicant fails to provide requested and (or) corrected documents(data) within the prescribed time limit the application shall be deemed to have not been filed, of which the applicant shall be notified thereafter.

1.1. After determining the filing date of the application for the grant of an invention patent the expert agency shall carry out a formal examination.

During the formal examination it shall be verified whether the documents provided for in paragraph 2 of article 17 of this Law have been submitted and whether the prescribed conditions have been complied with.

2. Where the applicant files additional elements relating to the application under article 21 of this Law during the examination it shall be ascertained whether they modify the subject matter of the claimed invention.

The additional elements shall be deemed to modify the subject matter of the claimed invention if they contain characteristics to be included in the claims and that did not figure in the initial application. The additional elements that modify the subject matter of the claimed invention shall not be taken into consideration for the purposes of the examination, and may be submitted by the applicant as a separate application, of which possibility the applicant shall be notified.

3. Where the documents contained in the application do not comply with the prescribed requirements, the applicant shall be invited to furnish the corrected or missing documents within three months from the date of receipt of the invitation.

If the applicant fails, within the prescribed time limit, to comply with the invitation or to file a request for extension of the said time limit, the application shall be deemed to have been revoked.

4. If the application does not comply with the unity of invention requirement, the applicant shall be invited to state, within three months following the date of notification of non-compliance with the requirement, which of the solutions should be examined and to correct, if necessary, the elements of the initial application accordingly. Other solutions contained in the initial application may be submitted as divisional applications. Priority of the divisional applications shall be determined in accordance with paragraph 5 of article 20 of this Law.

If the applicant fails, within three months following the date of receipt of the notification, to state which of the solutions should be examined and to furnish the corrected or missing documents, the examination shall be carried out only in respect of the solution that is mentioned first in the claims, as well as solutions so linked to the first solution as to satisfy the unity of invention requirement.

5. The applicant shall be notified of the results of the formal examination after its completion.

6. (excluded - of 2 March, 2007 # 237).

7. Upon completion of the formal examination with the favorable results the expert agency shall conduct the substantive examination.

The substantive examination shall comprise the determination of whether the claimed solution may relate to industrial property subject matter for which legal protection is granted, the state-of-art search in respect of the claimed invention, and verification of whether the claimed subject matter meets the unity of invention requirement and the criteria of patentability, provided for in article 6 of this Law, and shall be carried out upon payment of the substantive examination fee.

The substantive examination shall be conducted under condition that the expert agency receives proof of payment of the prescribed fee for the substantive examination within three months from the date of sending the notification of the results of the formal examination.

An examination that has not been paid shall be deemed revoked.

8. During the substantive examination the expert agency shall be entitled to request from the applicant to submit additional elements, including amended claims, where such elements are indispensable for the purposes of the examination.

The additional elements requested by the expert agency shall, without modifying the subject matter of the invention, be furnished within three months from the date of sending the request or copies of the elements opposing the application, under condition that the said copies were requested by the applicant during two months from the date when the expert agency sent the request.

Where the additional elements modify the subject matter of the invention, the provisions of paragraph 2 of this article shall apply. In the event that the applicant fails, within the prescribed time limit, to furnish the requested elements or to file a request for extension of the said time limit, the application shall be deemed to have been revoked.

9. Where the substantive examination finding is that the invention, as defined by the applicant in the claims, meets the criteria of patentability, provided for in article 6 of this Law, the expert agency shall, specifying the priority date, take a favorable opinion in respect of the patent, the claims of which have been approved by the applicant.

The authorized body shall, based on the opinion of the expert agency, within ten working days take a decision to grant an invention patent. On the basis of the decision of the authorized body to grant a patent for the invention, the expert organization within ten working days shall send to the applicant the conclusion of the expert organization and the notice about the need to pay fees for the grant of a title of protection.

Within three months from the date of notification of the applicant by the authorized body of the decision to grant the patent, applicant submits to an expert organization

document confirming payment for the appropriate preparation to the grant of a patent and publication, as well as the payment of the State fee. In case of failure to submit the above-mentioned documents, payment time can be restored within three months, subject to the submission of a document about payment recovery of a missed period. Otherwise, the application is deemed revoked, the processing of the application is stopped, as the applicant shall be notified within one month from the date of expiry of the period of recovery.

10. Where the invention, as defined by the applicant in the claims, does not meet the criteria of patentability, the expert agency shall take an opinion to refuse the grant of a patent.

An opinion refusing the grant of a patent shall be taken in the following cases:

- 1) where the application relates to the solution for which no legal protection is granted;
- 2) where the applicant fails to modify the subject matter of the claimed invention after receipt of the notification to the effect that the proposed amended claims contain characteristics that did not figure in the initial application or, in addition to the solution for which legal protection is granted, contain a solution for which no legal protection is granted, or which has not been examined because of its failure to satisfy the unity of invention requirement.

Where the applicant wishes to oppose an opinion of the expert agency to refuse the grant of a patent, he may do so to the authorized body within three months from the date of sending it. The appeal shall be examined within four months following the date of its receipt by the board of appeal.

