

# LAW No. 427 of 16th JULY 1999 OF THE REPUBLIC OF KAZAKHSTAN

## PATENT LAW OF THE REPUBLIC OF KAZAKHSTAN

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## AMENDMENTS AND ADDITIONS INTRODUCED BY:

Q) translation of the original;

1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property. (Articles: 1, 3, 4 replaced, 4-1 introduced, 5, 10, 11, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 28, 29, 30, 31, 32, 33, 35, 36 replaced, 37). Effective 25th July 2004;

2) Law No. 90 of 22nd November 2005 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property Rights. (Articles: 35 replaced, 36). Effective date n/a;

3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property. (Articles: 1 replaced, 5, 6, 13, 16, 17, 18, 19, 21, 22, 22-1 introduced, 23, 24 replaced, 26). Effective date n/a;

4) Law No. 179 of 10th July 2009 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan on Issues of Intellectual Property. (Articles: 10 replaced, 34); and

5) Law No. 452 of 5th July 2011 of the Republic of Kazakhstan Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan on Issues of Revision of the Competence of Authorised State Bodies and of the Government of the Republic of Kazakhstan to Pass Regulatory Legal Acts establishing Requirements to Audited Entities. (Article 4). Effective date n/a

L) last update by Law No.537 of 12 January 2012 . Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property Rights.

## CHAPTER 1. GENERAL PROVISIONS

### Article 1. General Definitions Used in This Law

Introduced by 3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property

The following general definitions are used in this Law:

1) exclusive right — a property right of the holder of the patent to use the industrial property item by any way at own discretion;

2) bulletin — an official periodical edition on issues of protection of industrial property items;

3) intellectual property items — results of intellectual activities and individualization means of participants in civil turnover, goods, work and services;

4) documents of title — innovation patents and patents for inventions, patents for industrial samples and useful models issued in accordance with this Law;

5) employees' inventions — industrial property items created by an employee when performing his service functions or an employer's concrete task;

6) licence agreement — an agreement under which the holder of the patent (licenser) grants to the other party (licensee) a right to use temporarily the appropriate industrial property item in a certain way;

7) industrial property items — inventions, useful models and industrial samples;

8) Paris Convention — the Paris Convention on Industrial Property Protection dated 20th March 1883 with further amendments and additions;

9) holder of the patent — the owner of the document of title;

10) patentability terms — terms of granting to industrial property items of legal protection as stipulated by this Law;

11) patented industrial property items — industrial property items for which documents of title are issued;

12) patent attorneys — citizens of the Republic of Kazakhstan who are granted in accordance with the legislation of the Republic of Kazakhstan a right to represent physical persons and legal entities before the authorised body and expert organisation.

## **Article 2. Relations Governed by Patent Law**

1. The present Law shall regulate the property as well as non-property relations related therewith, arising in connection with the creation of legal protection and use of items of industrial property.

2. Protection of other items of intellectual property (selection achievements, topologies of integrated circuits, trade marks, service marks, names of places of origin of goods and others) shall be regulated by other legislative acts.

## **Article 3. Sphere of Effect of Present Law**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. Provisions of the present Law shall apply to items of industrial property, protection documents thereon are issued by the authorised body [modified by 1], as well as to items of industrial property on which patents are issued on the basis of international treaties to which the Republic of Kazakhstan is a party.

2. When international treaty ratified by the Republic of Kazakhstan establishes other rules than those contained in the present Law, the rules of the international treaty shall apply.

## **Article 4. The Authorised State Body in the Sphere of Protection of Inventions, Useful Models, Industrial Samples**

*introduced by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

*5) Law No. 452 of 5th July 2011 of the Republic of Kazakhstan Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan on Issues of Revision of the Competence of Authorised State Bodies and of the Government of the Republic of Kazakhstan to Pass Regulatory Legal Acts establishing Requirements to Audited Entities.*

1. The authorised state body in the sphere of the protection of inventions, useful models, industrial samples (henceforth — the authorised body) — a state body appointed by the Government of the Republic of Kazakhstan and carrying out the state regulation in the sphere of protecting inventions, useful models, industrial samples.

2. The scope of the authorised body shall be as follows:
  - 1) the participation in the implementation of the state policy in the sphere of the legal protection of inventions, useful models, industrial samples;
  - 2) issuing of protection documents concerning inventions, useful models, industrial samples;
  - 3) supervision of activities of physical persons and legal entities using industrial property items;
  - 4) compilation of protocols and handling administrative violation cases, imposition of administrative punishments;  
*[repealed by 5]*
  - 5) performance of other powers provided for by this Law, other laws of the Republic of Kazakhstan, acts of the President of the Republic of Kazakhstan and Government of the Republic of Kazakhstan. *[introduced by 5]*

#### **Article 4-1. Expert Organisation**

*introduced by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. An organisation of experts — organisation subordinated to the authorised body, carrying out activity in spheres recognised as the state monopoly (rendering services in the sphere of protecting inventions, useful models, industrial samples).
2. The scope of an organisation of experts shall be as follows:
  - 1) acceptance of applications for inventions, useful models, industrial samples;
  - 2) conducting expert examination of inventions, useful models, industrial samples;
  - 2-1) examination of concessions contracts of protection documents and assignment of rights to receive them, as well as licensing agreements (sublicensing agreements);
  - 3) maintenance of the state registers of protected inventions, useful models, industrial samples;
  - 4) publication of information on inventions, useful models, industrial samples; *[introduced by 1]*
  - 5) exercise of other functions entrusted to it by the Republic of Kazakhstan legislation.

#### **Article 5. Legal Protection of Items of Industrial Property**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

*3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

*[repealed by 3]*

1. Rights to the invention shall be protected by an innovation patent or a patent, ones to the useful model and industrial sample shall be protected by a patent.

*[repealed by 3]*

2. The innovation patent for the invention shall be issued after the conducting of the expert examination of the application for issue of an innovation patent for the invention. The patent for the useful model shall be issued according to results of the expert examination of the application for issue of a patent for the useful model. *[introduced by 3]*

The patent for the invention and industrial sample shall be issued after the conducting of the formal expert examination and expert examination of the application as to substance. *[introduced by 3]*

The innovation patent and the patent shall certify priority, authorship and exclusive right to the industrial property item. The innovation patent shall be issued at the risk and under the responsibility of the applicant in relation to the world novelty and invention level. *[introduced by 3]*

3. Invention *[modified by 3]* patent on invention shall be valid during three *[modified by 3]* years from the date of submission of the application *[excluded by 1]* with possible extension of the validity term *[excluded by 1]* pursuant to the patentee petition, but not more than for two *[modified by 3]* years.

Patent on invention shall be valid during twenty years from the date of submission of the application. *[excluded by 1]*

The term of validity of patent on invention the use thereof in accordance with legislation requires the authorisation of the authorised body may be prolonged by the Kazpatent pursuant to the patentee petition, but not more than for five years.

Patent on utility model shall be valid during five years from the date of submission of the application *[excluded by 1]* with possible extension of the validity term *[excluded by 1]* pursuant to the patentee petition, but not more than for three years.

Patent on industrial design shall be valid during fifteen years from the date of submission of the application *[excluded by 1]* with possible extension of the validity term pursuant to the patentee petition, but not more than for five years.

The order extending the validity of the innovation patent and patent for the invention, the patent for utility model and industrial design shall be determined by the authorized body.

4. The scope of the legal protection granted by the protection document on invention and utility model shall be defined by their formula, and in the case of protection by the patent on the industrial sample *[modified by 3]* – by the totality of its essential features as indicated in pictures of the item (model) and listed among the substantial features of a given industrial sample. *[added by 1]* In order to interpret the formula of the invention, utility model the description and drawings may be may be used. *[modified by 1]*

The effect of the protection document issued for the method of manufacturing of a product shall also apply to the product directly obtained by this method.

In this respect, the new product shall be considered as manufactured by the protected method, unless proved otherwise.

5. The right to obtain the protection document, the rights ensuing from the registration of an application, the right to hold the protection document, and the rights ensuing from the protection document may assigned fully or partially to other person.

6. The legal protection in accordance with the present Law shall not be granted to items of industrial property recognised by the state as secret. The procedure for handling the secret items of industrial property shall be determined by the Government of the Republic of Kazakhstan.

## **CHAPTER 2. TERMS OF PATENTABILITY OF INDUSTRIAL PROPERTY ITEMS**

### **Article 6. Terms of Patentability of Invention**

*Amended by 3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

1. The legal protection shall be granted to an invention provided it is new, has the inventive level and is applicable in industry.

The invention shall be new when it is unknown from information on the state of the art.

The invention shall have the inventive level when it is not evident to the expert from information on the state of the art.

Information on the state of the art shall include any data which become generally available in the world prior to the date of the invention priority.

When establishing the novelty of invention, there shall also be included to the information on state of the art the applications on inventions and utility models (except for revoked) submitted in the Republic of Kazakhstan subject to their prior priority and the inventions and utility models patented in the Republic of Kazakhstan.

The invention shall be industrially applicable when it may be used in industry, agriculture, public health and other sectors of industry.

*[repealed by 3]*

2. Technical solutions in any field related to the product (device, matter, strain of microorganism, cell culture of plants or animals), method (procedure of performance of actions with a material item by material means), as well as application of a known product or method for a new purpose or of a new product for certain purpose shall be protected as an invention. *[introduced by 3]*

3. The following shall not be recognised as inventions:

- 1) discoveries, scientific theories and mathematical methods;
- 2) methods of organisation and management of the economy;
- 3) conventional designations, timetables, rules;
- 4) rules and methods for execution of mental operations, conducting of games; *[added by 3]*
- 5) software and algorithms as such;
- 6) designs and schemes of planning of structures, buildings, territories;
- 7) proposals related only to outward appearance of items;
- 8) proposals that are contrary to the public interest, humanitarian principles and morality.

4. It shall not recognised as a circumstance which affect the patentability of the invention the public disclosure of information related to the invention, by the applicant (author) or any other person who directly or indirectly received from him this information, including the demonstration of the invention as an exhibit at the official or officially recognised international exhibition organised in the territory of the state which is a member of the Paris Convention, provided the application for the invention is submitted not later than six months from the date of its disclosure or placement in the exhibition. In this respect the liability to prove this fact shall be borne by the applicant.

## **Article 7. Terms of Patentability of Utility Model**

1. The constructive implementation of means of production and items of consumption, as well as component parts (device) shall be referred to the utility model.

The utility model shall be granted the legal protection provided it is new and industrially acceptable

The utility model shall be the new model when the totality of its essential features is unknown from the information on the state of the art.

Information on the state of the art shall include the information which became generally available prior to the date of priority of the utility model published in the world concerning the means of the same designation as claimed utility model, information on its application in the Republic of Kazakhstan, and also the applications for utility models and inventions (except for revoked) submitted in the Republic of Kazakhstan by other persons subject to their prior priority, and utility models and inventions of the same designation patented in the Republic of Kazakhstan.

