

Country Survey of Montenegro (ME)

Trademark Law

The Montenegrin Trademark Law entered into force on December 16, 2010. However, from its enactment, the Trademark Law has undergone significant changes through the Laws on Amendments of the Trademark Law which entered into force on August 9, 2012, April 19, 2014, June 30, 2016, January 10, 2017 as well as through latest Law on Amendments of the Trademark Law which entered into force on January 18, 2023.

The key matters regulated by the Law on Amendments from 2012 include international trademarks and their transformation into national registrations, opposition proceedings against international trademarks, registration of international trademarks and vulnerability for non-use. This Law on Amendments was enacted to harmonize Montenegrin Trademark Law with EU legislation. Provisions of the Montenegrin Trademark Law were aligned with the Directive 2008/95/EZ through the Law on Amendments.

The Law on Amendments from 2014 improved the status of well-known and famous trademarks in Montenegro, and introduced the possibility of invalidating generic trademarks that lack the necessary distinctiveness. It introduced the option of withdrawal, seizure and destruction of goods infringing somebody's intellectual property rights, defined monetary fines for trademark infringement and entitled trademark holders to claim damages for trademark infringement.

The Law on amendments from 2016 focused mainly on terminology and allowed for a more precise interpretation of the Trademark Law. It also introduced the possibility for a Licensee with prior approval of the trademark holder, holder of a personal name, portrait, copyright or other industrial property right to file an opposition claim.

The Law on amendments from 2017 addressed appeals. Prior to its enactment, the Montenegrin Ministry of Economy had competence to rule in the second instance and further appeals were brought before the Administrative Court. Since the amendments, appeals are all to be brought directly before the Administrative Court.

The newest Law on Amendments of the Law on Trademarks was published in the Official Gazette of Montenegro No. 3/2023 on January 10, 2023 and entered into force on January 18, 2023.

The aim of the recent amendments is to harmonise national legislation with the legislation of the European Union, namely Directive (EU) 2015/2436 of the European Parliament and the Council on harmonization of the legislation of member states on trademarks.

The most significant novelties introduced by the Law on Amendments are as follows:

- deletion of the condition that only a mark which can be represented graphically can be protected by a trademark;
- expansion of the list of absolute reasons for refusal and other relative grounds of refusal, i.e., invalidation of a trademark, in the part that refers to the protection of traditional expressions for wines, guaranteed traditional specialties and plant varieties;
- expansion of the scope of rights held by a trademark holder in relation to use of its right, in relation to goods in transit and preparatory actions related to the use of packaging or other means;
- changes in the procedures related to objections filed by third parties and oppositions to trademark registration before the competent authority;
- compliance with the provisions of the Singapore Treaty on the Law of Trademarks (with regard to continuation of proceedings, restitution in integrum, correction of errors and licenses);
- specification of the procedure for registration of collective marks, especially in relation to refusals thereof;
- more detailed calculation of terms for proving the use of international trademarks in opposition, invalidation or cancellation proceedings;

- changes in the proceedings for invalidation/cancellation of a trademark, as well as a change of the competent authority before which said procedures will be conducted, from the court to the competent administrative body;
- more detailed arrangement of the inspection supervision procedure and the procedure of destruction of temporarily seized goods;
- the provisions of the Law regulating administrative procedure now contain specifics that reflect the obligation to harmonize this area with EU law and international standards and regulate certain issues differently compared to the provisions of the Law on administrative procedure.

Montenegro is a member of the Madrid Agreement and the Madrid Protocol.

Classification

Nice classification, 12th edition

What is Registrable as a Trademark

A registrable trademark is a mark capable of distinguishing the goods or services of one undertaking (a legal or natural person) from those of other undertakings and being represented on the registry in a manner which enables to determine the clear and precise subject matter of the protection afforded to its holder.

A mark may consist of words, personal names, slogans, letters, numbers, pictures, drawings, colours, colour arrangement, product shape or product packaging, combinations of these signs, as well as sounds.

Trademarks may be individual and collective.

