

PATENT LAW OF THE REPUBLIC OF KAZAKHSTAN

Title I. General Provisions

Article 1. Basic Definitions and Terms

- “*Gazette*” means an official periodical on industrial property protection matters published by Kazpatent;
- “*patented industrial property subject matter*” means industrial property subject matter for which a title of protection has been granted;
- “*the exclusive right*” means an economic right of the patent owner to use the industrial property subject matter in any way at his discretion;
- “*license contract*” means a contract by virtue of which the patent owner (the licensor) grants, for a specified period of time, the right to use the industrial property subject matter in a specified way to another person (the licensee);
- “*intellectual property subject matter*” means the results of intellectual creative activity and the means of identification of goods and services offered by participants in economic turnover;
- “*industrial property subject matter*” means inventions, utility models and industrial designs;
- “*titles of protection*” means provisional patents, invention patents, industrial design patents and utility model patents granted in conformity with this Law;
- “*the Paris Convention*” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as amended and supplemented;
- “*patent agent*” means a national who, under the legislation of the Republic of Kazakhstan, is authorized to represent natural persons or legal entities before Kazpatent;
- “*patent owner*” means a person holding a title of protection;
- “*invention created in the line of duty*” means an invention that has been created by the employee while carrying out his duties or specific duties entrusted to him by his employer;
- “*conditions of patentability*” means requirements for the grant of legal protection for industrial property subject matter laid down in this Law.

Article 2. Relations Governed by this Law

- 1) This Law shall govern economic and related moral relations arising out of the creation, legal protection and the use of industrial property subject matter.
- 2) The protection of other intellectual property subject matter (e.g. selection achievements, topographies of semiconductor integrated circuits, trademarks, service marks, appellations of origin etc.) shall be governed by special legal enactments.

Article 3. Scope of this Law

- 1) The provisions of this Law shall extend to industrial property subject matter for which Kazpatent has granted titles of protection as well as to industrial property subject matter for which patents has been granted in accordance with international treaties to which the Republic of Kazakhstan is party.

2) Where the provisions of an international treaty, that has been ratified by the Republic of Kazakhstan, are contrary to the provisions of this Law, the former shall prevail.

Article 4. Competent State Authority

The national patent Office of the Republic of Kazakhstan (hereinafter referred to as “Kazpatent”) shall, within the terms of this Law, be responsible for the State monopoly in the field of protection of industrial property subject matter, the receiving of applications for industrial property subject matter, examination thereof, the grant of titles of protection, shall publish in the Gazette official information on industrial property subject matter, and shall perform other functions entrusted to a patent Office.

Article 5. Legal Protection of Industrial Property Subject Matter

1) The rights in inventions and industrial designs shall be certified by provisional invention patents and provisional industrial design patents, invention patents and industrial design patents, while the rights in utility models shall be certified by utility model patents.

2) A provisional invention patent or industrial design patent shall be granted after a preliminary examination of the application has been carried out.

An invention patent or industrial design patent shall be granted after the substantive examination of the application has been carried out.

The provisional patent and patent shall certify the priority date of industrial property subject matter, the authorship thereof and the exclusive right to use the industrial property subject matter.

3) The term of a provisional invention patent shall be five years from the date of receipt of application by Kazpatent. The term may be extended by Kazpatent, at the request of the patent owner, for a period not exceeding three years.

The term of an invention patent shall be 20 years from the date of filing of the application with Kazpatent.

Where the use of a patented invention requires, in accordance with legislation in force, the authorization of a competent authority, the term of the invention patent may be extended by Kazpatent, at the request of the patent owner, for a period not exceeding five years.

The term of a utility model patent shall be five years from the date of filing of the application with Kazpatent. The term may be extended by Kazpatent, at the request of the patent owner, for a period not exceeding three years.

The term of a provisional industrial design patent shall be five years from the date of filing of the application with Kazpatent.

The term of an industrial design patent shall be 10 years from the date of filing of the application with Kazpatent. The term may be extended by Kazpatent, at the request of the patent owner, for a period not exceeding five years.

4) The scope of the legal protection conferred by an invention patent or utility model patent shall be determined by the claims, while the scope of legal protection conferred by an industrial design patent shall be determined by the sum of its essential features as shown on the photographs of the article (model, design).

The description and drawings may be used for interpretation of an invention or utility

model claims.

A title of protection granted for a process of manufacturing a product shall also extend to the product that has been directly manufactured by application of the process.

A product shall be deemed to have been manufactured by application of the patented process unless there is evidence to the contrary.

5) The right to obtain a title of protection and the rights deriving from the registration of an application, the right of ownership in a title of protection and the rights deriving from a title of protection may be transferred in whole or in part to any natural person or legal entity.

6) No legal protection shall be granted under this Law for industrial property subject matter that have been declared secret by the State. The appropriate procedure for the handling of secret industrial property subject matter shall be laid down by a special Law.

Title II. 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 is industrially applicable.

An invention shall be deemed new if it is not anticipated by prior 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 made available to the public anywhere in the world, before the priority of the invention.

When the novelty of an invention is determined, the state of the art shall be held to include all applications for the protection of inventions and utility models that have been filed in the Republic of Kazakhstan by other applicants, benefit from earlier priority and have not been withdrawn, and also 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 economy.