The utility model shall be industrially applicable when it may be used in practice.

2. It shall not be recognised as a circumstance which affects the patentability of the utility model the public disclosure of information related to the utility model, by its applicant (author) or any other person who directly or indirectly received from him this information, including the demonstration of the utility model as an exhibit at the official or officially recognised international exhibition organised in the territory of the state which is a member of the Paris Convention, provided the application for the utility model is submitted not later than six months from the date of its disclosure or placement in the exhibition. In this respect the liability to prove this fact shall be borne by the applicant.

3. Decisions related to items indicated in paragraph 3 of Article 6 of the present Law shall not be protected as utility models.

## **Article 8. Terms of Patentability of Industrial Design**

1. The artistic and design solution which determines the outward appearance of item shall be referred to industrial design. The industrial design shall be granted the legal protection provided it is new and original.

The industrial design shall be recognised as the new design when the totality of its essential features presented in pictures of the industrial design and given in the list of the essential features are not known from the information generally available in the world prior to the date of priority of the industrial design.

When establishing the novelty of the industrial design there shall also be considered, subject to their prior priority, the applications for industrial designs (except for revoked) submitted in the Republic of Kazakhstan by other persons, and industrial designs patented in the Republic of Kazakhstan.

An industrial design shall be recognised as original when its essential features define the creative nature of the item's specifics.

An industrial design shall be recognised as industrially acceptable when it may be repeatedly reproduced by way of manufacturing the relevant item.

2. The following decisions shall not be recognised as industrial designs:

- 1) those stipulated exclusively by the technical function of items;
- 2) objects of architecture (except for small architectural forms), industrial, hydrotechnical and other stationary structures;
- ~~3) published production as such;~~
- 4) objects of unstable form from liquid, gaseous, dry substances or similar substances;
- 5) items which contradict the public interests, principles of humanity and moral.

3. It shall not be recognised as a circumstance which affects the patentability of the industrial design the public disclosure of information related to the industrial design, by the applicant (author) or any other person who directly or indirectly received from him this information, including the demonstration of the industrial design as an exhibit at the official or officially recognised international exhibition organised in the territory of the state which is a member of the Paris Convention, provided the application for the industrial design is submitted not later than six months from the date of its disclosure or placement in the exhibition. In this respect the liability to prove this fact shall be borne by the applicant.

## **CHAPTER 3. AUTHORS AND PATENTEES**

### **Article 9. Author of Item of Industrial Property**

1. A physical person by whose creative labour the object of industrial property is created shall be recognised as the author of industrial property.

2. When several physical persons have participated in the creation of the item of the industrial property they shall be considered to be its authors (co-authors). The procedure for the use of the rights which belong to the co-authors shall be determined by agreement between them.

A physical person shall not be recognised as an author who has not introduced personal creative contribution to the creation of the object of industrial property, but has rendered to the author only technical, organisational or material assistance, or has only promoted the registration of the right to it and its use.

3. The copyright shall be an inalienable personal right, and it shall be protected for an indefinite period of time.

4. The author shall have the right to assign to the object of industrial property his name or special name, provided that the rights of third parties to trade marks protected in the Republic of Kazakhstan are not violated.

5. The authors of the most important and widely used inventions can be presented for the nomination "Honored Inventor of the Republic of Kazakhstan." The rules of acknowledgement as "Honored Inventor of the Republic of Kazakhstan" shall be defined by the Government of the Republic of Kazakhstan.

#### **Article 10. A Patent Holder**

*Introduced by 4) Law No. 179 of 10th July 2009 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan on Issues of Intellectual Property.*

1. The protective document shall be issued to:

- 1) the author (authors) of the item of industrial property;
- 2) employers in cases that are provided for by paragraph 2 of this Article;
- 3) their successor (successors), in particular to a person (persons) which received (received) the appropriate right according to the cession procedure;
- 4) jointly to persons stipulated by this paragraph provided there is consent between them.

2. Rights to protective documents in respect of a work invention shall be held by the employer, unless it is provided for otherwise in a contract between him and the employee.

3. The right to receive a protective document in respect of an invention that is made by the author which is not related to the performance by him of official duties or a specific task received by him from the employer, but with the use of information, and also material, technical and other funds of the employer, shall be held by the author, unless it is provided for otherwise by a contract between the author and the employer.

In the event that the work invention is made jointly by creative labour of several persons, among whom there is a person who is not an employee of the said employer, the right of such a person in relation to the said work invention shall be determined by a contract to be concluded by him with the said employer and other authors.

In the event that service inventions are made by authors as a result of performance by several employers of joint work on the basis of a contract, the rights of those employers in relation to the said inventions shall be determined by a contract between them.

4. When having made a work invention the author shall notify the employer in the written form concerning the making of it within a month from the day of exposure by him of the fact of making of the work invention.

The notice must be signed by the author (authors) and must comprise:

- 1) indication to the surname, name, patronymic (if any) and held position of the author;
- 2) the name of the work invention;
- 3) conditions and place of the making of it, expected field of application;



4) description made with the completeness that is sufficient to exposure the point, determination of a category and evaluation of the fitness of the invention in activity of the employer.

The employer shall be obliged to accept and register the notice concerning the making of the work invention submitted by the author on the day of submission of it, about what the authors shall be notified in the written form.

If the description and other data which are necessary to formulate an application are incomplete, then the employer shall have the right to require from the employee additional materials on the work invention, who will submit additional materials within one month from the date of receipt by him of the request. In this case the duration of the term specified in paragraph 7 of this Article shall suspend and renew upon the receipt of the requested information.

5. If the employee has not notified the employer that has the right to receive a protective document concerning the making of the work invention, then the term specified in paragraph 7 of this Article shall begin from the date when the employer becomes aware of the making of it.

If the fact of making of the work invention is established by the employer, then he shall be obliged to notify the author of the work invention in the written form concerning it. In this respect if the right to receive a protective document in relation to the work invention is held by the employer, the employer shall be obliged to notify the author concerning the beginning of the formulation by him of the appropriate application, and the author shall be obliged under the request of the employer to submit in the written form additional information that is necessary to formulate the application concerning the work invention, and a list of all the authors of the work invention.

6. When having lost interest to receive a protective document in relation to the work invention after the submission of the application for issue of them or to maintenance the protective document in force, the employer shall be obliged to grant timely and free-of-charge to the author the right to receive a protective document or the received protective document.

7. If the employer, within four months from the date of notification of him by the author concerning the made item of industrial property, has not submitted an application, has not ceded the right to receive a protective document to another person and has not informed the author concerning preservation of the appropriate item in secret, then the right to receive a protective document shall be passed on to the author. In this case the employer shall have a preferential right to use the appropriate item of industrial property for own production under a contract with the patent holder.

8. Neither of the parties to secure own rights in relation to the work invention shall have the right to submit to the expert organisation an application for receipt of a protective document without notification of the other party concerning it.

9. Amount, conditions and the procedure for payment of remuneration to the author for the work invention shall be determined by an agreement between him and the employer. Where no agreement is reached, a decision shall be passed by the court. If it is impossible to measure contributions of the author and employer in the making of the work invention, the right to a half of the benefit which the employer has gained or should gain shall be recognised as due to the author.

## **CHAPTER 4. EXCLUSIVE RIGHT TO USE INDUSTRIAL PROPERTY ITEMS**

### **Article 11. Exclusive right and obligations of patentee**

1. A patentee shall have the exclusive right to use at his own discretion the protected item of industrial property.

Exclusive right to use protected items of industrial property shall be exercised by the patent holder during the validity period of the protection document, beginning on the date of the publication of information concerning the issue of a given protection document in the official bulletin.

2. The following shall be recognized as the use of item of industrial property: manufacturing, application, import, offer to sell, sale, and any other introduction into civil turnover or storage for this purpose of the product containing the protected item of industrial property, as well as the application of the protected method.

The product shall be recognized as containing the protected invention or utility model, and the protected method shall be recognized as applicable when the product contains, and the method uses any feature of the invention, utility model given in an independent paragraph of the claim or a feature equivalent to it known in the prior art on the date of the beginning of application.

Introduction into civil turnover or storage for this purpose of the product manufactured directly by this method shall be recognized as the use of the protected method of manufacturing of the product.

The product shall be recognized as containing the protected industrial design when it contains all its essential features presented in the pictures of the item (model) and given in the list of essential features.

3. A patentee shall be obliged to use the item of industrial property.

Relations associated with the application of an item of industrial property the protection document on which belongs to several persons shall be defined by the agreement between them. In the absence of such agreement each of the patent holders may use the protected item at their own discretion, but they shall have no right to grant a license on it or assign the protection document to other person without the consent of other patentees.

A patentee may use warning marking indicating that the used item of industrial property is patented.

4. When the patentee does not use the industrial property item and refuses to conclude a licensing agreement on acceptable commercial terms any person shall have the right to apply to a court with a claim on being granted a compulsory non-exclusive licence when the item of industrial property was not continuously used after the first publication of information on the issue of the protection document on the industrial property item during any four years preceding the date of submission of such claim. If the patentee does not prove that the non-use is stipulated by good reasons, the court shall grant the indicated licence with determination of limits of use, deadlines, amount and procedure for payments. The amount of payments shall be established not lower than the market price of the licence as defined in accordance with the established practice.

Any compulsory licence shall be issued in the first instance for providing for demands of the domestic market of the Republic of Kazakhstan.

The right to use the indicated industrial property item may be assigned by the person to whom the compulsory licence was granted to other person only together with the relevant production in which this item is used.

The compulsory licence shall be subject to revocation by the court in the case of termination of the circumstances which were the reason for its issue.

5. The patentee who cannot use the item of industrial property without infringing the right of the holder of another patent who has refused to conclude a licensing agreement on acceptable commercial terms shall have the right to apply to the court with application claim on being granted a compulsory non-exclusive licence to use the item of industrial property in the territory of the Republic of Kazakhstan.

If the patent holder who cannot use the item of industrial property without infringing the rights of the holder of another patent proves that his industrial property item represents an important technical advance and has a considerable economic significance in relation to the item of industrial property of another patent, the court may decide to grant him a compulsory license.

When granting the indicated licence the court shall determine the limits of use of the item of industrial property the patent on which belongs to other person, deadlines, amount and procedure

for payments. In this respect the amount of payments shall be established not lower than the market price of the licence as defined in accordance with the established practice.

The right to use the item of industrial property obtained on the basis of the present paragraph may be assigned only with the assignment of the protection document on this item of industrial property in connection therewith this right is granted.

In the case of granting in accordance with this paragraph of a compulsory license to the patent holder of protection document the right to use on which was granted on the basis of indicated license shall also have a right to receive a license to use the dependent invention in connection therewith compulsory license was granted.

6. The patentee may assign the protection document to any natural or legal person. The contract on assignment shall be subject to obligatory registration by the authorised body.

