

Pursuant to Article 5 paragraph 8, Article 20 paragraph 3, Article 22 paragraph 3, Article 29 paragraph 2, Article 35 paragraph 4, Article 36 paragraph 7, Article 37 paragraph 4, Article 40 paragraph 6, Article 42 paragraph 10 and Article 49 paragraph 9 of the Law on Trademarks (*Official Gazette of Montenegro*, No. 72/10), the Ministry of the Economy has issued the following

REGULATION

ON THE PROCEDURE OF GRANTING, CHANGING, RENEWING AND INTERNATIONALLY REGISTERING TRADEMARKS

(Official Gazette of Montenegro, No. 50/11 dated 21 October 2011)

Subject Matter

Article 1

This Regulation defines in detail the contents and manner of keeping the Trademark Register and the application records, the detailed content of the application for the registration of a trademark, the content of the request for the issuance of a certificate of the priority right and the content of the certificate of the priority right, the content of the data from the application which are published in the Official Gazette, the detailed content of the data on the registration of a trademark which are published in the Official Gazette, the detailed content of the request for the division of a trademark and the documentation required to be submitted with the request, the content of the request to enter changes in the Trademark Register and the documentation required to be submitted with the request, the detailed content of the request for the entry of the transfer of a trademark and the documentation required to be submitted with the request, the content of the request for the renewal of the trademark and the documentation required to be submitted with the request, and the content of the request for the international registration of a trademark and the evidence required to be submitted with the request.

Detailed Content and Manner of Keeping the Application Record

Article 2

Besides the data referred to in Article 5 paragraph 3 of the Law on Trademarks (hereinafter: the Law), the following shall also be entered in the application records:

- 1) indications concerning the representative, if the application is being submitted through a representative;
- 2) indications concerning the joint representative, where there are several applicants;
- 3) indications concerning the requested priority right referred to in Articles 23 and 24 of the Law;
- 4) a designation of the colors, where protection is being requested for a trademark in color;
- 5) indication whether the registration is being sought of an individual trademark or of a collective trademark;
- 6) indication whether the registration is being sought for a verbal trademark, a figurative trademark, a three-dimensional trademark, a musical trademark, a trademark consisting of a single color or a combination of colors, or another type of trademark;
- 7) a transliteration of the trademark, if one is specified in the application;
- 8) a description of the trademark, if one is specified in the application;
- 9) a translation of the trademark, if one is specified in the application;
- 10) the date of publication of the application;

- 11) any alterations in the application referred to in Article 21 paragraph 5 of the Law;
- 12) indication concerning any opinion referred to in Article 30 of the Law which has been filed;
- 13) indication concerning the opposition which has been filed.

Besides the data referred to in paragraph 1 of this Article, where a request for the international registration of a trademark has been submitted, the number and date of filing of that request shall also be entered in the application records.

The Application Record shall be kept in electronic form and contain data prescribed by law and this Regulation.

Detailed Content and Manner of Keeping the Trademark Register

Article 3

Besides the data referred to in Article 5 paragraph 2 of the Law, the following shall also be entered in the Trademark Register:

- 1) indication concerning the representative, if the application is being filed through a representative;
- 2) indication concerning the joint representative, where there are several applicants;
- 3) indication concerning the recognized priority right: the date of the exhibition priority right, the date and number of the application which served as a basis for the recognition of an earlier priority right and the name of the country where that application had been filed;
- 4) a designation of the colors, where protection is being requested for a trademark in color;
- 5) indication whether the trademark is individual or collective;
- 6) indication whether the trademark is verbal, or figurative, or three-dimensional, or musical, or of a single color or a combination of colors, or another type of trademark;
- 7) a transliteration of the trademark, if one is specified in the application;
- 8) a description of the trademark, if one is specified in the application;
- 9) a translation of the trademark, if one is specified in the application;
- 10) indication concerning the changes relating to a trademark: transfer of rights, licenses, pledges, levy of execution and bankruptcy; changes of the name and address of the holder of the trademark, the licensee, or the pledge holder; a limitation of the list of goods and/or services, and other data of importance for the legal status of the trademark;
- 11) indication concerning the division of the trademark;
- 12) indication concerning the ceasing of the effect of the trademark, as well as the grounds for such ceasing of the effect of the trademark;
- 13) indication concerning the amendments of the general act on the collective trademark;

The Trademark Register shall be kept in electronic form and contain data prescribed by law and this Regulation.