2) The subject matter of an invention may be a device, a process, a substance, a microorganism strain or a culture of plant or animal cells, and also the use of a known device, process, substance or strain for a new purpose.

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

- discoveries, scientific theories and mathematical methods;
- methods of economic organization and management;
- symbols, schedules and rules;
- methods for performing mental acts;
- algorithms and programs for computers;
- projects and plans for structures and buildings and for land development;
- proposals concerning solely the outward appearance of manufactured articles;
- proposals that are contrary to the public interest, humanitarian principles or morality.

4) Disclosure of information that otherwise would affect the patentability of the invention claimed in the application shall not do so where the information has been disclosed, during the six months preceding the filing date of the application, including

disclosure of the invention incorporated in an exhibit displayed at an official or officially recognized international exhibition held in the territory of a State party to the Paris Convention, by the inventor or applicant or by any person having obtained the information directly or indirectly from them. The burden of proof of the foregoing shall be on the applicant.

Article 7. Conditions of Patentability of Utility Models

1) Utility models shall be construed as inventions that impart a new construction to means of production and consumer articles or parts thereof.

A utility model shall be granted protection if it is new and industrially applicable.

A utility model shall be new if the sum of its essential features is not anticipated by prior 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 claimed utility model, concerning devices of similar function and the use thereof in the Republic of Kazakhstan. The state of the art shall likewise include applications for the protection of inventions and utility models that have been filed by other persons in the Republic of Kazakhstan, benefit from earlier priority and have not been withdrawn, and also inventions and utility models that have been patented in the Republic of Kazakhstan.

A utility model shall be industrially applicable if it can be used in economy.

2) Disclosure of information that otherwise would affect the patentability of the utility model claimed in the application shall not do so where the information has been disclosed, during the six months preceding the filing date of the application, including disclosure of the utility model incorporated in an exhibit displayed at an official or officially recognized international exhibition held in the territory of a State party to the Paris Convention, by the inventor or applicant or by any person having obtained the information directly or indirectly from them. The burden of proof of the foregoing shall be on the applicant.

3) The subject matter specified in Article 6(3) of this Law shall not be protected as utility models.

Article 8. Conditions of Patentability of Industrial Designs

1) An industrial design shall be construed as an artistic and technical solution defining the outward appearance of a manufactured article.

An industrial design shall be granted protection if it is new, original and industrially applicable.

An industrial design shall be deemed new if the sum of its essential features appearing on the photographs of the design and in the description of its essential features, was not known from information generally available in the world before the priority date of the design.

When the novelty of an industrial design is determined, due regard shall be had to earlier applications that have been filed in the Republic of Kazakhstan by other persons, benefit from an earlier priority date and have not been withdrawn, and also to industrial designs that have been patented in the Republic of Kazakhstan.

An industrial design shall be deemed original if its essential features determine the creativeness of the special aspects of the manufactured article.

An industrial design shall be deemed industrially applicable if it can be reproduced in quantity by the manufacture of the corresponding article.

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

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

3) Disclosure of information that otherwise would affect the patentability of the industrial design claimed in the application shall not do so where the information has been disclosed, during the six months preceding the filing date of the application, including disclosure of the industrial design incorporated in an exhibit displayed at an official or officially recognized international exhibition held in the territory of a State party to the Paris Convention, by the inventor or applicant or by any person having obtained the information directly or indirectly from them. The burden of proof of the foregoing shall be on the applicant.

Title III. Authors and Patent Owners

Article 9. Author of Industrial Property Subject Matter

1) A natural person whose creative work resulted in industrial property subject matter shall be recognized as the author thereof.

2) Where industrial property subject matter is the result of the joint creative work of two or more natural persons, those persons shall be recognized as the joint authors thereof. The conditions for exercising the rights in the industrial property subject matter shall be determined by agreement between them.

Natural persons 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 of industrial property subject matter shall be an inalienable personal right. That right shall enjoy protection of unlimited duration.

4) The author shall have the right to give his own name or a special name to his industrial property subject matter unless such act infringes the rights of third parties in trademarks protected in the territory of the Republic of Kazakhstan.

Article 10. Patent Owners

1) A title of protection shall be granted to:

- author (or authors) of industrial property subject matter;
- the employer in the cases provided for in paragraph (2) of this Article;
- their successor (or successors) in title including the assignee (or assignees);
- beneficiaries specified in this paragraph jointly subject to agreement between them.

2) The right to obtain a title of protection for an invention that has been made by an employee in the line of duty, shall belong to the employer unless otherwise provided

in the employment contract.

3) Where the employer, within four months after having been notified by the author of the industrial property subject matter, has not filed an application with Kazpatent, has not assigned his right to file an application to another person or has failed 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.

The employer shall in that case be entitled to use the industrial property subject matter in his own manufacture on terms stipulated in a contract between the parties.

4) The amount of the remuneration, the terms and procedure for payment thereof shall be stipulated in a contract between the parties.

Where the parties have failed to agree on foregoing, the dispute shall be settled in court proceedings.

If the actual creative contribution by the author and the employer to the invention made in the line of duty is impossible to determine, the author shall be entitled to remuneration commensurate with half the amount of any proceeds derived or that would have been derived by the employer from the use of the invention.

Title IV. The Exclusive Right to Use Industrial Property Subject Matter

Article 11. Rights and Obligations of Patent Owners

1) The exclusive right to use the protected industrial property subject matter shall belong to the owner of the patent, who may exercise that right at his discretion.