Registration of the contract on protection document assignment and the contract on assignment of the right to receive the protection document shall be carried out by the results of examination materials, conducted by expert organization.

Regulation on registration of the contract of assignment shall be applied to order of registration of the contract of assignment of rights to receive a protection document, unless otherwise provided by legislation of the Republic of Kazakhstan.

An application form is submitted to the expert organization to register a contract of assignment.

The application shall include:

1) original contract of assignment in four copies, the subject of which is homogeneous items of industrial property, equipped with a title page. Each copy of the contract is stitched, sealed with a paper seal, which shall be recorded on the number of bound and numbered pages, shall bear the stamp and signature of authorized officials of both parties or the applicant.

Notarized copies of the contract may be submitted instead of original contract of assignment;

2) Power of Attorney in the case of an application through the offices of patent agent or other representative;

3) a document confirming payment of state duty.

National applicants, except for the above documents, shall provide the decision of governing bodies of the holder of protection document or the exclusive rights, the general meeting of shareholders or founders on the issue of the contract conclusion and providing the authority to sign the contract by the head of the enterprise.

The application and other required documents shall be submitted in Kazakh and Russian. Foreign names and names of legal persons shall be indicated in the Kazakh and Russian transliteration. If the documents are submitted in another language, the application shall include notarized translation into Kazakh and Russian.

The application must relate to one contract of assignment.

Natural persons living outside the Republic of Kazakhstan, or foreign legal persons submitting materials of the contract to the authorized body on their own behalf, exercise the rights relating to the registration of the contract through a registered patent agent of the Republic of Kazakhstan.

Citizens of the Republic of Kazakhstan, temporarily residing abroad, exercise the rights relating to the registration of the contract, without a patent agent but with indication of address for correspondence within the territory of the Republic of Kazakhstan.

7. After submission of documents for registration expert organization within fifteen working days from the date of receipt of an application conducts a preliminary examination to check the presence of the required documents and their compliance with the requirements. In case of absence of the document proving payment of the examination, the applicant shall be billed for payment. In

this case, deadlines shall be calculated from the date of receipt of payment by the expert organization.

Based on the materials of contract of assignment accepted for consideration substantive examination shall be carried out within twenty days, during which materials of the contract of assignment shall be studied in accordance with the present legislation of the Republic of Kazakhstan.

8. Removable reasons that prevent registration of the contract of assignment:

- 1) no payment for the keeping in force of the protection document;
- 2) provisions in the contract of assignment which are contrary to the civil legislation of the Republic of Kazakhstan and international treaties ratified by the Republic of Kazakhstan.

9. In case of violation of the requirements for registration of documents or reasons specified in paragraph 8 of this article, preventing registration of the contract of assignment, expert organization shall send a request to the applicant with a proposal within three months from the date of its sending to submit the missing or corrected documents or make necessary amendment. In this case deadlines specified in paragraph 7 of this article for the substantive examination shall be calculated from the date of submission of the missing or corrected documents.

10. Expert organization shall issue a decision to refuse to register the contract of assignment in the presence of the following grounds:

- 1) termination of the protection document validity in respect of which the contract is concluded;
- 2) failure to respond to the request of the expert organization timely within three months;
- 3) the lack of all the necessary information and documents.

Within two working days after the conclusion of the expert organization shall send the decision to the authorized body indicating the reasons for refusal.

11. In case of a positive result of the examination the expert organization within five working days shall send to the authorized body decision indicating that there is no reason preventing the registration of the contract of assignment.

The decision on registration or refusal of registration of the contract of assignment shall be made by the authorized body within five working days from receipt of the expert organization opinion.

12. After the decision on registration of the contract authorized body shall:

- 1) draw an annex to the protection document for an item of industrial property;
- 2) stamp the front page of the contract certifying its registration with indication of the date of registration and its registration number;
- 3) include information about the contract in the register of contracts;
- 4) send two copies of a registered contract and annex to the protection document to the address for correspondence specified in the application;
- 5) send the control copy of the contract and its decision to the expert organization to publish information on the registration of the contract.

The third and fourth copies of the contract shall be kept in the authorized body and expert organization as control copies.

Expert organization on registered contracts shall publish information on registered contracts in the Gazette, including number and date of registration of the contract, the name or full details of the contracting parties, the subject of the contract, validity of the contract and the territory of the contract.

Any person may obtain an extract from the register of registered contracts of assignment relating to information on registered contracts of assignment that are open for publication.

Familiarization of third parties with the text of the contract and obtaining an extract from it shall be allowed only with the written consent of the contracting parties.

In case if an authorized body makes the decision to refuse a registration of the contract of assignment on the basis of the conclusion of the expert organization all the documents shall be returned to the address specified in the application.

13. The contract of assignment of protection document and the contract of assignment of the right to receive it shall take effect from the date of their registration in the authorized body.

14. Protection document for item of industrial property and (or) the right to receive it shall pass by inheritance or succession.

15. The patentee shall pay annually for keeping in force of protection document.

## **Article 12. Acts which are not Recognised as Violation of Exclusive Right of Patentee**

The following shall not be recognised as violation of the exclusive right of the patentee:

1) use of means which contain the protected items of industrial property in the construction or in the operation of transport vehicles (marine, river, airborne, ground or cosmic) of other countries, provided that the indicated means are temporarily or accidentally located in the territory of the Republic of Kazakhstan and are used for the needs of transport vehicle. Such actions shall not be recognised as violation of the exclusive right of the patentee when transport vehicles belong to physical persons or legal entities of the countries which grant the same rights to owners of the transport vehicles of the Republic of Kazakhstan;

2) carrying out scientific research or experiment on the means which contain the protected item of industrial property;

3) application of such means in emergency circumstances (natural disasters, catastrophes, major accidents) with immediate notification of the patentee and subsequent payment of commensurate compensation to the patentee.

4) application of such means for personal, domestic or other non-business purposes, without receiving the profit;

5) in emergency situations, one-time manufacturing of medicine in the pharmacy pursuant to the doctor's prescription;

6) importation into the territory of the Republic of Kazakhstan, use, offering for sale, sale, other introduction into civil turnover or storage for this purpose of the means containing the protected items of industrial property, if they were previously put into civil turnover in the territory of the Republic of Kazakhstan by patentee or any other person with the permission of the patentee.

## **Article 13. The Right to Prior Use and Temporary Legal Protection**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

*3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

1. A person who prior to the industrial property item priority date used in the territory of the Republic of Kazakhstan in good faith a solution identical to the industrial property item independently of its author, or who made preparations required therefor, shall retain the right to its charge-free use without expanding the scope of such use (prior use right). *[introduced by 1]*

The right to prior use may be assigned to another person only together with the production on which the use of similar decision took place or preparations necessary for it have been made.

2. A person who began to use the item of industrial property after the date of priority but before the date of publication of information on the issue of the innovation patent, patent for an invention, the patent for an industrial sample *[modified by 3]* or patent on utility model shall be

obliged, pursuant to the demand of the patentee, to terminate its further use. However, such a person shall not be obliged to reimburse to the patentee the losses incurred by him as a result of such use.

3. An item of industrial property which is placed as an exhibit at the official or officially recognised international exhibition shall be granted temporary legal protection from the date of its placement on the exhibition until the date of first publication of information on the issue of the protection document, provided that an application on this item was submitted *[excluded by 1]* not later than six months from the date of its placement on the exhibition.

4. A person, who uses the item of industrial property during the period indicated in paragraph 3 of the present Article, shall pay the monetary compensation to the patentee after the issue of the protection document. The amount of compensation shall be defined by the agreement of the parties.

#### **Article 14. Granting Right to Use Item of Industrial Property**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. Any person, who is not the patentee, shall have the right to use the protected item of industrial property only with the permission of the patentee on the basis of the licence agreement.

2. A licensing agreement may stipulate the submission to the licensee of the right:

1) to use the item of industrial property with retention by the licensor of the possibility to use it and the right to issue the licence to other persons (general, nonexclusive licence);

2) to use the item of industrial property with retention by the licensor of the possibility to use it, but without the right to issue a licence to other persons (exclusive licence);

3) to use the item of industrial property without retention by the licensor of the possibility to use it and without the right to issue the licence to other persons (exclusive licence).

When the licence agreement does not stipulate the type of licence it shall be assumed to be general nonexclusive licence.

3. An agreement on granting by the licensee to other person (sublicensee) of nonexclusive licence for the right to use an item of industrial property (sublicensing agreement) may be concluded only in the cases stipulated by the licensing agreement.

The responsibility before the licensor for actions of a sublicensee shall be borne by the licensee, unless otherwise stipulated by the licensing agreement.

4. The licensing agreement and sublicensing agreement for the use of invention, utility model, industrial design shall be concluded in writing and be subject to the registration by the authorised body. *[modified by 1]* The non-observance of written form or the requirement on registration shall entail the invalidity of the agreement.

Registration of licensing agreement shall be based on materials of examination held by expert organization.

The provisions on registration of licensing agreement shall be applied to the order of registration of sublicensing agreement, unless otherwise provided by legislation of the Republic of Kazakhstan.

4-1. In order to register a licensing agreement application filled according to the prescribed form shall be sent to the expert organization.

The application shall include:

1) original contract in four copies, equipped with a title page. Each copy of the contract is stitched, sealed with a paper seal, which shall be recorded on the number of bound and numbered pages, shall bear the stamp and signature of authorized officials of both parties or the applicant.

Submission of materials for registration must be carried out no later than six months from the date of signing the contract.

Notarized copies of the contract may be submitted instead of original contract;

2) Power of Attorney in the case of an application through the offices of patent agent or other representative;

3) a document confirming payment of state duty.

National applicants, except for the above documents, provide the decision of governing bodies of the licensor (sub-licensor) on the issue of the contract conclusion and providing the authority to sign the contract by manager of the enterprise in case of an application on behalf of the entity.

The application and other required documents shall be submitted in Kazakh and Russian. Foreign names and names of legal persons shall be indicated in the Kazakh and Russian transliteration. If the documents are submitted in another language, the application shall include notarized translation into Kazakh and Russian.

The application must relate to one licensing agreement.

Natural persons living outside the Republic of Kazakhstan, or foreign legal persons submitting materials of the contract to the authorized body on their own behalf, exercise the rights relating to the registration of the contract through a registered patent agent of the Republic of Kazakhstan.

Citizens of the Republic of Kazakhstan, temporarily residing abroad, exercise the rights relating to the registration of the contract, without a patent agent but with indication of address for correspondence within the territory of the Republic of Kazakhstan.

4-2. The provisions set forth in paragraphs 7-12 of Article 11 of this Law shall be applied in signing of licensing agreement.

The licensing agreement (sub-licensing agreement) shall enter into force on the date of its registration by the authorized body.

5. The patentee may submit to the authorised body *[modified by 1]* the application on granting to any person the right to obtain the licence for the use of items of industrial property (open licence).

