



On approval of the Rules for reviewing objections by the Appeals Board

Unofficial translation

Order of the Minister of Justice of the Republic of Kazakhstan of August 28, 2018 № 1317. Registered with the Ministry of Justice of the Republic of Kazakhstan on August 29, 2018 № 17324.

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Under paragraph 2 of Article 3-1 of the Law of the Republic of Kazakhstan “On Protection of Selection Achievements”, paragraph 2 of Article 4 of the Law of the Republic of Kazakhstan “Patent Law of the Republic of Kazakhstan”, sub-paragraph 2) of paragraph 2 of Article 3 of the Law of the Republic of Kazakhstan “On Trademarks, Service Marks, Geographical Indications and Appellations of Origin of Goods” and sub-paragraph 2) of Article 4 of the Law of the Republic of Kazakhstan “On Legal Protection of Topologies of Integrated Circuits”, **I HEREBY ORDER:**

Footnote. The preamble - as reworded by order of the Minister of Justice of the Republic of Kazakhstan No. 736 dated 31.08.2022 (shall be put into effect upon expiry of ten calendar days after the day of its first official publication).

1. To approve the attached Rules for reviewing objections by the Appeals Board.
2. The Department of Intellectual Property Rights in accordance with the procedure established by the legislation shall ensure:
 - 1) state registration of this order;
 - 2) within ten calendar days from the date of state registration of this order with the Ministry of Justice of the Republic of Kazakhstan, the direction hereof in Kazakh and Russian languages to the Republican State Enterprise on the Right of Economic Management "Republican Center of Legal Information of the Ministry of Justice of the Republic of Kazakhstan" for official publication and placement in the Reference Control Bank of the Regulatory Legal Acts of the Republic of Kazakhstan;
 - 3) placing this order on the Internet resource of the Ministry of Justice of the Republic of Kazakhstan.
3. Control over the execution of this order shall be entrusted to the supervising Vice-Minister of Justice of the Republic of Kazakhstan.
4. This order shall be put into effect upon expiry of ten calendar days after the day of its first official publication.

Minister

M. Beketayev

Approved
by the order №1317 of the
Minister of Justice of the

Rules for reviewing objections by the Appeals Board Chapter 1. General provisions

1. The Rules for Reviewing of Objections by the Appeals Board (hereinafter referred to as the Rules) have been developed under the Law of the Republic of Kazakhstan “On Protection of Selection Achievements” (hereinafter referred to as the Law on Selection Achievements), the Law of the Republic of Kazakhstan “Patent Law of the Republic of Kazakhstan” (hereinafter referred to as the Patent Law), the Law of the Republic of Kazakhstan “On Trademarks, Service Marks, Geographical Indications and Appellations of Origin of Goods” (hereinafter - the Law on Trademarks), the Law of the Republic of Kazakhstan “On Legal Protection of Topographies of Integrated Circuits” (hereinafter - the Law on Integrated Circuits) and determine the procedure for consideration of objections by the Appeals Board.

Footnote. Paragraph 1 - as reworded by order of the Minister of Justice of the Republic of Kazakhstan No. 736 dated 31.08.2022 (shall be put into effect upon expiry of ten calendar days after the day of its first official publication).

2. The following terms and concepts are used herein:

1) the Appeals Board - a collegial body under the Ministry of Justice of the Republic of Kazakhstan;

2) protection documents - documents (patents for inventions, industrial designs, utility models, patents for selection achievements, certificates for trademarks, service marks, appellations of origin of goods) issued under the laws of the Republic of Kazakhstan in the field of intellectual property;

3) Madrid Agreement - Madrid Agreement Concerning the International Registration of Marks of April 14, 1891;

4) the Protocol to the Madrid Agreement - Protocol to the Madrid Agreement Concerning the International Registration of Marks of June 28, 1989;

5) industrial property objects - inventions, utility models, industrial designs, trademarks and service marks, appellations of origin of goods, selection achievements;

6) an applicant is a person who has filed an objection with the Appeals Board;

7) a patent attorney - a capable national of the Republic of Kazakhstan, permanently residing on its territory, having higher education, experience in the field of protection and defence of intellectual property rights for at least four years or having passed an internship in the Chamber of Patent Attorneys for at least one year, certified and entered in the Register of Patent Attorneys.