11. The applicant, at any time during the substantive examination, before the expert agency takes an opinion, may file an application to be granted an patent for utility model. In this case, the examination shall be carried out in accordance with article 23 of this Law.

12. The applicant shall have the right to acquaint himself with all materials cited by the examiner. The expert agency shall furnish copies of the cited documents requested by the applicant within one month from the date of receipt of the request.

13. If the applicant fails to respect the time limits provided for in paragraphs 3), 4), 7), 8) and 10) of this article, the expert agency may restore the time provided that the applicant submit a document containing proof of payment of the prescribed fee.

The request for restoration of the time may be filed by the applicant no later than 12 months after the expiration of time limit in question. The applicant shall file the said request with the expert agency simultaneously as he submits the documents requested by the examiner, payment documents or lodges an appeal with the board of appeal. The timing of the response to the request or submission of additional materials provided by paragraphs 3 and 8 of this article may be extended at the request of the applicant, submitted prior to the deadline, for a term not exceeding six months from the date of expiration of the prescribed period subject to payment, and filing of objection in accordance with paragraph 10 of this article, for a period not exceeding three months from the date of the deadline.

13-1. At the request of the applicant, the examination of an application for an invention patent is held in an accelerated form, if the claimed invention refers to objects that have favourable conditions of patentability.

Accelerated examination includes the holding within six months, subject to compliance by the applicant of the requirements referred to in paragraphs 1, 1-1, 2, 3, 4, 5, 7 and 8 of this article:

- 1) formal examination;
- 2) information search;
- 3) substantive examination.

The list of objects that have favourable conditions of patenting, is determined by the authorized body.

14. In the event that while the examination the application is found to contain information that constitutes state secret, the said application shall be declared secret according to the procedure provided for by the legislation of the Republic of Kazakhstan on state secrets.

**Footnote. Article 22 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 02.03.2007 # 237 (the act is entered into force since the day of its official publication); of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar**

days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).

**Article 22-1. Examination of an application for the grant of an innovation patent on an invention**

Footnote. Article 22-1 excluded by the Law of the RK of 07.04.2015 #300-V (the act is entered into force in ten calendar days after its first official publication).

**Article 23. Examination of utility model applications**

1. Upon receipt of the application the expert agency shall verify the presence of the documents required under subparagraphs 1), 2) and 4) of the first part of paragraph 2 of article 18 of this Law, and shall determine the filing date. If the application does not meet the requirements provided for in subparagraphs 1), 2) and 4) of the first part of paragraph 2 of article 18 of this Law, the expert agency shall notify the applicant of the said fact and shall suggest that the missing documents (data) be submitted within three months from the date of sending such notification. When applicant fail to submit the requested documents (data) within the prescribed period, the application shall be considered not to have been filed, as the applicant is sent a notification.

During the examination the expert agency shall verify the presence of the documents provided for in paragraph 2 of article 18 of this Law, as well as the compliance with the prescribed conditions thereto, and determine the priority date of the utility model, shall examine whether the claimed solution relates to the objects eligible for legal protection as a utility model, as well as shall verify the unity of utility model requirement.

No verification of the compliance of the claimed utility model with the conditions of patentability of utility models provided for in paragraph 1 of article 7 of this Law shall be carried out. A patent is granted on the risk and responsibility of the applicant.

2. The conduct of the examination of a utility model application shall be governed by the provisions of paragraphs 2), 3), 4) and 13) of article 22 of this Law.

Where the examination finding is that the claims relate to utility model for which legal protection is granted, and the documents comply with the prescribed conditions, the expert agency shall take a favorable opinion to grant a utility model patent.



The expert agency shall send to the authorized body the expert opinion within ten days, for the latter to take a decision to grant a patent, of which (if such decision is taken) the applicant shall be notified accordingly.

The authorized body, based on the opinion by the expert agency, shall, within ten days, take a decision to grant a patent for utility model.

On the basis of the decision of the authorized body for the grant of a patent for utility model expert organization within ten working days of the conclusion of the expert shall send to the applicant decision of the expert organization and the notice about the need to pay fees for the issuance of a title of protection.

The applicant shall, within three months from the date of receipt of the decision of the authorized body to grant a patent, furnish with the expert agency a document confirming the payment of the prescribed fees for preparation for the grant of a patent and for publication, and of the state fee. If the applicant fails, within the prescribed time limit, to provide the said document, the rights contingent on a time limit may be recovery within three months. Otherwise, the application shall be deemed to have been revoked and proceedings on the application shall be terminated, of which the applicant shall be notified within one month from the date of expiry of the recovery period.

3. Where the examination finding is that the claimed solution relate to utility model for which no legal protection is granted, a decision refusing the grant of a patent shall be taken. A decision refusing the grant of a patent shall also be taken in the case where the applicant fails to modify the subject matter of the claimed utility model after receipt of the notification to the effect that the proposed amended claims that did not figure in the initial application or, in addition to the solution for which legal protection is granted, contain a solution for which no legal protection is granted, or which has not been examined because of its failure to satisfy the unity of utility model requirement.

Where the applicant wishes to oppose an opinion of the expert agency to refuse the grant of a patent, he may do so to the authorized body within three months from the date of sending it. The appeal shall be examined within two months following the date of its receipt by the board of appeal.