Content of the Application for the Registration of a Trademark

Article 4

The request for the registration of a trademark, as a constituent part of the application, shall contain the following:

- 1) the name and address, or the title and the seat of the applicant;
- 2) indication concerning the representative, if the application is being submitted through a representative;
- 3) indication concerning the joint representative, where there are several applicants;
- 4) a representation of the trademark;
- 5) indication whether the application concerns an individual trademark or a collective trademark;
- 6) indication whether the application concerns a verbal trademark, a figurative trademark, a three-dimensional trademark, a musical trademark, a trademark consisting of a single color or a combination of colors, or another type of trademark;
- 7) specification of the colors, where protection is requested for a trademark in color;
- 8) a transliteration of the trademark, where the trademark contains elements written in a script which is not Latin or Cyrillic or numerals which are not Arabic or Roman;
- 9) indication of the class of the goods and services according to the International Classification of Goods and Services;
- 10) indication concerning the requested priority right referred to in Articles 23 and 24 of the Law;
- 11) evidence of payment of the prescribed application fee; and
- 12) the signature and seal of the applicant or the applicant's representative.

The request for the registration of a trademark may also contain the following:

- 1) a description of the trademark, if the applicant desires to explain its meaning; and
- 2) a translation of the trademark.

The applicant may submit to the competent authority an additional copy of the request referred to in paragraph 1 of this Article, which the competent authority shall deliver to the applicant with specification of the date or receipt as confirmation that the application has been received.

To the request referred to in paragraph 1 of this Article the following shall be attached:

- 1) the general act on a collective trademark, where protection of a collective trademark is sought;
- 2) a certificate on the priority right, translated into the Montenegrin language, issued by a competent authority of a member state of the Paris Union or a member state of the World Trade Organization, referred to in Article 23 of the Law (Union priority right); and
- 3) a certificate issued by a competent authority of a member state of the Paris Union or a member state of the World Trade Organization, translated into the Montenegrin language, referred to in Article 24 of the Law (exhibition priority right);

The data referred to in paragraphs 1 and 2 of this Article shall be entered in standard form Ž-1, which is a constituent part of this Regulation, or in a form containing the data referred to in that form.

List of Goods and Services

Article 5

A list of goods and services to which the trademark relates shall be attached to the request referred to in Article 4 of this Regulation.

The goods and services shall be clearly designated and classified according to the International Classification of Goods and Services in that the number of the class shall first be specified, followed by the goods and services encompassed by that class.

The goods and services shall be designated by their original titles.

The goods and services which may be listed in two or more classes shall be designated in such a manner that it can be concluded from the formulation to which class they belong (if possible, by using the terminology employed in the International Classification of Goods and Services).

Representation of the Trademark

Article 6

If the application requests for registration of a trademark consisting solely of letters, words, or numerals inscribed in standard fonts, or of combinations of the same, and which is not in any special graphical presentation or color, such a trademark is deemed a verbal trademark.

A verbal trademark shall be inscribed using a typewriter or a computer into the space provided for it on the request.

If the application requests for registration of a trademark containing graphic elements (drawings, images and similar), or where the applicant wishes a verbal trademark to be granted in a special logotype form and the registration of another type of trademark has not been requested, such a trademark shall be deemed a figurative trademark. A figurative trademark shall be displayed in the application by entering the trademark in the space provided for it on the form.

The position in which the trademark has been displayed in the application form shall be deemed the correct spatial position of the trademark.

A musical trademark shall be inscribed using musical notation on a musical scale divided into bars and besides the clef also contain notes and pauses, as well as sharps and flats.

If the application requests for registration of a three-dimensional trademark, a photograph or a drawing shall be attached to the application containing no more than six views of the trademark from different perspectives.

A three-dimensional trademark is displayed in the application by entering a representation of the trademark in the space provided for it on the request.

If the application requests for registration of a trademark consisting of one color or a combination of colors, the colors shall be specified and described in the request, together with the corresponding designation of the colors taken from the internationally recognized system of color identification. If the application requests for registration of a trademark consisting of a combination of colors, the colors shall be systematically arranged according to a previously determined system.

If the application requests for registration of a different type of trademark, it must be stated in the application which type of trademark is concerned. Depending on the type of trademark, a graphic representation of the trademark shall be attached to the application which shall be clear, precise, self-contained, easily accessible, legible, durable and objective.

The representation of the trademark shall be done in such a manner that it can fit in a square whose sides are 80 mm long, with the proviso that the distance between the two most distant points on the trademark (horizontally, vertically, or diametrically) may not be less than 15 mm.

The representation of the trademark shall be clear, done on good-quality paper and suitable for reproduction. No attachments, erasures, writing or covering with color shall be afterwards made to the representation of the trademark.

