

**Law of the Republic of Kazakhstan No 427-I of July 16, 1999  
“Patent Law of the Republic of Kazakhstan” (with  
amendments and modifications of July 10, 2012)**

Chapter 1. General Provisions	(Art. 1 – 5)
Chapter 2. Conditions of Patentability of Industrial Property Items	(Art. 6 – 8)
Chapter 3. Authors and Patent Holders	(Art. 9 – 10)
Chapter 4. Exclusive Right to Use an Industrial Property Item	(Art. 11 – 15)
Chapter 5. Procedure of Acquisition of a Protection Document	(Art. 16 – 28)
Chapter 6. Termination or Renewal of a Protection Document	(Art. 29 – 31)
Chapter 7. Protection of the Authors, Applicants and Patent Holders’ Rights	(Art. 32 – 34)
Chapter 8. Final Provisions	(Art. 35 – 38)

**Chapter 1. General Provisions**

**Article 1. Principal Definitions in this Law**

The following definitions shall be used in this law:

- 1) exclusive right – a property interest entitling a patent holder to use an industrial property item in her own discretion;
- 2) bulletin – an official periodical devoted to protection of industrial property items;
- 2-1) Eurasian application – an application filed in compliance with the Eurasian Patent Convention of September 9, 1994;
- 3) intellectual property item – the result of intellectual activity and the means of the civil turnover participants, goods, works or services individualization;
- 4) protection document – an innovation patent, an invention patent, a patent for an industrial design or a utility model granted in compliance with this Law;
- 5) employee invention – an industrial property item created by an employee in the course of her office or directly commissioned by the employer;

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

- 6) license agreement – an agreement of a patent holder (licensor) to grant to the other party (licensee) the provisional specific right to use an industrial property item;
- 7) industrial property item – an invention, utility model or industrial design;
- 8) Paris Convention – the Paris Convention for the Protection of Industrial Property of March 20, 1883 with amendments and modifications;
- 9) patent holder – the owner of the protection document;
- 10) conditions of patentability – the conditions of protection granted to an industrial property item under this Law;
- 11) patented industrial property item – an industrial property item protected by a formal protection document;
- 12) patent attorney – a national of the Republic of Kazakhstan authorized to represent an individual or a legal entity with a competent authority or an expert organization;
- 13) international application – an application filed in compliance with the Patent Cooperation Treaty of June 19, 1970.

## **Article 2. Relationships Governed by the Patent Law**

- 1. This Law shall govern the property interests and personal non-property relationships arising out of creation, legal protection or use of an industrial property item.
- 2. Protection of any other intellectual property item (a selection result, integrated circuit topology, trade mark, service mark, or an appellation of the origin of goods etc.) shall be governed by other statutes.

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

- 1. The provisions of this Law shall apply to an industrial property item protected by a formal document issued by the competent authority or an industrial property item protected by a patent granted pursuant to a Treaty that the Republic of Kazakhstan is a party to.
- 2. Should a Treaty ratified by the Republic of Kazakhstan provide otherwise than this Law, the provisions of the respective Treaty shall control.

## **Article 4. The State Authority for Protection of Inventions, Utility Models, Industrial Designs**

- 1. The state authority for the protection of inventions, utility models and industrial designs (hereinafter – the competent authority) – the state body appointed by the Government of the

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

Republic of Kazakhstan in order to formally regulate inventions, utility models and industrial designs protection.

2. The competent authority shall:

1) participate in implementation of the public policy in the field of legal protection of inventions, utility models and industrial designs;

2) issue the protection documents for inventions, utility models or industrial designs;

3) monitor the use of industrial property items by individuals or legal entities;

4) issue process or investigate administrative offence cases, impose sanctions;

5) act otherwise as provided for by this Law, other legislation of the Republic of Kazakhstan; by the acts of the President or the Government of the Republic of Kazakhstan.

#### **Article 4 -1. State monopoly in the Area of Protection of Inventions, Utility Models and Industrial Designs**

1. The state shall enjoy monopoly to be implemented by the expert organization established under the decree of the Government of the Republic of Kazakhstan in the form of a republican state enterprise with the right to carry out business as to the following: receipt and examination of applications for inventions, utility models or industrial designs; processing documents for the issue of a protection document; publication of information on the issue of the protection document; enforcement of the protection document; examination of the contract of transfer of the protection document or the assignment of the right to obtain such document, license (sub-license) agreements; maintenance of the State Register of inventions, utility models, industrial designs, including receipt of applications for conventional priority on the lapse of time; conversion of an international application into a national one; formal examination; supplemental examination on the merits of each several item of the claim exceeding one; prolongation and renewal of the term of replying to an examination inquiry or payment; modification of an invention or utility model application; consideration of an application in the applicant's presence; prolongation of the term for the filing of translation into Kazakh or Russian, prolongation of the term for the filing of the necessary documents for each month up to twelve months on the expiration date, revival of an expired limitations period for filing the translation; amendment of an application, protection document, a state register of inventions, utility models, industrial designs; entering a similar amendment; processing, examination and remittance of an international or Eurasian application; prior art examination in order to assess patentability of an invention, utility model or industrial design; issuance of an author's certificate, annex thereto or a duplicate thereof; enforcement, prolongation or renewal of a protection document, publication of the notice of enforcement; receipt of an application for the registration of the examination of an agreement for a complex

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

entrepreneurial license to one or more industrial property items; publication of the notice of an agreement registration; examination of collateral agreements; receipt of an application for an open license; issuance of excerpts from the state registers of inventions, utility models and industrial designs; search for the patent documents (numerical or nominal); realization and publication of printed or electronic editions; examination of the novelty of a technical or technological item; examination and analysis of the technical trends in the respective art; patent law analysis of the current research; examination of a pledge contract.

2. The following activities shall be technologically associated with the expert organization operations:

1) issuing copies of an application (priority document), application material, adverse documents; issuance of a protection document references or statistics;

2) payments setoff and confirmation.

3. The Government of the Republic of Kazakhstan shall fix the price for the goods (works, services) rendered and (or) sold by a subject of the state monopoly.

### **Article 5. Legal Protection of an Industrial Property Item**

1. The rights to an invention may be protected by an innovation patent or a patent while the rights to a utility model or an industrial design shall be protected by a patent.

2. An innovation patent for an invention shall be granted on examining the respective application. A patent for a utility model shall be granted on examining the respective application.

A patent for an invention or an industrial design shall be granted after a formal examination and on-the-merits examination of the respective application.

An innovation patent or a patent shall certify to the priority, authorship and exclusive right to an industrial property item. An innovation patent shall be granted subject to the burden of proof of the international novelty and inventive nature of the respective item lying on the applicant.

3. An innovation patent for an invention shall be valid for three years as of the date of filing the respective application subject to up to two years prolongation of the term at the request of the patent holder.

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

The term of validity of the patent for an invention that may be used only on consent of the competent authority may be prolonged up to five years at the request of the patent holder.

A patent for a utility model shall be valid for five years as of the date of filing the respective application subject to up to three years prolongation of the term at the request of the patent holder.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

A patent for an industrial design shall be valid for fifteen years as of the date of filing the application subject to up to five years prolongation of the term at the request of the patent holder.

The prolongation procedure for an innovation patent, an invention patent, a patent for a utility model or an industrial design shall be determined by the competent authority.

4. The scope of protection granted by the protection document for an invention or a utility model shall be determined by the patent claim, while that granted by the patent for an industrial design shall be determined by the aggregate of its distinctive features represented in the drawing (model) of the article and listed in the industrial design specification. The description and drafts may be used to interpret an invention or a utility model claim.

The protection document for a production process shall also apply to the product being the immediate result of such process.

In the absence of any evidence to the contrary, the new product shall be deemed to result from the protected process.

5. The right to obtain the protection document, the rights arising from the application registration, the right to own the protection document, as well as the rights arising out of the protection document shall be assignable to a third party in their total or in part.

6. This Law shall not extend legal protection to an industrial property item deemed to be a State secret. The procedure for treatment of classified industrial property items shall be determined by the Government of the Republic of Kazakhstan.

## **Chapter 2. Conditions of Patentability of an Industrial Property Item**

### **Article 6. Conditions of Patentability of an Invention**

1. Legal protection shall only be available to an invention that is novel, non-obvious and commercially useful.

An invention shall be deemed novel when it is not included into the relevant prior art.

An invention shall be deemed non-obvious when it would not have been obvious to a person having ordinary skill in the pertinent art.

The prior art shall include all the information available to general public before the priority date of the invention.

The scope of the prior art to be applied in determining the novelty of an invention or a utility model application shall include the applications for inventions

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

and utility models previously filed in the Republic of Kazakhstan (unless withdrawn) and the patents granted for the inventions and utility models in the Republic of Kazakhstan.

An invention shall be deemed commercially useful if it can be used in industry, agriculture, public health, etc.

2. Protectable inventions shall include technical solutions in any field concerning a product (a device, substance, microbial strain, plant or animal cell culture), process (a method of modifying a tangible object by tangible means), as well as using a known product or process for a new purpose or a new product for a specific purpose.

