

**Republic of Kazakhstan**

**Patent Law**

As amended up to Law of No. 268-VI of October 28, 2019

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## **Chapter 1. General provisions**

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

The following basic definitions are used in this Law:

- 1) "the exclusive right" means a property right of the patent owner to use the industrial property subject matter in any manner at his sole discretion;
- 2) "bulletin" means an official periodical on the protection of industrial property subject matter;
- 2-1) "Eurasian application" means an application filed in accordance with the Eurasian Patent Convention of 9 September 1994;
- 3) "intellectual property subject matter" means the results of intellectual activity and the means of ascertainment of participants in economic turnover, goods, works, and services;
- 4) "titles of protection" include innovation patents, patents for inventions, industrial design patents and utility models patents granted in conformity with this Law;
- 6) "license contract" means a contract under which the patent owner (the licensor) grants another party (the licensee) the right to temporarily use the industrial property subject matter in a particular manner;
- 7) "industrial property subject matter" means inventions, utility models and industrial design;
- 7-1) official industrial property subject matter - inventions, utility models, industrial designs created by an employee in the performance of his duties or specific tasks of the employer;
- 8) The Paris Convention means Paris Convention for the Protection of Industrial Property of March 20, 1983, with all further amendments and supplements.
- 9) "patent owner" means an owner of the title of protection;
- 10) "conditions of patentability" mean requirements provided for by this Law for the grant of legal protection for industrial property subject matter;
- 11) "patented industrial property subject matter" means an industrial property for which a title of protection has been granted;
- 12) "patent attorneys" means the citizens of the Republic of Kazakhstan, which in accordance with the legislation of the Republic of Kazakhstan have the right to represent individuals and legal entities to the authorized body and expert agency;
- 13) "international application" means an application filed under the

Patent Cooperation Treaty of 19 June 1970.

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

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

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

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

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

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

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

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

2. The authorized body shall include:

1) participating in the implementation of the state policy in the field of legal protection of industrial property;

2) developing and approving the following:

rules for the examination of applications for industrial property subject matters;

rules for registration of industrial property subject matters in the State Register of Inventions, State Register of Utility Models, and State Register of Industrial Designs, and issuance of protective

documents and their duplicates;  
invalidation and early termination of patents;  
rules for registration of the transfer of exclusive rights, grant of rights to use industrial property subject matters, and open or compulsory licenses in the relevant state registers;  
rules for the provision of extracts from the relevant state registers;  
rules for consideration of appeals by the Board of Appeal;  
rules for consideration of applications for industrial property subject matters under international treaties ratified by the Republic of Kazakhstan;  
regulations on the Attestation Commission;  
regulations on the Board of Appeal;  
regulations on the Appeals Commission;  
3) determination of the procedure for publishing information related to the registration of industrial property subject matters in the Bulletin;  
4) certification of candidate patent attorneys and their registration in the Register of Patent Attorneys;  
5) management of the activities of the Attestation Commission, the Board of Appeal, and the Appeals Commission;  
6) performing other powers provided for by this Law, other laws of the Republic of Kazakhstan, and acts of the President of the Republic of Kazakhstan and the Government of the Republic of Kazakhstan.

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

1. The expert organization established by the decision of the Government of the Republic of Kazakhstan, whose legal form of organization is a republican state-owned enterprise with the right to conduct business management, shall be sub-ordinate to the authorized body in its activities, such as:

- 1) examining industrial property right registration applications;
- 2) registering industrial property subject matters in the relevant state registers, and issuing protective documents and their duplicates;  
carrying out invalidation and early termination of patents;
- 3) registering the transfer of exclusive rights, grant of rights to use industrial property subject matters, and open or compulsory licenses in the relevant state registers;
- 4) operating the relevant state registers and the Bulletin, and

publishing them on its Internet site;

- 5) providing extracts from the relevant state registers;
- 6) publishing information related to industrial property subject matter registration in the Bulletin;
- 7) searching for information on registered industrial property subject matters based on requests from stakeholders;
- 8) considering applications for industrial property subject matters under international treaties ratified by the Republic of Kazakhstan;
- 9) carrying out other kinds of activities that are not prohibited by the laws of the Republic of Kazakhstan.

2. The expert organization, in coordination with the authorized body, shall approve fee for services in the field of industrial property object protection, on the condition of ensuring full reimbursement of the costs incurred by the organization for the provision of the said services, generating no losses, and financing from its own revenues.

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

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

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

A patent for an invention or industrial design shall be granted after the formal examination and substantive examination of the application. Patent shall certify the priority, authorship and exclusive rights to the industrial property subject matter.

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

In respect of inventions relating to medicinal products, pesticide, which requires obtaining permits in the order prescribed by the legislation of the Republic of Kazakhstan on permissions and notifications, the period of validity of the exclusive right and a patent proving it may be extended at the request of the patent owner, but not more than five years.