2) The use of industrial property subject matter shall be deemed to include manufacturing, utilization, importation, offering for sale, sale and any other form of distribution for commercial purposes or stocking for the above purposes of products incorporating the industrial property subject matter or the use of the patented process.

A patented invention or utility model shall be deemed to have been used in the manufacture of a product, and a process protected by an invention patent shall be deemed to have been applied, if the product or the process incorporates every essential feature of the patented invention or utility model included in an independent claim, or an equivalent feature known as such at the date of commencement of the use.

A patented process shall be deemed to have been applied in the manufacture of a product, if the product directly manufactured by the process has been distributed or stocked for commercial purposes.

A patented industrial design shall be deemed to have been used in the manufacture of a product if the product incorporates all essential features thereof as appearing on the photographs of the design and in the description of its essential features.

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

Where there are several owners of the same title of protection, their relations with regard to the use of the industrial property subject matter shall be determined by agreement between them.

Where no such agreement exists, each of the owners shall be entitled to use the patented industrial property subject matter at his discretion, but may not assign or license the title of protection without the consent of the other owners.

The patent owner may affix a warning sign indicating that the used industrial property subject matter is patented.

4) Where the patent owner has failed to continuously use the invention within four years following the date of first publication of the particulars of the patent grant and has declined an offer to conclude a license contract on commercially acceptable terms, any person may file an appeal with the court requesting the grant of a compulsory non-exclusive license.

If the patent owner fails to furnish proof to the effect that non-use of the invention is justified by reasonable grounds, the court shall grant the said license and shall determine the time limits of the use, the amount and terms 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.

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

The person to whom a compulsory license was granted may assign the right to use the invention to another person only together with the enterprise that uses the invention.

The court may decide to revoke a compulsory license if the grounds leading to the grant thereof no longer 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 file an appeal with the court requesting the grant of a compulsory non-exclusive license to use the industrial property subject matter in the territory of the Republic of Kazakhstan.

When the said compulsory license is granted, 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 time limits of the use, the amount and terms 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.

The right to use the industrial property subject matter acquired on the basis of this provision may be assigned only together with the title of protection granted for that industrial property subject matter.

6) The patent owner may assign the granted title of protection to any natural person or legal entity. The contract of assignment shall be obligatory registered with Kazpatent.

7) 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.

8) The patent owner shall be required to pay the prescribed annual maintenance fee with respect to his title of protection.

Article 12. Acts Not Infringing the Exclusive Right of the Patent Owner

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

- the use on board sea-going or river vessels of other countries or in the construction or operation of aircraft, space or land vehicles of other countries of devices incorporating protected industrial property subject matter, when such vessels or vehicles temporarily or accidentally enter the territory of the Republic of Kazakhstan, provided that such devices are used there exclusively for the needs of the vessel or vehicle. The above acts shall not constitute an infringement of the exclusive right of the patent owner

where such sea-going or river vessels or aircraft, space or land vehicles belong to natural persons or legal entities of the countries affording reciprocal right to natural persons or legal entities of the Republic of Kazakhstan;

- the use of the subject matter incorporating the protected industrial property subject matter for scientific research and experimental purposes;
- the use of the devices incorporating the protected industrial property subject matter in cases of natural disasters, catastrophes or dramatic accidents, provided the owner of the patent is subsequently paid a commensurate compensation;
- the use of the subject matter incorporating the protected industrial property subject matter for private and non-commercial purposes;
- the use of the subject matter incorporating the protected industrial property subject matter for the preparation for individual cases, in a pharmacy, of a medicine in accordance with a medical prescription;
- the use of the subject matter incorporating the protected industrial property subject matter for the marketing purposes in the territory of the Republic of Kazakhstan where the act is done in a legal way.

Article 13. Right of Prior User and Provisional Legal Protection

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

The right of the prior user may only be transferred by the said prior user to another natural person or legal entity together with his enterprise in which the use or the necessary preparations for use have been made.

2) Any person, whether a natural person or a legal entity, who, after the priority date of the protected industrial property subject matter but before the date of publication of the particulars of the granted provisional patent for an invention or industrial design or the granted utility model patent, had started the use of the 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 incorporated in an exhibit displayed 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 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 with Kazpatent within six months following the date of its display at the exhibition.

4) Any natural person or legal entity using the industrial property subject matter during the period specified in paragraph (3) of this Article shall pay compensation to the patent owner, after the grant of the title of protection, in an amount to be determined by agreement between the parties.

Article 14. Grant of the Right to Use Industrial Property Subject Matter

1) Any natural person or legal entity, other than the patent owner, who wishes to use

the protected industrial property subject matter shall be required to obtain the authorization of its owner on the basis of a license contract.

2) Under a license contract the patent owner (the licensor) may grant to the licensee the following:

a) the right to use the protected industrial property subject matter while the licensor retains all the rights deriving from the title of protection, including the right to grant licenses to third parties (an ordinary non-exclusive license);

b) the exclusive right to use the protected industrial property subject matter within the limits specified in the contract beyond which the licensor retains the said right but has no right to grant licenses to third parties (an exclusive license);

c) the exclusive right to use the protected industrial property subject matter at his discretion while the licensor retains neither the right to use the subject matter nor to grant licenses to third parties (a bloc (full) license).