3. Protectable inventions shall not include:

- 1) discoveries, scientific theories or mathematical methods;
- 2) business organization and management techniques;
- 3) nomenclatures, schedules or rules.
- 4) rules and techniques of intellectual operations, or gaming;
- 5) computer programs or algorithms per se;
- 6) design of installations, buildings, landscapes;
- 7) suggestions concerning exclusively the product exterior;
- 8) suggestions contrary to the public order, principles of humanity and morality. 4.

Patentability of an invention shall not be affected by disclosure of the relevant information by the applicant (author) or by any party directly or indirectly obtaining such information from the former, including exhibiting the invention at an official or formally recognized international exhibition on the territory of the Paris Convention member - state, subject to the application for the invention being filed within six months as of the date of its disclosure or exhibition. The burden of proof of this fact shall be on the applicant.

### **Article 7. Conditions of Patentability of a Utility Model**

1. A constructive implementation of an article of manufacture or a commodity, or of its components (device) shall be recognized as a utility model.

Legal protection shall only be available to a utility model that is novel and commercially useful.

A utility model shall be deemed novel when the aggregate of its distinctive features is not included into the relevant prior art.

The prior art shall include information publicly available all over the world on devices of the same purpose as the claimed utility model and the use of such devices in the Republic of Kazakhstan before the priority date of the respective utility model, as well as the applications for inventions and utility models previously filed in the Republic of Kazakhstan by other parties

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

(unless withdrawn) and the patents granted for the inventions and utility models of the same purpose in the Republic of Kazakhstan.

A utility model shall be deemed commercially useful when applicable in practice.

2. Novelty of a utility model shall not be affected by disclosure of the relevant information by the applicant (author) or by any party directly or indirectly obtaining such information from the former, including exhibiting the utility model at an official or formally recognized international exhibition on the territory of the Paris Convention member- state, subject to the application for the utility model being filed within six months as of the date of its disclosure or exhibition. The burden of proof of this fact shall be on the applicant.

3. Solutions concerning the articles listed in Article 6 (3) of this Law shall not be protectable as utility models.

### **Article 8. Conditions of Patentability of an Industrial Design**

1. An artistic and structural solution pertinent to the exterior of an article of manufacture shall be recognized as an industrial design. Legal protection shall be available for a novel and original industrial design.

2. Protectable industrial designs shall not include the solutions:

1) due exclusively to the technical function of an article;

2) architectural works (except for miniature architectural forms), industrial hydro-engineering or other permanent installations;

3) shall be excluded pursuant to the RK Law No 537-IV of January 12, 2012 (see the previous version)

4) unstable items of fluid, gaseous, friable or similar nature;

5) articles of a nature contrary to the public policies, principles of humanity and morality.

3. Patentability of an industrial design shall not be affected by disclosure of the relevant information by the applicant (author) or by any party directly or indirectly obtaining such information from the former, including exhibiting the industrial design at an official or formally recognized international exhibition on the territory of the Paris Convention member- state, subject to the application for the industrial design being filed within six months as of the date of its disclosure or exhibition. The burden of proof of this fact shall be on the applicant.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>



## **Chapter 3. Authors and Patent Holders**

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

1. An individual developing an industrial property item through her creative effort shall be deemed to be the author of the respective industrial property item.

2. Should more than one individual contribute to the creation of an industrial property item, all such individuals shall be deemed to be the authors (co-authors) of the respective item. The terms of exercising the co-author's rights shall be determined by an agreement between the co-authors.

An individual whose personal contribution to the industrial property item may not be deemed creative, i.e. providing but technical, organizational or financial support to the author, or assisting in the registration of the rights to the respective item or its implementation shall not be deemed the author.

3. The right of authorship shall be an inalienable personal right subject to perpetual protection.

4. The author may give the industrial property item her name or a specific appellation, unless the latter should infringe on any third party right to a trade mark protected in the Republic of Kazakhstan.

5. The authors of the most distinguished and widely used inventions may be nominated for the title of the "Honored Inventor of the Republic of Kazakhstan". The Regulation for awarding this title shall be determined by the Government of the Republic of Kazakhstan.

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

1. A protection document shall be available to:

- 1) the author (-s) of an industrial property item;
- 2) the employer as provided for in Item 2 of this Article;
- 3) a successor (-s) of the above mentioned, including their assignee (-s);
- 4) jointly to the aforementioned, subject to an agreement between them.

2. Unless otherwise stipulated by the contract between the employer and the employee, the right to the protection document for an employee invention shall belong to the employer.

3. Unless otherwise stipulated by the contract between the author and the employer, the right to the protection document for an invention created by the author out of the course of her office or an assignment of the employer, while making use of the employer's equipment,

**Source:** World Intellectual Property Organization

<http://www.wipo.int>



materials, etc. shall belong to the author.

Should an employee invention be developed by the joint creative effort of several individuals, a non-employee of the respective employer among them, the rights of the latter in the respective employee invention shall be determined by the contract between the employer and the other authors.

Should an employee invention be created by the authors as a result of contractual cooperation of several employers, the rights of such employers to the respective invention shall be determined by the contract between them.

4. The author of an employee invention shall notify her employer of the same in writing within one month on recognition of the fact of creation of the employee invention.

The notification shall be signed by the author (-s) and shall include: 1) surname, first name, patronymic (if any) and title of the author; 2) appellation of the employee invention;

3) conditions and place of creation thereof, its prospective use;

4) detailed description sufficient to assess the merits of the invention, define its category and commercial value to the employer.

The employer shall have the notification of the employee invention promptly accepted and registered notifying the authors respectively in writing.

Should the description or any other information required in order to file the application be incomplete, the employer may request additional materials on the employee invention from the employee who shall submit the additional materials within one month on receipt of the request. In this case the term stipulated in Item 7 of this Article shall be stayed and resume on receipt of the requested information.

5. Should the employee fail to notify the employer entitled to obtain the protection document about the employee invention, the term stipulated in Item 7 of this Article shall run as of the date when the employer knew of the invention.

Should the employer learn of the employee invention, she shall notify the author respectively in writing. Should the employer be entitled to obtain the protection document for the employee invention, she shall notify the author in writing of the intention to file the respective application. In this case the author shall at the employer's request in writing provide any additional information required for filing an application for the employee invention and the list of all the authors of the respective invention.

6. The employer no longer interested in obtaining the protection document for the employee invention after filing the respective application or in enforcement of such document shall promptly and gratuitously transfer to the author either the right to obtain the protection document or the document already in her possession.

7. Should the employer fail within four months on receipt of the author's notice of the new

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

industrial property item to file the necessary application, transfer the right to the protection document to another party, or notify the author to keep the creation secret, the right to obtain the protection document shall pass to the author. In this case the employer shall have a priority in using the respective industrial property item in her business under an agreement with the patent holder.

8. Neither party may apply to the expert organization for the protection document in order to enforce her rights to the employee invention without the proper notice to the other party.

9. The amount, terms and procedure of compensating the author for the employee invention shall be determined by the agreement between the author and the employer. Should the parties fail to come to terms, the dispute shall be settled judicially. In the absence of reliable means of assessment of the author's and the employer's respective contribution to the employee invention, the author shall be entitled to half of the profits the employer has derived or should have derived out of the invention.

## **Chapter 4. Exclusive Right to Use an Industrial Property Item**

### **Article 11. Exclusive Right and Obligations of a Patent Holder**

1. A patent holder shall enjoy the exclusive right to use the protected item of industrial property in her discretion.

The exclusive right to use the protected item of industrial property may be exercised by the patent holder within the effective period of the protection document as of the date of the notice of the protection document publication in the official bulletin.

2. Use of an industrial property item shall include manufacture, exploitation, importation, offer for sale, sale, other introduction into the civil turnover or storage for such purposes of a product containing a protected item of industrial property, as well as using a protected process.

A product shall be deemed to contain a protected invention or utility model, and the process shall be deemed usable if the product contains or the process uses every element of the invention or utility model cited in an independent item of the invention or utility model claim, or an equivalent thereof, included into the relevant prior art at the time of its first use.

Use of a protected process shall mean introducing into the civil turnover or storage for such purpose of a product manufactured through this process.

A product shall be deemed to contain a protected industrial design, should this product display every distinctive feature owned by the image (model) of the respective article of

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

manufacture listed as its distinctive feature.

3. The patent holder shall be obliged to use the item of industrial property.

The right to use an item of industrial property, protected by the document held by more than one party shall be determined by an agreement between the parties. In the absence of an agreement, each of the patent holders may use the protected object at her own discretion, but may neither license nor assign the protection document without the consent of the other patent holders.

The patent holder may mark the item of industrial property with a warning of its being patented.

4. Should the holder of a patent to an item of industrial property fail to use such an item or license it on commercially acceptable terms, any party may sue for a compulsory non-exclusive license alleging a lack of continuous use for the four years as of the first notice of the protection document issuance preceding the suit. Should the patent holder fail to show an excuse for non-use, the court shall grant the license determining its scope and term, as well as the amount of the license fee and the terms of payment. The fee may not be lower than the customary amount established in the ordinary course of business.

A compulsory license shall be primarily granted in order to satisfy the demands of the internal market of the Republic of Kazakhstan.

The holder of a compulsory license may assign the right to use the item of industrial property to another party only as part of the enterprise where the item is used.

