

## **Rules for Filing and Submission of Application for Registration of a Trademark**

Adopted by the Patent Agency of the Ministry of Economy and Commerce of the Republic of Kazakhstan on 8 October 1996, registered as No.226 at the Ministry of Justice of the Republic of Kazakhstan on 30 April 1997

### **Introduction**

The Rules for filing and submission of an application for registration of a trademark (hereinafter Rules 1) were developed in accordance with the Law of the Republic of Kazakhstan “On service trademarks and products’ appellations of origin” as well as the regulations adopted by the National Patent Office. They were developed taking into account the up-to-date trends in harmonization of the trademark legislation.

### **List of Abbreviations**

Law, the – the Law on trademarks, service marks, and products’ appellations of origin

ICGS – Nice International Classification of Goods and Services (Nice Classification)

Rules 1 - The Rules for filling out and submitting application for registration of a trademark

Trademark – trademark and/or service mark

Products – goods and/or services

### **1. Submitting an application**

1.1. Under Paragraph 1 of the Article 5 of the Law, any legal or natural body making business under the laws and regulations has the right to submit an application for a trademark registration.

1.2. Application is to be submitted to Kazpatent in person or by post. It is possible to fax the application. The fax can be accepted provided that the original of the application will be submitted within one month from the day of receiving the fax by Kazpatent.

1.3. According to subparagraph 2.3 of the Article 5 of the Law, the applicant shall submit the application either personally or through patent agent. Foreign legal bodies or individuals whose permanent place of residence is abroad or their agents make trademark registration arrangements through the patent agents registered in Kazpatent, if otherwise is not required by the international agreements, ratified by the Republic of Kazakhstan. The authority of the patent agent must be confirmed by the power of attorney.

1.4. Application is to be submitted in the Kazakh and Russian languages. Documents submitted in a foreign language shall have translation in the Kazakh and Russian languages attached. Translation shall be enclosed no later than in two months from the day of application submission.

1.5. Application must be in 2 copies.

### **2. The content of the application**

2.1. Application must be for one trademark. In accordance with the Article 4 of the Law, word, design, three-dimensional and other denotations can be registered as trademarks.

2.1.1. Word denotations may consist of words, word-like combinations of letters, word combinations, collocations, sentences, other speech units and their combinations.

2.1.2. Design denotations may consist of any graphic images on a surface (either specific or abstract images of any objects, figures, lines, styled font elements, and various combinations of the mentioned elements).

2.1.3. Three-dimensional (shape) denotations may consist of three-dimensional objects whose form is original and is not exclusively associated with product's function (product's packing, bottles, flasks, etc).

2.1.4. Combined denotations include combinations of various elements: word, design, and three-dimensional ones.

2.1.5. Other denotations are, for instance, sound denotations like signals.

2.1.6. A trademark can be registered in any color or color combination.

2.2. Application must be submitted on a typical form (T3-1 form), including:

- official application to Kazpatent for registration (par. 1) <\*>;
- full official name of the applicant (par. 2.1) <\*>; if there are several applicants, it should be noted (par. 8.10) and a list of all applicants with all relevant information must be submitted;
- applicant's full address (par. 2.5) <\*>;
- legal form of the legal body (par. 2.2);
- information about state registration of the legal body or entrepreneur (par. 2.3);
- declared denotation (par. 6) <\*>;
- indication that the applicant requests to protect 3D mark (par. 6.1);
- indication that the applicant requests to protect the color (par. 6.2);
- indication that the applicant requests to protect collective trademark (par. 2.4);
- indication that the applicant requests to protect mark in a standard font (par. 6.5);
- transliteration (par. 6.3), translation (par. 6.4) of the word denotation, if the denotation has been submitted in languages other than Kazakh or Russian;
- list of products and/or services for which trademark registration is requested (par. 7) <\*>;
- information about the patent agent (name and address), if the applicant employs services of a patent agent (par. 3) <\*>;
- indication that the applicant requests a convention priority and the information (country, date, application number), according to which the applicant demands convention priority (pars. 5.1, 5.2, 5.3);
- indication that the applicant requests a multiple priority (par. 5.4);
- indication that the applicant requests exhibition priority (par. 5.5);
- address for business correspondence, if any (par. 4);
- signature of the applicant or his agent <\*>;
- indication of the fee paid and how much it is (par. 8.4);
- indication of previous registrations (pars. 9, 10).

Note: the information marked with <\*> is necessary and enough to acknowledge that the application for a trademark registration has been submitted and to register the date and number of the application.

2.3.1. The following is to be enclosed to the application:

- additional five black and white reproductions of the declared denotation;
- description of the declared denotation, if the applicant considers it necessary to explain to experts the meaning of the denotation;
- document to certify the payment of the fee for application submission;
- the charter of the collective trademark in accordance with par. 7 of the Article 7 of the Law, if application is for collective trademark registration;
- power of attorney made by the applicant in favor of the patent agent with the indication of the limits of the power delegated, date of issue and validity period, if the application is submitted through a patent agent;

- a certified copy of a previous application, if the applicant requests conventional priority, and its translation into the Kazakh or Russian language;
- a certified document confirming the legality of requesting exhibition priority with the indication of international status of the exhibition, its date and place, objects to be exposed with denotation declared as the trademark, if the applicant requests exhibition priority;
- documented confirmation of the applicant's rights for the mark elements, if their protection can be provided on the basis of the Law with permission of the third parties (for example, elements of the state symbols or copyright protected objects).