A license shall be deemed to be non - exclusive unless otherwise provided in the license contract.

3) A contract (a sublicense contract) granting the right to use the protected industrial property subject matter to another person (the sublicensee) may be concluded by the licensee only in cases stipulated in the license contract.

The licensee shall be responsible before the licensor for any act performed by the sublicensee with regard to the protected industrial property subject matter unless otherwise provided in the license contract.

4) A license contract and sublicense contract for the use of the protected invention, utility model or industrial design shall be concluded in writing and shall be registered with Kazpatent, failing either of which it shall be deemed null and void.

5) The patent owner may file with Kazpatent a notice to the effect that he undertakes to grant the right to use his industrial property subject matter to any interested party (open license).

Any person wishing to obtain the said open license shall be required to enter into a contract of payments with the patent owner. Any such contract shall be registered with Kazpatent. Any dispute relating to the terms and conditions of the contract shall be settled in court.

The notice of the patent owner shall be valid within three years from the date of publication of the particulars of the notice in the Gazette.

In such a case the maintenance fee shall be reduced by 50 percent as from the year following the year of publication of the particulars of the notice.

6) The Government of the Republic of Kazakhstan may authorize the use of the protected industrial property subject matter without the consent of the patent owner in cases of national emergency and other force majeure situations provided that the owner is immediately informed and is paid a commensurate compensation.

Any dispute relating to the amount of compensation shall be settled by court.

Article 15. Infringement of the Exclusive Right of the Patent Owner

1) Any natural person 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 or the title of protection.

The performance of the following acts shall be deemed to constitute an infringement of

the exclusive right of the patent owner or the title of protection: 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 or the use of the patented process.

A new product shall be deemed to have been manufactured by a protected process unless there is evidence to the contrary.

2) The aggrieved patent owner may request that:

- the infringement of the title of protection cease;
- the infringer compensate the owner the damages sustained, including moral damage;
- the infringer pay the owner the amount of profits derived from the unauthorized use of the protected industrial property subject matter, in place of compensation for damage sustained;
- the infringer pay the owner compensation the amount of which shall be from 10 000 to 50 000 times the monthly calculated index in accordance with legislation in force, in place of compensation for damages sustained or payment the amount of the derived profits;
- the infringing products that have been commercialized or stocked for commercial purposes as well as materials and implements that have been especially used in the manufacture of infringing products be withdrawn from sale in favor of the aggrieved patent owner;
- information on the infringement, including the particulars of the owner of the infringed right, be published as a mandatory requirement.

3) Damages for infringement may also be claimed by the license holder unless otherwise provided in the license contract.

Title V. Procedure of Obtaining Titles of Protection

Article 16. filing of the Application for the Grant of a Title of Protection

1) An application for the grant of a title of protection shall be filed with Kazpatent by a person entitled to obtain the title in accordance with Article 10(1) of this Law (hereinafter referred to as “the applicant”).

2) The request 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 the Kazakh, Russian or in other languages.

Where 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 applicant may furnish a required translation within two months following the receipt by Kazpatent 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 furnish the required translation, the application shall be deemed not to have been filed.

Article 17. Application for the Grant of an Invention Title of Protection

1) The application for the grant of an invention title of protection (hereinafter referred

to as “the invention application”) shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (unity of invention requirement).

2) The invention application shall contain:

- the request for the grant of a title of protection, stating the names of the inventor (or inventors) 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;
- the description, disclosing the claimed invention in sufficient detail for it to be carried out by a specialist in the field;
- the claims, stating the essential features of the invention and fully supported by the description;
- the drawings or other material, where indispensable for the understanding of the disclosure;
- the abstract;
- a power of attorney if the application is filed through a patent agent;
- the request stipulated in Article 22(7) of this Law if an invention patent is sought.

The invention application shall be accompanied by proof of payment of the prescribed fee or of circumstances affording entitlement to a reduction in the amount of the prescribed fee which may be either furnished 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 furnish 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 invention application shall be determined by the date of receipt by Kazpatent of the following elements: the request for the grant of a title of protection, stating the name and forename (and the middle name if there is a middle name) or the official name of the applicant, the description, the claims and the drawings if there is a reference to the drawings in the description.

Where not all elements of the invention application are furnished at the same time, the filing date shall be determined by the date of receipt of the last of the elements.

4) The conditions to be met by the elements of the invention application shall be determined by Kazpatent.

Article 18. Application for the Grant of a Utility Model Title of Protection

1) The application for the grant of a utility model title of protection (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:

- the request for the grant of a title of protection, stating the names of the creator (or creators) 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;
- the description, disclosing the claimed utility model in sufficient detail for it to be

- made;
- the claims, stating the essential features of the utility model and fully supported by the description;
- the drawings;
- the abstract;
- a power of attorney if the application is filed through a patent agent.

The utility model application shall be accompanied by proof of payment of the prescribed fee or of circumstances affording entitlement to a reduction in the amount of the prescribed fee which may be either furnished together with the application or within two months following the date of its receipt.

If the applicant fails, within the prescribed time limit, to furnish 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 Kazpatent of the following elements: the request for the grant of a title of protection, stating the name and forename (and the middle name if there is a middle name) or the official name of the applicant, the description, the claims and drawings.