The specified period is extended by the time elapsed from the filing date of the patent for the invention before the date of the first authorization to use the invention for less than five years.

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

4. The legal protection for a patent for an invention and utility model shall be determined by their claims, and the legal protection provided for an industrial design shall be determined by the set of its essential features shown in the images of the product appearance. For the interpretation of the claims, patent for an invention and utility model can be used description and drawings. The effect of a protection document granted for a method for obtaining a product shall apply to the product directly obtained by this method. Therewith, unless proven otherwise, a new product shall be considered as obtained by the protected method.

5. Eligibility for a security document, the rights resulting from the application registration, the right of possession of a protection document, and the rights resulting from the protection document may be transferred fully or in part to another person.

6. No legal protection shall be granted under this Law for the industrial property subject matter that has been declared secret by the State.

The procedure for handling the secret industrial property subject matters are to be determined by the authorized body.



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

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

1. An invention shall be granted legal protection if it is new, involves an inventive step and capable of being industrially applicable. An invention shall be deemed new if it is not anticipated by prior state of art.

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

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

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

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

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

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

- 1) discoveries, scientific theories and mathematical methods;
- 2) methods of organization and management of economy;
- 3) symbols, schedules, rules;
- 4) rules and methods of performing the mental activities, conducting the games;
- 5) computer software and algorithms;
- 6) projects and plans for structures, buildings, territories;
- 7) proposals concerning solely the outward appearance of manufactured articles;

8) proposals that are contrary to public interest, humanitarian principles or morality.

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

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

1. A utility model include the technical solutions in any field related to the product (device, substance, strain of a microorganism, plant or animal cell culture), method (the process of affecting a material object using material resources), as well as the application of known product or process for a new purpose, or the use of a new product for a particular purpose, except for diagnostic, therapeutic and surgical methods for treatment of humans or animals.

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

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

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

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

2. Public disclosure of information, relating to the utility model, by the author (applicant) or any person having obtained the information directly or indirectly from them, including the

demonstration of a utility model as an exhibit at an official or officially recognized international exhibition organized in the state-party to the Paris Convention, shall not be deemed as affecting the novelty of the utility model, if the application for the utility model was filed within six months after said disclosure of information or displaying it at the exhibition. The burden of proof of the foregoing shall be on the applicant.

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

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

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

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

- 1) solutions that are determined exclusively by the technical function of an article;
- 2) solutions that relate to architectural works (with the exception of minor architectural forms) and industrial, hydraulic and other stationary structures;
- 4) solution that relate to subject matter of unstable shape such as liquids, gaseous and dry substances and the like;
- 5) articles that are contrary to the public interest, humanitarian principles or morality.

3. Public disclosure of information, relating to the industrial designs, by the author (applicant) or any person having obtained the information directly or indirectly from them, including the

demonstration of an industrial design as an exhibit at an official or officially recognized international exhibition organized in the state-party to the Paris Convention, shall not be deemed as affecting the patentability of the industrial designs, if the application for the industrial design was filed within six months after said disclosure of information or displaying it at the exhibition. The burden of proof of the foregoing shall be on the applicant.

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

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

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

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

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

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

5. To promote and raise awareness of innovative activities in the Republic of Kazakhstan, the authorized body shall cooperate with other authorized bodies in the fields of science, state support of industrial innovative activities, and other related bodies to develop and determine the procedure for the annual "Shapagat" contest. This contest shall aim to select socially and economically significant, competitive, and environmentally safe inventions, as well as to award the title "Honored Inventor" to authors of the most important and widely used inventions.

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

1. A title of protection shall be granted to:

1) the author (or authors) of the industrial property subject matter;

2) the employer in cases provided for by paragraph 2 of this article;

3) their successor (or successors) including the assignee (or assignees);

4) the beneficiaries provided for in this paragraph jointly subject to agreement between them.

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

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

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

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

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

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

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

The employer shall be obliged to accept and register the notification filed by the author about the creation of the service industrial property subject matter on the date of submission, and

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

5. If an employer has not been notified by the employee of the service industrial property subject matter for which the employer has the right to be granted a title of protection, the deadline specified in paragraph 7 of this article shall begin from the date when the employer became aware of its creation. If the fact of creation of the service industrial property subject matter is found by an employer he shall be obliged to notify in writing the author. Therewith, if the right to be granted a title of protection for service industrial property subject matter belongs to the employer, the employer shall notify the author of launching the application, and the author shall, upon the request of the employer, provide in writing additional information required to process an application for a service industrial property subject matter, as well as the list of authors.

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

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

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

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



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

### **Article 11. The Exclusive Right to Use the Industrial property subject matter and the Conditions for the Issuance of a Compulsory Non-Exclusive License**

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

2. The use of industrial property subject matter shall be deemed to include the manufacture, use, import, and offer for sale, sale, and any other form of distribution for commercial purposes or stocking for above purposes of products containing the industrial property subject matter, and the use of the protected method.

