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**MADRID PROTOCOL****FURTHER DECISION AFFECTING THE PROTECTION OF A MARK****Rule 18ter(4) of the Regulations**

I. Name of the Office:

**National Institute of Intellectual Property, Ministry of Justice, Republic of Kazakhstan**

Address:

**57A Mangilik Yel Avenue,  
non-residential premise 8,  
010000, Astana, Kazakhstan**

Telephone: +7 (7172) 62-15-15, + 7 (7172) 62-15-04

Website: [kazpatent.kz](http://kazpatent.kz)E-mail: [kazpatent@kazpatent.kz](mailto:kazpatent@kazpatent.kz)II. International registration number: **1266937**

III. Name and address of the holder:

**DERMAVITA COMPANY Ltd****Corniche Mazraa,****General Street,****Al Jichy Building (Lebanon Gulf Bank) -****4th Floor****Beirut (LB)**

IV. Information concerning the scope of the further decision:

- ☐ Protection for all the goods and/or services.
- ☒ Protection is refused for all the goods and/or services.
- ☐ Protection for some of the goods and/or services:

V. Authority of the Republic of Kazakhstan, which made the decision:

- ☐ Judicial body.
- ☒ Appellate Council of the Ministry of Justice.
- ☐ The Office.

VI. Signature of the Office sending the statement:

**Deputy Director****Y. Kussain**VII. Date: **18.10.2023**

## **Annex I:**

### **APPLICABLE PROVISIONS**

**Law No. 456 of the Republic of Kazakhstan dated 26 July 1999 «On Trademarks, Service Marks, Geographical Indications and Appellations of Origin».**

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

1-1) **marks that are confusingly similar** means similar signs or symbols that differ in single elements and are associatively perceived by the consumer as identical;

1-2) **identical trademarks** means signs and symbols that coincide in all elements;

1-3) **goods or services of the same kind** means goods or services performing the same function and relating to the same kind (sort) that may cause by consumer the idea of being produced by the same manufacturer in case of using the identical or similar trademarks;

4) **well-known trademark** - a designation used as a trademark, or a trademark, recognized as well-known by the decision of the authorized body, based on the evidences of interested persons;

8) **trademark, service mark** means a sign registered according to this Law or protected without registration by virtue of the international agreements to which the Republic of Kazakhstan is a party, serving to distinguish goods (services) of certain legal entities or individuals from goods (services) of the same kind of other legal entities or individuals.

#### **Article 6. Statutory grounds for refusal of registration of a trademark**

1. It is not allowed to register the trademarks consisting solely of the designations that are not distinctive, in particular:

1) entered into common use for marking goods (services) of the particular kind;

2) are generally accepted symbols and expressions;

3) indicate the sort, quality, quantity, character, purpose, value of goods as well as place and time of their manufacture or distribution;

3-1) are international unpatentable names of pharmaceutical products;

6) have the direct descriptive connection with goods or services that they are used to mark;

The mentioned designations may be used as unprotected elements of a trademark if they do not take the dominated place.

2. The designations reproducing armorial bearings, flags and symbols, abbreviated and full names of international organizations and their official signs, flags and symbols, hallmarks of control, warranty or assay, stamps, Olympic logos, awards and other honorary signs as well as designations that are confusingly similar to such signs may not be registered as trademarks. Such designations may be used as unprotected elements if the designation does not consist only of them and if there is consent of the appropriate authorized body or their owner thereof.

3. The registration of designations as trademarks or their elements is not allowed if they:

1) which are false or capable of misleading with respect to a product or its manufacturer, service or person providing a service, as well as names of geographical objects that may be misleading with respect to the place of production of the product;

2) formally indicate the real place of good manufacture but give a wrong impression regarding the origin of good from another territory;

3) constitute or contain the names of geographic locations identifying mineral waters, wines or spirits, for marking such goods not originating from this place as well as if the translation is used or the designation is accompanied by the expressions like “of kind”, “of sort”, “like” or others;

4) contrary to the public interest, humanity and morality principles.

#### **Article 7. Other grounds for refusal of registration of a trademark**

1. The designations may not be registered as trademarks that are identical or confusingly similar to:

1) with trademarks registered in the Republic of Kazakhstan and protected by international treaties with an earlier priority in the name of another person in respect of similar products or services or with identical trademarks of the same person in relation to the same

products or services, except for the trademarks the registration of which is recognized as invalid or which is terminated in accordance with Chapter 6 of this Law;

2) trademarks acknowledged well-known in accordance with the established practice in the Republic of Kazakhstan in regard to any kind of goods and services;

3) with designations, declared for registration with an earlier priority in the name of another person in respect of similar products or services (except for withdrawn and terminated) or with identical designations of the same person in relation to the same products or services;

5) appellation of origin protected in the republic of Kazakhstan in regard to any goods unless they may be incorporated as unprotected elements of the trademark registered in the name of the owner of right to use this appellation of origin if the trademark registration is made in regard to the same goods for ascertainment of which the appellation of origin was registered.

Registration of a designation as a trademark in relation to homogeneous products or services similar to the point of confusion with any of the trademarks specified in subparagraphs 1), 2) and 3) of part one of this paragraph, shall be allowed subject to the written consent of the owner of a trademark.

If the owner is a legal entity, then a written consent must be submitted on the letterhead, signed by an authorized person and sealed with the seal of the legal entity (if any), and if the owner is an individual, then the signature must be notarized.

2. Designations shall not be registered as trademarks if they reproduce:

1) industrial designs protected in the Republic of Kazakhstan in the name of other parties on condition of their earlier priority;

3) names of works of literature, science and art, known pieces of art and their fragments widely known in the Republic of Kazakhstan as of the date of filing an application when violating the copyrights;

4) surnames, forenames, pen-names and their derivatives, portraits and facsimiles when

violating personal non-property rights of these individuals, their heirs or successors as well as if these designations form part of the historical and cultural heritage of the Republic of Kazakhstan and are reproduced without permission of the appropriate authorized body.

**Rules on Examination of Applications for Trademarks, Service Marks, Geographical Indications and Appellations of Origin (Annex 3 to the Order of the Minister of Justice of the Republic of Kazakhstan dated 29 August 2018 No. 1349)**

**Unprotected elements (disclaimer)** - granting protection to a trademark as a whole with removal from protection of non-protectable elements of designation.

**Kind of goods** - a set of goods that differ in their individual purpose and characteristics.

**Quality of goods** - a set of consumer properties of a product that determine its suitability to meet current and future needs in accordance with its purpose.

**Purpose of goods** - the field of application of the goods, its functions, the circle of consumers.

**Characteristic of goods** - the properties, physical and non-physical characteristics of the product, manifested in the process of purchasing and using the product for its intended purpose, that affect the buyer.

**Value of goods** - a characteristic of a product that indicates its importance and usefulness to the consumer.

**Quantity of goods** - a category that characterizes goods in terms of size, weight, volume, number.

**Time of manufacture or distribution of goods** - an indication in the designation of the day, month, year or date in general, which indicate the time of production of the goods, the transition of the goods from the manufacturer to the consumer.

**Descriptive designations** include designations that describe a product or service as a whole or any of its characteristics and (or) features.