

大成 DENTONS

Intellectual Property and Information Technology



Dentons' Kazakhstan Intellectual Property practice will select the right options to suit your business needs, whether you are assessing an IP portfolio, performing due diligence for an acquisition, securing a patent, trademark, trade secret or copyright or need to resolve a dispute through litigation or other means.

We are uniquely positioned to help, with a full-service IP practice that is integrated with other practices, providing you with comprehensive and tailored legal solutions. Our enviable track record includes representing entrepreneurs, artists, public institutions, emerging companies and global corporations.

We are pioneers in researching cloud computing regulation in Kazakhstan. Given that there are no special (complex) regulations regarding cloud computing in the country, a set of normative acts are applicable, which requires a thorough knowledge of the national security law, personal data law, law on banks and banking activity, informatization, etc.

Overview

The leading legal practice in Kazakhstan

The leading legal practice in Kazakhstan. Dentons is the only international law firm with a full-service IP practice in Kazakhstan. It comprises five professionals: a Partner, two lawyers, including a qualified Patent and Trademark Attorney of the Republic of Kazakhstan and two paralegals. Dentons' IP and TMT practice is recognized as Tier 1 in Kazakhstan, according to The Legal 500. In 2021, our practice was also included in the World Trademark Review (WTR 1000) ranking.

Wide list of services

We can assist you with IP protection (procedural issues of registration of the exclusive rights to items of intellectual property) and issues of IP enforcement at pre-litigation (including administrative proceedings with state bodies) and litigation stages. We have extensive experience with data protection cases, including personal data protection issues and protection of commercial information of companies. Because of our firm's strong antitrust practice, we can handle any IP claim related to unfair competition.

One stop-shop principle

Being part of a global law firm, we can represent the interests of our clients in intellectual property protection not only in Kazakhstan but also in other CIS countries (Armenia, Azerbaijan, Belarus, Kyrgyzstan, Tajikistan, Uzbekistan), as well as in Georgia, Ukraine and Turkmenistan.

Active participation in professional associations' activities

Our memberships in the International Trademark Association (INTA) and Kazakhstan Association of Patent Attorneys, as well as our active participation in formal discussions of draft IP laws, allows us to anticipate tomorrow's IP issues for our clients. We cooperate with the authorized body in the area of IP by participating in roundtables and seminars and through lecturing on IP rights enforcement and protection. The patent attorney of our practice participates in the work group of the Mazhilis (the lower house of the Republic of Kazakhstan's parliament) on discussion of amendments and additions to legislative acts on intellectual property issues.

Wide span of sectors of the economy

Our expertise spans many industries including, inter alia, leisure and hospitality, pharmaceutical and life sciences, FMCG, mining, telecommunications, entertainment, financial services and luxury consumer brands.

The "Rule of Law" Initiative

Dentons' lawyers participated in preparation of the manual on decision writing on intellectual property protection disputes. This manual was prepared as part of the American Bar Association's Legal Initiative Program.

Key service areas

- Advising on protection of intellectual property.
- Registering intellectual property (mainly trademarks, but also inventions, industrial designs, utility models, copyright objects).
- Representing clients' interests in disputes with respect to refusal and partial refusal of registration of intellectual property objects in the appellate instance of the Patent and Trademark Office of Kazakhstan and in court.
- Representing clients' interests in disputes related to violation of intellectual property rights before state bodies (in particular, financial police, justice authorities, competition authorities, customs authorities) and in court.
- Advising on issues related to intellectual property, including highly specific questions on customs clearance of goods containing intellectual property objects.
- Advising information technology and communications companies on various regulatory issues.
- Advising on personal information, private correspondence and information security, encryption, electronic commerce, service providers' liability and other technology-related issues.
- Advising on parallel imports issues.
- Conducting due diligence of intellectual property objects.
- Drafting assignment, license / sub-license, franchising agreements and agreements on transfer of undisclosed information (know-how), distribution agreements, author's agreements, works for hire agreements and other intellectual property agreements and documents relating to intellectual property objects (in particular, company internal policies with respect to works for hire and job descriptions for employees of a company creating intellectual property objects), and revising agreements to comply with Kazakhstan law.
- Contract negotiations.
- Recording intellectual property objects with the

We advise on the following IP items

- Copyright objects
- Related rights objects
- Means of individualization (trademarks, names of appellation of origin, firm names)
- Domain names
- Industrial property (inventions, patent designs, utility models)
- Undisclosed information or know-how