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

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

A product is recognized as containing a protected industrial design if it contains all its essential features presented in the images of appearance.

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

The relations in regards the use of industrial property subject matter, the title of protection for which belongs to two or more persons, shall be determined by the agreement between them. Where no such agreement exists, each of the patent owners shall be entitled to use the patented industrial property subject matter at his discretion, but shall not have a right to grant a license on the title of protection or assign the title of protection to another

person without the consent of other owners.

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

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

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

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

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

Any compulsory non-exclusive license shall be issued primarily to meet the needs of the domestic market of the Republic of Kazakhstan, except in cases where such a license is requested for the medicinal product or manufacturing process of the medicinal product for the purposes of the export of patented medicine or medicine, obtained through the patented process in the territory, where is no or insufficient manufacturing facilities, in accordance with the international treaties ratified by the Republic of Kazakhstan. The person to whom a compulsory license was granted may assign the right to use the industrial property subject matter to another

person only in consort with the enterprise that uses the said subject matter.

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

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

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

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

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

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

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

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

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

16. The amount of fees for maintaining a Eurasian patent in force in the territory of the Republic of Kazakhstan shall be established by the authorized body.

**Article 11-1. Transfer of an exclusive right to an industrial property subject matter**

1. A patent owner shall have the right to transfer their exclusive right to an industrial property subject matter to another individual or legal entity under a contract of assignment.

An agreement on the transfer of an exclusive right to an industrial property subject matter shall be concluded in writing within the term of validity of the exclusive right.

2. The transfer of an exclusive right to an industrial property subject matter shall be registered in the relevant state register.

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

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

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

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

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

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

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

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

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

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

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

2. Any individual, who, after the priority date of the protected industrial property subject matter but before the date of publication of the particulars of the granted patent for invention, industrial design or the utility model patent, had started the use of the industrial property subject matter, shall, at the request of the patent owner, stop such use. The said person shall not be required to compensate the patent owner for damages sustained in the result of such use.

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

4. Any individual using the industrial property subject matter during the period set forth in paragraph 3 of this article shall, after the grant of the title of protection, pay compensation to the patent owner. The amount of compensation is to be determined by agreement between the parties. The parties may terminate the case by settlement agreement or the agreement relating to the settlement of the dispute (conflict) in the mediation procedure, which shall be signed by the parties and approved by the Court.

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

1. Any person who is not the patent owner (licensee) shall have the right to use the protected industrial property subject matter with the permission of the patent owner (licensor) on the basis of a license agreement, a comprehensive entrepreneurial license agreement, or any other agreement with the licensor that contains the terms and conditions of the license agreement (hereinafter, collectively referred to as the license agreement).

2. A license agreement can include a provision for the licensor to grant the licensee the right to use the industrial property subject matter, while:

- 1) retaining the licensor's right to use it and the right to grant a license to others (simple, non-exclusive license);
- 2) retaining the licensor's right to use it, without the right to grant a license to others (sole license);
- 3) not retaining the licensor's right to use it, or the right to grant a license to others (exclusive license).

In cases where the license agreement does not specify usage conditions, a simple and non-exclusive license shall be granted for the use of the industrial property subject matter.

The licensee shall have the right to use the industrial property

subject matter across the territory of the Republic of Kazakhstan, unless the license agreement specifies otherwise.

The validity period of the right to use the industrial property subject matter shall be defined in the license agreement, and may be extended by mutual agreement of the parties.

If the validity period is not specified in the license agreement, the validity period of the right to use the industrial property subject matter shall be five years as of the date of the agreement's registration.

Termination of the exclusive right to the industrial property subject matter shall lead to the termination of the license agreement.

The licensee shall have the right to transfer the right to use the industrial property subject matter to another person (sublicensee) on the basis of a sublicense agreement or an agreement of complex entrepreneurial sublicense, in accordance with the terms and conditions of the license agreement. The licensee shall be responsible to the licensor for the actions of the sub-licensee, unless the license agreement specifies otherwise. The transfer of the exclusive right to the industrial property subject matter to another person shall not result in the termination of the license agreement.

3. Agreements granting the right to use an industrial property subject matter and additional agreements shall be concluded in writing and registered in the relevant state register.

**Article 14-1. Conditions for registration of the transfer of an exclusive right and the grant of the right to use an industrial property subject matter**

1. The transfer of an exclusive right and the grant of the right to use an industrial property subject matter shall be registered by entering information in the relevant state registers within ten working days of the date of receipt of the application of a contracting party. Failure to comply with the written form and/or the requirement for registration shall result in nullification of the contract.

2. Changes to the relevant state registers in connection with the termination of the contract, or the cancellation of registration on the basis of a court decision that has become legally binding, shall

be carried out within one business day of the date of receipt of the application of a contracting party.

