# ANNOTATION

**dissertation of Kalmyrza Gaziza for the degree of Doctor of Philosophy (PhD) in the specialty «8D04201 – Jurisprudence»**

**Dissertation topic:** "Current Issues of Legal Protection of Trademarks in the Republic of Kazakhstan"

**Objective of the Dissertation Research.** The aim of this dissertation is to study the legislation and practice in the field of legal protection of trademarks in the Republic of Kazakhstan through a comprehensive theoretical and legal analysis, and to develop proposals for improving the mechanisms of legal protection of trademarks, taking into account international experience.

**Research tasks:**

To achieve the stated objective, the following tasks were set:

1. To analyze the types and disclose the content of means of individualization, with a focus on trademarks;
2. To determine the level of protection of trademarks, including in the Internet environment;
3. To conduct a comparative legal analysis of international and national practices related to legal remedies against the unlawful use of trademarks;
4. To examine and analyze judicial practice concerning legal disputes related to the unlawful use of trademarks;
5. To develop recommendations for the further development and improvement of the current legislation of the Republic of Kazakhstan related to the legal protection of trademarks;
6. To identify ways of addressing current issues in the legal protection of trademarks in the Republic of Kazakhstan, taking into account modern foreign experience.

**The methodological framework of the research** is based on general scientific and special legal methods of cognition used in legal science. During the study, the dialectical method was widely applied, which made it possible to examine legal phenomena arising in the process of the development of exclusive rights to trademarks, taking into account their interrelationships and internal contradictions. In addition, this method formed the basis for the study of the evolution of legislation in the field of legal protection of trademarks.

The method of system-structural analysis used in the study enabled the author to determine the place of the institution of trademark protection within the legal system, as well as to reveal its internal organization by identifying key elements and stable interconnections between them. It should be emphasized that this method allowed for a comprehensive understanding of the institution under study as an integral part of the legal system functioning in interaction with other legal institutions.

Another significant method of scientific inquiry applied in the research was the comparative legal method. Through its use, the author analyzed, in a comparative

context, legislative provisions, judicial practice, and legal mechanisms existing in foreign jurisdictions in comparison with those of the Republic of Kazakhstan. In particular, the study compared the relevant aspects of the Republic of Kazakhstan, the EAEU member states, the European Union, as well as such countries as China, the United States, and Japan. Owing to the application of this method, similarities and differences in approaches to the legal protection and enforcement of trademark rights were identified. Moreover, it made it possible to determine the specific features of the national model of trademark protection in Kazakhstan, including in the context of prevailing international trends. The research identified the most effective legal constructs and mechanisms used in the aforementioned foreign jurisdictions, which provided a basis for formulating proposals aimed at improving the legislation of the Republic of Kazakhstan with due regard to best foreign practices and standards.

Within the scope of the conducted research, the formal legal method was also widely employed, enabling the author to carry out a theoretical and dogmatic analysis of the provisions of the current regulatory legal acts governing the relevant field. Subsequently, the author assessed the content of the examined norms, their internal structure, identified their logical consistency, and determined the degree of coherence between them.

In analyzing judicial practice, as well as certain factual circumstances indicating infringements in the field of trademark protection, and in examining quantitative indicators characterizing the dynamics of trademark registration, the author applied expert and statistical methods. This made it possible to comprehend the existing law enforcement practice and, as a result, to identify problematic aspects of trademark protection. Taken together, these methods allowed for the correlation of theoretical provisions with contemporary law enforcement practice.

For the purposes of systematizing and classifying the identified problems, as well as determining causal relationships between the elements of the legal institution examined in this dissertation, logical and deductive methods of scientific cognition were applied. The use of these methods also made it possible to formulate a consistent and well-reasoned scientific analysis. In particular, the deductive method formed the basis for the transition from general theoretical propositions to specific conclusions and practical recommendations, while logical techniques such as analysis, synthesis, generalization, and abstraction ensured the depth and structured nature of the dissertation research.