4. In order to assess the patentability of the claimed utility model, the applicant, the patent owner or any third party at any time during the examination procedure, or after the particulars of the grant of a patent have been published, may request that a state-of-the-art search be carried out in respect of the application filed. In that case the provisions of paragraph 11 of article 22 of this Law shall apply.

**Footnote. Article 23 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 02.03.2007 # 237 (the act is entered into force since the day of its official publication); of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

#### **Article 24. Examination of industrial design application**

1. Upon receipt of application for the grant of an industrial design patent the expert agency shall carry out the formal examination and the substantive examination.

2. While the formal examination it shall be verified whether all the necessary documents, required under subparagraphs 1), 2) and 4) of paragraph 2 of article 19 of this Law have been furnished as well as the filing date and the priority date shall be determined.

Where the documents contained in the application for the grant of an industrial design patent do not comply with the prescribed requirements, the applicant shall be invited to furnish the corrected or missing documents within three months from the date of receipt of the invitation.

If the applicant fails, within the prescribed time limit, to comply with the invitation or to file a request for extension of the said time limit, the application shall be deemed to have not been filed, of which the applicant shall be notified. This time limit may be extended, provided appropriate payment, but for not more than three months.

Where the additional elements relating to the application are filed in accordance with article 21 of this Law during the examination it shall be ascertained whether they modify the subject matter of the claimed industrial design.

The additional elements shall be deemed to modify the subject matter of the claimed industrial design if they contain characteristics to be included in the claims and that did not figure in the initial application. The additional elements that modify the subject matter of the claimed industrial design shall not be taken into consideration for the purposes of the examination, and may be submitted by the applicant as a separate application, of which possibility the applicant shall be notified.

The applicant shall be notified of the results of the formal examination after its completion.

2-1. On the application filed in violation of the requirement of unity of industrial design, the applicant is invited, within a period of three months from the date of notification to him to announce which industrial design shall be subject to review and, if necessary, to clarify the application documents. Other industrial designs included in the initial application materials can be allocated to divisional applications. The priority of the divided applications will be installed in accordance with paragraph 5 of article 20 of this Law.

If the applicant, within a period of three months from the date of notification to him of the violation of the requirements of unity does not indicate which of industrial designs shall be subject to review and does not provide the specified documents, carried out the review of object the first specified in the description, as well as other industrial designs related to the first so that they meet the requirement of unity of industrial design.

3. Upon completion of the formal examination with the favorable results the expert agency shall conduct the substantive examination.

The substantive examination shall comprise the determination of whether the claimed solution may relate to industrial property subject matter for which the legal protection is granted, the state-of-art search in respect of the claimed industrial design in order to determine the level of artistic-design presentation of the article, and verification of whether the claimed subject matter meets the criteria of patentability set forth in article 8 of this Law, and shall be carried out upon payment of the substantive examination fee.

The document confirming the proof of payment of the prescribed fee for the substantive examination shall be submitted with the expert agency within three months from the date of sending the notification of the results of the formal examination.

4. During the substantive examination process the expert agency shall be entitled to request from the applicant to submit additional elements, including amended claims, where such elements are indispensable for the purposes of the examination.

The additional elements requested by the expert agency shall, without modifying the subject matter of the invention, be furnished within three months from the date of sending the request.

Where the additional elements modify the subject matter of the industrial design, the provisions of paragraph 1 of this article shall apply. In the event that the applicant fails, within the prescribed time limit, to furnish the requested elements or to file a request for extension of the said time limit, the application shall be deemed to have been revoked. This period may be extended, provided appropriate payment, but for not more than three months.

5. Where the substantive examination finding is that the solution, as defined by the applicant in the claims, meets the criteria of patentability of industrial designs, provided for in article 8 of this Law, the expert agency shall, specifying the priority date, take a favorable opinion in respect of the patent, the claims of which have been approved by the applicant.

The authorized body shall, based on the opinion of the expert agency, take a decision to grant an industrial design patent.

On the basis of the decision of the authorized body for the grant of a patent for industrial design, expert organization within ten working days of the conclusion of the expert shall send to the applicant the decision of the expert organization and notification on need to pay fees for the grant of a title of protection.

Within three months from the date of notification of the applicant by the authorized body of the decision to grant the patent, the applicant submits an expert organization document confirming payment for the appropriate preparation to the grant of a patent and publication,

as well as the payment of the State fee. In case he fails to submit the above-mentioned documents, payment period can be restored within three months, subject to the submission of a document about payment of a missed period recovery. Otherwise, the application is deemed revoked, the processing of the application is stopped, as the applicant shall be notified within one month from the date of expiry of the period of recovery.

6. Where the industrial design, as defined by the applicant in the claims, does not meet the criteria of patentability, the expert agency shall take an opinion to refuse the grant of a patent.