If there are technical errors in the registration information that do not affect its ownership, nature, or content, these can be corrected within one business day of the date of receipt of the application of a party concerned, and a written notification to that effect shall be sent to the other contracting parties.

3. Grounds for temporarily preventing registration shall be:

- 1) when a period of time is required for restoring a terminated exclusive right to an industrial property subject matter;
- 2) submission of an incomplete package of documents, or provision of inconsistent information in the submitted documents;
- 3) discrepancies between the information provided in submitted documents and the information registered in state registers, or in an international register ratified by the Republic of Kazakhstan.

4. If any of the grounds specified in paragraph 3 of this article are found to exist, the applicant shall be sent a request to eliminate the issue. The registration period shall be suspended for three months as of the date of the request.

5. Grounds for denial of registration shall be:

- 1) expiration of the period for restoration of a terminated exclusive right to an industrial property subject matter;
- 2) expiration of the period for elimination of an issue temporarily preventing registration;
- 3) receipt of an application for registration from a person who is not a contracting party;
- 4) absence of registration of the license agreement, or an additional agreement;
- 5) existence of obligations assumed by a party preventing the grant of the right to use the industrial property subject matter.

#### **Article 14-2. Open license**

1. A patent owner may submit an application to the expert organization for granting any person the right to use an industrial property subject matter.

2. A patent owner's application for an open license shall not be revoked, and shall remain valid for three years as of the date of



its registration. Within the said period, the fee for the security document maintenance shall be reduced by 50 percent starting from the year following the year of registration in the relevant state register.

3. A person who wishes to purchase an open license shall enter into a corresponding written agreement with the patent owner. Any disputes regarding the terms and conditions of the contract shall be resolved in court.

4. The grant of the right to an open license shall be registered within one business day of the date of receipt of the application of the patent owner, or a person concerned, with the required documents attached.

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

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

An unauthorized manufacturing, utilization, importation, stocking, offering for sale, sale and any other distribution for commercial purposes of products incorporating the protected industrial property subject matter, and the use of the protected method or the distribution for commercial purposes of a product obtained directly through such method shall be deemed to constitute an infringement of the exclusive right of the patent owner (infringement of the title of protection).

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

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

- 1) cease the infringement of the title of protection;
- 2) the infringer compensate the owner the damages sustained, including moral damage, from the date of first publication of particulars of the grant;
- 3) recover the owner the amount of profits derived from the unauthorized use of the protected industrial property subject matter, in lieu of compensation for damage sustained from the date of first publication of particulars of the grant of the title of protection;

4) the infringer pays the owner compensation in an amount from 10000 to 50000 thousand the monthly calculated index provided for by the legislation. The amount of compensation shall be determined by court in lieu of compensation for damages sustained or payment of the derived profits;

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

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

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

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

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

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

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

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

3. The application and information on the progress of its consideration shall not be provided to third parties, except as provided for by the laws of the Republic of Kazakhstan.

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

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

2. The invention application shall contain the following:

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

- 2) the description, disclosing the invention in sufficient detail for it to be carried out by a specialist in the field;
- 3) the claims, stating the essential features of the industrial property subject matter. The claims shall be clear and adequate, and shall be fully supported by the description;
- 4) the drawings and other materials, where indispensable for the understanding of the disclosure;
- 5) the abstract;
- 6) a power of attorney, in case of applying through a representative;

The application for an invention shall be accompanied by documents proving:

- 1) payment of filing fees, including formal examination fees;
- 2) grounds for fee reduction.

If the payment is made accordingly, this period shall be extended by two months. If the proof-of-payment documents are not submitted by the deadline, the application shall be deemed not to have been filed.

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

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

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

2. The utility model application shall contain:

- 1) the request for the grant of a patent, indicating the names of the author (or authors) of the utility model and the person (or persons) in whose name the grant of a patent is sought, and the addresses of their residences or places of business;
- 2) the description, disclosing the claimed utility model in sufficient detail for it to be made;

- 3) the claims, stating the essential features of the utility model and fully supported by the description;
- 4) the drawings;
- 5) the abstract;
- 6) a power of attorney if the application is filed via a representative.

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

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

3. The filing date of a utility model application shall be determined by the date of receipt by the expert agency of the application for the grant of a patent for a utility model, stating the name and forename (and the middle name if any) or the official name of the applicant, the description, the claims and drawings, and where the specified elements have not been submitted simultaneously, the filing date shall be determined by the date of receipt of the last element.

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

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

2. The industrial design application shall contain:

- 1) the request for the grant of a patent, indicating the names of the authors of the industrial design and the persons in favor of whom the grant of a patent is sought, and the addresses of their residences or places of business;
- 2) a set of images of the appearance of the product suitable for reproduction, giving a complete detailed picture of the essential features of the industrial design;
- 4) description of the industrial design;

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

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

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

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

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

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

2. Priority may be determined by the filing date of the first application in any state party to the Paris Convention, and with any international or regional organization specified in the Paris Convention (hereinafter referred to as "Convention priority") if the invention application or the utility model application has been filed with the expert agency within 12 months, and in the case of the industrial design application . within six months from the said date. If, for reasons beyond the control of the applicant, an application seeking Convention priority failed to be filed within the prescribed period, such period may be extended for not more than two months.