Where not all elements of the utility model application are furnished at the same time, the filing date shall be determined by the date of receipt of the last of the elements.

4) The conditions to be met by the elements of the utility model application shall be determined by Kazpatent.

Article 19. Application for the Grant of an Industrial Design Title of Protection

1) The application for the grant of an industrial design title of protection (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:

- the request for the grant of a title of protection, stating the name of the creator (or creators) 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;
- a set of photographs of the manufactured article (or articles) or model providing full and detailed view of its outward appearance and capable of reproduction;
- the drawings, affording general views of the manufactured article, ergonomic scheme, or confection chart where indispensable for the understanding of the disclosure;
- the description of the industrial design including the totality of its essential features;
- a power of attorney if the application is filed through a patent agent.

The industrial design application shall be accompanied by proof of payment of the prescribed fee or of circumstances affording entitlement to a reduction in the amount of the prescribed fee which may be either furnished 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 furnish 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 model application shall be determined by the date of receipt by Kazpatent of the following elements: the request for the grant of a title of protection, stating the name and forename (and the middle name if there is a middle name) or the official name of the applicant, the description, the set of photographs of the manufactured article (model).

Where not all elements of the industrial design application are furnished at the same time, the filing date shall be determined by the date of receipt of the last of the elements.

4) The conditions to be met by the elements of the utility model application shall be determined by Kazpatent.

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 subject matter application that is determined in conformity with Article 17(3), Article 18(3) and Article 19(3) of this Law.

2) Priority may be determined by the filing date of the first application in any State party to the Paris Convention or with any international or regional organization specified in the Paris Convention (hereinafter referred to as "Convention priority") where the invention application or the utility model application has been filed with Kazpatent within 12 months (and in the case of the industrial design application within six months) from the said date.

Where an application claiming Convention priority cannot, for reasons beyond the applicant's control, be filed within the prescribed time limit, the latter may be extended for a period not exceeding two months.

The applicant wishing to enjoy Convention priority shall make a declaration to that effect to be submitted to Kazpatent when filing the application or within two months following the date of receipt of the application by Kazpatent, 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 Kazpatent.

in such a case priority shall be determined by the date of filing the application with Kazpatent.

3) Priority may be determined by the date of receipt by Kazpatent of additional documents if they are submitted by the applicant as a separate application, provided it has been filed within three months following the date of receipt by the applicant of a notification from Kazpatent to the effect that the additional documents will not be taken into consideration since they are recognized as modifying the subject matter of the claimed solution.

4) Priority may be determined by the date of filing with Kazpatent of an earlier application filed by the same applicant disclosing the industrial property subject matter, on condition that the application claiming such priority has been filed with Kazpatent no later than 12 months from the filing date of the earlier invention application and no later than six months from the filing date of the earlier utility model or industrial design application. In such a case the earlier application shall be deemed to have been withdrawn.

Priority may be determined by the filing date of an application in which an earlier

priority has already been claimed.

5) The priority of industrial property subject matter based on a divisional application shall be determined by the date of filing with Kazpatent of the initial application disclosing the industrial property subject matter, provided that the divisional application is filed before a final decision refusing the grant of a title of protection has been taken and cannot be further contested in respect of the said initial application, or where a decision to grant a title of protection has been taken 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 on the basis of additional documents to such applications provided each of them meets the conditions prescribed in paragraphs (2) to (5) of this Article.

7) Where the examination finding is that the same priority date is claimed for similar industrial property subject matter, the title of protection shall be granted for the application having a proven earlier mailing date, or, where the mailing date coincide, for the application having an earlier registration number at Kazpatent.

Article 21. Amendment or Correction of the Application on the Applicant's Initiative

1) Within two months following the date of receipt of the application the applicant shall have the right to amend or correct the elements of the application on his own initiative, provided that the amendments or corrections do not modify the subject matter of the claimed industrial property subject matter.

2) such amendments or corrections may, subject to payment of the prescribed fee, be made to an application after the time limit specified in paragraph (1) of this Article has expired but not after a decision has been taken on the industrial property subject matter application.

Article 22. Examination of Invention Applications

1) After two months has elapsed following the date of receipt of the application, Kazpatent shall carry out a preliminary examination. On a written request from the applicant, the preliminary examination may be started before the prescribed time limit expires. In such a case after the request has been filed, the applicant shall have no right provided for in Article 21(1) of this Law.

A preliminary examination shall be carried out in order to verify the presence of the required documents and their compliance with the prescribed conditions, to determine the filing date of the application, and to ascertain whether the claimed solution relates to industrial property subject matter eligible for legal protection as well as to verify whether the unity of invention requirement is satisfied.

No verification of the compliance of the claimed invention with the conditions of patentability of inventions prescribed in Article 6(1) of this Law shall be carried out.

A provisional patent shall be granted to the applicant at his own risk and responsibility.

2) Where the applicant files additional elements relating to the application under Article 21 of this Law, a preliminary examination shall be carried out in order to ascertain 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 that did not figure in the initial application and

should be included in the claims.

The additional elements modifying the subject matter of the claimed invention shall not be taken into consideration for the purposes of examination, and the applicant may submit them as a separate application and shall be notified accordingly.

3) Where the documents contained in the application do not comply with one or more of the prescribed requirements, the applicant shall be invited to furnish the corrected or missing documents within two 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 withdrawn.