If the application requests for registration of a trademark in color, the registration request shall contain a representation of the trademark in color.

If the application requests for registration of a trademark in color referred to in paragraph 12 of this Article, and the request contains a representation of the trademark in black and white, it shall be deemed that the registration of a trademark in black and white has been requested.

Where a trademark or a part of a trademark consists of characters not of the Latin or Cyrillic script or numerals which are not Arabic or Roman, a transliteration of the trademark or its part in Latin or Cyrillic letters or Arabic or Roman numerals shall be entered in the appropriate space in the request.

Content of the Request for the Issuance of a Certificate of the Priority Right

Article 7

The request for issuing a certificate of the priority right shall contain the following:

- 1) a representation of the trademark identical to the trademark contained in the application for registration of the trademark;
- 2) a list of goods and/or services identical with the list of goods and/or services contained in the application for registration of the trademark; and
- 3) evidence of payment of the prescribed administrative fee for the issuance of the certificate.

Content of the Certificate of the Priority Right

Article 8

The certificate of the priority right shall contain the following:

- 1) indication concerning the applicant (name and address, or title and seat);
- 2) the number of the application (the “Ž” number) and the date of the filing of the application;
- 3) a representation of the trademark;
- 4) the list of goods and/or services; and
- 5) indication that the data in the certificate are identical to the data in the application for the registration of the trademark.

Content of the Data in the Application Published in the Official Gazette

Article 9

The following data from the application for the registration of a trademark shall be published in the official gazette of the competent authority:

- 1) the trademark application number (the “Ž” number);
- 2) the application filing date;
- 3) indication concerning the applicant (name and address, or title and seat);
- 4) indication concerning the representative, where the application is filed through a representative;
- 5) indication concerning a joint representative, where there is more than one applicant;
- 6) indication concerning the requested priority right;
- 7) a representation of the trademark for which protection is being sought, and where protection is being sought for a trademark in color, also a specification of the colors;
- 8) a list of goods and services classified according to the International Classification of Goods and Services;
- 9) the date of the publication of the application;
- 10) indication whether registration is sought of an individual trademark or a collective trademark; and
- 11) indication whether the registration is sought of a verbal, figurative, three-dimensional, or musical trademark, a trademark consisting of one color or of a combination of colors, or another type of trademark.

The data referred to in paragraph 1 of this Article shall be marked using Internationally Agreed Codes for the Identification of Bibliographic Data (INID) determined by the World Intellectual Property Organization (hereinafter: WIPO).

Detailed Content of the Data on Registered Trademarks to be Published in the Official Gazette

Article 10

The following data on registered trademarks shall be published in the official gazette of the competent authority:

- 1) the registration number of the trademark;
- 2) the date of entry in the Trademark Register;
- 3) the trademark application number (the “Ž” number);
- 4) the application filing date;
- 5) indication concerning the applicant (name and address, or title and seat);
- 6) indication concerning the representative, where the application is filed through a representative;
- 7) indication concerning a joint representative, where there is more than one applicant;
- 8) indication concerning the requested priority right;
- 9) a representation of the trademark for which protection is being sought, and where protection is being sought for a trademark in color, also a specification of the colors;
- 10) a list of goods and services classified according to the International Classification of Goods and Services;
- 11) the publication date of the application;
- 12) indication whether registration is sought of an individual trademark or a collective trademark;
- 13) indication whether registration is sought of a verbal, figurative, three-dimensional, or musical trademark, a trademark consisting of one color or of a combination of colors, or another type of trademark;
- 14) indication concerning opinions filed by other persons or oppositions filed after the publication of the application;
- 15) indication concerning the change of the name and address of the holder of the trademark;
- 16) the date up to which the trademark is valid;

- 17) indication concerning the transfer of the trademark;
- 18) indication concerning the license, pledge, levy of execution and bankruptcy;
- 19) indication on the renewal of the trademark registration;
- 20) indication on the amendments of the general act on the collective trademark; and
- 21) indication on the ceasing of the effect of the trademark;

The data referred to in paragraph 1 of this Article shall be designated using INID codes.

Detailed Content of the Request for Division of the Trademark

Article 11

Besides the data referred to in Article 36 paragraph 6 of the Law, the request for the division of a trademark shall also contain the following data:

- 1) the trademark application number (the “Ž” number);
- 2) indication concerning the applicant (name and address, or title and seat);
- 3) indication concerning the representative, where the request is filed through a representative;
- 4) indication of the class or classes which are being divided, where the division of the trademark is being effected within a specific class or classes; and
- 5) the signature and seal of the holder of the trademark or his/her representative.