A compulsory license may be judicially revoked due to the termination of the cause for its issuance.

5. The patent holder unable to use an item of industrial property without infringing the rights of the holder of another protection document to the item of industrial property who has declined an offer to enter into a license agreement on acceptable commercial terms, may sue for a compulsory non-exclusive license to use the item of industrial property in the Republic of Kazakhstan.

Should the patent holder unable to use the item of industrial property without infringing the rights of the holder of another protection document show his item of industrial property to be a significant technical achievement of great economic value in comparison to the item of industrial property owned by the holder of another protection document, the court may grant a compulsory non-exclusive license to the claimant.

The court granting the said compulsory license, shall determine the scope and the term of the use of the protected item of industrial property, owned by another party, as well as the amount of the license fee and the terms of payments. The fee may not be lower than the customary amount established in the ordinary course of business.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

The right to use the item of industrial property, acquired pursuant to this clause may only be assigned along with the protection document for the item of industrial property being the subject of the respective licensed right.

In case of issuance of a compulsory license pursuant to this clause the holder of the protection document licensing the respective right may obtain a license to use the dependent invention being the subject of the compulsory license.

6. The patent holder may assign the issued protection document to an individual or a legal entity. The assignment agreement shall be registered by the competent authority.

The registration of an agreement of assignment of the protection document or of the right to obtain such document shall be subject to the result of an examination of the required materials by the expert organization.

Unless otherwise stipulated by the legislation of the Republic of Kazakhstan, the procedure of registration of an agreement of assignment of the right to obtain the protection document shall be subject to the regulation of registration of assignment agreements.

To register an assignment agreement, one shall file a properly filled application with the expert organization.

The application shall be accompanied by the following:

1) the original agreement of assignment of uniform items of industrial property in quadruplicate, with the title page.

Each copy of the agreement shall be sewn and sealed with a paper seal listing the number of sewn and numbered sheets, stamped and signed by the authorized representatives of the both parties or the applicant.

Notarized copies of the agreement may substitute for its originals:

2) a power of attorney when filing through a patent attorney or another representative;

3) a receipt for the state duty paid.

National applicants, shall in addition to the aforementioned documents, file the resolution of the managing body of the holder of the protection document or the exclusive rights, of the general incorporator or shareholder meeting to conclude the agreement and authorize the chief executive officer to sign it.

The application and the other required documents shall be prepared in the Kazakh and Russian languages. Foreign names and legal names shall be cited in the Kazakh and Russian transliteration. A document filed in another language shall be accompanied by a notarized translation into Kazakh and Russian.

An application shall be filed per an assignment agreement.

An individual non-resident in the Republic of Kazakhstan, or a foreign legal entity filing the agreement materials on their own behalf shall register the agreement through a certified patent attorney of the Republic of Kazakhstan.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

A national of the Republic of Kazakhstan, temporarily residing abroad may register the agreement unassisted by a patent attorney supplying an address for the service of process in the Republic of Kazakhstan.

7. On the applicant's filing the scheduled documents for registration the expert organization shall within fifteen working days as of the date of filing process the received documents to establish their completeness and conformity to the requirements. In the absence of the receipt for payment of the examination fee in the application materials of assignment of the protection document, the fee shall be invoiced to the applicant. In this case the examination period shall run as of the day of crediting the payment to the expert organization.

The accepted assignment agreement materials shall be within twenty days examined on the merits to establish their conformity to the effective legislation of the Republic of Kazakhstan.

8. Rectifiable bars to registration of an assignment agreement:

- 1) failure to pay the enforcement fee for the protection document;
- 2) provisions in the assignment agreement contrary to the civil law of the Republic of Kazakhstan or to a treaty ratified by the Republic of Kazakhstan.

9. On discovery of a rectifiable bar to the assignment agreement registration referred to in Item 8 above, the expert organization shall notify the applicant of the necessity within three months of the date of the notice to deliver the missing documents or make the required amendments or modifications. In this case the term of the on-the-merits examination referred to in Item 7 of this Article shall run from the date of delivery of the missing or amended documents.

10. The expert organization may deny registration of an assignment agreement on the following grounds:

- 1) termination of the protection document being the subject of the agreement;
- 2) failure to properly reply to the request of the expert organization within the three-month term;
- 3) incomplete reply to the request.

The expert organization shall within two working days on rendering its opinion dispatch the same to the competent authority citing the reasons for the denial.

11. In case of a positive result of the examination the expert organization shall within five working days notify the competent authority of the absence of any bar to the registration of the assignment agreement.

The competent authority shall within five working days on receipt of the expert organization's opinion resolve to either register the assignment agreement or deny the registration.

12. On making the resolution to register the assignment agreement the competent authority shall:

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

- 1) make an attachment to the protection document for the item of industrial property being the subject of the agreement;
- 2) stamp the title page of the assignment agreement as registered citing the registration date and number;
- 3) enter the contractual information in the contracts register;
- 4) dispatch two copies of the registered agreement and the attachment to the protection document to the address cited in the application;
- 5) dispatch the check copy with the report to the expert organization for publication of the notice of the agreement registration.

The third and fourth copy of the agreement shall be maintained by the competent authority and the expert organization respectively as the check copies.

The expert organization shall publish information on the registered agreements in the bulletin, including the registration number and date, the name or complete description of the parties, the scope of the agreement, its term and territory.

Anyone may acquire an excerpt from the register of the assignment agreements citing any public data concerning an agreement.

A third party may get access to the text of an agreement or acquire an excerpt from it exclusively on the written consent of the parties thereto.

In case of denial of registration of the assignment agreement by the competent authority following the expert organization's opinion, the examined agreement documents and the resolution to deny registration shall be dispatched to the address cited in the application.

13. The agreement to assign the protection document or the agreement to assign the right to obtain such a document shall come into force as of the date of their registration by the competent authority.

14. A protection document for the item of industrial property and (or) the right to obtain it may be inherited or acquired by succession.

15. The patent holder shall pay the annual enforcement fee for the protection document.

## **Article 12. Exemptions to Infringement of the Exclusive Right of the Patent Holder**

Exemptions to infringement of the exclusive right of the patent holder shall include:

- 1) use of an article containing a protected item of industrial property in the structure or operation of a foreign transport vehicle (sea-going or river vessel, aircraft, space or land vehicle) subject to such means being in transit or accidentally finding itself in the Republic of Kazakhstan for the purpose of operating a vehicle. Such operations shall not be deemed to infringe the exclusive right of the patent holder, should the vehicle belong to a national or a legal entity of a state affording a reciprocal right to the owners of transport vehicles of the Republic of

**Source:** World Intellectual Property Organization

<http://www.wipo.int>



Kazakhstan;

2) use of an article containing a protected item of industrial property for scientific research or an experiment;

3) use of such an article in an emergency (natural disaster, catastrophe, major accident) subject to a prompt notice to the patent holder and subsequent payment of a fair compensation to the latter;

4) use of such an article for personal, family, domestic or other non-profit purposes;

5) one-time use in preparing a prescribed medication at a pharmacy;

6) import into the Republic of Kazakhstan, use, offer for sale, sale, other introduction into the civil turnover or storage for such purpose of an article containing a protected item of industrial property subject to its prior introduction into the civil turnover in the Republic of Kazakhstan by the patent holder or on the latter's consent.

### **Article 13. Right of Prior Use and Interim Legal Protection**

1. An honest user in the Republic of Kazakhstan of an independently developed solution identical to an item of industrial property prior to the priority date of the latter, or a party having made the necessary preparations for such use shall retain the right of further gratuitous use of the identical item without broadening the scope of the use (the right of prior use).

The right of prior use may only be assigned along with the enterprise where the identical solution has been used or the necessary preparations have been made.

2. A party commencing to use an item of industrial property after its priority date but prior to the date of publication of the notice of the innovation patent, patent for an invention, design patent or utility model patent shall discontinue her use at the patent holder's request without, however, any indemnification to the latter for the damages resulting from such use.

3. An item of industrial property exhibited at an official or officially recognized international exhibition shall enjoy interim legal protection as of the date of its display up to the date of the first publication of the notice of the protection document, subject to the application for the item being filed not later than six months as of the date of its display at the exhibition.

4. The party using the item of industrial property as referred to in Item 3 above shall on issuance of the protection document indemnify the patent holder in the amount agreed upon by the parties.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>



#### **Article 14. Grant of the Right to Use an Item of Industrial Property**

1. Anyone but the patent holder may use a protected item of industrial property only as a licensee of the patent holder.

2. A license agreement may grant the licensee:

- 1) the right to use the item of industrial property with the licensor retaining her right both to use the item and license it to another party (simple non-exclusive license);
- 2) the right to use the item of industrial property with the licensor retaining her right to use the item without the right to license it to another party (exclusive license);
- 3) the right to use the item of industrial property with the licensor retaining neither the right to use or to license the item to another party (absolute license).

Unless otherwise stipulated by the license agreement, the license shall be deemed a simple non-exclusive one.

3. A licensee may enter into a third party (sublicensee) sublicense agreement for a non-exclusive license to use an item of industrial property only as provided for by the license agreement.

