

Law on Amendments to the Law on Trademarks

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Article 1

In the Law on Trademarks (*Official Gazette of Montenegro*, No 72/10), in the heading of Article 5, in Article 5 paragraphs 1, 3, 4, 6 and 8, and in Article 63 paragraph 3, the word "Records," in all of its noun cases, shall be replaced by the word "Register" in the appropriate case form.

Article 2

Paragraph 2 of Article 20 shall be deleted.

Paragraph 3 in the current law shall become paragraph 2.

Article 3

Following Article 26, a new article shall be added to read as follows:

„Application Filing Date

Article 26 a

The date of filing an application containing the elements and information referred to in Article 20 paragraph 1 items 1 to 4 of this Law shall be recognised as the date of filing the application to the competent authority.

Upon receiving the application, the competent authority shall examine whether the application contains the elements and information required for the recognition of the date referred to in Article 20 paragraph 1 items 1 to 4 of this Law.

If an application does not contain the elements and information referred to in Article 20 paragraph 1 items 1 to 4 of this Law, the competent authority is required to invite the applicant to remedy all the detected deficiencies within 30 days of receiving the notification.

If an applicant remedies all the detected deficiencies within the time limit referred to in paragraph 3 of this Article, the competent authority shall recognize as the date of filing of the application the date when the applicant rectified the shortcomings which were found.

If an applicant fails to remedy the detected deficiencies within the time limit referred to in paragraph 3 of this Article, the competent authority shall reject the application.

An application which contains the elements and information referred to in Article 20 paragraph 1 items 1 to 4 of this Law shall be entered by the competent authority in the Register of Applications with the date and time of filing and the application's number of entry in the Register. ”

Article 4

Article 27 shall be revised to read as follows:

„After entering it in the Register of Applications, the competent authority shall examine whether the application fulfils the requirements referred to in Article 20 paragraph 1 items 5 and 6 of this Law and contains all the elements and appendices prescribed by the regulation governing in detail the trademark recognition procedure.

If an application does not fulfil the requirements referred to in paragraph 1 of this Article, the competent authority is required to invite the applicant to remedy the detected deficiencies within 60 days of receiving the notification.

If an applicant remedies the detected deficiencies within the time limit referred to in paragraph 2 of this Article, the application shall be deemed to have been orderly from the date of its filing.

If an applicant fails to remedy the detected deficiencies within the time limit referred to in paragraph 2 of this Article, the competent authority shall reject the application.

At the request of the applicant, the time limit referred to in paragraph 2 of this Article may be extended by 60 days at most.

If an applicant does not submit the evidence required for the recognition of a priority right referred to in Articles 23 and 24 of this Law, the request for the recognition of a priority right shall be rejected.“

Article 5

In Article 42 paragraph 3 the words: “provided that the double amount of the required administrative fees be paid” shall be replaced by the words: “provided that the prescribed administrative fees be paid.”

Article 6

Article 49 shall be revised to read as follows:

“A trademark holder and/or applicant may file a request for the international recognition of a trademark, through a competent authority.

The request referred to in paragraph 1 of this Article shall be accompanied by the following:

- 1) a representation of the mark;
- 2) a list of good and/or services drawn up according to the International Classification of Goods and Services, written in the English language;
- 3) A power of attorney, if the request is filed through a representative;
- 4) Proof of payment of the required administrative fees.

If the request for the international registration of a trademark is not orderly, the competent authority shall notify the applicant in writing to remedy the detected deficiencies within a period of 30 days.

If the applicant fails to remedy the detected deficiencies within the time limit referred to in paragraph 3 of this Article, the competent authority shall reject the application.

If in accordance with the Madrid Agreement and the Madrid Protocol the request cannot be submitted to the competent authority, the request shall be rejected.

If the request is complete and if the prescribed administrative fees have been paid, the competent authority shall forward the application to the International Bureau.

The provisions of this Article shall apply accordingly to the filing of requests for subsequent designation and entry of changes in the International Register.

The contents of the request for international registration of a trademark and the request for the entry of changes in the international register, as well as evidence submitted with the request, shall be regulated by the Ministry.

Article 7

Three new articles shall be added after Article 49, to read as follows:

“Fees

Article 49 a

The fees payable in accordance with the Madrid Agreement and the Madrid Protocol shall be paid directly to the International Bureau.