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 Article 20(5) 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) Where the preliminary examination finding is that the invention application relates to the solution for which legal protection is granted, a decision to grant a provisional patent shall be taken and the claims shall be approved by the applicant.

The applicant shall, within three months following the date of the decision, furnish to Kazpatent a document containing proof of payment of the prescribed fee.

If the applicant fails, within the prescribed time limit, to furnish the said document, the application shall be deemed to have been withdrawn and neither registration of the invention nor the grant of a provisional patent shall be effected.

6) Where the preliminary examination finding is that the invention application relates to the solution for which no legal protection is granted, a decision refusing the grant of a provisional patent shall be taken.

A decision refusing the grant of a provisional patent shall likewise be taken in the case where the applicant fails to modify the subject matter of the claimed invention after the 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.

Where the applicant wishes to contest a decision refusing the grant of a provisional patent he may do so, within three months following its date, by lodging an appeal with the Board of Appeal.

The appeal shall be examined within two months from the date of its receipt by the Board of Appeal.

7) The substantive examination shall be carried out by Kazpatent at the request of the applicant or any third party, which request may be filed after the publication of a particulars of the grant of a provisional patent at any time within the three years following the filing date or, in case of extension of the term of a provisional invention patent in conformity with Article 5(3) of this Law, within the five years following the filing date.

The substantive examination shall comprise a state-of-the-art search in respect of the claimed invention in order to verify its compliance with conditions of patentability prescribed in Article 6 of this Law.

Where the applicant files the request, the substantive examination shall be carried out provided that the applicant furnishes a document containing proof of payment of the prescribed examination fee and of maintenance fee in respect of the provisional patent.

Where no request for substantive examination is filed by the applicant within the prescribed time limit and he cannot justify his failure to do so with legitimate reasons, a provisional legal protection shall cease after the expiration of the term of the provisional patent.

8) During the substantive examination procedure Kazpatent may request the applicant to furnish additional elements, including amended claims, where such elements are indispensable for the purposes of the examination.

The additional elements requested by the examiner shall be furnished within three months from the date of the request and shall not modify the subject matter of invention.

Where the additional elements modify the subject matter of the invention, the provisions of paragraph (2) of this Article shall apply.

If the applicant fails, within the prescribed time limit, to furnish additional elements or to file a request for extension of the said time limit, the application shall be deemed to have been withdrawn.

9) Where the substantive examination finding is that the invention, as defined by the applicant in the claims, complies with the conditions of patentability provided for in Article 6 of this Law, Kazpatent shall decide to grant a patent and the claims shall be approved by the applicant.

The applicant shall, within three months following the date of the decision, furnish to Kazpatent a document containing proof of payment of the prescribed fee.

If the applicant fails, within the prescribed time limit, to furnish the said document, the application shall be deemed to have been withdrawn and neither registration of the invention nor the grant of a patent shall be effected.

10) Where the invention, as defined by the applicant in the claims, does not comply with the conditions of patentability, a decision to refuse the grant of a patent shall be taken.

A decision refusing the grant of a patent shall likewise be taken in cases provided for in paragraph (6) of this Article.

Where the applicant wishes to contest a decision refusing the grant of a patent he may do so, within three months following its date, by lodging an appeal with the Board of Appeal.

The appeal shall be examined within four months from the date of its receipt by the Board of Appeal.

11) In order to determine whether the claimed invention is patentable, the applicant, at any time during the substantive examination procedure, or after the particulars of the grant of a provisional patent have been published, the patent owner or any third party may request that a state-of-the-art search be carried out in respect of the application filed.

Kazpatent shall carry out no such search in respect of subject matter that is not recognized as patentable inventions in accordance with Article 6(3) of this Law and the requesting party shall be notified accordingly.

The appropriate procedure for carrying out the said search shall be determined by Kazpatent.

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

13) If the applicant fails to respect time limits prescribed in paragraphs (3), (5) to (10) of this Article, Kazpatent yet may reinstate his rights provided that he presents legitimate reasons for the delay and furnishes a document containing proof of payment of the prescribed fee.

The request for reinstatement of rights contingent on a time limit may be filed by the applicant no later than 12 months after the expiration of the time limit in question.

The applicant shall file the request with Kazpatent at the same time as he furnishes the documents requested by the examiner or lodges an appeal with the Board of Appeal.

Article 23. Examination of Utility Model Applications

1) A preliminary examination of a utility model application shall be carried out in order to verify the presence of the required documents and their compliance with the prescribed conditions, to determine the filing date of the application, and to ascertain whether the claimed solution relates to industrial property subject matter eligible for legal protection as a utility model as well as to verify whether the unity of invention requirement is satisfied.

No verification of the compliance of the claimed utility model with the conditions of patentability of utility models prescribed in Article 7(1) of this Law shall be carried out.

A patent shall be granted to the applicant at his own risk and responsibility.

2) The preliminary examination of a utility model application shall be carried out in conformity with the provisions of Article 22(2) to (4) and (13) of this Law.

Where the preliminary examination finding is that the application relates to subject matter for which legal protection is granted, and the documents contained in the application comply with the prescribed requirements, a decision to grant a patent shall be taken.

The applicant shall, within three months following the date of the decision, furnish to Kazpatent a document containing proof of payment of the prescribed fee.