Unless otherwise stipulated by the license agreement, the licensee shall be liable to the licensor for the acts of a sublicensee.

4. Both a license agreement and a sublicense agreement to use an invention, utility model or an industrial design shall be presented in writing and registered by the competent authority. Failure to either execute a written instrument or to register the agreement shall render the agreement invalid.

Registration of a license agreement shall follow an examination of the materials by the expert organization.

Unless otherwise stipulated by the law of the Republic of Kazakhstan, the procedure of registration of a sublicense agreement shall be identical to that of registering a license agreement.

4-1. In order to register a license agreement the applicant shall file a properly filled application with the expert organization.

The application shall be accompanied by:

- 1) the original of the agreement in quadruplicate, with the title page.

Each copy of the agreement shall be sewn and sealed with a paper seal citing the number of the sewn and numbered sheets, stamped and signed by the both parties or by their authorized representatives.

The registration documents shall be filed not later than six month on signing the agreement.

Instead of the originals one may file the notarized copies of the agreement;

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

- 2) a power of attorney when filing through a patent attorney or another representative;
- 3) receipt for the state duty paid.

National applicants shall in addition to the aforementioned documents deliver the resolution of the managing body of the licensor (sublicensor) to conclude the respective agreement and authorize the chief executive officer to sign it when filing on behalf of a legal entity.

The application as well as the other required documents shall be filed in the Kazakh and Russian languages. Foreign names and legal names shall be transliterated into Kazakh and Russian. A document filed in another language shall be accompanied by a notarized translation into Kazakh and Russian.

One application shall apply to one license agreement.

An individual non-resident in the Republic of Kazakhstan or a foreign legal entity filing on their own behalf shall exercise her right to register an agreement through a certified patent attorney of the Republic of Kazakhstan.

A national of the Republic of Kazakhstan temporarily living abroad may exercise her right to register an agreement without a patent attorney providing an address for the service of process in the Republic of Kazakhstan.

4-2. Registration of a license agreement shall be subject to the provisions of Article 11 (7-12) of this Law.

A license agreement (sublicense agreement) shall enter into force as of the date of its registration by the competent authority.

5. A patent holder may apply to the competent authority to grant to whom it may concern the right to obtain a license to use an item of industrial property (public license).

A party willing to obtain the aforementioned license shall conclude an agreement on the terms of payment with the patent holder subject to its compulsory registration by the competent authority. Any dispute arising out of the terms and conditions of the agreement shall be resolved judicially.

The application of the patent holder granting the right to a public license shall remain effective for three years as of the date of publication of the respective notice in the bulletin. Within the stated term the enforcement fee shall be reduced by 50 percent from the year following the one of publication of the public license notice.

Should a license agreement be made, the enforcement fee shall be paid in full from the year following that of the agreement conclusion.

6. In case of a state of emergency in the country, the Government of the Republic of Kazakhstan may allow use of an item of industrial property without the patent holder's consent subject to a prompt notification and a fair compensation

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

of the latter. A dispute over the payment amount shall be subject to judicial resolution.

### **Article 15. Infringement of the Exclusive Right of the Patent Holder**

1. Any party using a protected item of industrial property contrary to this Law shall be deemed an infringer of the exclusive right of the patent holder (infringer of the protection document).

Non-authorized manufacture, use, importation, storage, offer for sale, sale or any other introduction into the civil turnover of a product produced with the help of a protected item of industrial property, or use of a protected process or introduction into the civil turnover of a product manufactured through a protected process shall be deemed an infringement of the exclusive right of the patent holder (a protection document infringement). Absent any evidence to the contrary the new product shall be deemed to have been manufactured through the protected process.

2. The patent holder may claim:

- 1) termination of the protection document infringement;
- 2) reimbursement by the infringer of the damages incurred and the moral harm suffered as of the date of the first publication of the protection document notice;
- 3) forfeiture of the profits derived by the infringer of the protection document instead of damages as of the date of the first publication of the protection document notice;
- 4) compensation by the infringer of the protection document in the legally stipulated amount of 10 000 to 50 000 times of the calculated monthly index instead of the damages or forfeiture of the profits, the amount of compensation being determined judicially;
- 5) seizure in favor of the patent holder of the products introduced into the civil turnover or stored for such purpose and found to be infringing the protection document, as well as the means designed particularly in order to infringe the protection document as of the date of the first publication of the protection document notice;
- 6) a compulsory publication of an infringement notification, including reference to the holder of the infringed right.

3. A licensee may also claim against the infringer of the protection document, should such right be provided for by the license agreement.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

## **Chapter 5. Procedure of Issuance of a Protection Document**

### **Article 16. Filing for a Protection Document**

1. An application for a protection document shall be filed with the expert organization by the party entitled to acquire the protection document pursuant to Article 10 (1) of this Law (hereinafter - applicant).

An application may be filed in the form of an electronic document signed with the electronic digital signature.

2. An application for a protection document shall be filed in the state language or in Russian. Any other document accompanying the application may be filed in the state language, in Russian, etc. A document filed in any other language but the state or Russian shall be accompanied by the translation into the state or Russian language. The translation shall be delivered within two months as of the date of filing the respective application with the expert organization. Subject to payment of the respective fee, the term may be prolonged up to two months.

In case of failure to deliver the translation within the proper term the application shall be deemed void.

3. Neither the competent authority nor the expert organization may allow a third party access to the application prior to the date of the protection document notice publication, except at a request or on consent of the applicant or at the request of a prosecution or judicial authority.

### **Article 17. Filing for an Invention Protection Document**

1. An application for an invention protection document (hereinafter – invention application) shall refer to a single invention or a group of inventions, closely associated with one another so as to form an integrated inventive concept (the requirement of unity of an invention).

2. An invention application shall include:

1) application for the protection document naming the author(-s) of the invention and the party(-s) on whose behalf the protection document is sought, citing such parties' resident address or domicile;

2) detailed description of the invention sufficient for a party reasonably skilled in the respective art to implement it;

3) invention claim citing the target and nature of the invention; the claim shall be clear, precise and fully based on the description;

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

- 4) drawings or other materials necessary to understand the nature of the invention;
- 5) synopsis;
- 6) power of attorney when filing through a representative;
- 7) this Item shall be cancelled pursuant to the RK Law No 237-III of March 02, 2007 (see the previous version)

An invention application shall be accompanied by the receipt for the filing fee including the formal examination fee and the certificate of deduction (if any); these documents may be filed either simultaneously with the application or within two months of the application date; subject to payment of the respective fee the term may be prolonged up to two months.

For failure to properly deliver the payment documents the application shall be deemed void.

3. The date of filing an invention application shall be that of the expert organization's receipt of the application documents listed in Item 2 -1 (1), 2) and 4)) of this Article when filed simultaneously, or the date of receipt of the last document whichever may take place earlier.

4. The procedure for execution, completion and processing an invention application, entrance into the state register of inventions of the Republic of Kazakhstan, as well as issuance of the protection document shall be determined by the competent authority.

### **Article 18. Filing for a Utility Model Patent**

1. An application for a utility model patent (hereinafter – utility model application) shall refer to a single utility model or a group of utility models closely associated with one another so as to form an integrated inventive concept (the requirement of unity of a utility model).

2. A utility model application shall include:

- 1) application for the patent naming the author(-s) of the utility model and the party(-s) on whose behalf the patent is sought, citing such parties' resident address or domicile;
- 2) detailed description of the utility model sufficient for a party reasonably skilled in the respective art to implement it;
- 3) utility model claim citing the target and nature of the invention and fully based on the description;
- 4) drawings;
- 5) synopsis;
- 6) power of attorney when filing through a representative.

A utility model application shall be accompanied by the receipt for the filing fee including the certificate of deduction (if any); these documents may be filed either simultaneously with the application or within two months as of the application

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

date; subject to payment of the respective fee the term may be prolonged up to two months.

For failure to properly deliver the payment documents the application shall be deemed void.

3. The date of filing a utility model application shall be that of the expert organization's receipt of the application file including an application for the utility model patent citing the surname, name, patronymic (if any) or the complete appellation of the applicant, the model description, claim and drawings when filed simultaneously, or the date of receipt of the last document whichever may come earlier.

4. The procedure for execution, completion and processing a utility model application, entrance in the state register of utility models of the Republic of Kazakhstan, as well as issuance of the protection document shall be determined by the competent authority.

### **Article 19. Filing for a Design Patent**

1. An application for an industrial design patent (hereinafter – industrial design application) shall refer to a single industrial design or a group of industrial designs closely associated with one another so as to form an integrated inventive concept (the requirement of unity of an industrial design).

2. The industrial design application shall include:

1) application for the patent naming the author(-s) of the industrial design and the party(-s) on whose behalf the patent is sought, citing such parties' resident address or domicile;

2) set of reproducible images of the article (articles) or model providing a thorough idea of the claimed design (designs) details;

3) Subitem shall be cancelled pursuant to the RK Law No 237-III of March 02, 2007 (see the previous version);

4) description of the industrial design listing its distinctive features;

5) power of attorney when filing through a representative.

An industrial design application shall be accompanied by the receipt for the filing fee including the certificate of deduction (if any); these documents may be filed either simultaneously with the application or within two months of the application date; subject to payment of the respective fee the term may be prolonged up to two months.