The person, who expressed the wish to obtain the indicated licence, shall be obliged to conclude the contract for payment with the patentee with its obligatory registration by the authorised body *[modified by 1]*. Disputes with respect to the contractual terms shall be considered by the court.

An application of the patentee on granting the right to open licence shall retain its force during three years from the date of publication of information on the open licence in the bulletin. Within the indicated deadline the payment for the maintenance of the protection document in effect shall be reduced by 50 per cent from the year following the year of publication of information on the open licence.

In the case of concluding a licence agreement, the payment for the maintenance of the protection document in force shall be in full amount from a year following the year in which that agreement was concluded. *[introduced by 1]*

6. In emergency situations in the country ~~or other circumstances of the extreme need~~ the Government of the Republic of Kazakhstan shall have the right to allow to use the item of industrial property without the consent of the patentee, but with immediate notification of him and payment of commensurate compensation. The disputes on the amount of compensation shall be resolved by the court.

## **Article 15. Violation of Exclusive Right of Patentee**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. Any person, who uses the protected item of industrial property in contradiction with the present Law, shall be considered as a violator of the exclusive right of the patentee (violator of the protection document).

The following shall be recognised as violation of the exclusive right of the patentee (violation of the protection document): unauthorised manufacturing, application, import, storage, proposal to sell, selling and any other introduction into civil turnover of the product created with the use of the protected item of industrial property, as well as the use of the protected method or introduction into civil turnover of the product manufactured directly by the protected method. In this respect the new product shall be considered as obtained by the protected method in the absence of proofs of otherwise.

2. A patentee shall have the right to demand:

1) termination of the violation of the protection document;

2) reimbursement by the violator of inflicted losses and compensation of moral injure from the date of the first publication of information on the issue of the protection document; [added by 1]

3) recovery of income received by the violator of the protection document instead of reimbursement of losses from the date of the first publication of information on the issue of the protection document; [added by 1] 4) payment by the violator of the protection document of compensation in the amount from ten to fifty thousand monthly calculation indices as established by legislation. The amount of compensation shall be determined by the court instead of reimbursement of losses, or recovery of income.

5) seizure for own benefit of products introduced into civil turnover or stored for that purpose and recognised as violating the protection document, as well as means specifically intended for the violation of the protection document from the date of the first publication of information on the issue of the protection document; [added by 1] 6) obligatory publication concerning the violation committed with inclusion into it of the information on the person to whom the violated right belongs.

3. Demands to the violator of the protection document may also be declared by the licensee if it is stipulated by the licensing agreement.

## **CHAPTER 5. PROCEDURE FOR OBTAINING PROTECTION DOCUMENTS**

### **Article 16. Submission of Application for Issue of Protection Document**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

*3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

1. An application for the issue of the protection document shall be submitted to the an organisation of experts [modified by 1] by the person who has the right to the protection document in accordance with paragraph 1 of Article 10 of the present Law (henceforth – the applicant).

An application may be filed in the form of an electronic document, certified by digital signature.

2. An application for the issue of the protection document shall be submitted in the State or Russian languages. Other documents of the application shall be submitted in the State, Russian or



other languages. When other documents of the application are submitted in other language, the application shall be attached by their translation to the State or Russian languages. The translation must be submitted within two months after the receipt by the an organisation of experts [modified by 1] of the application which contains documents in another language. Under the condition of the relevant payment this deadline may be extended, but not more than by two months.

In the case of a failure to submit the translation within the established deadline the application shall be recognised as unsubmitted.

3. The authorised body and expert organisation must not allow access to the application to third persons before the publication of information on issue of the documents of title, except for cases where there is a request or permit of the applicant or a claim of the criminal prosecution bodies or court. [introduced by 3]

### **Article 17. Application for Issue of Protection Document on Invention**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

*3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

1. An application for the issue of the protection document on invention (henceforth – the application for invention) must relate to one invention or a group of inventions interrelated to such an extent that they form the single inventive conception (requirement of the unity of the invention).

2. An application for invention shall contain the following documents: [added by 3]

1) application for the issue of the protection document with the indication of the authors of the invention in the name of whom the protection document is sought, as well as their place of residence or location;

2) description of the invention which discloses it with the fullness sufficient for carrying out by an expert in the relevant area of knowledge;

[repealed by 3]

3) a formula of invention which determines the invention item and expresses its substance. The formula must be clear, exact and be based on the description; [introduced by 3]

4) drawings and any other materials if they are needed for the understanding of the essence of the invention;

5) abstract;

6) power of attorney in the case of keeping the clerical work through the representative;

[repealed by 3]

The application for invention shall be attached by a document which confirms the payment for submission, in particular for conducting of a formal expert examination, [inserted by 3] of application in the established amount and document confirming the basis for the reduction of its amount which may be submitted together with the application or during two months from the date of the application receipt.

Under condition of the relevant payment this deadline may be extended, but not more than for two months.

When documents on payment are not submitted within the established deadline the application shall be considered as unsubmitted.

[repealed by 3]

3. The date of presentation of the application for the invention shall be fixed according to the date of arrival to the expert organisation of the documents of the application as indicated in subparagraphs 1), 2) and 4) of the first part of paragraph 2 of this Article, and if said documents are

presented not at the same time, then it shall be fixed according to the date of arrival of the last one out of the presented documents. *[introduced by 3]*

4. Procedure for compilation, formulation and consideration of the application for the invention, the entry of data into the state register of inventions of the Republic of Kazakhstan, as well as the issuance of protection document shall be established by the authorized body.

**Article 18. Application for Issue of the Patent *[modified by 3]* On a Utility Model**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

*3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

1. An application for the issue of the patent *[modified by 3]* on utility model (henceforth – the application for utility model) must relate to one utility model or a group of utility models interrelated to such an extent that they form the single inventive conception (requirement of the unity of the utility model).

2. An application for utility model shall contain the following:

1) application for the issue of the patent *[modified by 3]* with the indication of the authors of the utility model in the name of whom the patent *[modified by 3]* is claimed, as well as their place of residence or location;

2) description of the utility model which discloses it with the fullness sufficient for its implementation;

3) claim of the utility model which expresses its essence and is fully based on the description;

4) drawings;

5) abstract;

6) power of attorney in the case of keeping the clerical work through the representative;

The application for the utility model shall be attached by a document which confirms the payment in the established amount for submission of application, and document confirming the basis for the reduction of its amount which may be submitted together with the application, or during two months from the date of the application receipt. Under condition of the relevant payment this deadline may be extended, but not more than for two months.

When documents on payment are not submitted within the established deadline the application shall be considered as unsubmitted.

3. The date of submission of the application for the utility model shall be established by the date of the receipt by the an organisation of experts *[modified by 1]* of the request containing the application for the issue of the patent *[modified by 3]* for the utility model with the indication of the surname, name, patronymic name (if any) or full name of the applicant, description, claim and drawings, and when the indicated documents are not submitted at the same time – by the date of receipt of the last of the submitted documents.

4. Procedure for compilation, formulation and consideration of the utility model, entering data into the state register of invention of the Republic of Kazakhstan, as well as the issuance of protection document shall be established by the authorized body.

**Article 19. Application for Issue of patent *[modified by 3]* on Industrial Design**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

3) *Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

1. An application for the issue of the patent [modified by 3] on industrial design (henceforth – the application for the industrial design) must relate to one industrial design or a group of industrial designs interrelated to such an extent that they comply with the requirement of the unity of the industrial design.

2. An application for an invention shall contain the following:

1) application for the issue of the patent [modified by 3] with the indication of the authors of the industrial design in the name of whom the patent [modified by 3] is claimed, as well as their place of residence or location;

2) a set of pictures of the item (items) suitable for reproduction or model which gives the full detailed presentation of the claimed design (designs);

[repealed by 3]

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

5) power of attorney in the case of keeping the clerical work through the representative;

The application for the industrial design shall be attached by a document which confirms the payment in the established amount for submission of application, and document confirming the basis for the reduction of its amount which may be submitted together with the application or during two months from the date of the application receipt. Under condition of the relevant payment this deadline may be extended, but not more than for two months.

When documents on payment are not submitted within the established deadline the application shall be considered as unsubmitted.

3. The date of submission of the application for the industrial design shall be established by the date of the receipt by the an organisation of experts [modified by 1] of the request containing the application for the issue of the protection document for the industrial design with the indication of the surname, name, patronymic name (if any), or full name of the applicant, description, picture of the item (model), and when the indicated documents are not submitted at the same time – by the date of receipt of the last of the submitted documents.

4. Procedure for compilation, formulation and consideration of applications for industrial design, entering data into the state register of industrial designs of the Republic of Kazakhstan, as well as the issuance of protection document shall be established by the authorized body.

#### **Article 20. Priority of Item of Industrial Property**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. The priority of an item of industrial property shall be established by the date of submission of the application for the relevant item of industrial property as established in accordance with paragraph 3 of Article 17, paragraph 3 of Article 18, and paragraph 3 of Article 19 of the present Law.

2. The priority may be established by the date of the first application in the member - state of the Paris Convention, as well as in international or regional organisations stipulated by it (convention priority) when the application for an invention, utility model is submitted to the an organisation of experts [modified by 1] within twelve months, and the application for the industrial design – within six months from the indicated date. When due to circumstances which are outside of the control of the applicant the application with claiming the convention priority could not be submitted within the indicated period, the deadline may be extended, but not more than for two months.

An applicant, who wish to use the right of convention priority, shall be obliged to indicate it when submitting the application or within two months from the date of the application receipt by the an organisation of experts [modified by 1] and attach a notarised [inserted by 1] copy of the first application, or submit it not later than six months from the date of the application receipt by the Kazpatent. In the case of a failure to submit the indicated document the applicant shall lose the right to convention priority. In this case the priority shall be established by the date of submission of the application to the an organisation of experts [modified by 1].

3. The priority may be established by the date of receipt of additional materials when they are formulated by the applicant as an independent application submitted prior to the expiration of the three months deadline from the date of forwarding to the applicant of the notification of the an organisation of experts [modified by 1] on the impossibility to take into consideration the additional materials in connection with their recognition as changing the essence of the declared decision, and at the date of its submission the application which presents said additional materials has not been revoked and is not recognised as revoked. [added by 1]

4. The priority may be established by the date of submission to the an organisation of experts [modified by 1] of senior application of the same applicant which discloses the item of industrial property not revoked and not recognised as revoked at the time of submission of the application, [inserted by 1] when the application under which such a priority is claimed was submitted not later than twelve months from the date of the senior application for the invention and six months – from the date of the senior application for the utility model, industrial design. In this respect the senior application shall be considered as revoked.

The priority may not be established by the date of submission of the application under which the senior priority was claimed.