8) an expert organisation - an organisation established by the decision of the Government of the Republic of Kazakhstan, approved by Decree of the Government of the Republic of Kazakhstan No. 756 of July 11, 2002 “On the Establishment of the National Institute of Intellectual Property Republican State Enterprise of the Committee for Intellectual Property

Rights of the Ministry of Justice of the Republic of Kazakhstan”, in the legal form of a republican state enterprise on the right of economic management, subordinated in its activities to the competent authority;

9) parties - natural and (or) legal persons participating in the review of objections by the Appeals Board;

10) an authorised body - the Ministry of Justice of the Republic of Kazakhstan.

Footnote. Paragraph 2 - as reworded by order of the Minister of Justice of the Republic of Kazakhstan No. 736 dated 31.08.2022 (shall take effect ten calendar days after the date of its first official publication).

Chapter 2. Procedure for reviewing objections by the Appeals Board Paragraph 1. Submission of objections

3. The following objections shall be filed with the Appeals Board:

1) against decisions of the expert organisation on refusal to register a trademark, including refusal to grant legal protection to a trademark applied for under paragraphs 1 and 2 of Article 5 of the Protocol to the Madrid Agreement;

2) against decisions of the expert organisation on refusal to register and (or) grant the right to use the geographical indication and appellation of origin of goods;

3) against the registration of a trade mark, including under paragraph 6 of Article 5 of the Protocol to the Madrid Agreement;

4) against registration and (or) granting the right to use a geographical indication and appellation of origin of goods;

5) against decisions of the expert organisation on refusal to grant a patent for an invention ;

6) against decisions of the expert organisation on refusal to consider the application for granting a patent for a breeding achievement;

7) against decisions of an expert organisation to refuse to grant a patent for a breeding achievement;

8) against decisions of the expert organisation on refusal to grant a utility model patent;

9) against decisions of the expert organisation to refuse to grant a patent for an industrial prototype.

Footnote. Paragraph 3 - as reworded by order of the Minister of Justice of the Republic of Kazakhstan No. 736 dated 31.08.2022 (shall be effective ten calendar days after the date of its first official publication).

4. The registration of a trademark may be disputed and recognized as invalid fully or partially during the whole period of validity, if it has been carried out in violation of requirements, established by articles 6 and 7, except for the cases of sub-items 1), 2) and 3) item 1 of article 7, of the Law on trademarks, or within five years from the date of registration of a trademark, if it has been carried out in violation of requirements established by sub-items

1), 2) and 3) item 1 of article 7 of the Law on trademarks. The objection against registration of a trademark under the reason, specified in this item shall be submitted to the Appeals Board by any concerned person.

The registration of a trademark may be disputed and recognized as invalid fully or partially during the whole period of validity if it has been carried out in the name of the representative of the one, who is the owner of identical or confusingly similar to a trademark in one of the member countries of the Paris Convention for the Protection of Industrial Property, without authorization of the latter. Objection against registration of a trademark under the reason, specified in this item shall be submitted by the owner (copyright holder) of a trademark, registered in one of the member countries of the Paris Convention for the Protection of Industrial Property.

5. The registration of a trademark shall be disputed and recognized as invalid fully or partially if a trademark is identical or confusingly similar in respect of uniform goods or services with the company name of another person, exclusive right to which in the Republic of Kazakhstan has arisen earlier the date of the priority of a trademark.

Objection against registration of a trademark under the reason specified in this item shall be submitted to the Appeals Board by a legal entity, which company name is identical or confusingly similar to the trademark, registered in respect of the uniform goods or services.

6. A patent attorney as a representative of an applicant or a patentee shall engage in activities related to the conduct of business with an authorised body and an expert organisation on the issues of legal protection of intellectual property objects. The applicant and (or) the patentee may also conduct business with the authorised body and expert organisation independently.

Natural persons residing outside the Republic of Kazakhstan or foreign legal entities shall exercise their rights of an applicant, owner of a trademark, service mark and the right to use a geographical indication and appellation of origin of goods, as well as the rights of an interested party before the Authorised Body and its organisations through patent attorneys.