For failure to properly deliver the payment documents the application shall be deemed void.

3. The date of filing an industrial design application shall be deemed that of the expert organization's receipt of the application file including an application for the industrial design patent citing the surname, name, patronymic (if any) or the complete appellation of the applicant, the description and drawing (model) of the article when filed simultaneously, or the date of receipt of the last document whichever may come earlier.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

4. The procedure for execution, completion and processing an industrial design application, entrance in the state register of industrial designs of the Republic of Kazakhstan, as well as issuance of the protection document shall be determined by the competent authority.

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

1. The priority of an item of industrial property shall be established as of the date of the patent application for the respective item of industrial property determined pursuant to Article 17(3), Article 18(3) or Article 19 (3) of this Law.

2. The priority date may be that of filing the first application in a member state of the Paris Convention for the Protection of Industrial Property or with a conventionally stipulated international or regional organization (convention priority), should an application for an invention or utility model be filed with the expert organization within twelve months of the said date or an application for an industrial design be filed within six months of the said date. Should an applicant be unable to file for a convention priority within the aforementioned period due to reasons beyond her control, the term may be prolonged up to two months.

An applicant wishing to exercise the right to convention priority shall either allege it in the application or declare the intention within two months on filing an application with the expert organization attaching a certified copy of the first application or furnishing such within six months of the date of filing the application with the expert organization. A failure to deliver the aforementioned document shall be deemed waiver of the right to convention priority. The priority date shall in this case be deemed that of filing the application with the expert organization.

3. The priority date may be established as that of receipt of the supplemental materials, provided such materials are filed by the applicant as an independent application within three months of the expert organization's notice to the applicant of dismissing the supplemental materials due to their changing the nature of the claim unless the application to be supplemented by the respective materials has been withdrawn or deemed to be withdrawn by the date of the independent application.

4. The priority may be established as of the date of the same applicant filing with the expert organization an earlier application claiming the item of industrial property, unless the earlier application has been withdrawn or deemed to be withdrawn by the date of filing the application wherefore the priority is sought, provided the application is filed within twelve months of an earlier invention application, or six months of an earlier utility model or industrial design application. In this case the earlier application shall be deemed withdrawn.

Priority shall not be established as of the date of an application wherefore an earlier priority

**Source:** World Intellectual Property Organization

<http://www.wipo.int>



has been sought.

5. The priority of an item of industrial property sought under a divisional application shall be established as of the date of the same applicant filing with the expert organization her initial application disclosing the nature of the item or, should a right to an earlier priority exist, by the priority date under the initial application, provided the divisional application has been filed prior to the expert organization's non-opposed negative opinion or in case of the expert organization's positive opinion – before the date of registration in the proper register of the Republic of Kazakhstan.

6. The priority may be established on the basis of several earlier applications or supplemental materials thereto, subject to the respective provisions of Items 2-5 of this article.

7. Should there appear to be more than one identical item of industrial property with the same priority date, the priority shall be established on the application with the earliest proven date of filing with the expert organization or in case of identical dates – on the application with the earliest registration number with the expert organization.

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

1. An applicant may prior to the resolution on the application being taken amend or modify the application file without changing the nature of the claimed item.

Modifications or amendments made within two months of the application date shall be free of charge.

2. Novation of the applicant due to an assignment of the right to obtain the protection document or an amendment due to a change of the applicant's appellation, or correction of a clerical error may be effected before the date of the registration of the item of industrial property in the respective State register for a proper fee.

### **Article 22. Examination of an Invention Patent Application**

1. An application filed with the expert organization shall be processed for conformity to the requirements of Article 17(2-1), Subitems 1), 2) and 4) of this Law with the application date fixed. On discovery of a deficiency as to the aforementioned requirements, the expert organization shall notify the applicant respectively and suggest she complete and (or) amend the documents (information) within three months of the date of the notice. Should the applicant fail to deliver and (or) amend the documents, the application shall be deemed void with the respective notice to the applicant.

1-1. Upon fixation of the filing date of the invention application the expert organization shall effect a formal examination thereof.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

In the course of the formal examination the application file shall be examined for conformity to Article 17(2) of this Law.

2. Had the applicant acting pursuant to Article 21 of this Law delivered any supplemental materials, the latter shall be checked for conformity to the nature of the claimed invention.

An additional material shall be deemed to change the nature of the invention should it contain an element absent from the initial application that should have been included in the invention claim. In as much as such material changes the nature of the claimed invention it shall not be taken into account in the examination of the application with the applicant being notified of the right to file the aforementioned material as an independent application.

3. The filer of a deficient application shall be notified of the request to complete or amend the deficient application file within three months of the date of the notice.

Should the applicant fail to either deliver the required documents or file a request for a prolongation of the fixed term, the application shall be deemed withdrawn.

4. A filer of an application violating the requirement of unity of an invention shall be notified of the necessity within three months of the date of the notice to elect the invention to be considered and where necessary amend the application. Any other invention included into the initial application may be filed as a divisional application. The priority of divisional applications shall be determined pursuant to Article 20 (5) of this law.

Should the applicant fail within three months of the date of the notice of noncompliance with the unity of an invention requirement to elect the invention to be examined delivering the amended documents, only the first item of the claim and the items linked to it so as to satisfy the unity of an invention requirement shall be examined.

5. On completion of the formal examination the applicant shall be notified of the results thereof.

6. This Item shall be cancelled pursuant to the RK Law No 237-III of March 02, 2007 (see the previous version)

7. Should the formal examination result in a positive opinion of the expert organization, the latter shall commence an on-the-merits examination of the application.

The aim of the on-the-merits examination shall be to establish whether the claimed item may be legally protected as an invention, therefore the prior art in the respective field, the claimed item (items) conformity to the unity of an invention requirement, as well as the conditions of patentability provided for by Article 6 of this Law shall be established. An on-the-merits examination shall be subject to payment of the respective fee.

The receipt for the on-the-merits examination fee shall be delivered to the expert organization within three months of the date of the notice of the formal examination result to the applicant.

In case of failure to pay the on-the-merits examination fee the respective application shall be

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

deemed withdrawn.

8. In the course of the on-the-merits examination the expert organization may request the applicant supply supplemental materials pertinent to the examination, including an amended invention claim.

The supplemental materials requested by the expert organization may not change the nature of the invention and shall be delivered within three months of the date of the request or dispatch of the copies of the materials adverse to the application, provided the applicant requests such copies within two months of the date of the expert organization's request.

The supplemental materials changing the nature of the invention shall be subject to the procedure stipulated in Item 2 of this article. Should the applicant fail to deliver the requested materials or file a request for prolongation of the fixed term within the aforementioned period, the application shall be deemed withdrawn.

9. Should the on-the-merits examination show the conformity of the claimed item to the sought legal protection scope and the conditions of patentability of an invention stipulated in Article 6 of this Law, the expert organization shall render a positive opinion recommending a patent to be granted with the invention claim approved by the applicant and the stated priority date.

Following the expert organization's opinion the competent authority shall decide to either issue or deny an invention patent.

10. Should the on-the-merits examination show a non-conformity of the claimed item to the sought legal protection scope and the conditions of patentability, the expert organization shall render a negative opinion.

A negative opinion shall be rendered by the expert organization in the following cases:

- 1) the application referring to an object not entitled to protection as an invention;
- 2) the applicant's failure to amend the invention claim on being notified of the filed claim containing an element absent from the initial application materials, or containing in addition to the item entitled to protection as an invention, elements ineligible for protection as an invention, or denied examination due to failure to satisfy the unity of an invention requirement.

The applicant may challenge a negative opinion of the expert organization with the competent authority within three months of the mailing date of the opinion. The challenge shall be considered by the board of appeal within four months of the date of its receipt.

11. The applicant may at any time during the examination of the application, prior to the expert organization rendering its opinion, move for an innovation patent. In this case the examination shall be carried out pursuant to Article 22-1 of this Law.

12. The applicant may get access to any and all adverse materials discovered in the course of the examination. The expert organization shall dispatch any copies of the materials requested by the applicant within one month of the date of receipt of the request.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

13. Should the applicant fail to act within the period provided for by Items 3, 4, 7, 8 and 10 of this Article, the expert organization may revive the laches for a good cause subject to the applicant delivering a receipt for payment of the revival fee.

The applicant may within twelve months on expiry of the time limit file a request for revival of the laches. The request shall be filed with the expert organization simultaneously with the documents requested by the expert organization or with the opposition to the board of appeal.

14. Should the examination show that the invention application includes any classified information, such an application shall be classified as a state secret pursuant to the law of the Republic of Kazakhstan on state secrets.

### **Article 22-1. Examination of an Innovation Patent Application**

1. An application filed with the expert organization shall be processed for conformity to the requirements of Article 17(2-1), Subitems 1), 2) and 4) of this Law with the application date fixed. On discovery of a deficiency as to the aforementioned requirements, the expert organization shall notify the applicant respectively and suggest she complete the documents (information) within three months of the date of the notice. Should the applicant fail to deliver the documents (information), the application shall be deemed void with the respective notice to the applicant.

