

On some issues in the field of industrial property

Unofficial translation

Order of the Minister of Justice of the Republic of Kazakhstan of August 29, 2018 No. 1350. Registered with the Ministry of Justice of the Republic of Kazakhstan on October 1, 2018 No. 17455.

Unofficial translation

For the purposes of implementation of the Law of the Republic of Kazakhstan dated June 20, 2018 no.161 "On introducing amendments and addenda to some legislative acts of the Republic of Kazakhstan on the issues of improvement of legislation in the field of intellectual property" **I HEREBY ORDER:**

1. To approve the attached:

1) Rules for consideration of an application for the item of industrial property in accordance with the Agreement on patent cooperation and Eurasian Patent Convention in accordance with Annex 1 to this order;

2) The Rules for consideration of an application for a trademark in accordance with Madrid Agreement Concerning the International Registration of Marks and the Protocol to the Madrid Agreement Concerning the International Registration of Marks, in accordance with Annex 2 to this order;

2. The Department of Intellectual Property Rights of the Ministry of Justice of the Republic of Kazakhstan shall ensure:

1) state registration of this order with the Ministry of Justice of the Republic of Kazakhstan;

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.

Rules

for consideration of an application for an industrial property object in accordance with the Patent Cooperation Treaty and the Eurasian Patent Convention

Footnote. The Rules as amended by the order of the Minister of Justice of the Republic of Kazakhstan dated 20.09.2022 No. 793 (shall be enforced upon expiry of ten calendar days after the date of its first official publication).

Chapter 1. General provisions

1. These Rules for consideration of an application for an industrial property object in accordance with the Patent Cooperation Treaty and the Eurasian Patent Convention (hereinafter referred to as the Rules) developed in accordance with subparagraph 2) of paragraph 2 of Article 4 of the Law of the Republic of Kazakhstan "Patent Law of the Republic of Kazakhstan" (hereinafter referred to as the Law) and shall determine the procedure for consideration of an application for an industrial property object in accordance with the Patent Cooperation Treaty and the Eurasian Patent Convention.

2. The following notions shall be used in these Rules:

1) The World Intellectual Property Organization – an international organization providing and regulating international policies and cooperation of countries in the field of intellectual property (hereinafter referred to as the "WIPO");

2) a Eurasian application – an application, submitted in accordance with the Eurasian Patent Convention dated September 9, 1994 or the Protocol on the Protection of Industrial Designs to the Eurasian Patent Convention of September 9, 1994;

3) an expert organization – an organization established by the decision of the Government of the Republic of Kazakhstan, approved by the Decree of the Government of the Republic of Kazakhstan dated July 11, 2002 No. 756 "On the establishment of the Republican State Enterprise "National Institute of Intellectual Property of the Committee for Intellectual Property Rights of the Ministry of Justice of the Republic of Kazakhstan";

4) an international application is an application filed under the Patent Cooperation Treaty of June 19, 1970 (hereinafter referred to as the PCT).

Chapter 2. Procedure for consideration of an international application

3. The expert organization in accordance with the PCT, Instructions under the PCT, Administrative Instructions under the PCT, the Law, shall perform functions of the receiving authority, associated with receipt, verification and forwarding of an international application.

4. Consideration of an international application in the national phase shall be carried out in accordance with the Rules for Examining Applications for Industrial Property Objects, approved by Order of the Minister of Justice of the Republic of Kazakhstan dated August 29, 2018 No. 1349 (registered in the Register of State Registration of Regulatory Legal Acts No. 17459).

5. In the event of the absence of translation of documents of the application into Kazakh or Russian languages in the submitted materials, if they are submitted in other language, the applicant shall be notified about the need to provide it within two months from the expiration date for entering the national phase. The period of provision of translation shall be extended but not more than two months in accordance with item 2 of article 16 of the Law.

In case of a failure to provide the translation within the specified period, the application shall be considered not entered the national phase, of which the applicant will be notified. Registered materials shall not be returned, the clerical correspondence shall not be restored.