The comprehensive set of methods selected by the author ultimately made it possible, upon completion of the dissertation research, to formulate well-substantiated conclusions and recommendations of both theoretical and practical significance, aimed at improving the current legislation of the Republic of Kazakhstan and law enforcement practice in the field of trademark protection.

**Main Provisions (Proven Scientific Hypotheses and Novel Findings Submitted for Defense):**

1. The necessity of forming a comprehensive mechanism of legal regulation for the use of generative artificial intelligence systems in the creation of trademarks has been substantiated through the adoption of a special “State Program for the

Development and Implementation of AI Technologies in the Field of Intellectual Property."

The proposed state program should provide for the development and normative consolidation of unified requirements for the content of the initial task (prompt) used for generating designations claimed as trademarks. This should include criteria of registrability, distinctiveness, the absence of similarity to the extent of confusion with previously registered means of individualization, as well as mechanisms for preliminary verification of the generated designations for compliance with the exclusive rights of third parties.

2. The current national legislation of the Republic of Kazakhstan protects the results of exclusively human creativity. However, the expansion of the use of artificial intelligence (AI) technologies, including in the creation of intellectual property objects, raises the issue of determining the holder of exclusive rights to results created in this manner, since a unified legal regime for such objects is currently absent. In this regard, there is an objective need to develop special legal mechanisms.

Accordingly, it is proposed to supplement Article 125 of the Civil Code of the Republic of Kazakhstan with a new paragraph and to state it as follows:

"Paragraph 3. The exclusive right to intellectual property objects created using artificial intelligence shall belong, unless otherwise provided by law or contract, to the legal entity or individual that is the owner of the AI system, or to the person at whose initiative the relevant object was created.

A trademark created using artificial intelligence must bear a warning label in the form of the verbal designation 'RAI' inside a circle, indicating its registration in the Republic of Kazakhstan" (Appendix A).

3. In order to harmonize the national legislation of the Republic of Kazakhstan with the international TRIPS standards and the law of the Eurasian Economic Union (EAEU), it is proposed to supplement paragraph 1 of Article 5 of the Law of the Republic of Kazakhstan "On Trademarks, Service Marks, Geographical Indications, and Appellations of Origin of Goods" with the following wording:

"As trademarks, figurative, verbal, letter, numeral, three-dimensional, sound, olfactory, and holographic signs or their combinations may be registered, provided that they make it possible to distinguish the goods and services of one person from homogeneous goods or services of other persons."

4. In order to improve the legal mechanisms for the protection of well-known trademarks, it is proposed to amend Article 20 of the Law of the Republic of Kazakhstan *"On Trademarks, Service Marks, Geographical Indications, and Appellations of Origin of Goods"* by introducing a warning marking for well-known trademarks. In particular, it is proposed to grant the owner of a well-known trademark the right to use a warning marking in the form of the Latin letter "R" inside a circle with the addition of an asterisk symbol (Appendix A).

5. It is proposed to supplement paragraph 3 of Article 3 of the Law of the Republic of Kazakhstan "On the Judicial System and the Status of Judges" with the words *"in intellectual property cases"* and to state this paragraph as follows:

*"3. Other courts may be established in the Republic of Kazakhstan, including cassation and specialized courts (military, financial, economic, administrative, juvenile courts, courts for intellectual property cases, and other specialized courts)."*

6.In order to improve the legal regulation of marketplace operations and to counteract the sale of goods infringing trademark rights through marketplaces, it is necessary to:

– normatively establish the obligation of marketplace platform owners to monitor the placement of goods bearing trademarks, including mandatory verification against lists of restricted brands and the request for documents confirming the lawful use of trademarks;

– establish specific sanctions for untimely responses to claims submitted by rights holders, ensuring a balance of liability between sellers and platforms;

– introduce a system of electronic registration and accounting of trademarks in e-commerce to simplify confirmation of their lawful use.