Natural persons permanently residing in the Republic of Kazakhstan but temporarily located outside the Republic of Kazakhstan shall exercise their rights of an applicant, owner of a trade mark, service mark and the right to use a geographical indication and appellation of origin of goods, as well as the rights of an interested party without a patent attorney when specifying an address for correspondence within the Republic of Kazakhstan.

Footnote. Paragraph 6 - as reworded by order of the Minister of Justice of the Republic of Kazakhstan No. 736 dated 31.08.2022 (shall be enforced upon expiry of ten calendar days after the day of its first official publication).

7. The objection shall be submitted to the Appeals Board in an arbitrary written form in Kazakh and Russian languages via the office of the authorized body. The materials attached to the objection shall be submitted in Kazakh and Russian languages.

8. The objection shall indicate the surname, name, patronymic (if any) of an individual and the name of a legal entity, submitted the objection, place of residence or place of location, a contact phone, e-mail, as well as an address for correspondence.

9. The submitted objection shall be attached with:

1) materials, to which the reference have been given in the text of the objection;

2) a power of attorney, in the event of submission of an objection through a patent attorney or other representative. The power of attorney shall be submitted in Kazakh and Russian languages, if the power of attorney is submitted in a foreign language, then its notarized translation in Kazakh and Russian shall be submitted. In the event of submission of a copy of a power of attorney, the applicant shall provide an original copy of a power of attorney when appearing at the Appeals Board (after confirmation of the authenticity, the original copy of a power of attorney shall be subject to the return);

3) a copy of objection attached with documents for the owner (right holder).

10. The objection shall be signed by a person, submitting the objection. On behalf of a legal entity, the objection shall be signed by the head of the organization or by an authorized person specifying the position.

When submitting the objection through a patent attorney or other representative, the objection shall be signed by a patent attorney or other representative correspondingly.

Paragraph 2. Registration and acceptance of objections

11. The submitted objection shall be registered and shall be assigned with a registration number. Within ten working days from the date of receipt of the objection, verification of compliance with the specified requirements of the Patent law, Law on Trademarks, Law on Selection Achievements, Law on integrated circuit topologies and by these Rules to execution, content and procedure of submission of an objection.

In the event of the lack of necessary materials, a notice about refusal of acceptance of the objection for reviewing shall be sent to the address of the person, submitted the objection.

In case of repeated submission after elimination of the circumstances, served as the grounds for the return, the objection of the concerned person shall be reviewed according to the standard procedure.

12. The acceptance of the objection for reviewing shall be refused if:

1) the objection is not subject to reviewing in the Appeals Board;

2) the objection is not signed, or it is signed by a person, not authorized for signing thereof;

3) the objection has been submitted in violation of the established period and the opportunity of extending and resetting of a specified period of time is forfeited;

4) the applicant within the established period of time has not eliminated the deficiencies, regarding the requirements to execution, content and procedure of submission of the objection

In the presence of these circumstances, the person, submitted the objection, shall be sent a notice that the received objection may not be accepted for reviewing and it is reviewed as not submitted.

13. The owner of the protection document, after acceptance of the objection for reviewing, stipulated by sub-items 3) and 4) of item 3 of these Rules, shall be sent a notice about receipt of an objection attached with a copy of an objection and materials of objection for submission of his applications to them based on challenging the protection document.

The applications on challenging shall be submitted to the Appeals Board five working days prior to the planned date of the meeting of the panel of the Appeals Board.

The owner of the trademark, registered in accordance with the Madrid Agreement, shall be sent the mentioned notice immediately to his address, if before the owner has not ordered the conducting affairs associated with the registration of this trademark to a patent attorney of the Republic of Kazakhstan. At the same time, the notice shall inform that the presentation of a comment to the objection as well as participation in reviewing an objection in the Appeals Board shall be carried out through a patent attorney of the Republic of Kazakhstan.

14. A person submitted the objection or his representative may call back the submitted objection before announcement of the decision of the panel of the Appeals Board.

Paragraph 3. Period of reviewing objections

15. The objections specified under sub-paragraphs 1) and 2) of paragraph 3 hereof shall be considered by the Appeals Board within four months from the date of their receipt.

