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Naphtyzinum: 'Soviet' Trademark or Public Interest?

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In Kazakhstan's judicial practice there are growing disputes related to the early termination of legal protection for trademarks that have come into common use for the designation of goods of a certain type by virtue of Article 6.1.1 of the Law of the Republic of Kazakhstan 'On Trademarks, Service Marks and Appellations of Origin of Goods' No. 456-I, dated 26 June 1999 (hereinafter - the 'Trademark Law'). This trend is most likely due to the fact that in Kazakhstan, like in neighbouring states, there is a 'battle' for Soviet (retrospective) trademarks between the copyright holders, who registered the trademark rights, and actual users, who did not manage to do this after Kazakhstan gained independence.

In this article we would like to share our expert opinion and give a legal assessment of the judicial acts that have entered into legal force and which turned the trademarks (names) of well-known medicines into the common use designations. To make it more understandable, we suggest replacing "designation that has come into common use to designate goods of a certain type" with the wording 'common designation' throughout the text.

First, let us consider what is a 'common designation'. Pursuant to the Rules for the Examination of Applications for Trademarks and Appellations of Origin (Appendix 3 to the Order of the Minister of Justice of the Republic of Kazakhstan No. 1349, dated 29 August 2018), this term is defined as follows: 'a common designation, is a designation that became an indication of a certain products type, i.e., a generic notion, as a result of its long-term use by various manufacturers for the same product or the same product type.' In other words, the transition of a trademark into a common designation is a consequence of the widespread use of the trademark by various business entities for a long time, when manufacturers and consumers cease to treat a particular designation as a trademark. The trademark loses its distinctive ability and is transformed from an individual designation into a generic one. As an example, we can cite the well-known notions: THERMOS, ESCALATOR, LINOLEUM, SCANNER, JEEP, MAYONNAISE, WINCHESTER, etc.

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