6. The conversion of an international application for an invention into an application for a utility model shall be carried out in accordance with the Rules for the examination of applications for Industrial property objects approved in accordance with sub-item 2) of item 2 of article 4 of the Law.

Chapter 3. Procedure for consideration of a Eurasian application

7. The expert organization being governed by the Eurasian Patent Convention, Patent Instructions to the Eurasian Patent Convention and the Law shall perform the functions, related to verification and forwarding the Eurasian application to the Eurasian authority.

8. The conversion of a Eurasian application into a national patent application and its consideration shall be carried out in accordance with the Eurasian Patent Convention and the Patent Instructions to the Eurasian Patent Convention.

9. The document of payment for processing, checking and forwarding the Eurasian application shall be submitted when the application is filed or within three months from the date of sending the notification of receipt of the Eurasian application to the applicant. If the document of payment for the processing, verification and forwarding of the Eurasian application is not submitted, the application shall be considered not submitted, of which the applicant shall be notified within five working days.

Chapter 4. Procedure for consideration of a Eurasian application for an industrial design

10. The expert organization, being governed by the Protocol on the Protection of Industrial Designs to the Eurasian Patent Convention, the Patent Regulations to the Eurasian Patent Convention (Part II Industrial Designs) and the Law, shall perform the functions related to receiving, verifying and forwarding a Eurasian application for an industrial design to the Eurasian Office.

11. The conversion of a Eurasian application for an industrial design into a national patent application and its consideration shall be carried out in accordance with the Protocol on the Protection of Industrial Designs to the Eurasian Patent Convention, the Patent Instructions to the Eurasian Patent Convention (Part II Industrial Designs)

Annex 2
to the order of the Minister of Justice
of the Republic of Kazakhstan
dated August 29, 2018 No. 1350

Rules

for consideration of a trademark application in accordance with the Protocol to the Madrid Agreement concerning the International Registration of Marks

Footnote. The Rules as amended by the order of the Minister of Justice of the Republic of Kazakhstan dated 20.09.2022 No. 793 (shall be enforced upon expiry of ten calendar days after the date of its first official publication).

Chapter 1. General provisions

1. These Rules for consideration of a trademark application in accordance with the Protocol to the Madrid Agreement concerning the International Registration of Marks (hereinafter referred to as the Rules) have been developed in accordance with sub-item 2) of item 2 of article 3 of the Law of the Republic of Kazakhstan "On Trademarks, Service Marks, Geographical Indications and Appellations of Origin" (hereinafter referred to as the Law) shall determine the procedure for consideration of a trademark application in accordance with the Protocol to the Madrid Agreement concerning the International Registration of Marks.

The following notions shall be used in these Rules:

1) The International Bureau of the World Intellectual Property Organization - an international organization that ensures and regulates international policy and cooperation of countries in the field of intellectual property (hereinafter referred to as the International Bureau);

2) Expert organization - an organization created by decision of the Government of the Republic of Kazakhstan in the organizational-legal form of the Republican State Enterprise on the Right of Economic Management subordinated in its activities to the authorized body;

3) International Classification of Goods and Services (hereinafter referred to as the ICGS) –, classification of goods and services used for registration of trademarks, adopted in the framework of the Nice Agreement of June 15, 1957 with subsequent amendments and additions;

4) International Register – Register of international trademark applications and international registrations of marks of the International Bureau.

Chapter 2. Procedure for submission of an application for international registration of a mark

2. The expert organization, being governed by the Madrid Agreement Concerning the International Registration of Marks and the Protocol to the Madrid Agreement Concerning the International Registration of Marks, shall perform the functions of the Office of Origin.

3. The international application shall be attached with:

A request for verification and forwarding of the international application;

a request for registration and forwarding, or verification and forwarding of the application, of the international application, indicating the number of the basic application / registration of the mark, the name and address of the applicant, countries of distribution, goods and services of the international classification of goods and services;

a document certifying the powers of a patent attorney (if an international application is submitted by a patent attorney) or a representative;

a document confirming payment of the international fee to the International Bureau provided for by the Madrid Agreement Concerning the International Registration of Marks and the Protocol to the Madrid Agreement Concerning the International Registration of Marks ;

a document confirming payment for the services of an expert organization for processing and sending, or checking and sending an application to the International Bureau;

official form of MM2, filled out in accordance with the Regulations to the Protocol to the Madrid Agreement Concerning the International Registration of Marks, when submitting a request for verification and forwarding of an application for international registration;

documents provided in accordance with international treaties of the Republic of Kazakhstan (if necessary).