If the applicant fails, within the prescribed time limit, to furnish the said document, the application shall be deemed to have been withdrawn and neither registration of the utility model nor the grant of a patent shall be effected.

3) Where the preliminary examination finding is that the application relates to the solution for which no legal protection is granted, a decision refusing the grant of a

patent shall be taken.

A decision refusing the grant of a patent shall likewise be taken in the case where the applicant fails to modify the subject matter of the claimed utility model after the 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.

Where the applicant wishes to contest a decision refusing the grant of a patent he may do so, within three months following its date, by lodging an appeal with the Board of Appeal.

The appeal shall be examined within two months from the date of its receipt by the Board of Appeal.

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

Article 24. Examination of Industrial Design Applications

1) Kazpatent shall carry out both a preliminary and a substantive examination of an industrial design application.

The preliminary examination of an industrial design application shall be carried out in conformity with the provisions of Article 22(1) to (6) and (13) of this Law.

2) The substantive examination of an industrial design application shall be carried out in conformity with the provisions of Article 22(7) to (10), (12) and (13) of this Law.

Article 25. Registration of Industrial Property Subject Matter; Grant of Titles of Protection

1) Kazpatent shall register an invention in the State Register of Inventions of the Republic of Kazakhstan or, in the case of a utility model, in the State Register of Utility Models of the Republic of Kazakhstan or, in the case of an industrial design, in the State Register of Industrial Designs of the Republic of Kazakhstan.

2) At the same time as it publishes the particulars of the grant, Kazpatent shall grant a title of protection to the person in whose name the application was filed.

Where several persons are registered as applicants for the same title of protection, only one title of protection shall be granted to them.

3) Kazpatent shall issue to the author of the industrial property subject matter who is not the patent owner an official certificate attesting his authorship.

4) The layout of the title of protection and the list of particulars contained therein shall be prescribed by Kazpatent.

Article 26. Publication of Particulars of the Granted Title of Protection

1) Kazpatent shall publish in the Gazette the particulars of the grant of a provisional invention patent or a utility model patent after expiration of 18 months from the filing date of the application, and in the case of a provisional industrial design patent after

expiration of 12 months from the said date.

At the request of the applicant Kazpatent may publish the particulars of the grant of a title of protection before the expiration of the said time limit.

- 2) Within two months following the date of registration of the industrial property subject matter in the appropriate State Register of the Republic of Kazakhstan, Kazpatent shall publish in the Gazette the particulars of the grant of an invention patent or industrial design patent.
- 3) The author of the industrial property subject matter may waive his right to be identified in the published particulars of the title of protection.
- 4) The full list of the published particulars shall be determined by Kazpatent.
- 5) Any natural person or legal entity shall have the right to inspect the documents of the application after the particulars of the grant of the title of protection have been published.
- 6) Kazpatent shall publish in the Gazette information on any extension of the term of a title of protection in conformity with Article 5(3) of this Law.

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 a decision on the invention application, convert the said application into a utility model application by filing a request to that effect.

Where a decision to refuse the grant of a title of protection has been taken on the invention application, the applicant may, prior to expiration of the time limit for lodging an appeal contesting the decision, convert the application into a utility model application.

- 2) The applicant may, prior to a decision on the utility model application, convert the said application into an invention application by filing a request to that effect.
- 3) The converted application shall have the priority date and the filing date of the initial application.

Title VI. Revocation and Restoration of Lapsed Titles of Protection

Article 29. Opposition to the Grant of Title of Protection

1) A title of protection may be contested and revoked, either entirely or in part, at any time during its period of validity on the basis of the notice of opposition contesting its grant, in the following cases:

- a) the protected industrial property subject matter does not comply with the conditions of patentability prescribed by this Law;
- b) 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 as filed;
- c) the grant of the title of protection was effected contrary to the provisions of Article 37 of this Law;

d) the title of protection contains an incorrect indication of the author (or authors) or of the patent owner (or patent owners).

2) The notice of opposition filed on the grounds specified in paragraph (1)(a) to (c) of this Article shall be filed with Kazpatent.

The Board of Appeal shall examine the notice of opposition within six months from the date of its receipt.

The person who has filed the notice of opposition shall give the patent owner opportunity to familiarize himself with the notice.

Article 30. Invalidation and Premature Expiration of Validity of Title of Protection

1) A title of protection may be invalidated, either entirely or in part, in the result of a decision taken by the Board of Appeal or by the court.

2) The validity of the title of protection shall expire prematurely:

a) at the request of the patent owner filed with Kazpatent as from the date of publication of the particulars of the premature expiration;

b) in the event of failure to pay the annual maintenance fee by the prescribed time limit as from the date of expiration of the said time limit.

3) Kazpatent shall publish in the Gazette information concerning titles of protection invalidated, either entirely or in part, as well as information concerning premature expiration of their validity.

Article 31. Restoration of Patent Validity; Right of Interim User

1) at the request of the patent owner the validity of the patent that has expired prematurely on the grounds specified in Article 30(2)(b) of this Law may be yet restored, within three years following the date of expiration of the time limit for payment the annual maintenance fee, provided that the patent owner presents legitimate reasons to justify his failure and furnishes a document containing proof of payment of the prescribed restoration fee.

Kazpatent shall publish information on restoration of the validity of patents in the Gazette.

The date of restoration of the patent validity shall be the date of publication of the said information.