[repealed by 1]

5. Priority of an industrial property item based upon an isolated application shall be established on the basis of the date of submission to the organisation of experts of the original application of the same applicant, disclosing its essence, and in the event that rights exists to establish an earlier priority on the basis of the original application, — on the basis of the date of its priority, provided the isolated application was submitted prior to the adoption of a negative resolution of the expert organisation on the original application, the possibility of challenging which have been exhausted, and in the event that a positive resolution of the expert organisation was issued on said application, — until the date of registration in the relevant state register of the Republic of Kazakhstan. [introduced by 1]

6. The priority may be established on the basis of several prior submitted applications or additional materials thereto with the compliance of them with terms indicated in paragraphs 2 – 5 of the present Article, respectively.

7. When it is established that similar items of industrial property have the one and the same date of priority the priority shall be established in favour of the application [modified by 1] with respect thereto prior date of sending to the organisation of experts [modified by 1] is proved, and in the coincidence of those dates – for the application which has the earlier registration number of the organisation of experts [modified by 1].

## **Article 21. Amendments to Documents of Application on the Initiative of Applicant**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

*3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

*[repealed by 3]*

1. The applicant shall have the right to introduce to the documents of the application amendments and determinations without change of the substance of the stated item before the appropriate decision is passed on the said application. *[introduced by 3]*

Where those amendments are introduced within two months from the date of arrival of the application, the payment shall not be collected. *[introduced by 3]*

*[repealed by 1]*

2. Alterations concerning the applicant in the case of reassignment of rights to receive protection documents or resulting from alternation in the name of the applicant, as well as correction of technical mistakes in application documents, may be made prior to the date of the registration of industrial property items in the appropriate State Register provided that the appropriate payment has been made. *[modified by 3] [introduced by 1]*

## **Article 22. Expert Evaluation of the Application for Issuing a Patent for *[inserted by 3]* an Invention**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

*3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

*[repealed by 3]*

1. In relation to the application received by the expert organisation there shall be checked the availability of the documents of the application as stipulated by subparagraphs 1), 2) and 4) of the first part of paragraph 2 of Article 17 of this Law and the compliance with requirements made to them, the date of presentation of the application shall be fixed. Where the application does not meet the requirements of subparagraphs 1), 2) and 4) of the first part of paragraph 2 of Article 17 of this Law and the requirements to said documents, the expert organisation shall inform the applicant of that and propose to submit missing and (or) corrected documents (data) within three months from the date of delivery of such a notice. If the applicant has presented no requested and (or) corrected documents (data) by the fixed time, the application shall be considered as invalid, about what the applicant shall be delivered an appropriate notice. *[introduced by 3]*

1-1. After the fixation of the date of presentation of the application for issue of a patent for the invention, the expert organisation shall conduct a formal expert examination of it. *[introduced by 3]*

During conducting of the formal expert examination there shall be checked the availability of the documents stipulated by paragraph 2 of Article 17 of this Law and the compliance with requirements made to them. *[introduced by 3]*

2. When for the application in accordance with Article 21 of the present Law the applicant submits additional materials, it shall be reviewed in the course of the expert evaluation whether they change the essence of the claimed invention.

Additional materials shall change the essence of the invention when they contain features subject to inclusion to the claim of the invention and which were absent in the original materials of the application. Additional materials in part changing the essence of the claimed invention shall not be taken account of in consideration of the application, and may be formulated by the applicant as an independent application on which the applicant shall be informed.

3. With respect to the application submitted in violation of requirements to documents attached thereto, *[modified by 1]* the applicant shall be sent a request with the proposal within three months deadline from the date of its submission to submit the rectified or missing documents..

In the event that the applicant shall not submit within the indicated deadline the requested documents or petition on the extension of the established deadline the application shall be considered revoked.

4. With respect to the application submitted with the violation of the requirement of the unity of the invention the applicant shall be requested within three months deadline from the date of forwarding to him of the relevant notification to communicate which invention must be considered, and, if needed, to introduce specifications to the documents of the application. Other inventions entered into materials of the original application may be formulated by separate *[modified by 1]* applications. The priority of the isolated applications shall be established in accordance with paragraph 5 of Article 20 of the present Law.

In the event that the applicant within three months deadline from the date of sending to him the notification of the violation of the unity requirement does not communicate which of the inventions must be considered and does not submit specified documents the review shall be carried out of the item indicated first in the claim, as well as other inventions connected with the first to such extent that they satisfy the requirement of the unity of invention.

5. After the completion of the formal expert examination the applicant shall be informed of its result. *[introduced by 3]*

*[repealed by 3]*

7. After the completion of the formal expert examination with a positive result the expert organisation shall conduct an expert examination of the application as to substance. *[introduced by 3]*

The expert examination of the application as to substance shall comprise establishment of the possibility to attribute the stated proposals to items protected as an invention, to conduct an information search in relation to the stated invention to determine the technology level, examination of the conformity of the stated item (items) with the requirement of the uniformity of invention and the patentability terms established by Article 6 of this Law, and it shall be conducted provided that the payment is made for the expert examination of the application as to substance. *[introduced by 3]*

~~The payment for the~~ Expert examination of the application as to substance shall be made provided that the expert organisation is presented a document confirming the payment of the expert examination of the application as to substance within three months from the date of delivery of the notice concerning the result of the formal expert examination. *[introduced by 3]*

Where the expert examination as to substance is unpaid, the application shall be considered as recalled. *[introduced by 3]*

8. During the period of the conduct of the expert evaluation as to the essence the organisation of experts *[modified by 1]* shall have the right to request additional materials without which the conduct of the expert evaluation is impossible, including amended claims.

*[excluded by 1]*

Additional materials pursuant to the request of the expert organisation must be submitted without alteration of the essence of the invention within three months from the date of submission of the request or copy materials objecting to the application, provided said copies were requested by the applicant within two months from the date of submission to him of the request of the organisation of experts. *[introduced by 1]*

The procedure as established in paragraph 2 of the present Article shall apply to additional materials in part amending the essence of the invention. In the case that the applicant fails to submit the requested materials within the established deadline or the petition on the extension of the established deadline the application shall be considered revoked.

*[repealed by 1]*

9. Where as a result of an expert examination of an application with regard to its essence, the organisation of experts establishes that the presented proposal in the legal protection volume sought by the applicant, conforms to the condition of patentability of an invention as defined in

Article 6 of this Law, the positive resolution shall be issued by the organisation of experts on the patent with the formula of invention to be coordinated with the applicant and with the mention of the priority established. *[introduced by 1]*

On the basis of the conclusion of the expert organisation the authorised body shall pass a decision concerning issue or denial of issue of the patent for the invention. *[introduced by 3]*

10. In the event of establishing the incompliance of the claimed invention in the scope of legal protection claimed by the applicant with terms of patentability of the invention a negative resolution shall be issued by the organisation of experts. *[modified by 1]*

*[repealed by 3]*

The negative conclusion of the expert organisation shall be issued in the cases as follows: *[introduced by 3]*

1) if the application is related to items which are not protected as inventions; *[introduced by 3]*

2) if the applicant has not modified the formula of invention after the notification that the proposed formula contains features, which are absent in the primary materials of the application or, besides the item protected as an invention, it also characterises a proposal, which is not included among items protected as an invention or in relation to which consideration was not conducted in connection with violation of the requirement of the uniformity of invention. *[introduced by 3]*

The applicant may submit the objection to the authorised body *[modified by 1]* concerning a negative resolution of the organisation of experts *[modified by 1]* within a three months period from the date of its sending. The objection must be considered by the Appellate Council within four months deadline from the moment of its receipt.

*[excluded by 1] [repealed by 3]*

11. At any stage of consideration of the application before the issue of the appropriate conclusion by the expert organisation the applicant may present a petition for issue of an innovation patent. In this case the expert examination shall be conducted in accordance with Article 22-1 of this Law. *[introduced by 3]*

12. The applicant may acquaint himself with all materials opposed by the expert evaluation. The the organisation of experts *[modified by 1]* shall within one month deadline from the date of receipt of the request forward to the applicant copies of materials requested by him.

13. Deadlines stipulated by paragraphs 3, 4, 7, 8, 10 *[modified by 3]* of the present Article and missed by the applicant may be restored by the the organisation of experts *[modified by 1]* in the existence of good reasons and submission of a document on the payment for the restoration of the missed deadline.

Petition for the restoration of the deadline may be submitted by the applicant not later than twelve months from the day of expiration of the missed deadline. Such a petition shall be submitted to the the organisation of experts *[modified by 1]* simultaneously with materials requested by the expert evaluation commission or with objections to the Appellate Council.

14. If, when considering an application, it is established that it contains information constituting state secrets, the application shall be classified in accordance with the procedure established by the Republic of Kazakhstan legislation concerning state secrets. *[introduced by 1]*

## **Article 22-1. Expert Examination of an Application for Issue of an Innovation Patent for the Invention**

*Introduced by 3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

1. In relation to the application arrived to the expert organisation there shall be checked the availability of the documents of the application stipulated in subparagraphs 1), 2) and 4) of the first

part of paragraph 2 of Article 17 of this Law, the date of presentation of the application shall be fixed. Where the application does not meet the requirements of subparagraphs 1), 2) and 4) of the first part of paragraph 2 of Article 17 of this Law, the expert organisation shall inform the applicant of that, and it shall propose to present missing documents (data) within three months from the date of delivery of such a notice. Where the applicant has presented no requested documents (data) by the fixed time, the application shall be considered as invalid, about what the applicant shall be delivered the appropriate notice.

After the fixation of the date of presentation of the application for issue of an innovation patent for the invention, the expert organisation shall conduct in relation to it an expert examination, during the process of which there shall be checked the availability of the documents stipulated by paragraph 2 of Article 17 of this Law, compliance with established requirements to them, compliance with the requirement of the uniformity of invention; the issue shall be solved whether the stated solution is related to the protected item as an invention, as well as the priority date shall be fixed, and the check of local novelty of the stated solution shall be conducted in relation to inventions, useful models, patents issued on the basis of international agreements, which the Republic of Kazakhstan participates in, published Eurasian applications, non-recalled applications of other applicants submitted to the expert organisation before the priority date of the application in question, as well as the check for industrial application shall be conducted.

2. If in accordance with Article 21 of this Law the applicant has presented additional materials for the application, during the process of expert examination there shall be checked whether they change the substance of the stated invention or not.

Additional materials shall change the substance of the stated invention where they contain features to be entered in the formula of invention and which were absent in the primary materials of the application. Additional materials shall not be taken into account in the part, which changes the substance of the stated invention, when the application is under consideration, and they may be formulated by the applicant as an independent application, what the applicant shall be informed of.

3. As regards the application submitted with violation of the requirements to its documents the applicant shall be delivered a request with the proposal to present corrected or absent documents within a three-month period from the date of its delivery.

In the event that the applicant has presented no requested documents or a petition for prolongation of the fixed term by the indicated time, the application shall be considered as recalled.