The applicant wishing to make use of Convention priority shall make a declaration to that effect to be submitted to the expert agency when filing the application or within two months following the date

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

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

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

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

5. Priority of the industrial property subject matter under a divisional application shall be determined by the date of the filing by the same applicant with the expert agency of the initial application, disclosing the said industrial property subject matter, and in the presence of the right to get earlier priority under the initial application - for the priority date, given that the divisional application was filed before a final decision refusing the grant under the initial application has been taken and cannot be further contested, or where a decision to grant has been taken by

the expert agency in respect of the initial application, before the date of registration of the industrial property subject matter in the State register of the Republic of Kazakhstan.

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

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

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

1. An applicant shall have the right to make amendments or clarifications in the application documents without changing the essence of the claimed industrial property subject matter, as well as changes concerning the marking of the applicant when transfer a right for grant of title of protection title, by filing a petition in the expert organization prior to the decision to that effect. The applicant shall not be charged a fee for making the said changes within two months from the date of receipt of the application.

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

**Article 22. Examination of invention applications**

1. Upon receipt of application the expert agency shall verify the presence of the required documents provided for in subparagraphs 1), 2) and 4) of the first part of paragraph 2 of article 17 of this Law, and the compliance with the prescribed conditions thereto and shall determine the filing date of the application. If the application does not meet the requirements provided for in subparagraphs 1), 2) and 4) of the first part of paragraph 2 of article 17 of this Law, and the conditions prescribed thereto, the



expert agency shall notify the applicant of the said fact and shall suggest that the missing and (or) corrected documents (data) be submitted within three months from the date of sending such notification. If the applicant fails to provide requested and (or) corrected documents(data) within the prescribed time limit the application shall be deemed to have not been filed, of which the applicant shall be notified thereafter.

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

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

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

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

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

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

4. If the application does not comply with the unity of invention requirement, the applicant shall be invited to state, within three months following the date of notification of non-compliance with the requirement, which of the solutions should be examined and to

correct, if necessary, the elements of the initial application accordingly. Other solutions contained in the initial application may be submitted as divisional applications.

Priority of the divisional applications shall be determined in accordance with paragraph 5 of article 20 of this Law.

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

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

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

The substantive examination shall be conducted under condition that the expert agency receives proof of payment of the prescribed fee for the substantive examination within three months from the date of sending the notification of the results of the formal examination. An examination that has not been paid shall be deemed revoked.

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

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

the date when the expert agency sent the request.

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

9. If, as a result of thorough examination of the application, the examining authority confirms that the proposed invention meets the patentability conditions outlined in Article 6 of this Law in the scope of legal protection sought by the applicant, a decision shall be made to grant a patent for the invention. Within three months of the date of receipt of the notification of the decision to grant the patent from the expert organization, the applicant shall submit a document proving payment for the patent preparation and publication. In case of failure to submit the said document, the deadline for payment may be rescheduled within three months, provided that the document of payment for the restoration of the missed period is submitted. Otherwise, the application shall be deemed withdrawn, the proceedings on the application shall be terminated, and the applicant shall be notified accordingly within one month of the date of expiration of the recovery period.

10. If the proposed invention is confirmed to fail to meet the patentability conditions outlined in Article 6 of this Law in the scope of legal protection sought by the applicant, a decision shall be made to refuse to grant a patent for the invention.

A decision to refuse to grant a patent shall be made in the following cases:

1) where the application relates to the solution for which no legal protection is granted;

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

The applicant shall be able to file an appeal with the authorized

body against the decision of the expert organization to refuse the patent, within three months of the date of sending the decision. The appeal shall be considered by the Board of Appeal within four months of the date of its receipt.

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

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

13. If the applicant fails to respect the time limits provided for in paragraphs 3), 4), 7), 8) and 10) of this article, the expert agency may restore the time provided that the applicant submits a document containing proof of payment of the prescribed fee. The request for restoration of the time may be filed by the applicant no later than 12 months after the expiration of time limit in question. The applicant shall file the said request with the expert agency simultaneously as he submits the documents requested by the examiner, payment documents or lodges an appeal with the board of appeal.

The timing of the response to the request or submission of additional materials provided by paragraphs 3 and 8 of this article may be extended at the request of the applicant, submitted prior to the deadline, for a term not exceeding six months from the date of expiration of the prescribed period subject to payment, and filing of objection in accordance with paragraph 10 of this article, for a period not exceeding three months from the date of the deadline.