2) Any person, whether a natural person or a legal entity, who, during the period between the date of premature expiration of the patent validity and the date of restoration thereof, was using in the territory of the Republic of Kazakhstan the protected 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 the scope thereof is not extended (right of interim user).

The right of interim user may only be transferred by the said interim user to another natural person or legal entity together with his enterprise in which the use or the necessary preparations for use have been made.

Title VII. Defence of Rights of Authors, Applicants and Patent Owners

Article 32. Board of Appeal

1) The Board of Appeal, a specialized structural unit within Kazpatent, shall be the

competent authority entrusted with extrajudicial consideration of disputes relating to the notice of opposition filed in accordance with Article 22(6) and (10), Article 23(3) and Article 29(2) of this Law.

The Statute of the Board of Appeal and the appropriate procedure for filing and consideration of the notice of opposition shall be approved by Kazpatent.

2) The notice of opposition shall be considered by a collegium of experts of the Board of Appeal within the time limit prescribed by this Law.

The said time limit may be extended, at the request of the contestant or the patent owner, for a period not exceeding six months from the date of expiration of the prescribed time limit.

3) Where the contestant or the patent owner wishes to contest the decision taken by the Board of Appeal he may do so, within six months following the date of receipt of the decision, by lodging an appeal with the court.

Article 33. Settlement of Disputes in Court Proceedings

1) The competence of the courts shall extend to disputes arising from:

- the authorship of industrial property subject matter;
- the legality of the grant of a title of protection;
- the identification of the patent owner;
- the grant of a compulsory license;
- infringements of the exclusive right to use the protected industrial property subject matter and of other economic rights of the patent owner;
- the conclusion and execution of license contracts for the use of the protected industrial property subject matter;
- the rights of the prior user and the interim user;
- the remuneration payable to the author by the employer under Article 10(4) of this Law;
- the payment of compensation under this Law;
- other disputes arising out of the protection of rights evidenced by a title of protection.

2) Kazpatent shall, on the basis of a court decision, publish information on changes concerning the title of protection.

Article 34. Liability for Infringement of the Rights of Authors, Applicants and Patent Owners

Any person who usurps authorship, acquires the status of author by coercion or without the authorization of the author or the applicant discloses information on industrial property subject matter, or uses the protected industrial property subject matter in a manner contrary to the provisions of this Law, or violates the procedure for filing abroad of applications for the protection of industrial property subject matter shall be liable to sanctions under the legislation of the Republic of Kazakhstan.

Title VIII. Final Provisions

Article 35. Fees for Legal Acts Payable to Kazpatent

The performance by Kazpatent of legal acts provided for in this Law including the receipt of applications for the grant of a title of protection and registration thereof,

carrying out examination of industrial property subject matter, grant of titles of protection and of any other acts giving rise to rights and obligations for participating parties, shall, under legislation in force, be subject to payment of fees to Kazpatent.

Article 36. Patent Agents

1) Natural persons who are nationals of the Republic of Kazakhstan having their residence in its territory and whose professional qualities meet the prescribed requirements may qualify for a patent agent.

The requirements to be met by patent agents and the appropriate procedure for their qualification and registration shall be determined by Kazpatent.

2) Natural persons having their residence outside the territory of the Republic of Kazakhstan and foreign legal entities shall be required to act through patent agents registered with Kazpatent in all proceedings conducted for the purpose of obtaining titles of protection and maintenance thereof as well as for lodging an appeal with the Board of Appeal.

Natural persons having their permanent residence in the Republic of Kazakhstan but temporarily residing outside its territory may act on their own in all proceedings conducted for the purpose of obtaining titles of protection, provided that they indicate the address for business in the Republic of Kazakhstan.

3) The powers of the patent agent shall be certified in a power of attorney issued by the applicant or the patent owner.

Article 37. Filing Applications for Industrial Property Subject Matter Protection Abroad

1) The filing abroad of applications for industrial property subject matter created in the Republic of Kazakhstan shall be effected no earlier than three months after the filing of the corresponding application with Kazpatent or, after verification of the presence of information constituting a State secret carried out in accordance with the procedure prescribed by the legislation of the Republic of Kazakhstan, before the expiration of the prescribed time limit.

2) Nationals of the Republic of Kazakhstan having their residence in its territory and legal entities of the Republic of Kazakhstan shall only file an application for the protection of industrial property subject matter with a competent international patent organization through Kazpatent unless otherwise provided in the relevant international treaty.

3) Where an application for the protection of industrial property subject matter is filed with a competent authority of another State or with a competent international patent organization in a manner contrary to the procedure prescribed in this Article, no title of protection for the industrial property subject matter shall be granted in the Republic of Kazakhstan.

Article 38. Rights of Foreign Natural Persons, Legal Entities and Stateless Persons

1) Foreign natural persons and legal entities shall, on the basis of international treaties to which the Republic of Kazakhstan is a party or on the basis of reciprocity, enjoy the same rights as provided in this Law for its own natural persons and legal entities.

2) Stateless persons residing in the Republic of Kazakhstan shall enjoy the same rights as provided in this Law and other legal enactments relating to the legal protection of

industrial property subject matter on the same footing as natural persons and legal entities of the Republic of Kazakhstan unless otherwise provided in this Law and other legal enactments.

President of the Republic of Kazakhstan

N. Nazarbaev

July 16, 1999, Astana

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