

Based on items 2, 3, 4 and 5 of the Decision on Declaration of the Independence of the Republic of Montenegro (RM Official Gazette No. 36/06), the Government of the Republic of Montenegro, at the session held on 20 September 2007 has adopted the following

## **REGULATION ON PROVIDING THE APPLICATION OF INTELLECTUAL PROPERTY RIGHTS\***

### **Article 1**

This Regulation shall govern the recognition of intellectual property rights granted by the Intellectual Property Office of Serbia and Montenegro (hereinafter referred to as: the Union Office) or the Intellectual Property Office of Serbia (hereinafter referred to as: the Serbian Office), rights deriving from applications pending before those Offices, and rights in works subject to copyright and related rights, rights registered through international registrations as well as rights deriving from international applications.

### **Article 2**

The intellectual property rights referred to in Article 1 of this Regulation shall be those established under the laws and international agreements governing copyright and related rights, patents, petty patents, designs, topographies of integrated circuits, trademarks and indications of geographical origin applicable in the Republic of Montenegro (hereinafter referred to as: Montenegro).

## **1. PATENT, PETTY PATENT, DESIGN AND TOPOGRAPHY OF INTEGRATED CIRCUITS**

### **Article 3**

Registration of any patent, petty patent, design or a topography of integrated circuit granted by the Union Office, as well as any changes or amendments thereto, before June 3, 2006, which is the effective date of the Decision on Declaration of the Independence of the Republic of Montenegro, shall be effective in Montenegro until the expiry of their respective terms of protection or the terms for which the maintenance fees have been paid for, as the case may be, subject to the provisions of the applicable laws, without any additional registration and without payment of any additional fees.

### **Article 4**

The provisions of Article 3 of this Regulation shall also apply to any patent, petty patent, design or topography of integrated circuit granted by the Union Office or the Serbian Office, as the case may be, on or after June 3, 2006, but prior to the

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commencement of operation of the Intellectual Property Office of Montenegro (hereinafter referred to as: Montenegrin Office).

### **Article 5**

Any rights deriving from an application for granting a patent, petty patent, design right or a topography of integrated circuit, pending before the Serbian Office at the time of commencement of operation of the Montenegrin Office, shall be recognized in Montenegro with the effect as of the date of filing of the application with the Union Office or the Serbian Office, as the case may be, or, in the case of international application which entered the national phase with either the Union Office or the Serbian Office as designated Office under the Patent Cooperation Treaty (hereinafter referred to as: PCT), as of the international filing date or, where applicable, as of the claimed priority date, provided that the applicant:

- 1) Files with the Montenegrin Office a request for the grant of the right, not later than six months after the commencement of operation of the Montenegrin Office;
- 2) Submits, together with the request, a copy of the application and of any attachment thereto, filed with the Union Office or the Serbian Office, as the case may be, with the certificate of receipt or, in the case of international applications which have entered the national phase with either the Union Office or the Serbian Office as designated Office under the PCT, submits the certificate of receipt of the application by the Office with which it was previously filed; and
- 3) Pays the prescribed fee.

Where the application referred to in paragraph 1 of this Article is complete, the Montenegrin Office shall continue the processing of the application under the provisions of the applicable law.

## **2. TRADEMARK AND INDICATION OF GEOGRAPHICAL ORIGIN**

### **Article 6**

The provisions of Articles 3, 4 and 5 of this Regulation shall apply to trademark registrations granted by the Union Office or the Serbian Office, as the case may be, and to applications for such registrations pending before the Serbian Office at the time of commencement of operation of the Montenegrin Office.

### **Article 7**

Any renewal of the registration of a trademark filed at or recorded by the Serbian Office on or after June 3, 2006, but prior to the commencement of operation of the Montenegrin Office, shall be valid in Montenegro.

Renewal procedures pending before the Serbian Office at the time of commencement of operation of the Montenegrin Office may be concluded before the Serbian Office, and the resulting renewed registration shall be valid in Montenegro as provided under Article 6 of this Regulation.

After the commencement of operation of the Montenegrin Office, renewals of trademark registrations shall be applied for and recorded as provided by the applicable law. The Montenegrin Office shall establish a record for the mark on the basis of the record in the appropriate register of the Serbian Office, or on the basis of the trademark certificate from the Serbian Office that shall be submitted together with the application for the trademark renewal.