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

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

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

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

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

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

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

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

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

2. During the examination of the utility model application, the provisions contained in paragraphs 2, 3, 4 and 13 of Article 22 of this Law shall be applied accordingly.

If, as a result of the examination, the application is confirmed to

be related to subject matters protected as utility models, and the documents meet the prescribed requirements, the expert organization shall make a decision to grant a patent for a utility model. Within three months of the date on which the expert organization sends a notification of its decision to grant the patent to the applicant, the applicant shall submit a document proving payment for the patent preparation and publication. In case of failure to submit the said document, the deadline for payment may be rescheduled within three months, provided that the document of payment for the restoration of the missed period is submitted. Otherwise, the application shall be deemed withdrawn, the proceedings on the application shall be terminated, and the applicant shall be notified accordingly within one month of the date of expiration of the recovery period.

3. If, as a result of the examination, the application is confirmed not to be related to subject matters protected as utility models, a decision shall be made to refuse to grant a patent for a utility model. A decision to refuse to grant a patent shall also be made if the applicant does not amend the utility model claims after being notified that their proposed claims contain features that were absent in the original application materials, or, in addition to a subject matter protected as a utility model, also characterizes a proposal that is unrelated to a subject matter protected as a utility model, or for which no examination has been conducted due to its violation of the requirement of unity of the utility model. The applicant shall have the right to file an objection to the decision to refuse to grant a patent to the expert organization to the authorized body within three months from the date of sending it. The appeal shall be examined within two months following the date of its receipt by the board of appeal.

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

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

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

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

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

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

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

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

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

2-1. On the application filed in violation of the requirement of unity of industrial design, the applicant is invited, within a period of three months from the date of notification to him to announce which industrial design shall be subject to review and, if necessary, to clarify the application documents. Other industrial designs included in the initial application materials can be

allocated to divisional applications. The priority of the divided applications will be installed in accordance with paragraph 5 of article 20 of this Law.

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

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

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

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

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

The additional materials in the part that changes the essence of the industrial design shall be subject to the procedure established by paragraph 1 of this article. In the event that the applicant does not submit the requested materials or a request for an extension of the deadline within the prescribed period, the application is considered withdrawn. This period may be extended, subject to appropriate payment, but not more than three months.



5. If, as a result of the substantive examination of the application, the expert organization establishes that the claimed proposal in the scope of legal protection requested by the applicant meets the conditions for patentability of an industrial design specified in Article 8 of this Law, a decision shall be issued to grant a patent indicating the established priority.

Within three months from the date of sending the decision to grant a patent to the applicant, the applicant shall submit to the expert organization a document confirming the appropriate payment for the preparation for the grant of a patent and publication. If the specified document is not submitted, the payment period may be restored within three months, subject to the submission of a document on payment for the restoration of the missed deadline. Otherwise, the application is considered withdrawn, the proceedings on the application are terminated, and the applicant shall be notified within one month from the date of expiration of the restoration period.

6. If it is established that the claimed industrial design does not comply with the conditions for the patentability of the industrial design in the scope of legal protection requested by the applicant, a decision shall be made to refuse to grant a patent for an industrial design.

The decision to refuse to grant a patent shall also be made if the application relates to subject matter that is not protected as industrial designs or in respect of which the examination was not carried out in connection with the violation of the requirement of the unity of the industrial design.

The applicant shall have the right to file an objection to the decision to refuse to grant a patent to the expert organization to the authorized body within three months from the date of its sending. The objection must be considered by the Board of Appeal within two months from the date of its receipt.

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

8. If the applicant fails to respect the time limits provided for in

paragraphs 2), 3) and 4) of this article, the expert agency may restore time, subject to payment of restored time.

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

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

1. The expert organization shall carry out registration in the relevant state registers:

1) the register of issuance of protection documents and open or compulsory licenses;

2) the register of transfer of the exclusive rights to industrial property subject matters;

3) the register of grants of the rights to use industrial property subject matters;

4) the register of termination or invalidation of issued patents.

The relevant state registers shall be listed on the Internet site of the expert organization.

2. Information on registration shall be published weekly in the Bulletin.

3. A patent shall be only granted to the applicant as a single copy, regardless of the number of authors named in the patent application. An author's certificate shall be issued to the applicant for each author of the industrial property subject matter whose name is indicated in the patent application.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

1. A title of protection at any time during its period of validity may be, on the basis of the notice of opposition, contested and annulled

either entirely or in part in the following cases:

- 1) the protected industrial property subject matter does not comply with the conditions of patentability provided for by this Law;
- 2) the claims of the protected invention or utility model or the sum of essential features of the industrial design include elements that did not figure in the application when filed;
- 3) the grant of the title of protection was effected contrary to the provisions of Article 37 of this Law;
- 4) the author (or authors) or the patent owner is indicated incorrectly in the title of protection.