An opinion refusing the grant of a patent shall also be taken in the cases where the application relates to the solution for which no legal protection is granted, and where the applicant fails to modify the subject matter of the claimed invention after receipt of the notification to the effect that the proposed amended claims contain characteristics that did not figure in the initial application or, in addition to the solution for which legal protection is granted, contain a solution for which no legal protection is granted, or which has not been examined because of its failure to satisfy the unity of industrial design requirement;

Where the applicant wishes to oppose the opinion of the expert agency to refuse the grant of a patent, he may do so to the authorized body within three months from the date of sending it. The appeal shall be examined within two months following the date of its receipt by the board of appeal.

7. The applicant shall have the right to acquaint himself with all materials cited by the examiner. The expert agency shall furnish copies of the cited documents requested by the applicant within one month from the date of receipt of the request.

8. If the applicant fails to respect the time limits provided for in paragraphs 2), 3) and 4) of this article, the expert agency may restore time, subject to payment of restored time.

The request for extension of time may be filed by the applicant no later than six months after the expiration of missed time limit. The applicant shall file the said request with the expert agency simultaneously as he submits the documents requested by the examiner or lodges an appeal with the board of appeal.

**Footnote. Article 24 as amended by the Law of the Republic of Kazakhstan**

of 2 March, 2007 # 237 (the act is entered into force since the day of its official publication); as amended by the laws of the Republic of Kazakhstan of 12.01.2012 # 537-IV (the act is entered into force in ten calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).

**Article 25. Registration of industrial property subject matter and grant of titles of protection**

1. The expert agency shall register an invention, a utility model and an industrial design in the State register of inventions of the Republic of Kazakhstan, the State register of utility models of the Republic of Kazakhstan, and the State register of industrial designs of the Republic of Kazakhstan respectively.

2. At the same time as it publishes in the bulletin the particulars of the grant, the authorized body shall grant a title of protection to the patent owner.

Where several persons are registered as applicants for the same title of protection, a single title of protection shall be granted to them.

3. The authorized body shall issue to the author of the industrial property subject matter who is not the patent owner an official certificate attesting his authorship.

4. The layout of the title of protection and author's certificate, the list of particulars, contained therein shall be determined by the authorized body.

**Footnote. Article 25 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 # 586.**

**Article 26. Publication of particulars of the grant of title of protection**

1. The expert agency shall publish in the bulletin the particulars of the grant of an invention patent after expiration of eighteen months, and in the case of utility model patent and an industrial design patent after expiration of twelve months from the filing date of the application. At the request of the applicant the expert agency may publish the particulars of the grant before the expiration of the said time limit.

2. (excluded - of 2 March, 2007 # 237);

3. The author shall be entitled to waive the right to be cited as such in the published particulars of the title of protection.

4. The authorized body shall determine the full list of the published particulars.

5. After the publication of information about the grant of title of protection any person shall have the right to familiarize himself with the documents of the application and search report prepared by the expert agency.

6. The expert agency shall publish in the bulletin information on any extension of the term of a title of protection in accordance with paragraph 3 of article 5 of this Law, as well as information on change of records in the corresponding state registers.

**Footnote.** Article 26 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 02.03.2007 # 237 (the act is entered into force since the day of its official publication); of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication); of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).

#### **Article 27. Withdrawal of applications**

The applicant may withdraw his application prior to registration of the industrial property subject matter in the appropriate State register of the Republic of Kazakhstan.

#### **Article 28. Conversion of applications**

1. The applicant may, prior to an opinion on the invention application by the expert agency, convert the said application into a utility model application by filing a request to that effect.

2. Conversion of an application for a utility model in an application for an invention may, before issuing the decision of expert organization on an application for a utility model by submitting a petition.

3. During such conversions retained the priority and the date of filing of the first application.

**Footnote.** Article 28 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 # 586.

### **Chapter 6. Termination and renewal of title of protection.**

## **Article 29. Opposition of the title of protection.**

1. A title of protection at any time during its period of validity may be, on the basis of the notice of opposition, contested and annulled either entirely or in part in the following cases:

1) the protected industrial property subject matter does not comply with the conditions of patentability provided for by this Law;

2) the claims of the protected invention or utility model or the sum of essential features of the industrial design include elements that did not figure in the application when filed;

3) the grant of the title of protection was effected contrary to the provisions of Article 37 of this Law;

4) the author (or authors) or the patent owner is indicated incorrectly in the title of protection.

2. The notice of opposition filed on the grounds provided for in subparagraphs 1) - 3) of paragraph 1 of this article shall be filed with the authorized body. The Board of appeal shall examine the notice of opposition within six months from the date of its receipt. The person who has filed the notice of opposition shall give the patent owner opportunity to familiarize himself with the notice.

**Footnote. Article 29 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 # 586.**

## **Article 30. Invalidation and early termination of validity of title of protection**

1. A title of protection shall be invalidated, either in full or in part, in the result of a decision taken by the Board of appeal or by the court.

In the case of recognition of title of protection as invalid partly, on the remaining protected object of the invention, the option of invention, utility model or industrial design shall be issued a new patent. Patent for invention, utility model or industrial design, recognized as invalid in whole or in part, shall be cancelled from the date of filing of the patent application.



Licensing contracts concluded on the basis of a patent subsequently recognized invalid, save the action, in so far as they were performed at the time of the judgement on invalidity of the patent.