Representative experience¹

Intellectual property litigation

- **Major Kazakh telecom operator:**
Representing the client in a major dispute against an intellectual property rights collective management company. Dentons team assisted Kazakhstan's largest mobile operator in successfully resolving a US\$ 2 million intellectual property dispute.
- **Major European pharmaceutical company:**
Successfully representing the client in a trademark dispute in Uzbekistan. This was a landmark case in Uzbekistan showing the positive changes in the development of the court practice on IP rights protection in the country.
- **Leading international tobacco product manufacturer:**
Successfully representing the client in a criminal case against a company organizing a large-scale production of fake branded cigarettes to be sold in Kazakhstan and Kyrgyzstan.
- **Global energy drinks producer:**
Successfully representing the client in trademark enforcement actions in Kazakhstan and in a set of other countries (including, Georgia, Azerbaijan, Tajikistan, Uzbekistan, Kyrgyzstan, Turkmenistan). The mandate included trademark opposition and cancellation, customs recording, licensing of trademarks and trademark infringement.
- **Major Russian extractor of natural gas:**
Successfully representing the client in a court dispute with the Intellectual Property Rights Committee of the Ministry of Justice of the Republic of Kazakhstan, challenging the Committee's refusal to register the client's trademarks in Kazakhstan.
- **Multinational dairy products corporation:**
Successfully representing the clients in court against a Kazakhstan dairy products company for the illegal use of the clients' trade name and trademark.
- **Kazakhstan bank:**
Successfully representing the client in a court dispute with the Ministry of Justice, where registration of common terms as a part of trademarks of a third party was challenged.
- **Beer-producing company:**
Successfully representing the client in a court dispute with the Ministry of Justice, challenging the decision to cancel the client's trademark in Kazakhstan on the basis of non-use.
- **French multinational pharmaceutical company:**
Representing the client in the first patent litigation in Kazakhstan, where the right of after-use was claimed.
- **Multinational Finnish communications and information technology corporation:**
Assisting in a country-wide fight against the sale of counterfeit goods and grey imports, representing in administrative cases.
- **Kazakhstan music publishing company:**
Representing the client in a dispute with a mobile network operator and content provider over the rights to ring tones and ring-back tones.

¹ The firm maintains client confidentiality, and client names are not disclosed here. The list of Dentons' clients includes major players in the Kazakhstan market, including Fortune Global 500 corporations, operating in all industry sectors and investment areas

Trademark prosecution

- **American energy drinks producer:**
Assisting in successfully challenging two confusingly similar trademark registrations owned by a Russian company.
- **Multinational telecommunications, information technology, and consumer electronics company:**
Successfully representing the client in a trademark infringement against the brand owned by the infringer in the CIS countries (Tajikistan, Uzbekistan, Kyrgyzstan, Turkmenistan).
- **Multinational oil and gas company:**
Successfully representing the client in a trademark and firm name dispute with a local chain of filling stations.
- **European watch producer:**
Advising with respect to an office action related to client's trademark.
- **Major FMCG tobacco, manufacturing companies:**
Trademark filing and prosecution services.
- **Multinational footwear and clothing manufacturer:**
Representing the client's interests in an extra-judicial instance, in the Appellate Council under the Intellectual Property Rights Committee in particular; successful appeal of refusal to register the trademark of the client in Kazakhstan, which included gathering evidence of the use of the trademark in Kazakhstan, Russia and worldwide; conducting an opinion poll among consumers in Kazakhstan on the perception of the trademark; eliminating false information about the trademark on Wikipedia; investigating perception of the trademark on the Internet.

Intellectual property counselling

- **American multinational hospitality company:**
Assisting the client with IP restructuring: drafting, negotiating, revising, registration of the license/ assignment/ franchise agreement in Kazakhstan.
- **Multinational media company:**
Advising on mass-media regulation in Kazakhstan (regulation of foreign TV channels in Kazakhstan).
- **Multinational telecom corporation:**
Advising on the potential legal and regulatory concerns that might arise in relation to the use of client's service in Kazakhstan (licensing, National Security Law requirements etc.).
- **International retail coffeehouse chain company:**
Assisting the client in Kazakhstan with intellectual property matters, namely franchising of coffee shops, and potential dispute on debt recovery.
- **Russian software provider:**
Advising the client in connection with building and selling to cellular companies of a platform combining software and mobile content for provision of value-added services in Kazakhstan and other CIS countries. Our advice included a wide range of legal matters, including use of copyright and related rights items for making mobile content, liability of informational intermediaries, etc.
- **French multinational pharmaceutical company:**
Representing the client in drafting proposed amendments to Kazakhstan's regulation on generics aimed at preventing patent infringement.
- **UK manufacturer and retailer of luxury mobile phones:**
Transaction support on the assignment of a trademark from a local distributor of the client to a multinational communications and information technology corporation and further licensing of the named trademark to a local distributor, drafting all necessary agreements/documents.

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ABOUT DENTONS

Dentons is the world's largest law firm, connecting talent to the world's challenges and opportunities in more than 75 countries. Dentons' legal and business solutions benefit from deep roots in our communities and award-winning advancements in client service, including Nextlaw, Dentons' innovation and strategic advisory services. Dentons' polycentric and purpose-driven approach, commitment to inclusion and diversity, and world-class talent challenge the status quo to advance client and community interests in the New Dynamic.

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