7.The expansion of digitalization processes and the transfer of trade in trademarked goods into an electronic format through various websites and platforms lead to the abandonment of physical trading locations by sellers, which contributes to the emergence of a gap in the legislatively закрепed definition of a "trading facility" and, consequently, to gaps in the legal regulation of trade organization.

In this regard, it is proposed to supplement Article 1 of the Law of the Republic of Kazakhstan "On the Regulation of Trading Activities" by clarifying the definition of a trading facility and equating marketplaces to it, setting out the definition as follows:

"27) trading facility – a building or part of a building, structure or part of a structure, a trading market, an automated device or a vehicle specially equipped with equipment intended and used for the display and demonstration of goods, customer service, and the execution of monetary settlements with customers during the sale of goods, as well as online platforms (marketplaces, electronic trading websites)."

At the same time, it is of fundamental importance to establish the obligation of the seller, when posting a product listing on an online platform, to indicate information confirming the lawful use of a trademark, either as its owner or on the basis of a license. Otherwise, the placement of such a product listing should be regarded as an infringement of the exclusive rights of the trademark owner and entail the imposition of sanctions on both the owner of the online platform (marketplace) and the seller of the goods.

**Description of key research results**: The research objectives set in the dissertation were fully achieved, namely: the types of means of individualization were analyzed and their content was revealed; the level of trademark protection in the online environment was determined; a comparative legal analysis of international and national

practices related to measures for legal protection against unlawful use of trademarks was conducted; judicial practice in legal disputes concerning unlawful use of trademarks was analyzed; proposals were developed for the further development and improvement of the current legislation of the Republic of Kazakhstan related to trademark protection; and solutions to current issues of legal protection of trademarks in Kazakhstan were identified, taking into account contemporary international experience.

**Novelty and significance of the results:** The dissertation represents the first monographic study written in the state language, aimed at the further development and improvement of the national legal system through a comprehensive study of legal regulation, judicial practice, and international experience in the field of trademark protection during the period of intensive digitalization.

The scientific novelty of the dissertation lies in the legal regulation of trademarks created with the use of artificial intelligence and the introduction of preventive marking for such trademarks, the implementation of preventive marking for well-known trademarks, clarification of the responsibilities of sellers and marketplace platform owners in cases of counterfeit goods being traded on marketplaces, proposals for the creation of specialized courts to handle intellectual property disputes, and the introduction of holographic trademarks.

The theoretical significance of the study broadly lies in its comprehensive coverage of issues related to trademark protection. It is based on an in-depth analysis of the national legislation of the Republic of Kazakhstan, international legal acts, scholarly literature, information resources, and judicial practice.

**Compliance with scientific development directions or state programs:**
The dissertation was carried out in accordance with the goals and objectives set forth in the Concept for the Development of Higher Education and Science in the Republic of Kazakhstan for 2023–2029, approved by the Resolution of the Government of the Republic of Kazakhstan No. 248 dated March 28, 2023, in the Concept for the Protection and Development of Competition in the Republic of Kazakhstan for 2022–2026 dated June 22, 2022, in the National Development Plan of the Republic of Kazakhstan until 2029, as well as in the “Kazakhstan-2050: New Political Course of the Established State” Strategy.

**Description of doctoral candidate’s contribution to publications:**
The candidate’s personal contribution is reflected in the independent research, collection, discussion, and synthesis of scientific results, which were confirmed in the doctoral candidate’s published works, as well as in proposals for the improvement of legislation. The main theoretical ideas, conclusions, and practical recommendations of the dissertation are presented in nine scientific articles, including: one publication in an international journal indexed in the Scopus database; four publications in scientific journals recommended by the Committee for Quality Assurance in Science and Higher Education of the Ministry of Science and Higher Education of the Republic of Kazakhstan; and four publications in the proceedings of international conferences.