Invalidation means cancellation of the decision of the authorized body for the grant of a patent for invention, utility model or industrial design and the cancellation of an entry in the appropriate state register.

2. The validity of a title of protection shall be subject to early termination in the following cases:

1) at the request of the patent owner filed with the authorized body as from the date of publication in the bulletin of the particulars of the early expiration. Where the title of protection has been granted for a group of industrial property subject matter, while the applicant filed the application only in respect of part of the industrial property subject matter, the title of protection shall be invalidated only in respect of that industrial property subject matter cited in the application;

2) in the case of failure to pay in due time maintenance fee from the date of expiry of the prescribed term for the payment.

3. The expert agency shall publish in the bulletin information concerning titles of protection invalidated, either in full or in part, as well as information concerning early termination of their validity.

**Footnote. Article 30 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

### **Article 31. Restoration of patent validity. Right of post-grant user**

1. At the request of the patent owner the validity of the patent that has been terminated early on the grounds specified in subparagraph 2 of paragraph 2 of article 30 of this Law may be yet restored, within three years following the expiration of the time limit for payment the maintenance fee. The request for restoration shall be accompanied by proof of payment for the preparation of the documents for the restoration of a patent and the maintenance in force during the validity period, payment of which was missed.

The expert agency shall publish in the bulletin information on restoration of validity of the patent. The date of restoration of the patent validity shall be the date of publication of the said information.

2. Any person, who, during the period between the date of early termination of the patent validity and the date of restoration thereof was using in the territory of the Republic of Kazakhstan the patented industrial property subject matter, or was making necessary preparations for such use, shall have the right to proceed with that use free of charge, provided that the scope thereof is not extended (right of post-grant use).

The right of post-grant use may only be transferred to another person together with the enterprise in which the use or the necessary preparations for use have been made.

**Footnote. Article 31 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 #586; of 07.04.2015 # 300-V (the act is entered into force in ten calendar days after its first official publication).**

## **Chapter 7. Protection of rights of authors, applicants, and patent owners**

### **Article 32. Board of appeal**

1. The Board of appeal is a structural unit within the authorized body for the pre-trial consideration of disputes concerning the objections filed under paragraph 10 of article 22, paragraph 3 of article 23, paragraph 6 of article 24 and paragraph 2 of article 29 of this Law. The Statute of the Board of appeal shall be approved by the authorized body.

1-1. Pre-trial disputes, objections specified in paragraph 2 of this article, is required.

2. The following notices of opposition may be filed with the Board of appeal:

1) over the decision of the authorized body (the opinion of the expert agency) to refuse the grant of an innovation patent for an invention, utility model patent and of industrial design patent;

2) against the grant of an invention patent, utility model patent and of industrial design patent, against the Eurasian patent..

The notice of opposition provided for in subparagraph 1 of this paragraph shall be filed either directly by the applicant or his successor, or through a representative.

The notice of opposition provided for in subparagraph 2 of this paragraph shall be filed either directly by any interested person or through a representative.

The notice of opposition in Kazakh or Russian languages shall be submitted with the authorized body directly or be sent via mail. The accompanying materials to be furnished shall be in Kazakh or Russian languages.

The notice of opposition, when furnished by facsimile or by electronic mail, shall be confirmed by the original hard copy not later than one month from the date of receipt of such opposition.

The notice of opposition shall be furnished within the terms provided for in this Law.

If the applicant fails to respect the time limits prescribed in paragraph 1) of this article, the time limits may be restored provided that the applicant presents request in the term established by the present Law. The applicant shall file the said request with the Board of appeal simultaneously as he submits the notice of opposition.

3. Where the notice of opposition is furnished by the patent attorney or any other representative the power of attorney shall be in Kazakh or Russian languages, and if the power of attorney is presented in a language other than (foreign) the Kazakh or Russian, it shall be translated into Kazakh and Russian languages, and the translation shall be notarially certified. The notice of opposition shall be either accompanied by the original copy of notarized power of attorney or in order to confirm the notarization shall be furnished to the secretary of the Board of appeal together with the copy.

4. The notice of opposition shall be considered by a collegium of experts of the Board of appeal within the terms provided for in this Law. The said time limits may be extended, at the request of the contestant or the patent owner, for a period not exceeding six months from the date of expiration of the prescribed time limit.

5. Where the contestant or the patent owner wishes to contest the decision taken by the board of appeal, he may do so, within six months following the date of receipt of the decision, by lodging an appeal with the court.

**Footnote. Article 32 as amended by the Law of the Republic of Kazakhstan of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official**

publication); as amended by the laws of the Republic of Kazakhstan of 07.04.2015 #300-V (the act is entered into force in ten calendar days after its first official publication); of 31.10.2015 # 378-V (the act is entered into force since 01.01.2016).

### **Article 32-1. Grounds for refusal to consider the notice of opposition in the board of appeal**

1. The consideration of the notice of opposition shall be refused, if:

1) the notice of opposition is not the subject to consideration by the Board of appeal in accordance with the legislation of the Republic of Kazakhstan;

2) the notice of opposition is not signed or signed by a person who has not authorized to do so;

3) the prescribed time limits has not been complied with and the right to that effect for the extension or restore has been forfeited;

4) the applicant fails, within the prescribed time limits, to rectify the deficiencies relating to the requirements of filing the notice of opposition as for the design, content and the procedure.