Entry in the Trademark Register

Article 49 b

The date and number of the international trademark registration shall be entered in the Register, provided an international registration of the trademark has been effected based on an international application.

Transformation of an Internationally Registered Trademark into a National Trademark Application

Article 49 c

If by the date of deletion of an international registration from the international register all requirements prescribed by the Madrid Protocol for a transformation of an internationally registered trademark which is protected in Montenegro have been fulfilled, at the request of its holder the trademark shall be entered in the Register, provided the prescribed administrative fee for acquiring the trademark for a period of ten years and a duty for special costs for a publication of a recognised trademark have previously been paid.

The registration date of a national trademark effected by a transformation in accordance with paragraph 1 of this Article shall be the date of the international registration of the trademark which is the basis for the transformation.

An internationally registered trademark which is not protected on the territory of Montenegro until the date of the deletion of the international registration from the international register, in connection with which procedures and measures have been undertaken before the competent authority and which procedures and measures are in progress by the date of filing the request for transformation, shall be deemed an integral part of the of national trademark application procedure implemented in accordance with provisions of this Law.

The date of the national trademark application referred to in paragraph 3 of this Article proceeding from a request for transformation shall be the date of the international

registration of the trademark for which expansion of protection to the territory of Montenegro has been sought.”

Article 8

Article 50 shall be revised to read as follows:

“Provisions of this Law shall be applied to international registrations of trademarks whose protection has been expanded to the territory of Montenegro based on the Madrid Agreement and the Madrid Protocol, concerning questions not regulated by those compacts, unless prescribed otherwise by articles 50 a, 50 b and 50 c of this Law.”

Article 9

Three new articles shall be added after Article 50, to read as follows:

“Opposition to an International Trademark Registration

Article 50 a

The publication of the international registration of a trademark in the official journal of the International Bureau of the World Intellectual Property Organization shall be considered as the publication of the trademark registration in Montenegro.

The time limit for submitting an opposition to international registration of a trademark shall begin running from the first day of the month following the month marked on the issue of the official journal of the International Bureau of the World Intellectual Property Organization in which the international trademark registration was published.

If following an opposition to an international registration of a trademark a registration has been provisionally refused, the competent authority is required to notify the holder of the internationally registered trademark in writing about the provisional refusal, and invite the holder to appoint a representative, who is required to submit to the competent authority a power of attorney within four months of the date of receiving notice of the rejection.

A copy of the opposition shall be delivered to the representative following the submission of the power of attorney.

The time limit for submitting a response to the opposition shall be 60 days from the date of receipt by the representative of the copy of the opposition.

Refusing to Protect International Trademark Registration

Article 50 b

By exception from Article 28 paragraph 3 of this Law, for a holder of an international trademark registration the time limit for submitting evidence which could be of influence for the final decision of the competent authority shall be four months from the receipt of a written notice about the reasons for provisional rejection of registration.

If the holder of an international trademark registration referred to in Article 50 of this Law does not respond to the provisional notice of the competent authority on the intention to refuse validity of the mark in Montenegro, the competent authority shall issue a decision on refusing the validity of the trademark, which shall after its finality be submitted to the International Bureau.

Proving the Use of an Internationally Registered Trademark

Article 50 c

For the needs of proving the use of an internationally registered trademark in a procedure concerning an opposition, a legal action for a deletion of a trademark from the Register, or a legal action challenging the right to a trademark, the date of the international registration of the trademark shall be the date of expiry of a period of one year after the day following the date of receipt of notification from the International Bureau of the request to extend protection of an internationally registered trademark to the territory of Montenegro.

If at the expiry of the one-year time limit referred to in paragraph 1 of this Article the procedure in connection with a request to expand protection of an internationally registered trademark to the territory of Montenegro has not been completed, the date of international registration shall be the date when the competent authority notified the International Bureau of its final decision on granting protection.”

Article 10

Article 66 shall be deleted.

Article 11

This Law shall enter into force on the eighth day from the date of its publication in the *Official Gazette of Montenegro*.

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Podgorica, 26 July 2012

Parliament of Montenegro on its 24th convocation

Speaker of the Parliament,
Ranko Krivokapić (sgd.)