The objections specified in sub-paragraphs 3) and 4) of paragraph 3 hereof shall be considered by the Appeals Board within six months from the date of their receipt.

Objections mentioned in subparagraph 5) of paragraph 3 hereof shall be considered by the Appeals Board within four months from the date of receipt thereof.

Objections referred to in sub-paragraph 6) of paragraph 3 hereof shall be considered by the Appeals Board within three months from the date of receipt thereof.

Objections as specified in sub-paragraph 7) of paragraph 3 hereof shall be reviewed by the Appeals Board within three months from the date of their receipt;

The objections listed in sub-paragraphs 8) and 9) of paragraph 3 hereof shall be considered by the Appeals Board within two months from the date of their receipt.

Footnote. Paragraph 15 - as reworded by order of the Minister of Justice of the Republic of Kazakhstan No. 736 dated 31.08.2022 (shall have effect ten calendar days after the date of its first official publication).

16. When omission of the time limit for submission of the objection, the Appeals Board shall accept it for reviewing in the event of recognition of the reasons for omission of the time limit or of the term as valid on the basis of the provided documents.

17. Pursuant to paragraph 3 of Article 22-3 of the Law on Selection Achievements, paragraph 3 of Article 32-2 of the Law on Patents and paragraph 3 of Article 41-2 of the Law

on Trademarks, the term for examination of an opposition shall be extended up to three months, including at the written request of the applicant.

Appeals Board meetings shall be held in face-to-face (or) and distance format.

Footnote. Paragraph 17 - as reworded by order of the Minister of Justice of the Republic of Kazakhstan No. 736 dated 31.08.2022 (shall become effective ten calendar days after the date of its first official publication).

Paragraph 4. Reviewing an objection at the meeting of the Appeals Board

18. The applicant, the owner (right holder) and the representative of the expert organization who has examined the relevant industrial property object shall participate in the reviewing the objection.

The applicant, the owner (right holder) may participate in the reviewing personally as well as through their representative, subject to provisions of item 6 of these Rules. The powers of the representative shall be confirmed by a power of attorney.

Employees of the authorized body and expert organization may not be representatives of these persons.

19. The Appeals Board shall postpone the date of a meeting in cases of:

- 1) the failure of the parties to appear, with the exception of their request to consider the objection without his or her participation;
- 2) the applicant's petition for time to submit additional evidence.

Footnote. Paragraph 19 - as reworded by order of the Minister of Justice of the Republic of Kazakhstan No. 736 dated 31.08.2022 (shall take effect ten calendar days after the date of its first official publication).

20. Reviewing the objection on the merits shall start with the presiding officer.

Further reviewing the case shall be conducted in the following sequence:

- 1) the speech of the secretary about reviewing the objection;
- 2) the speech of a person, submitted the objection, and (or) his representative;
- 3) the speech of the owner of the protection document (registration of a trademark) and (or) his representative;
- 4) the speech of the representative of the expert organization;
- 5) answers of the parties to the questions of the members of the Appeals Board.

21. Persons, participating in reviewing the objection shall:

- 1) familiarize with materials of the case, make extracts from them, order them and receive their copies;
- 2) present evidence;
- 3) participate in investigation the evidence;
- 4) ask questions to participants of the Appeals Board;
- 5) present motions;
- 6) provide oral and written explanations to the members of the panel;

7) provide their arguments and reasons on all issues arising during reviewing the objection;

8) provide objections against motions, arguments and reasons of other persons, participating in the case.

22. Persons, participating in the case shall voluntarily exercise all rights belonging to them.

Paragraph 5. Decisions, made by the Appeals Board by the results of reviewing objections

23. The Appeals Board shall issue one of the following decisions:

- 1) on satisfaction of the objection;
- 2) on partial satisfaction of the objection;
- 3) on refusal of reviewing the objection;
- 4) on refusal of satisfaction of the objection.

The Appeals Board on its own initiative shall not change the subject matter or the grounds of the objection.

24. All members of the Appeals Board when reviewing the objection shall exercise equal rights. The decision of the Appeals Board shall be adopted by the majority of votes of the total number of its members.

The presiding officer shall declare the operating part of the decision made to persons, participating in the reviewing the objection.