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

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

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

Licensing contracts concluded on the basis of a patent subsequently recognized invalid, save the action, in so far as they were performed at the time of the judgement on invalidity of the patent. Invalidation means cancellation of the decision for the grant of a patent for invention, utility model or industrial design and the cancellation of an entry in the appropriate state register.

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

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

industrial property subject matter, the title of protection shall be invalidated only in respect of that industrial property subject matter cited in the application;

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

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

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

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

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

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

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

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

1. The Board of Appeal is a collegial body under the authorized body for pre-trial consideration of applicants' appeals.

2. Appeals against decisions of the expert organization to refuse to grant patents for industrial property subject matters can be filed with the Board of Appeal. Pre-trial consideration of those appeals shall be mandatory.

3. The Board of Appeal shall include an odd number of members (at least five), including representatives of the authorized bodies in the field of protection of inventions, utility models, and industrial designs, representatives of the authorized bodies in the fields of science, state support of industrial and innovation activities, and healthcare, as well as representatives of public councils from the said authorized bodies.

4. The Board of Appeal shall not include:

- 1) patent attorneys;
- 2) spouses, close relatives, or relatives through marriage;
- 3) the expert organization staff.

5. Any member of the Board of Appeal can be replaced in the event of:

- 1) self-recusal or recusal by the Board of Appeal meeting participants based on paragraph 4 of this article;
- 2) absence due to temporary disability, vacation, or business trip.

6. Each meeting of the Board of Appeal shall be video recorded in the manner determined by the authorized body.

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

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

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

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

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

4) the applicant fails, within the prescribed time limits, to rectify the deficiencies relating to the requirements of filing the notice of opposition as for the design, content and the procedure. At the presence of these circumstances the contestant shall be sent a notification that the notice of opposition cannot be taken into consideration and shall be deemed to have not been filed. The contestant or his representative may withdraw the notice of opposition before the collegium of experts of the Board of appeal takes a decision.

#### **Article 32-2. Appeal Consideration**

1. The Board of Appeal shall carry out consideration of appeals in the manner determined by the authorized body and within the time frame specified by this Law.
2. In the event of missing the appeal filing deadline, the Board of Appeal may still accept an appeal for consideration if the reasons for missing the deadline are deemed valid based on the submitted documents.
3. The time period for consideration of the appeal can be extended up to three months at the written request of the applicant.
4. The Board of Appeal can postpone the date of the meeting in the event of:
  - 1) failure of the appellant to appear at the meeting, unless they have requested that their appeal be considered without their participation;
  - 2) the appellant's request for time to present additional evidence.
5. The Board of Appeal shall make one of the following decisions:
  - 1) a decision to sustain the appeal;
  - 2) a decision to partially satisfy the appeal;
  - 3) a decision to refuse to consider the appeal;
  - 4) a decision to refuse to sustain the appeal.The Board of Appeal shall not have the right to change the subject

matter or basis of an appeal on its own initiative.

6. All the Board of Appeal members shall have equal rights when considering an appeal. The Board of Appeal shall make its decision by a majority vote of all its members.

7. The decision made shall be sent to the appellant within 10 days of the date of the decision.

8. The Board of Appeal may leave an appeal without consideration, at the request of the appellant. The decision to leave an appeal without consideration shall be recorded by means of the Board of Appeal meeting minutes.

9. The decision made can be appealed in court.

**Article 32-3. Correction of misspellings and obvious technical errors in the decision of the Board of Appeal**

1. After announcing a decision on an appeal, the Board of Appeal, which made the decision, shall not have the right to overturn or alter it.

2. The Board of Appeal can correct any misspellings or technical errors in its decision, whether on its own initiative or upon request from persons involved in the appeal.

Matters regarding corrections shall be resolved at the Board of Appeal meeting. The persons involved in the appeal shall be notified of the time and place of the Board of Appeal meeting, but their failure to appear at the meeting shall not be an obstacle to considering the issue of making corrections.

3. Corrections to the decisions of the Board of Appeal shall be documented by means of an additional decision of the Board of Appeal.

**Article 32-4. Leaving an appeal without consideration**

1. The Board of Appeal can leave an appeal without consideration if:  
1) the appellant has been duly notified of the time and place of the Board of Appeal meeting, and has not requested that their appeal be considered without their participation, and fails to appear at the meeting after receiving a second summons;



2) the appellant has filed a request for their appeal to be withdrawn.

2. The decision to leave an appeal without consideration shall be recorded in the Board of Appeal meeting minutes.

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

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

- 1) the authorship of an industrial property subject matter;
- 2) the legality of the grant of a title of protection;
- 2-1) on invalidation of the patent;
- 3) the identification of the patent owner;
- 4) the grant of a compulsory license;
- 5) infringement of the exclusive right to use the industrial property subject matter and of other economic rights of the patent owner;
- 6) the conclusion and execution of license contracts of the protected industrial property subject matter;
- 7) the right over the prior use and post-grant use;
- 8) the remuneration to be paid to the author by the employer under paragraph 4 of article 10 of this Law;
- 9) the payment of compensation provided for in this Law;
- 10) other disputes relating to the protection of rights arising from a protection document. The parties may agree to try to resolve the said disputes, except for those specified in subparagraphs 1), 2), 3), 4), 7), and 10) of the first part of this paragraph, using arbitration or mediation, if not prohibited by the Law of the Republic of Kazakhstan "On Arbitration" and the Law of the Republic of Kazakhstan "On Mediation".