On fixation of the filing date of the innovation patent application the expert organization shall effect a formal examination thereof for completeness and conformity to the requirements of Article 17 (2) of this Law, compliance with the unity of an invention requirement, protectability of the claimed item as an invention; then the priority shall be established and the local novelty of the claimed item as against the inventions, utility models patented in the Republic of Kazakhstan, patents issued on the basis of the international treaties ratified by the Republic of Kazakhstan, published Eurasian applications, non -withdrawn applications of other applicants, filed with the expert organization before the priority date of the application in question as well as industrial fitness of the claimed item shall be checked.

2. Had the applicant acting pursuant to Article 21 of this Law delivered any supplemental materials, the latter shall be checked for conformity to the nature of the claimed invention.

An additional material shall be deemed to change the nature of the invention, should it contain an element absent from the initial application that should have been included in the invention claim. In as much as such material changes the nature of the claimed invention it shall not be taken into account in the examination of the application with the applicant being notified of the right to file the aforementioned material as an independent application.

3. The filer of a deficient application shall be notified of the request to complete or amend

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

the deficient application file within three months of the date of the notice.

Should the applicant fail to either deliver the required documents or file a request for a prolongation of the fixed term, the application shall be deemed withdrawn.

4. A filer of an application violating the requirement of unity of an invention shall be notified of the necessity within three months of the date of the notice to elect the invention to be considered and where necessary amend the application. Any other invention included into the initial application may be filed as a divisional application. The priority of divisional applications shall be determined pursuant to Article 20 (5) of this law.

Should the applicant fail within three months of the date of the notice of noncompliance with the unity of invention requirement to elect the invention to be examined delivering the amended documents, only the first item of the claim and the items linked to it so as to satisfy the unity of an invention requirement shall be examined.

5. Should the examination show the claimed items to be protectable as an invention, as well as satisfying the requirement of local novelty and industrial fitness referred to in Item 1 of this Article, and the filed documents to be properly filled, the expert organization shall render a positive opinion recommending issuance of an innovation patent with the patent claim approved by the applicant.

Following the expert organization's opinion the competent authority shall decide to either issue or deny an innovation patent.

6. A negative opinion concerning an innovation patent shall be rendered by the expert organization in the following cases:

1) an application referring to an object not entitled to protection as an invention; 2) the applicant's failure to amend the invention claim on being notified of the filed claim containing an element absent from the initial application materials, or containing in addition to the item entitled to protection as an invention, elements ineligible for protection as an invention, or denied examination due to failure to satisfy the unity of an invention requirement;

3) an application failing to satisfy the requirement of local novelty or industrial fitness referred to in Item 1 of this Law.

The applicant may challenge a negative opinion of the expert organization with the competent authority within six months of the mailing date of the opinion. The challenge shall be considered by the board of appeal within two months of the date of its receipt.

7. An applicant may at any time during the examination, or a patent holder or a third party may on publication of the patent notice, file a request for a prior art search in order to assess the prospective patentability of the invention. The expert organization shall not initiate a prior art search concerning an item not deemed to be an invention pursuant to Article 6(3) of this Law notifying the requesting party respectively.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

8. At the request of the applicant filed at any time during the examination, or the request of the patent holder filed on the patent issuance, or a third party request following the publication of the patent notice, but not later than three years of the date of filing for an innovation patent renewal pursuant to Article 5(3) of this Law, the expert organization shall initiate an on-the-merits examination of the application. Should the request be filed by the applicant or the patent holder, the on-the-merits examination shall be subject to payment of the proper examination and patent enforcement fees.

An on-the-merits examination shall be carried out in the order provided for by Article 22, Items 7-10 and 13 of this Law.

### **Article 23. Examination of a Utility Model Patent Application**

1. An application filed with the expert organization shall be processed for conformity to the requirements of Article 18 (2-1), Subitems 1) - 4) of this Law with the application date fixed. On discovery of a deficiency as to the aforementioned requirements, the expert organization shall notify the applicant respectively and suggest she complete the documents (information) within three months of the date of the notice. Should the applicant fail to properly deliver the documents (information), the application shall be deemed void with the respective notice to the applicant.

The application shall be processed for completeness and conformity to the requirements of Article 18 (2) of this Law, then the priority date, protectability of the claimed item as a utility model and its conformity to the unity of a utility model requirement shall be established.

The claimed utility model shall not be processed for patentability as provided for by Article 7(1) of this Law. The patent (if any) shall be granted at the risk of the applicant.

2. Examination of a utility model application shall be governed by the respective provisions of Article 22 (2- 4 and 13).

Should the examination show the item claimed by the applicant to be protectable as a utility model and the documents properly completed, the expert organization shall render a positive opinion recommending a utility model patent be granted.

The opinion of the expert organization shall be delivered to the competent authority in order within ten days to decide whether to grant the patent, the applicant being notified of the resolution in her favor.

Following the expert organization's opinion the competent authority shall within ten days decide to either issue or deny a utility model patent.

Thereon the applicant shall within three months of the date of the notice of the competent authority's resolution to grant the patent deliver to the expert organization a receipt for payment of the patent execution and publication fee, and payment of the state duty. In case of failure to

**Source:** World Intellectual Property Organization

<http://www.wipo.int>



deliver the proper documents the dates of payment may be revived within three months. Otherwise the application shall be deemed withdrawn and the process terminated with the respective notice to the applicant.

3. Should the examination show the claimed item to be ineligible for protection as a utility model, the expert organization shall render a negative opinion. A negative opinion may also be rendered for the applicant's failure to modify the utility model patent claim on being notified of the filed claim including elements absent from the initial application file, or beside the elements protectable as a utility model containing an ineligible element, or an element denied examination as violating the unity of a utility model requirement.

The applicant may challenge a negative opinion of the expert organization with the competent authority within three months of the mailing date of the opinion. The challenge shall be considered by the board of appeal within two months of the date of its receipt.

4. The applicant may at any time during the examination, or a patent holder or a third party may on publication of the patent notice, file a request for a prior art search in order to assess the prospective patentability of the utility model. The procedure shall thereon be governed by the respective provisions of Article 22(11) of this Law.

#### **Article 24. Examination of an Industrial Design Patent Application**

1. The expert organization shall carry out both a formal and an on-the-merits examination of an industrial design application.

2. At the formal stage the application documents shall be processed for completeness and conformity to the requirements of Article 19(2), Subitems 1), 2) and 4) of this Law with the filing and priority date being fixed.

The filer of an industrial design application found defective shall be notified to complete or amend the deficient application file within three months of the date of the notice.

In case of failure to deliver the required documents or request a prolongation of the fixed term within the aforementioned period, the application shall be deemed void with the respective notice to the applicant.

Had the applicant acting pursuant to Article 21 of this Law delivered any supplemental materials, the latter shall be checked for conformity to the nature of the claimed industrial design.

An additional material shall be deemed to change the nature of the claimed industrial design, should it contain an element absent from the initial application. In as much as such material changes the nature of the claimed industrial design it shall not be taken into account in the examination of the application with the applicant being notified of the right to file the

**Source:** World Intellectual Property Organization

<http://www.wipo.int>



aforementioned material as an independent application.

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

3. On reaching a positive result of the formal examination, the expert organization shall effect an on-the-merits examination of the application.

The aim of the on-the-merits examination shall be to establish the legal protectability of the claimed industrial design, therefore the prior art in the respective field shall be searched in order to evaluate the artistic design of the item, as well as its conformity to the patentability conditions provided for by Article 8 of this Law. An on-the-merits examination shall be subject to payment of the respective fee.

The receipt for the on-the-merits examination fee shall be delivered to the expert organization within three months of the date of the notice of the formal examination result to the applicant.

4. In the course of the on-the-merits examination the expert organization may request the applicant supply supplemental materials pertinent to the examination, including an amended list of distinctive features.

The supplemental materials requested by the expert organization may not change the nature of the industrial design and shall be delivered within three months of the date of the request.

The supplemental materials changing the nature of the industrial design shall be subject to the procedure stipulated in Item 1 of this article. Should the applicant fail to deliver the requested materials or file a request for prolongation of the fixed term within the aforementioned period, the application shall be deemed withdrawn.

5. Should the on-the-merits examination show the conformity of the claimed item to the sought legal protection scope and the conditions of patentability of an industrial design stipulated in Article 8 of this Law, the expert organization shall render a positive opinion recommending the patent be granted with the schedule of distinctive features approved by the applicant and the fixed priority date.

Following the expert organization's opinion the competent authority shall decide to either issue or deny an industrial design patent.

6. Should the examination show the claimed item to be ineligible for the sought protection scope as an industrial design, the expert organization shall render a negative opinion.

A negative opinion may also be rendered should the claimed item be ineligible for protection as an industrial design, or in case of the applicant's failure to modify the schedule of distinctive features on being notified of the filed claim including elements absent from the initial application file, or beside the elements protectable as an industrial design containing an ineligible feature, or an element denied examination as violating the unity of an industrial design requirement.

The applicant may challenge a negative opinion of the expert organization with the

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

competent authority within three months of the mailing date of the opinion. The challenge shall be considered by the board of appeal within two months of the date of its receipt.