4. As regards the application submitted with violation of the requirement of the uniformity of invention the applicant shall be proposed to inform within a three-month period from the date of delivery of the appropriate notice to him what of the inventions must be considered, and to introduce determinations in the documents of the application, if any. Other inventions entered in the documents of the primary application may be formulated by separated applications. Priority of separated applications shall be established in accordance with paragraph 5 of Article 20 of this Law.

In the event that within the three-month period from the date of delivery of the notice concerning the infringement of the requirement of the uniformity of invention the applicant has not informed what of the inventions is to be considered and if he has presented no documents determined more precisely, the consideration shall be conducted in relation to the item which is presented first in the formula, as well as other inventions related to the first one to such an extent to which they meet the requirement of the uniformity of invention.

5. If it is established as a result of the expert examination that the application is related to items protected as inventions, the documents meet the established requirements and the application characterises the proposal meeting the term of local novelty and industrial application in accordance with paragraph 1 of this Article, the positive conclusion of the expert organisation shall be issued for a patent with the formula coordinated with the applicant.

On the basis of the conclusion of the expert organisation the authorised body shall pass a decision concerning issue or denial of issue of an innovation patent for the invention.



6. The negative conclusion of the expert organisation to an invention patent shall be issued in the cases as follows:

- 1) if the application is related to items not protected as inventions;
- 2) if the applicant does not change the formula of invention after the notification that the proposed formula contains features, which are absent in the primary documents of the application or, besides the item protected as invention, it characterises also a proposal, which is not related to items protected as an invention or in relation to which consideration was not conducted in connection with the infringement of the requirement of the uniformity of invention;
- 3) if the application contains a proposal which does not meet the term of local novelty and industrial application in accordance with paragraph 1 of this Article.

The applicant may present to the authorised body an objection against the negative conclusion of the expert organisation within a six-month period from the date of delivery of it. The objection must be considered by the council of appeals within a two-month period from the date it arrived on.

7. On any stage of consideration of the application the applicant, as well as after the publication of the information on issue of the innovation patent the holder of the patent and third persons may petition for conducting of an information search to determine the technology level in comparison with which the evaluation of the patentability of the invention may be performed. The expert organisation shall conduct no information search in relation to items, which in accordance with paragraph 3 of Article 6 of this Law are not recognised as inventions, what the person petitioned for the information search shall be informed of.

8. Under the petition of the applicant at any stage of consideration of the application or patentee after the issuance of the innovation patent or of third persons, which shall be presented after the publication of information on the issue of the innovation patent, but not later than in three years from the date of submission of the application in case of prolongation of the term of the innovation patent in accordance with paragraph 3 of Article 5 of this Law, the expert organisation shall conduct an expert examination of the application as to substance. The expert examination as to substance shall be conducted providing for the appropriate payment for the expert examination of the application as to substance is made, as well as if the innovation patent is in force where the petition is presented by the applicant or by the patentee.

The expert examination as to substance shall be conducted in accordance with the procedure stipulated by paragraphs 7—10 and 13 of Article 22 of this Law.

**Article 23. Expert Evaluation of the Application for Issuing a Patent for [inserted by 3]  
a Utility Model**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

*3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

*[repealed by 3]*

1. In relation to the application arrived to the expert organisation there shall be checked the availability of the documents of the application as stipulated in subparagraphs 1) — 4) of the first part of paragraph 2 of Article 18 of this Law, the date of presentation of the application shall be fixed. Where the application does not meet the requirements of subparagraphs 1) — 4) of the first part of paragraph 2 of Article 18 of this Law, the expert organisation shall inform the applicant of that, and it shall propose to present missing documents (data) within three months from the date of delivery of such a notice. Where the applicant has presented no requested documents (data) by the

fixed time, the application shall be considered as invalid, about what the applicant shall be delivered the appropriate notice. *[introduced by 3]*

During conducting of the expert examination there shall be checked the availability of the necessary documents as stipulated by paragraph 2 of Article 18 of this Law, and the compliance with requirements made to them, the priority date of the application and the possibility to attribute the stated proposal to items protected as useful models shall be determined, the uniformity of the useful model shall be examined. *[introduced by 3]*

Review of the conformity of the submitted useful model with the patentability requirements established by paragraph 1 of Article 7 of this Law shall not be carried out. A patent shall be issued for the risk and responsibility of the applicant. *[introduced by 1]*

2. When conducting the *[excluded by 3]* expert evaluation of the application for the utility model provisions contained in paragraphs 2 – 4 and 13 of Article 22 of the present Law shall be applied, respectively.

If as a result of the *[excluded by 3]* expert evaluation it is established that the application refers to items protected as utility models, and documents comply with the established requirements a positive resolution for issuing a patent for the useful model *[modified by 3]* shall be issued by the expert organisation. *[modified by 1]*

*[repealed by 1]*

The resolution of the expert organization shall be sent to the authorized body to pass a decision on the issuance of the patent within the period of ten days, about which (in case if such decision was made), the applicant shall be notified.

On the basis of the resolution of the expert organisation the authorised body shall make a decision concerning issue or denial of issue of a patent for the useful model.

Within three months from the date of notification on decision made by the authorized body on the patent the applicant shall submit to the expert organization a document confirming the payment for issuance of a patent and publication, as well as the payment of state duty. In case of a failure to submit the indicated documents the term of payment may be recovered within three months. Otherwise, the application shall be revoked, and the proceedings on the application shall terminated, whereof the applicant shall be notified

3. If as a result of the *[excluded by 3]* expert evaluation it is established that the application refers to items not protected as utility models a negative resolution on the patent shall be issued by the expert organisation. *[modified by 1]* A negative resolution of the organisation of experts shall be issued *[modified by 1]* in the case when the applicant does not change the claim of the utility model after notifying him that the submitted claim contains features missing in the original materials of the application, or in addition to the item protected as utility model also characterises a proposal which is not related to items protected as the utility model, or with respect thereto the consideration was not conducted in connection with the violation of the requirement of the unity of the utility model.

The applicant shall have the right to submit objections against a negative resolution of the organisation of experts to the authorised body within three months from the date of its submission. *[modified by 1]* The objection shall be considered by the Appellate Council within two months deadline from the date of its receipt.

4. The applicant at any stage of consideration of the application, as well as the patentee and third parties after the publication of information on the issue of the patent may petition on the conduct of information search for the determination of the state of the art in comparison therewith the evaluation of patentability of the utility model may be carried out. In this respect provisions of paragraph 11 of Article 22 of the present Law shall be respectively applied.

## **Article 24. Expert Examination of an Application for the Industrial Sample**

*Introduced by 3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan.  
Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the  
Republic of Kazakhstan Concerning Issues of Intellectual Property*

1. In relation to the application for the industrial sample the expert organisation shall conduct a formal expert examination and expert examination as to substance.

2. On the stage of the formal expert examination there shall be checked the availability of the documents of the application as stipulated in subparagraphs 1), 2) and 4) of the ~~first part of~~ paragraph 2 of Article 19 of this Law, the date of presentation of the application and the priority date shall be fixed.

In relation to the application for the industrial sample, which is formulated with infringement of requirements to its documents, the applicant shall be delivered a request with a proposal to present corrected or missing documents within three months from the date of delivery of it.

Where by the fixed time the applicant has presented no requested documents or a petition for prolongation of the established term, the application shall be considered as invalid, what the applicant shall be delivered the appropriate notice about.

If in accordance with Article 21 of this Law additional materials are presented to the application for the industrial sample, there shall be checked whether they change the substance of the stated industrial sample or not.

Additional materials shall change the substance of the stated industrial sample where they contain features which were absent in the primary materials of the application. Additional materials shall not be taken into account in the part, which changes the substance of the stated industrial sample, when the application is under consideration, and they may be formulated by the applicant as an independent application, what the applicant shall be informed of.

The applicant shall be informed of results of the formal expert examination upon the completion of the formal expert examination.

3. After the completion of the formal expert examination with the positive result the expert organisation shall conduct an expert examination of the application as to substance.

The expert examination of the application as to substance shall comprise establishment of the possibility to attribute the stated proposal to items protected as an industrial sample, to conduct an information search in relation to the stated industrial sample to determine the level of the art-development solution, examination of the conformity of the stated solution with the patentability terms established by Article 8 of this Law, and it shall be conducted provided that the document is presented which confirms the payment for the expert examination of the application as to substance.

The document concerning payment for the expert examination of the application as to substance shall be presented to the expert organisation within three months from the date of delivery of the notice concerning results of the formal expert examination.

4. During the period of conducting of the expert examination of the application as to substance the expert organisation shall have the right to request from the applicant additional materials, without which it is impossible to conduct the expert examination, in particular the modified list of essential feature.

Additional materials under the request of the expert organisation must be presented without change of the substance of the industrial sample within a three-month period from the date of delivery of the request.

Additional materials in the part, which changes the substance of the industrial sample, shall be covered by the procedure established by paragraph 1 of this Article. Where the applicant has not presented by the fixed time the requested materials or a petition for prolongation of the fixed term, the application shall be considered as recalled.

5. Where as a result of the expert examination of the application as to substance the expert organisation establishes that the stated proposal in the requested volume of legal protection meets the industrial sample patentability terms as determined by Article 8 of this Law, then the positive conclusion of the expert organisation shall be issued for a patent with a totality of essential features coordinated with the applicant, with indication of the established priority.

On the basis of the conclusion of the expert organisation of the authorised body shall pass a decision concerning issue or denial of issue of a patent for the industrial sample.

6. Where there is established the inconsistency of the stated industrial sample in the legal protection volume requested by the applicant with the industrial sample patentability terms, the negative conclusion of the expert organisation shall be issued.

The negative conclusion of the expert organisation shall be also issued if the application is related to items not protected as industrial samples and in case if the applicant does not change the totality of essential features after the notification that the proposed totality of essential features contains features, which are absent in the primary materials of the application, or, except for the item protected as an industrial sample, it also characterises a proposal, which is not included among items protected as an industrial sample or in relation to which consideration was not conducted in connection with infringement of the requirement of the uniformity of industrial sample.

The applicant may file an objection to the authorized body on the negative conclusion of the expert organization within three months from the date of its sending. The objection shall be considered by the Appellate Council within two months from the date of its receipt.

7. The applicant may be acquainted with all the materials opposed by the expert examination. The expert organisation shall deliver copy materials requested by the applicant within a month period from the date of reception of the request.

8. The term stipulated by paragraphs 3 and 4 of this Article and missed by the applicant may be restored by the expert organisation if there are good reasons and a document is presented concerning payment for restoration of the missing term.

The petition for restoration of the term may be presented by the applicant not later than in six months from the day of expiration of the missing term. Such a petition shall be presented to the expert organisation together with the materials requested by the expert examination or with the objection of the council of appeals.

## **Article 25. Registration of Item of Industrial Property and Issue of Protection Document**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. The organisation of experts [modified by 1] shall enter to the State Register of Inventions of the Republic of Kazakhstan, the State Register of Utility Models of the Republic of Kazakhstan, the State Register of Industrial Designs of the Republic of Kazakhstan the invention, utility model or industrial design, respectively.