To note the submission of additional materials in enclosure the applicant puts 'X' in the line of the correspondent point and puts the number of pages enclosed in the last line of par. 8.

All the documents listed in par. 2.2.1 must be submitted within two months after the submission of the application.

2.3. The declared denotation must be submitted as a photograph or printed on 8 x 8 cm paper. Labels and special kinds of marks can be submitted in original size, if their size does not exceed 21 x 29.7 cm. If the image exceeds this size, it shall be reduced.

The image of the denotation declared for registration is to be submitted in the same color or color combination as the trademark, which is requested to be registered. It shall be glued to the form in the place marked with a box (par. 6).

The image should be of a good quality, i.e. clear and contrast. All its elements shall be combined by design.

2.3.1. If the applicant requests to protect the color, the mentioned color or color combination shall be noted in the correspondent line (par. 6.1): for instance, the trademark is protected in red, white, and green color combination. In that case, the applicant is to provide 10 color and 5 black and white copies of the declared designation.

2.3.2. If the applicant requests protection of a three-dimensional denotation, it is necessary to make a correspondent mark (par. 6.1). In that case, besides the main 2D image in graphic or photographic form, the applicant can enclose various images in different views so as the experts can evaluate the shape to be protected.

2.3.3. If a label is submitted for registration as a trademark, the label itself can be provided instead of a copy of the declared denotation.

2.3.4. If the word denotation or word component of the trademark is in a different language than the Kazakh or Russian, it is necessary to transliterate it, i.e. to render phonetic sound in letters of one of the official languages (par. 6.3) as well as to make a translation in case if the word (word combination) has a meaning (par. 6.4).

2.3.5. If the applicant requests to protect a sound denotation, he shall enclose its musical notation and a phonogram of the sound designation as a track on a tape. If a part of music to be registered, it is necessary to specify its author and name.

2.3.6. If the applicant requests to protect a collective trademark, he shall enclose the Charter of the collective trademark in accordance with Article 7 of the Law, signed by all users.

2.4. The list of products and/or services is in par. 7 and defines the scope of protection.

If products or services fall into several classes of the ICGS, they shall be grouped in accordance with those classes. Applicant specifies the number of each declared class in ascending order and puts a list of products and/or services of that class besides the number. In making the list of products it is necessary to use specific terms and headings of the correspondent ICGS class.

If such terms are not specified by the classification, it is possible to use generally accepted notions. If it is impossible to put the list on the form, the list shall be enclosed on a separate sheet of paper. Applicant shall avoid overgeneralization when notions might concur with the names of the classes themselves.

2.5.. The application is to be signed by:

- an authorized official, if the application is submitted on behalf of a legal body; first name, surname, and title of the official shall be specified;
- a natural body, if he/her submits the application on his/her own behalf;

- a patent agent, if he submits the application.

If the application is signed by an authorized official, he/her shall specify his/her surname and initials and affix a stamp.

2.6. The letter of attorney shall include:

- a full name and address of the constituent;
- signature of the authorized representative of the applicant or applicant himself;
- title and name of the person who signed the letter of attorney;
- indication of authorization granted to the patent agent, including the right to recall the application and abandon registration;
- the name of the agent;
- date of issue;
- validity period;
- stamp certifying the signature of the responsible authorized person.

Any action of the patent agent within his authorization or any action by Kazpatent concerning the agent has the same effect as the actions by the applicant or concerning the applicant.

2.6.1. General letter of attorney can be made for several applications (registrations) and must reflect all the authorizations provided by it.

### 3. Making changes in the application

3.1. Applicant can request in writing to make changes in the application that do not affect the scope of the protection requested within 2 months since the date of the application submission. No fees charged for this. Applicant pays the fee for any changes made after the specified period of time.

3.2. In case of making changes to the declared denotation that do not affect its general perception, applicant submits changed image of the denotation in the quantity specified in par. 2.2.1.

3.3. Change of applicant's name or address without transfer of the property right can be made by applicant's request in writing with specification of the application number.

3.4. In case of a cession of the right for acquisition of the certificate to another body, in the official request the applicant specifies information about the assignee and certifies the fact of assignee's agreement for the succession.

3.5. It is possible to request change names or addresses of the applicant in several application by one request.

3.6. Division of the application by applicant's request can be made at any phase of application processing by distribution of classes between the divided applications. In doing this the priority is preserved according to the date of the initial application.

3.7. Correction of mistakes in application can be made by applicant or patent agent's request in writing. For that it is necessary to specify the application number and the mistake. The request can concern correction of typical mistakes in a number of applications. For that it is necessary to specify the number of every application with the mistakes.

### 4. Recall of application

In accordance with the Article 12 of the Law the application can be recalled at any time of examination before the trademark registration date. The date of recall is the date when the applicant is sent the notice of withdrawal.

The Rules become effective in the day of the official publication.