7. The applicant may get access to any and all adverse materials discovered in the course of the examination. The expert organization shall dispatch any copies of the materials requested by the applicant within one month of the date of receipt of the request.

8. Should the applicant fail to act within the period provided for by Items 3 and 4 of this Article, the expert organization may revive the laches for a good cause subject to the applicant delivering a receipt for payment of the revival fee.

The applicant may within six months on expiry of the time limit file a request for revival of the laches. The request shall be filed with the expert organization simultaneously with the documents requested by the expert organization or with the opposition to the board of appeal.

#### **Article 25. Registration of an Item of Industrial Property; Issuance of a Protection Document.**

1. The expert organization shall enter the invention, utility model or industrial design in the State register of inventions of the Republic of Kazakhstan, the State register of utility models of the Republic of Kazakhstan or the State register of industrial designs of the Republic of Kazakhstan respectively.

2. The competent authority shall deliver a protection document to the patent holder simultaneously with the publication of the respective notice in the bulletin.

Should protection be sought on behalf of more than one party, all such parties shall be entitled to a joint protection document.

3. The author of an item of industrial property who is not the patent holder shall be issued a formal certificate of authorship by the competent authority.

4. The form of the protection document and the certificate of authorship, as well as the wording of these documents, shall be approved by the competent authority.

#### **Article 26. Publication of a Protection Document Notice**

1. The expert organization shall on expiry of an eighteen-month period publish the invention patent notice in the bulletin, while the notice of an innovation patent, utility model or industrial design patent shall be published in twelve months of the application date.

2. The Item shall be cancelled pursuant to the RK Law No 237-III of March 02, 2007 (see the previous version)

3. An author may waive the reference to her authorship in the protection document notice.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

4. The wording of the published notice shall be specified by the competent authority.
5. On publication of the protection document notice there shall be free access to the application file and the prior art search report of the expert organization.
6. The expert organization shall publish the notice of a protection document renewal pursuant to article 5(3) of this law or of an amendment to an entry in the respective State register in the bulletin.

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

An applicant may withdraw her application prior to the entry of the respective item of industrial property in the proper State register of the Republic of Kazakhstan.

### **Article 28. Conversion of an Application**

1. Prior to the expert organization rendering its opinion of an invention patent application, the applicant may petition to convert it into a utility model application.
2. A utility model application may be converted into an invention application prior to the expert organization's opinion being rendered by filing a respective petition.
3. A converted application shall retain the priority and the filing date of the original application.

## **Chapter 6. Termination or Renewal of a Protection Document**

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

1. Within the whole term of validity of a protection document its validity may be challenged resulting in a total or partial invalidity of the respective document in the following cases:
  - 1) nonconformity of an item of industrial property to the conditions of patentability provided for by this Law;
  - 2) an invention or utility model claim, or the schedule of an industrial design distinctive features containing elements absent from the original application;
  - 3) issuance of a protection document to a violator of Article 37 of this Law;
  - 4) erroneous reference to the author (-s) or the patent holder in the protection document.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

2. A protection document may be challenged for cause as provided for by Item 1 (1-3) above by petitioning the competent authority. The board of appeal shall consider the petition within six months of the date of filing. The petitioner shall notify the patent holder of the challenge.

### **Article 30. Invalidation or Early Termination of a Protection Document**

1. A protection document may be declared totally or partially invalid either judicially or by a resolution of the board of appeal.

2. A protection document shall be subject to an early termination in the following cases:

1) On petition of the patent holder to the competent authority as of the date of publication of the respective termination notice in the bulletin. In case of a patent holder filing a petition in respect of a part of a group of industrial property items, the protection document shall be deemed terminated only in respect of industrial property items listed in the petition.

2) for default in payment of the enforcement fee.

3. The expert organization shall notify of a totally or partially invalidated, or early-terminated protection document in the bulletin.

### **Article 31 Patent Renewal; Subsequent Use**

1. A patent terminated pursuant to Article 30 (2 - 2) of this Law may be renewed at the patent holder's request within three years of the patent enforcement fee due date on delivery of the receipt for payment of the patent renewal fee.

The expert organization shall publish the patent renewal notice in the bulletin. The patent shall be deemed renewed as of the date of the notice.

2. Any party whose use of an item of industrial property in the Republic of Kazakhstan shall commence on the patent termination prior to its renewal, or the one making the necessary preparations thereto, shall retain the right of gratuitous use of such an item without broadening the scope of the use (the right of subsequent use).

The right of subsequent use may be assigned to another party only as part of the enterprise where the respective item of industrial property is used or the necessary preparations for such use have been made.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

## **Chapter 7. Protection of the Author, Applicant or Patent Holder's Rights**

### **Article 32. Board of Appeal**

1. The board of appeal shall be a division of the competent authority responsible for out-of-court resolution of disputes arising out of an opposition filed pursuant to Article 22 (10), Article 22 -1 (6), Article 23 (3) or Article 29 (2) of this Law. The regulation of the board of appeal shall be approved by the competent authority.

2. The board of appeal shall consider the following oppositions:

1) decision of the competent authority (resolution of the expert organization) to deny an innovation patent for an invention, utility model or industrial design;

2) decision to grant an innovation patent for an invention, utility model or industrial design;

An opposition pursuant to Subitem 1) of this Item may be filed by the applicant, her successor or a representative of the same.

Anyone may file an opposition pursuant to Subitem 2) of this paragraph either personally or through a representative.

An opposition shall be executed in the Kazakh and Russian languages and delivered to the competent authority personally or by mail. Any enclosure in the opposition shall be in the Kazakh and Russian languages. An enclosure in another language shall be accompanied by a notarized translation into the Kazakh and Russian languages.

An opposition dispatched by fax or email shall within one month of the date of dispatch be followed by the hard copy of the original.

An opposition shall be filed within the timeframe specified by this Law. Should an applicant fail to file as specified in Subitem 1) above, the laches may be revived for good cause on delivery of a receipt for payment of the laches revival fee. An applicant may file for revival of the laches as provided for by this Law. The respective petition shall be filed with the board of appeal along with the opposition.

3. In case of an opposition filed through a patent attorney or another representative, the power of attorney shall be in the Kazakh and Russian languages; a power of attorney in another (foreign) language shall be accompanied by a notarized translation into Kazakh and Russian. The original power of attorney shall be attached to the opposition materials or delivered to the secretary of the board of appeal along with the copy to certify notarization.

4. The panel appointed by the board of appeal shall consider the opposition within the term provided for by this Law. The term for consideration of the opposition may be prolonged at the request of the petitioner or the patent holder up to six months on expiry of the original term.

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

5. The petitioner or the patent holder may appeal the decision of the board of appeal judicially within six months of the date of the opposed decision.

#### **Article 32-1. Grounds for the Board of Appeal Dismissal of the Opposition**

1. An opposition may be dismissed as follows:

- 1) consideration by the board of appeal is barred by the law of the Republic of Kazakhstan;
- 2) filing an unsigned petition or a petition signed by an unauthorized party;
- 3) default in filing or failure to revive the laches;
- 4) failure to properly eliminate a defect in completion, content or filing a petition.

Subject to the aforementioned circumstances, the petitioner shall be notified of dismissal and avoidance of the opposition.

A petitioner or her representative may withdraw the opposition prior to the delivery of the board of appeal decision.

#### **Article 32-2. Consideration of the Opposition by the Board of Appeal Panel**

1. An opposition shall be considered by a panel of at least five members of the board of appeal. Prior to consideration the composition of the board of appeal panel shall be kept confidential.

In meeting the panel may hear the opinion of a research organization's representative or an expert on the pertinent art.

2. The board of appeal panel may postpone its meeting in the following cases: 1) due to default of a party entitled to participate in the consideration of the opposition;

2) in order for the parties to deliver supplemental materials (evidence) pertinent to an on-the-merits resolution;

3) at the parties' request.

3. The parties participating in the consideration of the opposition may:

- 1) get access to the case file, take excerpts from the latter, order and acquire copies of it;
- 2) deliver evidence;
- 3) participate in the discovery of evidence;
- 4) question the participants of the appellate procedure;
- 5) file a motion;
- 6) give oral or written explanation to the board of appeal panel;
- 7) present an allegation or argument on any issue under consideration;

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

8) object to another party's allegation or argument.

4. The panel shall take its decision on completion of the on-the-merits consideration.

The decision shall be taken by a simple majority of the board of appeal panel. In case of a tied vote, the chair of the panel shall cast the decisive vote.

The panel may decide as follows:

- 1) uphold the opposition;
- 2) partially uphold the opposition;
- 3) postpone the consideration of the opposition;
- 4) dismiss the opposition.

5. The board of appeal panel shall within ten business days of the decision execute and dispatch its decision to the parties. The decision of the board of appeal shall be executed in writing and include an introduction, description, motivation, and resolution.

The decision of the board of appeal shall be signed by every panel member.