In the division of a trademark the list of goods or services of the divided trademark and the list of goods and services which remain in the original trademark shall be contained in the list of goods or services of the first trademark.

A copy of the files of the first trademark registration shall become an integral part of the files of the divided trademark, and a copy of the request for division shall become a part of the files of the first trademark registration.

In the case of a division of goods or services by the transfer of the trademark in respect of specific goods and services for which the trademark is registered, division shall be effected by a copy of the files of the registered trademark becoming a part of the files of the divided trademark, and a copy of the request for the transfer of certain goods and/or services and a copy of the contract on the transfer of certain goods and services becoming a part of the files of the first trademark registration.

A new number shall be allotted to the divided trademark.

Documentation to be Submitted with the Request for Division of a Trademark

Article 12

The following shall also be submitted together with the request referred to in Article 11 paragraph 1 of this Regulation:

- 1) a power of attorney, where the procedure for the division of a trademark is initiated through a representative;
- 2) evidence of payment of the prescribed fee for the request for the division of the trademark;

- 3) evidence of payment of prescribed fees for the divided trademark or trademarks, where there is more than one; and
- 4) a list of goods and services according to the classes specified in the request.

Where the division of a trademark is being effected within a specific class or several classes, the holder of the trademark is required to attach to the request referred to in Article 11 paragraph 1 a list of goods and services which the divided trademark concerns, as well as a of goods and services which remain in the first registration.

The provisions of Article 11 and the provisions of this Article shall apply accordingly to requests for division of a trademark application.

Content of the Request for Entering Changes in the Trademark Register

Article 13

Requests for entering changes in the Trademark Register shall contain the following:

- 1) the registration number of the trademark;
- 2) the trademark application number (the “Ž” number);
- 3) indication concerning the applicant (name and address, or title and seat);
- 4) specification of the type of change (change of name and address, a transfer of the trademark, license, pledge);
- 5) indication concerning the representative, where the request for entering changes is filed through a representative; and
- 6) the signature and seal of the applicant or the representative.

The data referred to in paragraph 1 of this Article shall be entered in standard form Ž-2, which is an integral part of this Regulation, or on a form containing the data referred to in that form.

Documentation to be Submitted with the Request for Entering Changes

Article 14

The following shall be attached to the request referred to in Article 13 paragraph 1 of this Regulation:

- 1) a power of attorney, where the procedure of entering changes is initiated through a representative;
- 2) evidence of payment of the prescribed fee for the decision on the request for entering changes in the Trademark Register; and
- 3) evidence of payment of the prescribed fee for the publication of the data entered in the Trademark Register.

The entry of a change of a name and address relating to several trademarks may be sought by one request referred to in paragraph 1 of this Article, provided the registration numbers and application numbers (“Ž” numbers) are specified in the request.

The provisions of Article 13 shall apply accordingly to requests for entering changes in the application concerning corrections of the name and/or address of the applicant, and corrections of errors in the text or copies, provided such changes do not affect an expansion of the list of goods and/or services.

Detailed Content of the Request for Entering the Transfer of a Trademark

Article 15

A request for entering the transfer of a trademark shall contain the following:

- 1) the registration number of the trademark;
- 2) the trademark application number (the “Ž” number);
- 3) indication concerning the applicant (name and address, or title and seat);
- 4) specification that an entry of the transfer of a trademark is being sought;
- 5) indication concerning the representative, where a request for entering the transfer of a trademark is filed through a representative;
- 6) evidence or payment of the prescribed fee for the decision on the request for entering the transfer of a trademark; and
- 7) the signature and seal of the applicant, or the representative.

Besides the data referred to in paragraph 1 of this Article, where the entry of a license or pledge is being sought, the request shall also contain the following:

- 1) a specification of the right whose entry is being sought, and
- 2) a specification of the numbers of classes of goods and services to which the right whose entry is being sought relates.

The entry of a transfer of rights concerning several trademarks may be sought by one request referred to in paragraph 1 of this Article, provided the earlier and the new holders of the trademark rights are the same persons and that the registration numbers and trademark application numbers (“Ž” numbers) are specified in the request.

The entry of a license or a pledge relating to several trademarks may also be sought by one request referred to in paragraph 1 of this Article, provided that the holder of the rights and the licensee or pledge assignee are the same persons and the registration numbers and trademark application numbers (“Ž” numbers) are specified in the request.