25. The adopted decision shall be sent to the persons who participated in the consideration of the objection within ten business days from the date of its issuance. The decision of the Appeals Board shall be stated in writing and shall consist of an introductory, descriptive, motivational and operative parts.

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

Footnote. Paragraph 25 - as reworded by order of the Minister of Justice of the Republic of Kazakhstan No. 736 dated 31.08.2022 (shall be enforced upon expiry of ten calendar days after the day of its first official publication).

26. The Appeals Board shall abandon the objection without reviewing under the motion of the applicant of the objection. The decision about abandonment of the objection without reviewing shall be executed as a protocol of the Appeals Board.

27. The decision made may be appealed in the court in accordance with the civil legislation of the Republic of Kazakhstan.

28. The Appeals Board shall abandon the objection without reviewing, if:

1) a person, submitted the objection, duly informed about the time and date of the meeting of the Appeals Board, not declared about reviewing the objection in its absence, has not appeared to the meeting of the Appeals Board on the secondary call;

2) There is a motion of a person, submitted the objection on withdrawal of its objection

29. The decision on abandonment of the objection without the reviewing shall be registered in the protocol of the meeting of the Appeals Board.

Chapter 3. Procedure of application of video recording

30. Video recording shall be conducted in the course of every meeting of the Appeals Board, except for impossibility of use by technical reasons.

31. The use of video recording equipment in the course of the meeting of the Appeals Board shall be carried out uninterruptedly. The stop of video recording equipment shall not be reviewed as the break from the time of declaring to the present at the meeting about the break or removal of the parties for making the decision and prior to the time of its declaration.

32. The use of video recording equipment ensuring the recording of the course of the meetings of the Appeals Board shall be carried out by the secretary of the meeting.

33. Before the beginning of the meeting of the Appeals Board, the secretary shall inspect the operability of the video recording equipment, ensuring the fixation of the course of the meeting.

34. In the event of impossibility to use video recording equipment, the secretary shall report this to the chairperson with the reflection of the reasons for non-use of video recording in the protocol. After the end of the meeting of the Appeals Board, the secretary shall inform the Information Technology Officer of the Ministry of Justice about the technical failures of the video recording equipment.

35. Impossibility to use video recording equipment for objective reasons shall not preclude the continuation of the meeting of the Appeals Board.

36. The secretary shall provide the video recording of the meeting by means of video recording equipment, as well as the recording the copy on a tangible (electronic) medium in one copy, which shall be attached to the case files with an indication in the inventory after the protocol.

37. The use of video recording equipment in a meeting shall be indicated in the protocol of the Appeal Board, which shall indicate the name of the file containing the video.

38. Excluded by Order No. 193 of the Minister of Justice of the Republic of Kazakhstan dated 15.04.2019 (shall come into effect ten calendar days after the date of its first official publication).

39. The tangible (electronic) carrier containing the video shall be attached to the case files in a packaged form (envelope) with indication of the protocol number, the date of the Appeals Board meeting, and the signature of the secretary.

40. In the event of impossibility of further recording of the course of the meeting using video recording equipment, the participants of the Appeal Board shall be announced about it.

41. If due to technical problems record keeping using video recording equipment is impossible, or it is revealed that the video of the Appeals Board's meeting has not been actually recorded, an act shall be made.

42. The act shall be signed by the secretary, the chairperson and members of the Appeals Board and shall be attached to the protocol of the Appeals Board.

43. The video recording of a meeting shall not be suspended or corrected except in the case of technical fragmentation of the video recording or change of its format.

Footnote. Paragraph 43 as reworded by Order No. 193 of the Minister of Justice of the Republic of Kazakhstan dated 15.04.2019 (shall be enforced ten calendar days after its first official publication).

44. Excluded by Order No. 193 of the Minister of Justice of Republic of Kazakhstan dated 15.04.2019 (shall be enacted ten calendar days after the date of its first official publication).

45. The safety of a copy of the video of the meeting of the Appeals Board, attached to the case file, shall be ensured by the secretary before the transfer of the file to the archive.

46. When accepting a case, the archivist shall check for a copy of the video recording of the meeting on a material (electronic) medium attached to the case files.

47. Video recordings of meetings of the Board of Appeal shall be kept for at least 1 (one) year.