#### **Article 8**

Any appellation of origin or geographical indication registered directly with the Union Office or the Serbian Office prior to the commencement of operation of the Montenegrin Office shall be valid in Montenegro with the effect as of the date of filing of the appropriate application with the Union Office or the Serbian Office, as the case may be.

Any amendment to the registration of an appellation of origin or geographical indication referred to in paragraph 1 of this Article, made after the commencement of operation of the Montenegrin Office, shall be recorded with this Office, upon the submission of the certificate issued by the Serbian Office and payment of the prescribed fee.

### **3. COPYRIGHT AND RELATED RIGHTS**

#### **Article 9**

Any rights deriving from the deposit in the Union Office or the Serbian Office of works subject to copyright and related rights prior to the commencement of operation of the Montenegrin Office shall be valid in Montenegro.

Any copyright and related rights that came into existence prior to June 3, 2006 by virtue of the laws of the State Union Serbia and Montenegro or of treaties binding on Montenegro shall be valid in Montenegro and shall remain effective until the expiry of their term of protection, as provided under the applicable law.

### **4. INTERNATIONAL REGISTRATIONS UNDER THE MADRID AGREEMENT AND THE PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

#### **Article 10**

International registrations under the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as the Madrid Agreement) or the Protocol Relating to that Agreement (hereinafter referred to as the Protocol), which contain a territorial extension to the State Union of Serbia and Montenegro effective from a date prior to June 3, 2006 shall be effective in Montenegro subject to compliance with the procedure established in Rule 39 of the Common Regulations under the Madrid Agreement and the Protocol.

### **Article 11**

A mark that has been registered under the Madrid Agreement or the Protocol with a territorial extension to the Republic of Serbia, on or after June 3, 2006, but prior to December 4, 2006, shall be registered by the Montenegrin Office if the holder of the international registration:

- 1) Files with the Montenegrin Office an application for the registration of the mark, not later than six months after the commencement of operation of the Montenegrin Office;
- 2) Attaches with the application a proof of the international registration of that mark established by the International Bureau of the World Intellectual Property Organization (hereinafter referred to as: International Bureau), showing that the registration extends to the Republic of Serbia; and
- 3) Pays the prescribed fee.

The registration referred to in paragraph 1 of this Article shall have effect as of the date of the territorial extension to the Republic of Serbia, and the term of the registration shall be computed from that date.

Any intervening rights acquired by third parties in respect of the use or exploitation of a sign identical with or similar to the mark prior to the registration shall be taken into consideration.

The scope, term, maintenance and validity of the registration under the Madrid Arrangement and the Protocol shall be governed by the applicable law that governs trademarks.

## **5. INTERNATIONAL REGISTRATIONS UNDER THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS**

### **Article 12**

International registrations under the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as the Hague Agreement), which contain a designation of the State Union of Serbia and Montenegro, effective from a date prior to June 3, 2006, shall be valid in the Montenegro with the effects prescribed in the Hague Agreement.

### **Article 13**

Any design that has been registered under the Hague Agreement designating the Republic of Serbia on or after June 3, 2006, but prior to December 4, 2006, may be registered in Montenegro if the holder of the international registration:

- 1) Files with the Montenegrin Office an application for the registration of a design, not later than six months after the commencement of operation of the Montenegrin Office;

- 2) Attaches with the application a proof of the international registration of that design established by the International Bureau, showing that the registration designates the Republic of Serbia; and
- 3) Pays the prescribed fee.

The registration of a design under paragraph 1 of this Article shall have effect as of the date of the international registration, and the term of the registration shall be computed from that date.

Any intervening rights acquired by third parties in respect of the use or exploitation of a design prior to the registration shall be taken into consideration.

The scope, term, maintenance and validity of the registration under the Hague Agreement shall be governed by the applicable law that governs legal protection of designs.

## **6. INTERNATIONAL REGISTRATIONS UNDER THE LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION**

### **Article 14**

International registrations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, which were effective in the State Union of Serbia and Montenegro prior to June 3, 2006, shall be valid in Montenegro with the effects prescribed in that Agreement.