At the presence of these circumstances the contestant shall be sent a notification that the notice of opposition cannot be taken into consideration and shall be deemed to have not been filed.

The contestant or his representative may withdraw the notice of opposition, before the collegium of experts of the Board of appeal takes a decision.

**Footnote. Chapter 7 was completed with article 32-1 according to the Law of the RK of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication).**

### **Article 32-2. Consideration of the notice of opposition at the meeting of the collegium of the Board of appeal**

1. The notice of opposition shall be examined at the meeting of the collegium of experts of the Board of appeal to be consisted of not less than five of its members. The identities of the members of the experts collegium of the Board of appeal shall be kept confidential prior to the start of consideration of the dispute.

In order to obtain the experts' opinions the meeting of the collegium of experts of the Board of appeal shall comprise the invitation of the representatives from research institutions and experts with specialized background.

2. The collegium of experts of the Board of appeal shall be entitled to postpone the date of meeting:

- 1) where the notice of opposition cannot be examined because of the absence of a person who is entitled to participate on the consideration;
- 2) where in order to take a decision on its merits the parties are required to submit the missing or additional documents (evidence);
- 3) at the request of the parties.

3. Any person, who has the right to participate on the consideration of the notice of opposition, shall be entitled:

- 1) to familiarize himself with the materials of the case, and to make extracts from them, request and receive their copies;
- 2) to produce evidence;
- 3) to participate in the investigation of the evidence;
- 4) to ask questions to the participants of the appeal process;
- 5) to file a request;
- 6) to give oral and written explanations before the collegium of experts of the Board of appeal;
- 7) to present arguments and suggestions on all issues arising during the consideration of the notice of opposition process;
- 8) to oppose the petitions, arguments and the suggestions of others involved in the case.

4. The collegium of experts of the Board of appeal shall take a decision while resolving the dispute on its merits.

The decision shall be taken by a simple majority vote of the members of the collegium of experts of the Board of appeal. At equality of votes the vote of the chairman of the meeting shall be decisive.

Based on the results of the examination of the notice of opposition following decisions shall be taken:

- 1) to satisfy the notice of opposition;
- 2) to partially satisfy the notice of opposition;
- 3) to postpone the date of consideration of the notice of opposition;
- 4) to dismiss the notice of opposition.

5. The collegium of experts of the Board of appeal shall, within ten business days from the date of taking the decision, prepare and send to the parties the decision of the Board of appeal. The decision of the Board of appeal shall be in writing and shall consist of an introduction, descriptive, motivation and conclusion parts.

The decision of the Board of appeal shall be signed by all members of the collegium of experts of the Board of appeal.

**Footnote. Chapter 7 was completed with article 32-2 according to the Law of the RK of 12.01.2012 # 537-IV (the act is entered into force in 10 calendar days after its first official publication).**

### **Article 33. Settlement of disputes in court proceedings**

1. The competence of the court shall extend to disputes over:

- 1) the authorship of an industrial property subject matter;
- 2) the legality of the grant of a title of protection;
- 3) the identification of the patent owner;
- 4) the grant of a compulsory license;

5) infringement of the exclusive right to use the industrial property subject matter and of other economic rights of the patent owner;

6) the conclusion and execution of license contracts of the protected industrial property subject matter;

7) the right over the prior use and post-grant use;

8) the remuneration to be paid to the author by the employer under paragraph 4 of article 10 of this Law;

9) the payment of compensation provided for in this Law;

10) other disputes arising out of the protection of rights certified by the title of protection;

1-1. Claim made in the decision of the authorized body, indicated in paragraph 2 of article 32 of this Law, filed in the Court after consideration of the relevant objection by board of appeal.

2. The expert agency shall, on the basis of a court decision, publish information on changes relating to the title of protection.

**Footnote. Article 33 as amended by the laws of the Republic of Kazakhstan of 09.07.2004 # 586; of 31.10.2015 # 378-V (the act is entered into force since 01.01.2016).**

### **Article 34. Liability for infringement of the rights of authors, applicants and patent owners**

The usurpation of authorship, acquisition of the status of author by coercion, disclosure of information on the industrial property subject matter without the author's or the applicant's consent prior to the publication of its particulars, unlawful use of the protected title of protection, violation of the process of patenting the industrial property subject matter in foreign countries shall entail liability in accordance with the laws of the Republic of Kazakhstan.

**Footnote. Article 34 as amended by the laws of the Republic of Kazakhstan of 10.07.2009 # 179-IV (order of enforcement see Article 2 of the Law).**

## **Chapter 8. Final provisions**

### **Article 35. State fee**

The performance by the authorized body of legal actions on the grant of the titles of protection, registration of the agreements, professional attestation of the patent attorneys as well as the grant of the certificate of registration of the patent attorneys shall, under tax legislation of the Republic of Kazakhstan, be subject to state fees.