1-1. Claims against the decisions of the expert organization specified in paragraph 2 of Article 32 of this Law shall be filed in court after the relevant appeals have been considered by the Board of Appeal.

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

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

Appropriation of authorship, coercion to co-authorship, disclosure

without the consent of the author or applicant of the essence of the industrial property subject matter prior to the publication of information about it, illegal use of the protected industrial property subject matter, violation of the procedure for patenting the industrial subject matter property in foreign countries entail liability in accordance with the laws of the Republic of Kazakhstan.

## **Chapter 8. Final provisions**

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

The authorized body shall charge a state duty in accordance with the Code of the Republic of Kazakhstan "On Taxes and Other Obligatory Payments to the Budget" (Tax Code) for certifying and registering patent attorneys.

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

1. A person who is a legal citizen of the Republic of Kazakhstan, lives there permanently, holds a higher education degree, and has at least four years of work experience shall have the right to become a patent attorney if they are certified and registered in the Register of Patent Attorneys.

To be registered in the Register of Patent Attorneys, the candidate shall pass the certification process and obtain a patent attorney certificate as proof of their qualification.

The certification process for patent attorney candidates shall be conducted in the form of testing their knowledge of the laws of the Republic of Kazakhstan governing the protection of intellectual property subject matter.

The procedures for the certification process for patent attorney candidates, registration in the Register of Patent Attorneys, and making changes to the said Register shall be determined by the authorized body.

The Register of Patent Attorneys shall be published on the Internet site of the authorized body.

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

- 1) who, under the laws of the Republic of Kazakhstan, are prohibited to be engaged in business activities;
- 2) who are employees of the authorized body and its lower organizations, as well as their close relatives, spouse (wife);
- 3) whose criminal conviction of criminal offence has not been removed or expunged from official records in accordance with the law;
- 4) who, under this Law, has been excluded from the register of patent attorneys.

3. The activities of the patent attorneys shall be suspended by the

protocol decision of the attestation commission:

- 1) where the patent attorney files the request with the attestation commission;
- 2) for a period when the persons have been classified as those who, under the laws of the Republic of Kazakhstan, are prohibited to be engaged in business activities, and are the employees of the authorized body and its lower organizations;
- 3) in order to clarify the circumstances provided for in subparagraphs 2) and 6) of paragraph 1 and in paragraph 5 of article 36-2 of this Law.

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

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

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

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

Individuals having their permanent residence in the Republic of Kazakhstan, but temporarily residing outside its territory may act on their own in exercising their rights of the applicant, patent owner and the interested person in the authorized body and its lower organizations, provided that they indicate the correspondence address within the territory of the Republic of Kazakhstan.

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

met.

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

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

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

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

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

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

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

3. Where the patent attorney provides to the authorized body or the expert agency, the copy of the power of attorney authorizing the patent attorney to conduct affairs related to the submission of the invention application, application for utility model and industrial design application, and (or) the related to the receipt of the title of protection, as well as filing the notice of opposition before the Board of appeal.

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

4. The patent attorney shall be obliged to deny the instruction

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

**Article 36-2. Revocation of a certificate of patent attorney and withdrawal of information from the Register of Patent Attorneys**

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

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

2. A certificate of patent attorney shall be declared invalid based on the decision of the Attestation Commission, or an effective court decision, and the relevant information about the invalidation shall be entered into the Register of Patent Attorneys.

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

5. If an individual or legal entity files a complaint against the actions of a patent attorney, the authorized body shall establish an Appeals Commission consisting of an odd number of the authorized body employees.

During the consideration of the complaint by the Appeals Commission,

the validity of the certificate of the patent attorney shall be suspended, and a note thereof shall be made in the Register of Patent Attorneys.

Based on the results of the review of the complaint, the Appeals Commission shall make one of the following decisions:

- 1) to recommend that the authorized body send to the court a statement of claim for termination of the certificate of the patent attorney;
- 2) to dismiss the complaint.

The decision of the Appeals Commission shall be made by a simple majority vote, and shall be documented in the meeting minutes. The decision of the Appeals Commission can be appealed in court.

**Article 37. International registration of industrial property subject matters**

The international registration of industrial property subject matters shall be conducted by applying to the expert organization. Rules for consideration of applications shall be approved by the authorized body in accordance with the international treaties ratified by the Republic of Kazakhstan.

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

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

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