## **7. INTERNATIONAL REGISTRATIONS UNDER THE PATENT COOPERATION TREATY**

### **Article 15**

Any rights deriving from the European patent applications and international applications under the PCT that have entered the European phase (hereinafter referred to as: European patent applications) and European patents extended to the State Union of Serbia and Montenegro or to the Republic of Serbia, as the case may be, in accordance with the Agreement between the Federal Government of the Federal Republic of Yugoslavia and the European Patent Organization on Co-operation in the Field of Patents ratified on June 15, 2004 shall have effect in Montenegro.

### **Article 16**

Articles 120 to 129 of the Patent Law shall apply *mutatis mutandis* to European patent applications and European patents provided that they are expressly referred to in this Regulation.

### **Article 17**

Any European patent extended to the State Union of Serbia and Montenegro or to the Republic of Serbia which has been granted upon a European patent application filed before June 3, 2006, shall be valid in Montenegro until the expiry of the term for which maintenance fees have been paid to the Serbian Office without any additional registration and without payment of any additional fees.

Any European patent extended to the State Union of Serbia and Montenegro or to the Republic of Serbia which has been granted upon a European patent application filed on or after June 4, 2006, but prior to the date of coming into force of a Co-operation and Extension Agreement between the Republic of Montenegro and the European Patent Organization shall be effective in the Republic until the expiry of the term for which maintenance fees have been paid to the Serbian Office and without any additional registration and without payment of any additional fees.

After the expiration of the term for which the maintenance fee has been paid to the Serbian Office referred to in paragraphs 1 and 2 of this Article, any subsequent extension of the term of protection shall be granted by the Montenegrin Office, which shall collect the maintenance fee.

### **Article 18**

Any European patent recognized under this Regulation shall have the effects and be subject to the changes identical to those in the Republic of Serbia.

Article 125 of the Patent Law shall apply *mutatis mutandis* to any extended European patent application or European patent recognized under this Regulation. The translations referred to in paragraphs 2 and 3 of Article 125 of the Patent Law shall be the translations filed with the Serbian Office.

Articles 126, 127 and 128 of the Patent Law shall apply *mutatis mutandis* to any extended European patent recognized under this Regulation.

### **Article 19**

Pending European patent applications for which extension to the Republic of Serbia has been requested and which are recognized under this Regulation shall have the effects and be subject to the changes identical to those in the Republic of Serbia.

Article 123 of the Patent Act shall apply *mutatis mutandis* to pending applications referred to in paragraph 1 of this Article. The translation referred to in paragraph 2 of Article 123 shall be made in the official language used in Montenegro and communicated by the applicant to the person using the invention in Montenegro.

## **Article 20**

Nationals or residents of Montenegro, as the case may be, may file international applications with the International Bureau as receiving Office under the PCT under Rule 19.1(a)(iii) of PCT as from June 3, 2006, and with the Montenegrin Office as receiving Office under the PCT as from the date of the commencement of operations of that Office.

Any international application filed in accordance with this Regulation shall have effect in accordance with PCT Article 11(3) and (4).

International applications filed before June 3, 2006, shall, if patent protection is desired in Montenegro, enter the national phase before the Montenegrin Office within:

- 1) the time limit under Article 22 or 39(1) PCT; or
- 2) six months after the date of the commencement of operations of the Montenegrin Office

In the case referred to in paragraph 3 of this Article the time limit that expires later shall apply.

## **8. ISSUANCE OF CERTIFICATES**

### **Article 21**

Any right holder may request the Montenegrin Office to be issued a certificate on validity of any rights under this Regulation.

The application referred to in paragraph 1 of this Article shall be accompanied by the certified copy of the application filed with the Union Office or the Serbian Office, or a certified copy of the European patent application extended to the State Union of Serbia and Montenegro or to the Republic of Serbia, as the case may be, and copies of any attachments thereto, a certified copy of the certificate of the right granted by the Union Office or the Serbian Office, or a certified copy of the European patent extended to the State Union of Serbia and Montenegro or to the Republic of Serbia, as the case may be, as well as the proof of the payment of the prescribed fee.

### **Article 22**

The date of commencement of the operation of the Montenegrin Office shall be publicized in the Official Gazette of the Republic of Montenegro, in one daily newspaper distributed in the territory of Montenegro and on the internet website of the Government of the Republic of Montenegro.

### **Article 23**

This regulation shall come into force on the eighth day after its publication in the Official Gazette of the Republic of Montenegro.