

Law on amendments and supplements of the Law on Trademarks

The Law is published in the "Official Gazette of Montenegro", No. 44/2012 from 9.8.2012.

Article 1

In the Law on Trademarks ("Official Gazette of Montenegro", No. 72/10) in the title of Article 5 paragraphs 1, 3, 4, 6 and 8, and in Article 63 paragraph 3, word "record", in different cases, shall be changed by the word "register" in the corresponding case.

Article 2

In Article 20, paragraph 2 shall be deleted.
Paragraph 3 shall become paragraph 2.

Article 3

Article 26 shall be followed by a new Article which shall read:

"The date for filing application

Article 26 a

The date for filing application which contains elements and details referred to in Article 20 paragraph 1 points 1 to 4 of the present Law shall be recognized as the date for filing application to the competent authority.

Upon receipt of the application, the competent authority shall examine whether the application contains the elements and the details for recognition of the date referred to in Article 20 paragraph 1 points 1 to 4 of the present Law.

If the application fails to contain the elements and the details referred to in Article 20 paragraph 1 points 1 to 4 of the present Law, the competent authority shall notify the applicant to remedy the detected deficiencies, within the period of 30 days from the date of the receipt of such notification.

If the applicant remedies the detected deficiencies within the time period referred to in the paragraph 3 of the present Article, the competent authority shall recognize the date when the applicant has remedied the detected deficiencies as the date for filing application.

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

The application which contains the elements and the details referred to in Article 20 paragraph 1 points 1 to 4 of the present Law shall be entered by the competent authority into the Register of Applications with the date and time for filing and number of the entry of the application into the Register."

Article 4

Article 27 shall be amended and shall read:

"After entry of the application into the Register of Applications, the competent authority shall examine whether the application fulfils the conditions referred to in Article 20 paragraph 1 points 5 and 6 of the present Law, and whether it contains all elements and appendices prescribed by the regulation which defines more closely the procedure for granting trademark.

If the application fails to fulfill the conditions referred to in the paragraph 1 of the present Article, the competent authority shall notify the applicant to remedy the detected deficiencies within 60 days from the date of the receipt of such notification.

If the applicant remedies the detected deficiencies within the time period referred to in paragraph 2 of the present Article, it will be considered that the application was complete on the date when filed.

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

Upon the request of the applicant, the time period referred to in paragraph 2 of the present Article may be prolonged for max. 60 days.

If the applicant fails to submit the proofs for granting priority right referred to in Articles 23 and 24 of the present Law, the request for granting priority right shall be rejected."

Article 5

In Article 42 paragraph 3, the wording: "provided that the double amount of the required administrative fee be paid" shall be substituted by the wording: "provided that the prescribed administrative fee is paid".

Article 6

Article 49 shall be amended and shall read:

"A trademark holder and/or applicant may file a request for the international registration of a trademark through a competent authority.

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

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

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

If the applicant fails to remove the detected deficiencies within the time period referred to in the paragraph 3 of the present Article, the competent authority shall reject the request.

If the request is not in consistency with the Madrid Arrangement and Madrid Protocol 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 submit the application to the International Bureau.

The provisions of the present Article shall be applied to the filing request for subsequent designation and for entry of the changes into the International Register.

The Ministry shall prescribe the content of the request for international registration of the trademark and of the request for entry of changes into the International Register, as well as the proofs accompanying the requests.

Article 7

Article 49 shall be followed by three supplemented Articles which shall read:

"Fees

Article 49 a

The fees to be paid in consistency with Madrid Arrangement and Madrid Protocol shall be paid directly to the International Bureau.

Entry into the Register of Trademarks

Article 49 b

The date and the number of the international registration of a trademark shall be entered into the Register, provided that the international registration of the trademark has been made under the international application.

Transformation of the internationally registered trademark into the national trademark application

Article 49 c

If all the conditions prescribed by Madrid Protocol for transformation of the internationally registered trademark which is protected in the territory of Montenegro into the national trademark have been met until the date of deletion of the international registration from the International Register, such trademark shall, under

the request of its holder, be entered into the Register, provided that the administrative fee for gaining trademark for the period of 10 years and the fee for specific costs for publication of the granted trademark have been previously paid.

The date of registration of the national trademark composed by transformation, as per paragraph 1 of the present Article, shall be the date of the international registration of the trademark which construes the basis for transformation.

Internationally registered trademark which is not protected in the territory of Montenegro until the date of the deletion of its international registration from the International Register, in relation to which the procedures and the measures have been undertaken before the competent body and which until the date of submission of request for transformation are underway, shall be deemed as integral part of the procedure of national trademark application conducted in accordance with the present Law.

The date of national trademark application referred to in paragraph 3 of the present Article which arises from the request for transformation shall be the date of international trademark registration for which the extension of the protection has been requested for the territory of Montenegro."

Article 8

Article 50 shall be amended and shall read:

"The provisions of the present Law shall be applied to the international registrations of trademarks whose protection has been extended onto the territory of Montenegro under Madrid Arrangement and Madrid Protocol in relation to issues which are not regulated by such contracts, unless otherwise prescribed by the provisions of Articles nos. 50 a, 50 b and 50 c of the present Law."

Article 9

Article 50 shall be followed by three supplemented Articles which shall read:

"Opposition on international trademark registration

Article 50 a

Publication of international trademark registration in the Gazette of the International Bureau of the World Intellectual Property Organization shall be deemed as publication of the trademark application in Montenegro.

The time limit for submission of the opposition starts from the first day in the month following the month designated in the edition of the Gazette of the International Bureau of the World Intellectual Property Organization in which such international trademark registration has been published.

If the opposition has been preliminary refused under the opposition on international trademark registration, the competent authority shall notify in writing the holder of internationally registered trademark about preliminary refusal and invite him / her to nominate the representative who shall, within four months from the date of the notification of refusal, submit a power of attorney.

A copy of opposition shall be submitted to the representative upon the submission of the power of attorney.

The deadline for declaration onto the opposition shall be 60 days from the date of receipt of a copy of opposition by the representative.

Refusal of protection of international trademark registration

Article 50 b

Notwithstanding Article 28 paragraph 3 of the present Law, the deadline for the holder of international trademark to submit the proofs of the facts which could affect the final decision of the competent authority shall be four months from the date of the receipt of a written notification of the reasons for preliminary refusal of registration.

If the holder of the international trademark referred to in Article 50 of the present Law fails to provide declaration on preliminary notification of the competent authority about intention to refuse the validity of such trademark in Montenegro, the competent authority shall render the decision on refusal of the validity of the trademark, which shall finally be submitted to the International Bureau.

Proving usage of internationally registered trademark

Article 50 c

For the purposes of proving usage of internationally registered trademark in the procedure upon opposition, claim for deletion of the trademark or claim for denial of the right to trademark, the date for international trademark registration shall be the date when one year period, lasting from the date following after the date of the receipt of the notification of the International Bureau on request for extended protection of the internationally registered trademark in the territory of Montenegro, has expired.

If upon expiration of one year period referred to in paragraph 1 of the present Article, the procedure under the request for extension of protection of internationally registered trademark in the territory of Montenegro has not been finished, the date for international registration shall be the date when competent authority has informed the International Bureau about its final decision to approve the protection."

Article 10

Article 66 shall be deleted.

Article 11

The present Law shall enter into force on the eight day from the date of its publication in the 'Official Gazette of Montenegro'.

No. 07-2/12-1/5

EPA 866 XXIV

Podgorica, 26 July 2012

Parliament of Montenegro on its 24th convocation

Speaker of the Parliament,
Ranko Krivokapić (sgd.)