4. A request for the execution and forwarding of an international application to the International Bureau shall be submitted in any form, a document confirming payment for the services of an expert organization for the preparation and forwarding of an international application to the International Bureau shall be attached to the request.

5. A request for the execution and forwarding of an international application may be submitted by the representative of the applicant on the basis of a power of attorney.

6. In the absence of a document confirming payment for the services of an expert organization, an invoice for payment shall be sent to the applicant. The document on payment shall be submitted by the applicant no later than one month from the date of sending the invoice for payment.

If one of the documents specified in item 3 of Chapter 2 of these Rules is not submitted, the application for execution and forwarding, or verification and forwarding of the international application for consideration shall not be accepted, of which the applicant shall be notified in writing.

7. The applicant (right holder) or his representative, by proxy, shall be sent a written notification of the sending of the international application to the International Bureau.

Chapter 3. Procedure for consideration of an international application

8. A full examination of an international application shall be carried out from the date of notification by the International Bureau of the extension of the international mark to the territory of the Republic of Kazakhstan.

9. An expert opinion on an international application shall be drawn up in accordance with the forms approved by the International Bureau in accordance with the requirements of the Administrative Instructions on the Application of the Protocol to the Madrid Agreement, approved by the Assembly of the countries participating in the Madrid Agreement, and the Protocol to the Madrid Agreement.

10. The examining organization shall notify the International Bureau of its decision on protection, partial protection or refusal, indicating all the reasons, not later than one year from the date on which the notification of extension of protection was sent by the International Bureau.

11. Protection of a trademark under an international registration arises from the date of the decision. In the event of a preliminary decision on partial registration or refusal of registration - from the date of the final decision of the examination.

Chapter 4. Conversion of the international registration into the national application

12. The applicant has the right to request that the international registration be converted into a national application.

Such a request shall be made when an international registration is canceled in whole or in part by reason of termination of protection of the basic mark.

An application will enjoy the same priority as an international registration if the application is for the same mark and for the same goods and services, within three months from the date on which the international registration was struck from the register of the International Bureau.

13. A request for the conversion of an international registration into a national application shall be submitted in the form in accordance with the appendix to these Rules.

The application shall be submitted by the applicant or his/her representative by proxy, the application shall be attached with an extract from the register of the International Bureau, an application for registration of a trademark and a document confirming payment for the conversion of an international registration into a national application.

In the absence of a document confirming payment, the expert organization issues invoices for payment.

The payment document shall be submitted no later than one month from the date of sending the invoice for payment. If the document on payment is not submitted, the application

for the transformation of the international registration into a national application is not accepted for consideration, of which the applicant or his representative by proxy is notified in writing.

14. The applicant or his representative, by proxy, shall be sent a notification on the transformation of the international registration into a national application, which contains the designation claimed for registration as a trademark, the application number, the filing date of the application, the name of the applicant, the list of goods and services.

15. On the basis of the notification of the transformation of the international registration into a national application, the applicant or his representative by proxy shall be sent an invoice for payment for the registration of a trademark and publication of information about the registration.

Annex
to the Rules for consideration
of an application for an industrial
property object in accordance with
the Patent Cooperation Treaty
and the Eurasian Patent Convention

REQUEST

for conversion of the international registration into the national application

applicant: application: no. date of application:

I kindly request that the international registration be converted into a national application, preserving the priority date, in respect of the following goods and/or services:

Application:

1. document confirming payment for the services of an expert organization 2. power of attorney (in case of application through a representative) 3. extract from the register of the International Bureau

Signature surname, name patronymic (if any) Seal (if any) Date