Registration Proceedings

The national application is filed at the Montenegrin IP Office (IPO).

Multiple-class applications are possible.

Foreign applicants need a local agent.

A simply signed power of attorney is sufficient – no legalization/notarization is required.

The application process includes a formal examination as well as an examination on absolute grounds of refusal.

If the formal requirements are not fulfilled (outlook of the mark, list of goods/services, complete information about the applicant and/or application form is missing), the IPO of Montenegro invites the applicant to submit the missing documents. The deadline for submitting the necessary documents is 30 days as from the receipt of the invitation (this term is not extendable). If the missing documents are submitted, the date of filing of the trademark application will be the date of fulfilling the formal requirements. If the requirements are however not fulfilled before the deadline, the application will be rejected. If the application is not accompanied by a valid Power of Attorney or proof of payment of the required fees, the IPO will issue an official action inviting the applicant to submit the necessary evidence within 30 days. This term may be extended an additional 30 days.

Upon filing and once the formality examination is completed, the new trademark application enters the Examination procedure in which absolute grounds of refusal are examined, while relative grounds are subject to opposition proceedings. Trademark applications in Montenegro are published for opposition purposes. If an opposition is not filed during the opposition period (90 days as from publication), or is rejected, the IPO invites the Applicant to proceed with the payment of the registration, 10-year protection and publication fees.

Opposition against a national trademark

The opposition period is 90 days from the date of publication of the trademark application in the Intellectual Property Gazette of Montenegro. This term is not extendable.

Opposition against designation of International Registrations

90 days counting as from the first day of the month following the month of the publication in the WIPO Gazette.

Duration

The trademark is valid for 10 years from the application date (respectively the date of the fulfilled formal requirements). There is a possibility to pay renewal fees for a further 10 years (and this action can be repeated unlimited number of times).

Grace Period for Trademark Renewal

The grace period for renewals is 6 months from the expiration date of the trademark (late renewal fees are subject to a 50% surcharge).

Use Requirements

According to the Trademark Law the trademark holder is obliged to use his mark, i.e., if, within a period of five years following the date of the completion of the registration procedure, the holder has not put the trademark to genuine use in Montenegro in connection with the goods/services for which it is registered, or if such use has been suspended during a continuous five-year period, the trade mark shall be subject to limits and sanctions unless there are justifiable reasons for non-use. Those limitations can be raised in opposition, invalidation, and proceedings for revocation due to non-use before the local IP office. An exception related thereto exists if the defendant requests a ban on the use of the trademark, then the trademark holder must furnish proof that, during the five-year period preceding the date of bringing the action, the trademark was in genuine use in connection with the goods or services in respect of which it is registered and which are cited as legal basis for the action, or that there are justified reasons for non-use, provided that at the date of bringing the action the trade mark was registered for at least five years.

Use of a trademark in a form that differs in terms of elements that do not change the distinctive features of the trademark, as well as placing of the trademark on goods or their packaging or services only for export purposes constitute valid use.

Use of the trademark with the consent of the trademark holder or a person authorized to use a collective trademark is considered as use by the trademark holder.

The date of commencement of the five-year period is entered in the Registry.

Application Fees (*please in local currency*)

The official fee for trademark application is EUR 60 for up to 3 classes and EUR 8 for each additional class or for a device mark. The registration fee is EUR 80 in up to 3 classes and EUR 13 for each additional class or device mark. Publication fees are EUR 10 for publication of the application and EUR 10 for publication of registration in up to 3 classes and EUR 3 for each additional class above the third, while the fee for issuance of the Decision on Grant is EUR 50. Renewal fees are EUR 80 for up to 3 classes and EUR 13 for each additional class or device mark.

Office(s)

Ministry of Economic Development and Tourism of Montenegro, Directorate of Internal Market and Competition, Intellectual Property Directorate (IPOM)

Bulevar Mihaila Lalića 1

81000 Podgorica

Montenegro

Tel +382 20 234 591

Fax +382 20 234 592

<https://www.gov.me/mek/is>