**Footnote. Article 35 as amended by the Law of the Republic of 10.07.2012 # 34-V (the act is entered into force since the day of its official publication).**

### **Article 36. Patent attorneys**

1. Individuals who are capable citizens of the Republic of Kazakhstan, having their permanent residence in its territory, and with the higher education and work experience in the field of intellectual property to be not less than four years, who have been attested and registered with the authorized body in the field of intellectual property may qualify for a patent attorney.

In order to certify the candidates for patent attorneys the authorized body shall strike an attestation commission consisting of the staff of the authorized body and the expert agency. In this case, the number of members of the attestation commission shall be at not less than five people.

The authorized body shall carry out the attestation of candidates for patent attorneys at least once a year upon receipt of applications from the candidates for patent attorneys.

Upon results of the attestation the attestation commission shall take a decision to attest the candidate or refuse the attestation of the candidate. The form of the decision taken by the attestation commission shall be approved by the authorized body.

The decision of the attestation commission may be appealed in court within three months from the date of taking such decision.

Candidate, who successfully passes the attestation exam for patent attorneys, shall be granted a certificate of patent attorney, the form of which shall be established by the authorized body.

Carrying out a professional attestation of patent attorneys and the granting the certificate shall, under tax legislation of the Republic of Kazakhstan, be subject to state fees.

2. The following persons shall not be admitted to the attestation of candidates for patent attorneys:

1) who, under the laws of the Republic of Kazakhstan, are prohibited to be engaged in business activities;

2) who are employees of the authorized body and its lower organizations, as well as their close relatives, spouse (wife);



3) whose criminal conviction of criminal offence has not been removed or expunged from official records in accordance with the law;

4) who, under this Law, has been excluded from the register of patent attorneys.

3. The activities of the patent attorneys shall be suspended by the protocol decision of the attestation commission:

1) where the patent attorney files the request with the attestation commission;

2) for a period when the persons have been classified as those who, under the laws of the Republic of Kazakhstan, are prohibited to be engaged in business activities, and are the employees of the authorized body and its lower organizations;

3) in order to clarify the circumstances provided for in subparagraphs 2) and 6) of paragraph 1 and in paragraph 5 of article 36-2 of this Law.

In the case referred to in subparagraph 3) of this paragraph, the activities of the patent attorney shall be suspended until the attestation commission takes a corresponding decision within three months.

The activities of the patent attorney shall be restored by the protocol decision of the attestation commission where the grounds, which served as suspension of the activities, have been remedied.

4. The patent attorney shall, as a representative of the applicant or the patent owner, carry out activities related to the conduct with the authorized body and expert agency on the legal protection of intellectual property. The conduct of affairs with the authorized body and the expert agency may also be carried out by the applicant and (or) patent owner on their own.

Individuals having their residence outside the territory of the Republic of Kazakhstan and foreign legal entities shall be required to act through patent attorneys in exercising their rights of the applicant, patent owner and the interested person in the authorized body and its lower organizations.

Individuals having their permanent residence in the Republic of Kazakhstan, but temporarily residing outside its territory may act on their own in exercising their rights of the applicant, patent owner and the interested person in the authorized body and its lower

organizations, provided that they indicate the correspondence address within the territory of the Republic of Kazakhstan.

5. The information that the patent attorney receives from the grantor of the power of attorney in respect with his instruction shall be acknowledged confidential where the requirements provided for by legislative acts of the Republic of Kazakhstan to the confidential information or other secret protected by law have been met.

**Footnote. Article 36 as amended by the Law of the Republic of 12.01.2012 # 537-IV (the act is entered into force in ten calendar days after its first official publication).**

### **Article 36-1. Rights and obligations of patent attorney**

1. The patent attorney shall, on behalf of the applicant (individual or legal entity), employer with whom he has the employee agreement, or on behalf of the person, with whom he or his employer concluded a commercial contract, has the right to conduct the following activities:

1) consulting on the legal protection of intellectual property rights, acquisition and transfer of the intellectual property rights;

2) performing the works on the execution and drawing up, on behalf of or by instruct of the customer, grantor and employer, of invention application, utility model application and industrial design application;

3) the cooperation with the authorized body and (or) expert agency on the issues of the legal protection of the rights for an invention, utility model, and industrial design, including the conducting of correspondence, preparation and transmission of the notice of opposition for the examination decision, participation in the meetings of the Council of experts under the expert agency.

4) the assistance in drawing up, considering, and sending for the examination the license (sublicense) contracts and (or) assignment agreement.

2. The powers of patent attorney shall be certified in a power of attorney.

3. Where the patent attorney provides to the authorized body or the expert agency, the copy of the power of attorney authorizing the patent attorney to conduct affairs related to the submission of the invention application, application for utility model and industrial

design application, and (or) the related to the receipt of the title of protection, as well as filing the notice of opposition before the Board of appeal.

Where the power of attorney is presented in a language other than (foreign) the Kazakh or Russian, the patent attorney shall obligatory provide its translation into Kazakh and Russian languages, and the translation shall be notarially certified.

4. The patent attorney shall be obliged to deny the instruction where in relation to that case he has represented or consulted the persons whose interests contradict with the interests of the person filing the request for the conduct of affair or otherwise participating in the consideration, and where proceedings involves an official, who is a close relative of the patent attorney, his spouse (wife) and (or) his (her) close relative.

