

Based on items 4 and 5 of the Decision on Declaration of the Independence of the Republic of Montenegro, 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 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 *mutatis mutandis* 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

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the 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:

- 1) pending before the Serbian Office at the time of commencement of operation of the Montenegrin Office, or,
- 2) in the case of an international patent 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), or,
- 3) in the case of an international patent application, which had not entered the national phase before the Serbian Office and for which on June 3, 2006, the time limit under PCT Article 22(1) or 39(1) had not yet expired,

shall be valid 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 as of the international filing date, provided that the applicant:

- 1) files with the Montenegrin Office a request for the registration of the right, not later than one year 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 patent applications, 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 *mutatis mutandis* 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 or recorded by at 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 relevant 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 copyright and related rights that came into existence prior to June 3, 2006 by virtue of the laws of the State Union of Serbia and Montenegro or of treaties binding on Montenegro shall be valid in Montenegro and remain effective until the expiry of their term of protection, in accordance with 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 aforementioned Agreement and 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 valid Montenegro, if it was not rejected by the Serbian Office.

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.

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 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 shall be valid in Montenegro until the expiry of its term.

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.

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 EUROPEAN PATENT CONVENTION AND THE PATENT COOPERATION TREATY

Article 15

Any rights deriving from 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 Organisation 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 Montenegro and the European Patent Organization shall be effective in Montenegro 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 same effects and be subject to the same changes to its effects as 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 in 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 same effects and be subject to the same changes to their effects as in the Republic of Serbia.

Article 123 of the Patent Law 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, shall file international applications with the International Bureau of the World Intellectual Property Organization (hereinafter referred to as: WIPO) as the receiving Office under the PCT under Rule 19.1(a)(iii) PCT as from June 3, 2006.

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

8. ISSUANCE OF CERTIFICATES

Article 21

Any right holder may, upon the payment of the prescribed fee, request the Montenegrin Office to be issued a certificate on validity of any rights subject to provisions of Articles 5, 6, and 7 of 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 of the Serbian Office,

with any attachments thereto, or the certified copy of the European patent application, as well as a proof of payment of the prescribed fee.

The certificate referred to in paragraph 1 of this article may take a form of a note attached to the certificate issued by the Union Office of the Serbian Office, as the case may be.

The proof of validity of any other rights under this Regulation shall be the certificate issued by the Serbian Office, or in the case of international trademark or international design, by the certificate issued by the International Bureau.

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 Montenegro.

Article 23

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