

Use Requirements Montenegro (ME)

1. Use for trademark registration

In Montenegro, use is not required for trademark registration.

2. Use for trademark renewal

In Montenegro, use is not required for trademark renewal.

3. Use in order to preserve rights in a trademark

According to the Article 17 of the Montenegrin 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.

If the holder of an earlier trademark does not prove use of the trademark in the period of five years preceding the date of publication of the opposed application in relation to the goods or services for which it is registered and on which the opposition is based or does not provide evidence of justified reasons for its non-use, the competent authority shall by decision reject the opposition.

In the invalidation proceedings based on a registered trademark with an earlier filing date or an earlier date of priority, upon request of the later trademark holder, the holder of an earlier trademark must prove that his trademark was in real use in relation to the goods or services for which it is registered and which it cites as reasons for invalidation request during the five-year period preceding the date of filing the invalidation request or that there are justified reasons for non-use, under condition that earlier trademark had been registered for at least five years on the date of filing the request for trademark invalidation.

The competent authority will not issue a decision on revocation of a trademark due to its non-use, if the use of the trademark had begun or was continued after the expiry of the five-year period of non-use of the registered trademark and before submission of a request for revocation of a trademark due to its non-use except if the commencement of continuation of use of the registered trademark occurred after the trademark holder had become aware that a request for revocation of his trademark will be submitted and if the use began or was continued within a period of three months before the submission of a request for the revocation of a trademark.

Invalidation and non-use revocation proceedings are reviewed by the IPO of Montenegro as the competent administrative body.

The procedure for invalidating a registered trademark can be initiated by the competent authority ex officio or at the request of interested parties if the applicant did not act in good faith when submitting the application. The invalidation request can be submitted by any interested person (natural or legal person, group or body that was established to represent the interests of producers, service providers, traders or consumers, who can sue and be sued in their own name).

The request for revocation due to non-use can be submitted by any interested party.

3.1 Burden of proof

If during opposition and invalidation proceedings, the holder of an earlier mark is invited to prove real use of his trademark on the territory of Montenegro, the burden of proof would be on the

holder of the earlier trademark. The burden of proof lies on the holder of the earlier trademark that is subject to the revocation proceedings.

3.2 Nature and extent of use

Use in Montenegro is required for goods/services for which the trademark is registered. There are no provisions in law as to nature and extent of use, but that the law does stipulate that use of a trademark in a form that differs in terms of elements that do not change the distinctive features of the registered trademark would also constitute genuine use as would placing the trademark on goods or their packaging only for export purposes.

It will not suffice to use a similar or related trademark or a mark which is registered in a different class.

Use by a licensee constitutes genuine use. Hence, even though the recording of a license is not mandatory, it is recommendable to record licenses, since in case of any dispute, it is easy to prove the use of trademark. Only recorded licenses have effect on third parties.

3.3 Means of demonstrating use

The Trademark Law does not prescribe what is to be considered as evidence of use. However, the parties involved in proceedings are entitled to submit all kinds of evidence and it is up to the responsible examiner from the local IPO to decide what is considered as valid evidence and who will base his/her decision on his/her evaluation of the submitted evidence. The evidential material should however contain information showing the period of use of the respective trademark.

3.4 Circumstances and time periods for excusable non-use

According to the Trademark Law, non-use may be excused upon existence of justified reasons, although the latter are not clearly defined. The grace period for use is five years as from the registration date.

4. Further relevant aspects or legal provisions with regard to use of a trademark

None

International Registrations

The Montenegrin Trademark Law does not make a difference between national trademarks and International Registrations regarding the period of use. Hence, legal provisions are the same for national trademarks and International Registrations with the difference related to the determining the registration date.

In order to prove the use of an internationally registered trademark in the procedures of opposition, invalidation or revocation, the date of publication of the statement of grant of protection of the Montenegrin designation of the international trademark registration in the Official Gazette of the International Bureau will be considered as the registration date.

If, within one year as from the date of the notification of the International Bureau on the request for the extension of the protection of the international registration on the territory of Montenegro, the competent authority has not notified the International Bureau of the preliminary refusal of protection, nor has it submitted a statement of grant of protection of the international trademark registration, the non-use period would be calculated from the first day after the expiration of that term.

If by the end of the mentioned period, the procedure for the extension of protection of an internationally registered trademark on the territory of Montenegro has not been completed, the

date of international registration is the date when the competent authority notifies the International Bureau of its decision to grant protection.