2. The authorised body [modified by 1] shall issue to the patentee the protection document simultaneously with the publication in the bulletin of information on its issue.

In the existence of several persons in whose name the protection document is claimed one protection document shall be issued to them.

3. The authorised body [modified by 1] shall issue the official certificate confirming the authorship to the author of the item of industrial property who is not the patentee.

4. The authorised body [modified by 1] shall establish the pro-forma of the protection document and the author's certificate, the composition of information indicated in it.

## **Article 26. Publication of Information on Issue of Protection Document**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property; and*

*3) Law No. 237 of 2nd March 2007 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property*

*[repealed by 3]*

1. The expert organisation shall publish in the bulletin information on issue of the patent for the invention upon the expiration of eighteen months, and information on issue of the innovation patent for the invention, patent for the useful model, patent for the industrial sample shall be published upon the expiration of twelve months from the date of presentation of the application. Under the petition of the applicant the expert organisation shall publish the data before the indicated time. *[introduced by 3]*

*[repealed by 3]*

3. The author shall have the right to refuse to be mentioned as the author in published information on the protection document.

4. The full composition of information shall be defined by the authorised body *[modified by 1]*.

5. After publication of information on the issue of the protection document any person shall have the right to acquaint himself with the application materials and with the report on information search as prepared by the organisation of experts. *[added by 1]*

6. In accordance with paragraph 3 of Article 5 of the present Law the organisation of experts *[modified by 1]* shall publish in the bulletin the information on the extension of the term of validity of the protection document as well as information on changes in entries in the relevant state registers. *[added by 1]*

## **Article 27. Withdrawal of Application**

An applicant shall have the right to withdraw the application submitted by him prior to the registration of the item of industrial property with the relevant State Register of the Republic of Kazakhstan.

## **Article 28. Transformation of Applications**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. An applicant shall have the right prior to the issuing of appropriate resolution by the organisation of experts *[modified by 1]* on the application for an invention to transform it into the application for utility model by submitting the relevant petition.

*[excluded by 1]*

2. Transformation of the application for the utility model into the application for the invention may be possible prior to the issue of a resolution by the organisation of experts *[modified by 1]* on the application for the utility model by submission of the relevant petition.

3. The priority and date of submission of the first application shall be retained in the indicated transformations.

## **CHAPTER 6. TERMINATION AND RESTORATION OF PROTECTION DOCUMENT VALIDITY**

### **Article 29. Challenging of Protection Document**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. The protection document during the entire period of the validity may be challenged and recognised as invalid fully or partially pursuant to the objection against its issue in the cases of:

1) incompliance of the protected item of industrial property with terms of patentability as established in the present Law;

2) existence in the claim of the invention, utility model or in totality of essential features of industrial design of features missing in the original materials of the application;

3) issue of the protection document in violation by the applicant of provisions of Article 37 of the present Law;

4) inaccurate indication in the protection document of the author (authors), or patentee.

2. Objection against the issue of the protection document pursuant to basis stipulated in subparagraphs 1) – 3) of paragraph 1 of the present Article shall be submitted to the authorised body [modified by 1]. The objection shall be considered by the Appellate Council within six months deadline from the date of its receipt. The person, who submitted the objection, shall be obliged to acquaint the patentee with the objection.

### **Article 30. Recognition of Protection Document as Invalid and Early Termination of its Effect**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. The protection document shall be recognised as invalid fully or partially on the basis of the decision of the Appellate Council or decision of the court.

2. Effect of the protection document shall be terminated ahead of time:

*[repealed by 1]*

1) on the basis of the application submitted by a patentee to the authorised body, from the date of publication in the bulletin of information on the premature termination of validity of the protection document. In the event that the protection document is issued for a group of industrial property items and the patentee's application is submitted only with regard to a certain items of the group, the validity of the protection document shall terminate only with regard to the industrial property items specified in the application; [introduced by 1]

2) in non-payment within the established deadline for the maintenance of the protection document in effect from the date of expiration of the established deadline for payment.

3. The organisation of experts [modified by 1] shall publish in the bulletin the information on the protection documents recognised as invalid fully or partially, and also on those which term of effect is terminated ahead of time.

### **Article 31. Restoration of Effect of Patent. Right to After-Use**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. The effect of a patent terminated pursuant to the basis indicated in subparagraph 2) of paragraph 2 of Article 30 of the present Law may be restored pursuant to the petition of the patentee during three years from the date of expiration of the deadline for the payment for the maintenance of patent in effect, subject to *[excluded by 1]* submission of a document on the payment for the restoration of the patent effect.

The organisation of experts *[modified by 1]* shall publish in the bulletin the information on the restoration of effect of the patent. The date of publication shall be the date of restoration of the patent's effect.

2. Any person, who during the period between the date of termination and the date of restoration of the patent's effect commenced the use in the territory of the Republic of Kazakhstan of the item of industrial property protected by the patent, or has made the preparations necessary for it, shall retain the right to its further charge free use without extension of the scope (the right to the after-use) of such use. *[added by 1]*

The right to the after-use may be assigned to another person only together with the production on which the use of the item of industrial property took the place, or preparations necessary for it have been made.

## **CHAPTER 7. PROTECTION RIGHTS OF AUTHORS, APPLICANTS AND PATENTEES**

### **Article 32. Appellate Council**

1. The Appellate Council shall be a specialized structural subdivision of the authorized body for the pre-court consideration of disputes with respect to objections raised in accordance with paragraph 10 of Article 22, paragraph 6 of Article 22-1, paragraph 3 of Article 23 and paragraph 2 of Article 29 of the present Law. The Regulations concerning the Appellate Council shall be approved by the authorized body.

2. The following objections may be filed to the Appellate Council:

1) on the decision of the authorized body (the conclusion of the expert organization) to refuse to issue the innovation patent for invention, patent for invention, utility model or industrial design;

2) against the issue of innovation patent for invention, patent for invention, utility model or industrial design.

The objection provided by subparagraph 1) of this paragraph, shall be submitted by the applicant or his successor, either directly or through a representative.

The objection provided by subparagraph 2) of this paragraph shall be submitted by any interested person, either directly or through a representative.

Objection shall be submitted to the authorized body in Kazakh and Russian either directly or by mail. The attached materials to the objection shall be submitted in Kazakh and Russian. If the materials are in another language, notarized translation into Kazakh and Russian shall be attached to the objection.

If an objection is filed by facsimile or e-mail it must be confirmed by the original hard copy no later than one month from the date of receipt of such objections.

The objection shall be filed within the terms established by this Law.

Missed deadline for objections provided by subparagraph 1) of this paragraph may be re-established at the presence of justifiable reasons and the document on payment for re-establishment of the missed deadline. Application for re-establishment of missed deadline may be filed by the applicant within the terms established by this Act. The application shall be submitted simultaneously with an objection to the Appellate Council.

3. In the case of filling an objection by a patent agent or other representative a power of attorney shall be submitted in Kazakh and Russian; if a power of attorney shall be submitted in

other (foreign) language, power of attorney shall be translated into Kazakh and Russian and notarized. The original of notarized power of attorney shall be attached to the objections materials or it shall be submitted together with a copy to the Secretary of the Appellate Council to confirm notarization.

4. Objection shall be considered at the board meeting of the Appellate Council within the term prescribed by this Law. This term may be extended at the request of the person who filed the objection and the patentee, but not more than for six months from the date of expiry of the deadline for the consideration of objection.

5. A person filed an objection and the patentee have the right to appeal against the decision of the Appellate Council within six months from the date of the decision.

#### Article 32-1. Grounds for refusal to consider objection in the Appellate Council

1. Acceptance of objection for consideration shall be refused if:

1) an objection according the legislation of the Republic of Kazakhstan is not subject to consideration in the Appellate Council;

2) an objection is not signed or signed by a person not having an authority to sign it;

3) an objection is submitted with the violation of the specified term and the possibility of its extension and re-establishment is lost;

4) an applicant within the prescribed period did not comply with requirements for content and procedure for submission of objection.

In case of the presence of these circumstances the person submitted the objection shall be notified that an objection shall not be taken into consideration and shall be considered as not submitted.

A person submitted an objection or his representative may withdraw an objection before the announcement of the decision of the board of the Appellate Council.

#### Article 32-2. Consideration of objection at the board meeting of the Appellate Council

1. Consideration of the objection shall be carried out at the board meeting of the Appellate Council consisting of not less than five members. Prior to the start of the dispute consideration the confidentiality of the members of the board of Appellate Council must be provided.

To provide conclusions at the board meeting of the Appellate Council representatives of scientific organizations and specialists of appropriate profile may be invited.

2. Board of the Appellate Council shall have the right to postpone the meeting in case of:

1) inability to consider the objections at this meeting due to the absence of any of the persons entitled to take part in the consideration of objections;

2) need to submit the missing or additional documents (evidence) for a decision-making by parties;

3) the request of the parties.

3. Individuals participating in the consideration of objection have a right to:

1) become familiar with the case, make extracts, order and receive copies thereof;

2) present evidence;

3) participate in examination of the evidence;

4) question the participants of Appellate process;

5) make a petition;

6) give oral and written explanations to the members of the Board of Appellate Council;

7) present their arguments and views on all issues arising during the consideration of objections to the issues;

8) oppose the petitions, arguments and views of others involved in the case.

4. In order to resolve a dispute the Board of Appellate Council shall make a decision.



Decision shall be taken by a simple majority vote of the Board members of Appellate Council. When votes are equal the Chairman's vote of the board meeting of the Appellate Council shall be decisive.

Upon consideration of objections the following decisions shall be made:

- 1) satisfy the objections;
- 2) partially satisfy the objections;
- 3) postpone consideration of objections;
- 4) dismiss the objection.

5. Within the ten working days from the date of the decision the Board of Appellate Council shall prepare and send the decision to the parties of the Appellate Council. The decision of the Appellate Council shall be in writing and shall consist of an introduction, descriptive part, reasoning and conclusion.

The decision of the Appellate Council shall be signed by all members of the Board of Appellate Council.

#### **Article 33. Consideration of Disputes in Judicial Procedure**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. The following disputes shall be subject to consideration in a judicial procedure:
  - 1) concerning the authorship on item of industrial property;
  - 2) concerning the lawfulness of the issue of protection document;
  - 3) concerning the establishment of patentee;
  - 4) concerning the issue of compulsory licence;
  - 5) concerning the violation of the exclusive right for the use of protected item of industrial property and other rights of property of the patentee;
  - 6) concerning the conclusion and implementation of licensing agreements for the use of protected item of industrial property;
  - 7) concerning the right to the prior use and after-use;
  - 8) concerning the payment by the employer of remuneration to the author in accordance with paragraph 4 of Article 10 of the present Law;
  - 9) concerning the payment of compensations as stipulated by the present Law;
  - 10) concerning other disputes associated with the protection of rights ensuing from the protection document.