Chapter VIII as supplemented by article 36-1 by the Law of the Republic of Kazakhstan dated 12.01.2012

**Footnote. Chapter 8 was completed with article 36-1 according to the Law of the RK of 12.01.2012 # 537-IV (the act is entered into force in ten calendar days after its first official publication); as amended by the laws of the Republic of Kazakhstan of 07.04.2015 #300-V (the act is entered into force in ten calendar days after its first official publication).**

#### **Article 36-2. Withdrawal and annulment of certificate of the patent attorney**

1. The patent attorney shall be excluded from the register of patent attorneys by the decision of the attestation commission:

- 1) where he files with the attestation commission the personal application;
- 2) upon termination of the citizenship of the Republic of Kazakhstan or on leaving for permanent residence outside the Republic of Kazakhstan;
- 3) where he interrupted the professional activities of the patent attorney for a period of over five years;
- 4) upon entry into force of a guilty verdict which was passed upon the patent attorney for convicting the crime;
- 5) in case of death of the patent attorney or where he is declared as a missing or dead person;
- 6) where the patent attorney is recognized as incapable or restrictedly capable.

2. The certificate of the patent attorney shall be annulled by the decision of the attestation commission where the patent attorney is excluded from the register of patent attorneys on the grounds set forth in subparagraphs 4), 5) and 6) of paragraph 1 of this article. Information on the annulment of the certificate shall be introduced in the register of patent attorneys.

3. The certificate of the patent attorney shall be withdrawn by the decision of the attestation commission upon request of the patent attorney or any third party authorized thereto in the cases referred to subparagraphs 1), 2) and 3) of paragraph 1 of this article.

The patent attorney, who has been excluded from the register on the grounds set forth in subparagraphs 1) and 2) of paragraph 1 of this article, may be re-registered as a patent attorney without passing the qualification exam, provided that the grounds which served the his exclusion from the register have been eliminated and the application was filed with the attestation commission within three years from the date of publication of the decision to exclude from the register. The attestation commission shall, upon submitted documents, establish the fact of elimination of the grounds set forth in subparagraphs 1) and 2) of paragraph 1 of this article.

4. The patent attorney, who has been excluded from the register of patent attorneys, shall forfeit the right to carry out the activities of the patent attorney from the date of introducing such information in the register, and the certificate of this as a patent attorney shall be withdrawn or annulled.

5. If the patent attorney fulfills his obligations, provided for provided for by this Law, in bad faith, the authorized body shall strike an appeals commission consisting of an odd number of the staff of the authorized body.

The appeals commission is a collegial body and considers the complaints of individuals and (or) legal entities against the patent attorneys representing their rights and legitimate interests for actions committed in violation of applicable laws.

Any individual, who filed the complaint against the patent attorney, and the patent attorney in respect of whom such complaint was filed, shall have the right to participate in the meeting of the appeals commission.

Upon results of consideration of the complaint the appeals commission shall recommend that the authorized body sent a lawsuit on the annulment of the certificate of the patent attorney or shall take one of the following decisions:

1) to postpone the consideration of the complaint for the lack of evidence or until the clarification of circumstances which could contribute to the taking of the objective decision;

2) to dismiss the complaint.

The appeals commission shall take a decision by a simple majority votes documented by the protocol. The decision of the appeals commission may be appealed in court.

The Statute of the appeals commission shall be determined by the authorized body.

**Footnote. Chapter 8 was completed with article 36-2 according to the Law of the RK of 12.01.2012 # 537-IV (the act is entered into force in ten calendar days after its first official publication).**

### **Article 37. Patenting of the industrial property subject matter abroad**

1. The filing abroad of applications for industrial property subject matter created in the Republic of Kazakhstan shall be made no earlier than three months after filing the corresponding application with the expert agency or earlier, after verification of the presence of information constituting a State secret carried out according to the procedure provided for by the legislation of the Republic of Kazakhstan.

2. Citizens of the Republic of Kazakhstan, having their residence in its territory and legal entities of the Republic of Kazakhstan shall only file the application for the protection of industrial property subject matter with a competent international patent organization through the expert agency unless otherwise provided in the relevant international treaty.

3. Where an application for the protection of industrial property subject matter with a competent authority of another state or with a competent international patent organization in a manner contrary to the procedure prescribed in this article, no title of protection for the industrial property subject matter shall be granted in the Republic of Kazakhstan.

**Footnote. Article 37 as amended by the Law of the Republic of Kazakhstan of 9 July, 2004 # 586.**

**Article 38. Rights of foreign individuals, legal entities and stateless persons**

1. Foreign individuals and legal entities shall, on the basis of international treaties to which the Republic of Kazakhstan is party or on the principle of reciprocity, enjoy the same rights provided for in this Law for its individuals and legal entities.

2. Stateless persons residing in the Republic of Kazakhstan shall enjoy the same rights provided for in this Law and other legal enactments relating to the legal protection of industrial property subject matter on the same basis as individuals and legal entities of the Republic of Kazakhstan unless otherwise provided in this Law and other legal enactments.

*The President  
of the Republic of Kazakhstan*