### **Article 33. Judicial Dispute Resolution**

1. The following disputes shall be subject to judicial resolution:

- 1) authorship of an item of industrial property;
  - 2) legitimacy of a protection document;
  - 3) identification of the patent holder;
  - 4) grant of a compulsory license;
  - 5) infringement of the exclusive right to use a protected item of industrial property or another interest of a patent holder;
  - 6) execution or performance of a license agreement to use a protected item of industrial property;
  - 7) the right of prior or subsequent use;
  - 8) an employer's compensation to an employee-inventor pursuant to Article 10
- (4) of this Law;
- 9) payment of compensations provided for by this Law;
  - 10) any other dispute arising out of a protection document.

2. Following the judgment the expert organization shall publish a notice of an amendment to the protection document.

### **Article 34. Liability for Infringement of the Author, Applicant or Patent Holder's Rights**

**Source:** World Intellectual Property Organization

<http://www.wipo.int>



Misappropriation of authorship, coercion to co-authorship, disclosure of the nature of an item of industrial property prior to its publication without the author or the applicant's consent, unauthorized use of a protected item of industrial property, or violation of a foreign patenting procedure shall result in liability under the law of the Republic of Kazakhstan.

## **Chapter 8. Final Provisions**

### **Article 35. State Duty**

Issuance of a protection document, registration of an agreement, certification of a patent attorney or issuance of a patent attorney registration certificate shall be subject to a state duty as provided for by the tax law of the Republic of Kazakhstan.

### **Article 36. Patent Attorney**

1. Any competent national of the Republic of Kazakhstan permanently resident in the Republic of Kazakhstan owning a higher education certificate with at least four years of professional experience in the area of intellectual property, duly certified and registered by the proper intellectual property authority may act as a patent attorney.

In order to certify the prospective patent attorneys, the competent authority shall form a certification committee of its own officers and the officers of the expert organization. There shall be no less than five certification committee members.

Certification of patent attorney candidates shall take place at least once a year as the respective applications are filed.

Following the certification results, the committee shall either certify or deny certification to a candidate. The form of the certification committee resolution shall be approved by the competent authority.

The certification committee resolution may be opposed judicially within three months from the date of its making.

A candidate passing the patent attorney certification exam shall be awarded a patent attorney certificate in the form approved by the competent authority.

A patent attorney certification and the issuance of the respective certificate shall be subject to a state duty provided for by the tax law of the Republic of Kazakhstan.

2. Certification as a patent attorney shall be denied to the following parties:

1) an individual enjoined from business by the operation of law of the Republic of

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

Kazakhstan;

2) an officer of the competent authority or its subsidiary, or a close relative or spouse of the same;

3) an individual under an effective criminal conviction;

4) an individual struck from the patent attorney register pursuant to this Law.

3. A patent attorney may be suspended by a written resolution of the certification committee as follows:

1) at the patent attorney's request to the certification committee;

2) when entered in the list of the parties enjoined from business by the operation of law of the Republic of Kazakhstan, including officers of the competent authority or its subsidiary;

3) to investigate the circumstances referred to in Article 36-2 (5 or 1 (2); 6)) of this Law.

In a case referred to in Subitem 3) of this Item, the patent attorney shall be suspended until the respective resolution of the certification committee to be taken within three months .

A patent attorney shall be rehabilitated by a written resolution of the certification committee on termination of the grounds for suspension.

4. A patent attorney shall represent an applicant or a patent holder with the competent authority or the expert organization on the issues of legal protection of intellectual property items. An applicant or a patent holder may address the competent authority or the expert organization directly as well.

An individual non-resident in the Republic of Kazakhstan or a foreign legal entity may interact with the competent authority or its subsidiary as an applicant, patent holder or an interested party exclusively through a patent attorney.

A permanent resident of the Republic of Kazakhstan temporarily abroad may act as an applicant, patent holder or an interested party without a patent attorney subject to delivery of a mailing address in the Republic of Kazakhstan.

5. Information disclosed to a patent attorney by a client in the course of her appointment shall be deemed confidential for the purposes of the law of the Republic of Kazakhstan governing confidential information or another legally protected secret.

### **Article 36-1. Rights and Obligations of a Patent Attorney**

1. A patent attorney may act on behalf of an applicant (an individual or a legal entity), her employer or a party under a civil contract with the latter as follows:

1) advise on the matters of protection, acquisition or assignment of intellectual property rights;

2) execute and file an application for an invention, utility model or an industrial design on behalf of a client, principal or employer;

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

3) interact with the competent authority and/or the expert organization on the issues of protection of the rights to an invention, utility model or industrial design, including written communication, appeal of an expert opinion or participation in the procedure of the expert council at the expert organization;

4) aid in execution, analysis and filing for examination of a license (sublicense) or an assignment agreement.

2. A patent attorney shall act under a power of attorney certifying to her authority.

3. Should a patent attorney act under a copy of the power of attorney when filing an application for an invention, utility model or an industrial design and/or obtaining a protection document, or filing a petition with the board of appeal, the patent attorney shall within three months of the date of filing deliver to the expert organization and the competent authority the original power of attorney. The latter shall be returned on authentication.

A power of attorney executed in a foreign language shall be accompanied by a notarized translation into Kazakh and Russian.

4. A patent attorney may not accept an appointment in a conflict of interest situation, i.e. having either represented or consulted a party with an interest adverse to that of the prospective principal, or when a close relative or spouse of the patent attorney or a close relative of the spouse may officially participate in the resolution of the respective case.

### **Article 36-2. Recall or Cancellation of a Patent Attorney Certificate**

1. A patent attorney may be struck from the register of patent attorneys by the resolution of the certification committee:

1) at the patent attorney's request to the certification committee;

2) on cessation of citizenship of the Republic of Kazakhstan or establishment of a permanent residence without the borders of the Republic of Kazakhstan;

3) in case of discontinuance of professional service as a patent attorney for longer than five years;

4) on coming into force of a criminal conviction against a patent attorney; 5) on the death of a patent attorney or on her being declared missing or dead; 6) on declaring a patent attorney incompetent or of limited competence;

2. Should a patent attorney be struck from the register on the grounds referred to in Subitems 4), 5) or 6) above, her certificate shall be canceled by the resolution of the certification committee with the respective entry in the register of patent attorneys.

3. In cases listed in Item Subitems 1), 2) or 3) of this Article, the certificate of the patent attorney shall be canceled by the resolution of the certification committee at the request of the

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

respective patent attorney or a proper third party.

A patent attorney struck from the register as provided for by Item 1, Subitem 1) or 2) of this article may renew her patent attorney registration without any promotion exam subject to termination of the avoidance cause and an application to the certification committee within three years of the date of publishing the avoidance notification. The certification committee shall process the filed documents to establish the fact of the grounds listed in Item 1, Subitem 1) or 2) of this article termination.

The appellate committee shall be a joint body authorized to consider an individual or corporate appeal of the acts of a patent attorney violating the applicable law when representing a client.

Both the claimant and the patent attorney.

4. A patent attorney struck from the register of patent attorneys may no longer act as a patent attorney as of the date of the respective entry in the register while the respective patent attorney certificate is deemed recalled or canceled.

5. Should a patent attorney be in breach of her duties provided for by this Law, the competent authority shall call an appellate committee of an odd number of its officers.

The appellate committee shall be a joint body authorized to consider an individual or corporate appeal of the acts of a patent attorney violating the applicable law when representing a client.

Both the claimant and the patent attorney allegedly guilty of a violation may participate in the appellate committee procedure.

Upon consideration of the complaint, the appellate committee shall either recommend the competent authority sue for the patent attorney certificate cancellation or take one of the following decisions:

1) postpone consideration of the complaint due to insufficient evidence or until discovery of new evidence leading to an objective resolution;

2) dismiss the complaint.

The appellate committee resolution shall be taken by a simple majority vote and recorded in the minutes. The appellate committee resolution may be appealed judicially.

The appellate committee Regulation shall be approved by the competent authority.

### **Article 37. Patenting an Item of Intellectual Property in a Foreign Country**

1. An application for a patent for an item of industrial property created in the Republic of Kazakhstan may be filed in a foreign country in three months on the respective application being filed with the expert organization, or earlier on completion of the process of establishing the

**Source:** World Intellectual Property Organization

<http://www.wipo.int>

absence of any classified information (state secret) therein.

2. A national of the Republic of Kazakhstan domiciled in the Republic of Kazakhstan or a legal entity incorporated in the Republic of Kazakhstan shall file for an international patent for an item of industrial property through the expert organization unless a treaty of Kazakhstan provides otherwise.

3. Should an application for a patent for an item of industrial property created in the Republic of Kazakhstan be filed in a foreign country or with an international patent organization in violation of this article, no protection document for such an item of industrial property shall be issued in the Republic of Kazakhstan.

### **Article 38. Rights of a Foreign Individual, Legal Entity or Stateless Person**

1. A foreign individual or a legal entity shall enjoy the rights conferred by this Law to the same extent as a national or a legal entity of the Republic of Kazakhstan pursuant to the treaties of the Republic of Kazakhstan or reciprocally.

2. A stateless person residing in the Republic of Kazakhstan shall enjoy the rights conferred by this Law or other regulations governing protection of items of industrial property to the same extent as an individual or a legal entity of the Republic of Kazakhstan, unless this Law or another legal act provides otherwise.

**President  
of the Republic of Kazakhstan**

**N. NAZARBAYEV**

**Source:** World Intellectual Property Organization

<http://www.wipo.int>