2. The organisation of experts [modified by 1] shall, based on the court's decision, publish information on amendments concerning protection documents.

#### **Article 34. Responsibility for Violation of Rights of Authors, Applicants and Patentees**

*Amended by 4) Law No. 179 of 10th July 2009 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan on Issues of Intellectual Property.*

Appropriation of the authorship, compulsion to the co-authorship, disclosure without consent of the author, or applicant of the essence of industrial property before the publication of information on it, illegal use of the protected item of industrial property, violation of the procedure for patenting the item of industrial property in foreign countries shall entail the responsibility in accordance with laws of the Republic of Kazakhstan. [modified by 4]

### **CHAPTER 8. CONCLUDING PROVISIONS**

**Article 35. The State Duty and Payment for the Operations of an Expert Organisation**  
*Introduced by 2) Law No. 90 of 22nd November 2005 of the Republic of Kazakhstan.  
Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the  
Republic of Kazakhstan Concerning Issues of Intellectual Property Rights*

For the performance by the authorised body of efforts associated with issuing of protection documents, registration of agreements, certification of patent agents and issuing of a patent agent registration certificate the state duty shall be collected in accordance with the tax legislation of the Republic of Kazakhstan.

For the performance by an organisation of experts of efforts stipulated by this Law, including reception of requests for issuing protective documents, their registration, conducting expert examination of industrial property items, examination of contracts of assignment of protection documents and assignment of the right to receive it, as well as licensing agreements (sublicensing agreements) and for other efforts generating rights and obligations for their participants, an organization of experts shall collect a payment in accordance with the legislation of the Republic of Kazakhstan.

**Article 36. Patent Agents**

*introduced by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning  
the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of  
Kazakhstan Concerning Issues of Intellectual Property; and*

*amended by 2) Law No. 90 of 22nd November 2005 of the Republic of Kazakhstan.  
Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the  
Republic of Kazakhstan Concerning Issues of Intellectual Property Rights*

1. Legally capable citizen of the Republic of Kazakhstan who permanently resides in its territory, with higher education and work experience in the field of intellectual property not less than four years, certified and registered by the authorized body in the field of intellectual property shall be a patent agent.

In order to certificate candidates as patent agent the authorized body forms Certification Commission from the staff of the authorized institution and expert organization. The minimum number of members of the certification committee shall be not less than five employees.

Certification of candidates as patent agent shall be conducted by the authorized body at least once a year upon receipt of applications from candidates to the patent agent.

As a result of certification Certification Commission shall make a decision to certify or deny certification of the candidate. The form of decision of Certification commission shall be approved by the authorized body.

The decision of Certification commission shall be appealed in court within three months from the date of decision.

Successful candidates of qualification examination shall receive a certificate of patent agent, in accordance with the form set by the authorized body.

State duty for the certification of candidates for patent agents and issue of the certificate shall be determined by the tax legislation of the Republic of Kazakhstan.

2. The following persons shall not be accepted for certification of candidates for patent agents:

1) those who in accordance with the legislation of the Republic of Kazakhstan are not allowed to be engaged in entrepreneurial activities;

2) employees of the authorized body and its subordinate organizations, as well as their close relatives, spouse;

3) those who has a conviction;  
4) those who are excluded from the register of patent agents in accordance with this Law.

3. Activity of a patent agent shall be suspended by the protocol decision of the Certification Commission:

- 1) based on the application of a patent agent submitted to the Certification commission;
- 2) for the period referring to persons who in accordance with the legislation of the Republic of Kazakhstan are prohibited from engaging in entrepreneurial activity, including the staff of the authorized body and its subordinate organizations;
- 3) in order to clarify the circumstances provided by subparagraphs 2) and 6) of paragraph 1 and paragraph 5 of Article 36-2 of this Law.

In the case provided by subparagraph 3) of this paragraph, the activity of a patent agent shall be suspended for three months until the decision is taken by the Certification Commission.

The activity of a patent agent shall be resumed by the protocol decision of the Certification Commission in the case if the shortcomings caused by the suspension of its activities are removed.

4. Patent agent as a representative of the applicant or patentee shall carry out activity related to the conduct of business with the authorized body and the expert organization on the legal protection of intellectual property. Conduct of business with the authorized body and the expert organization may also be carried out by the applicant and (or) the patent owner himself.

Natural persons who reside beyond the territory of the Republic of Kazakhstan, or foreign legal entities shall exercise the rights of the applicant and patentee as well as the rights of the interested person in the authorized body and its organization through patent agents.

Natural persons who permanently reside in the Republic of Kazakhstan, but are temporarily situated beyond its territory, may exercise the rights of the applicant, patentee, as well as the rights of the interested person without a patent agent, specifying an address for the letter exchange within the Republic of Kazakhstan.

5. Information which a patent agent receives from the trustor in connection with the performance of his/her instructions shall be recognized as confidential subject to condition of compliance with the requirements of the legislative acts of the Republic of Kazakhstan on confidential information or other secrets protected by the law.

#### Article 36-1. The rights and obligations of a patent agent

1. A patent agent shall be entitled to carry out to the benefit of the applicant (individual or legal entity), the employer concluded an employment contract with him, or a person concluded with him or his employer a civil contract, the following activities:

- 1) advise on the protection of intellectual property rights, acquisition or transfer of intellectual property rights;
- 2) preparation of applications for inventions, utility models and industrial designs on behalf of the customer, principal, employer;
- 3) interaction with the authorized body and (or) expert organization for the protection of rights for inventions, utility models and industrial designs, including letter exchange, preparation of the objections for the decision of examination, participation in meetings of the advisory council of experts organization;
- 4) assist in the preparation, consideration and onward dispatch for examination of licensing (sublicensing) agreements and (or) contracts of assignment.

2. Powers of patent agent attorney shall be certified by a power of attorney.

3. If patent agent submits a copy of power of attorney to conduct of businesses related to the filing of applications for inventions, utility models and industrial designs, and (or) receipt of protection documents, as well as filing an objection to the Appellate Council within three months

from the date of this application or objection patent agent shall be obliged to submit the original power of attorney, respectively, to the expert organization and the authorized body. After confirming the authenticity of the original power of attorney must be returned.

If the power of attorney is made in a foreign language, its notarized translation into Kazakh and Russian must necessarily be represented.

4. A patent agent shall be obliged not to accept a commission in cases if earlier he represented or advised persons whose interests are contrary to the interests of the person requesting the conduct of business, and if the case involves an official, who is closely related to a patent agent, her/his husband (wife), and (or) his (her) close relative.

#### Article 36-2. Revocation and cancellation of certificate of patent agent

1. A patent agent shall be excluded from the register of patent agents by the decision of certification commission:

- 1) on the basis of personal application submitted to the Certification Commission;
- 2) upon termination of citizenship of the Republic of Kazakhstan or permanent residence outside the Republic of Kazakhstan;
- 3) in the event of interrupt of professional patent agent activity for more than five years;
- 4) upon the entry into force of a judgment of conviction, by which the patent agent was convicted of committing a crime;
- 5) in the case of the death of a patent agent or his recognition as missing or declared dead;
- 6) in the event of acknowledgement of a patent attorney as legally incompetent.

2. In the case of exclusion of patent agent from the register of patent agents on the grounds specified in subparagraphs 4), 5) and 6) of paragraph 1 of this Article, the certificate shall be canceled by the decision of certification commission. Information about the cancellation of the certificate shall be entered in the register of patent agents.

3. In the cases specified in subparagraphs 1), 2) and 3) of paragraph 1 of this article, certificate of a patent agent shall be revoked by the decision of certification commission based on the application of the patent agent or the third party.

Patent agent, excluded from the register on the grounds of subparagraphs 1) and 2) of paragraph 1 of this Article may be re-registered as a patent agent without re-passing a qualifying examination, in case of the termination of reasons of exclusion from the registry, and application to the Certification Commission within three years from the date of publication of the decision to remove from the registry. Certification Commission according to the documents submitted shall establish the fact of termination of the grounds specified in subparagraphs 1) and 2) of paragraph 1 of this article.

4. Patent agent, excluded from the register of patent agents, shall lose the right to pursue activities of a patent agent and a certificate of his registration as a patent agent shall be revoked or canceled.

5. In the case of unfair performance by patent agent of his duties, prescribed by this Law, the authorized body shall form the Appellate Commission, which shall consist of an odd number of members of the authorized body.

The Appellate Commission shall be a collegial body, and investigate complaints of natural and (or) legal entities representing the actions of their rights and legitimate interests of patent agents, committed, according to them, in violation of applicable legislation.

As a result of a complaint Appellate Commission shall recommend the authorized body to refer to court a lawsuit to annul a certificate of patent agent or make one of the following decisions:

- 1) postpone consideration of the complaint due to lack of evidence or to clarify the circumstances that contribute to making objective decisions;

2) dismiss the complaint.

Decision of appellate commission shall be made by simple majority vote and registered in the minutes. Decision of appellate commission may be appealed in court.

The regulation of the Appellate commission shall be established by the authorized body.

#### **Article 37. Patenting of Item of Industrial Property in Foreign Countries**

*Amended by 1) Law No. 586 of 9th July 2004 of the Republic of Kazakhstan. Concerning the Introduction of Amendments and Additions to Certain Legislative Acts of the Republic of Kazakhstan Concerning Issues of Intellectual Property.*

1. Submission to foreign countries of an application for an item of industrial property created in the Republic of Kazakhstan may be carried out upon the expiration of three months from the date of submission of the application to the organisation of experts [modified by 1] or earlier – after the completion of the review, conducted in accordance with the procedure established by legislation, of information constituting the state secret.

2. Citizens of the Republic of Kazakhstan residing in its territory, as well as legal entities of the Republic of Kazakhstan shall submit an application for the item of industrial property to international patent organisation through the organisation of experts [modified by 1] provided it does not contradict the relevant international treaty.

3. In the case of submission to foreign countries or international patent organisation of an application for the item of industrial property created in the Republic of Kazakhstan with violation of the procedure of the present Article the protection document on this item of industrial property in the Republic of Kazakhstan shall not be issued.

#### **Article 38. The Rights of Foreign Physical Persons, Legal Entities and Stateless Persons**

1. Foreign physical persons, legal entities shall enjoy the rights stipulated by the present Law on a par with physical persons and legal entities of the Republic of Kazakhstan by force of international treaties to which the Republic of Kazakhstan is a party, or on the basis of the principle of reciprocity.

2. Stateless persons residing in the Republic of Kazakhstan shall enjoy the rights stipulated by the present Law and any other acts related to the legal protection of items of industrial property on a par with physical persons and legal entities of the Republic of Kazakhstan, unless otherwise ensues from the present Law and other legislative acts.

**President of the Republic of Kazakhstan**

**N. NAZARBAEV**