The data referred to in paragraphs 1 and 2 of this Article shall be entered in standard form Ž-2, which is an integral part of this Regulation, or on a form containing the data referred to in that form.

Documentation to be Submitted with the Request

Article 16

Besides the data referred to in Article 40 paragraph 3 of the Law, to a request for the entry of a transfer of a trademark, or a request for the entry of a license or pledge, shall also be attached evidence of payment of the prescribed fee for the publication of changes of data entered in the Trademark Register.

Where the transfer of a trademark is the result of a transfer contract, the following shall be attached to the request referred to in Article 15 paragraph 1 of this Regulation as proof of the legal basis of the transfer of the trademark whose entry is being sought:

- 1) a certified copy of the transfer contract, signed by the parties to the contract;
- 2) a certified excerpt from the transfer contract from which can be ascertained the identities of the parties to the contract and that a transfer of the trademark has been effected; or

- 3) the original of the certification on the transfer of the trademark signed by the parties to the contract.

Where a transfer of a trademark is being conducted in the case of a consolidation of companies, to the request referred to in Article 15 paragraph 1 of this Regulation shall be attached the original or a certified copy of the document issued by the competent authority which issues the decision on the consolidation of the companies.

Where a transfer of the trademark has occurred pursuant to the law or on the basis of a court or an administrative decision, to the request referred to in Article 15 paragraph 1 of this Regulation shall be attached the original or a certified copy of the court decision, or another document certifying the change.

Where the entry of a license or pledge is being sought by the request, the following shall be submitted as proof of the legal basis:

- 1) a certified excerpt from the license contract or pledge contract from which can be ascertained the identities of the parties to the contract and the rights licensed or pledged, and
- 2) the original of the certificate granting a license or pledge signed by the license or pledge assigner and the assignee.

Content of the Request for Renewal of a Trademark

Article 17

The request for the renewal of a trademark shall contain the following:

- 1) the registration number of the trademark and the date of expiration of the trademark;
- 2) the trademark application number (the “Ž” number);
- 3) indication concerning the applicant (name and address, or title and seat);
- 4) indication concerning the representative, where the request was filed through a representative;
- 5) evidence of the payment of prescribed fees; and
- 6) the signature and seal of the applicant.

The data referred to in paragraph 1 of this Article shall be entered in standard form Ž-3, which is an integral part of this Regulation, or on a form containing the data referred to in that form.

Documentation to be Submitted with the Request for Renewal of a Trademark

Article 18

The following shall be submitted together with the request referred to in Article 17 paragraph 1 of this Regulation:

- 1) evidence of payment of the prescribed fee for renewal of the trademark for a period of 10 years, and
- 2) a power of attorney, where the request is filed by a representative.

Content of the Request for International Registration of a Trademark

Article 19

Besides the data referred to in Article 49 paragraph 2 of the Law, a request for international registration of a trademark shall also contain the following:

- 1) indication concerning the applicant (name and address, or title and seat);
- 2) a contact address, if there is any;
- 3) indication concerning the representative, where a request for international registration of a trademark is being filed through a representative;
- 4) the number and date of the application and the registration number of the trademark which serves as a basis for international registration;
- 5) indication concerning the requested priority right (the country, the date and the number of the first application, in accordance with Article 4 of the Paris Convention for the Protection of Industrial Property);
- 6) a representation of the trademark, printed by means of a computer or pasted onto the form, identical to the appearance of the trademark in the domestic application for registration of the trademark which serves as a basis for international registration;
- 7) the type of trademark;
- 8) a transliteration of the trademark (if it is not written in Latin or Cyrillic script);
- 9) translation of the trademark into the English language (optional);
- 10) a specification of the colors and combination of colors (in English);
- 11) a list of goods and services, in the English language (if there is insufficient space, a separate list shall be submitted in two copies);
- 12) the countries for which protection is sought (to be specified by marking an 'x' in the shaded square)If any country is not included in the list, the applicant shall specify that country in an attachment submitted together with the request;
- 13) a list of all supplements filed together with form MŽ-1, and
- 14) the signature and seal of the applicant.

A request for international registration of a trademark may also contain a description of the trademark, if one is included in the national application for registration of the trademark or the registration of the trademark which serves as a basis for international registration, as well as a translation of the trademark, if it is possible to translate it.

The description and translation of the trademark may be given in the English language.

The data referred to in paragraph 1 of this Article shall be entered in standard form MŽ-1, which is an integral part of this Regulation, or on a form containing the data referred to in that form.

The data referred to in paragraph 1 items 4 to 7 of this Article must be identical to the data contained in the domestic application or the registration of the trademark which serves as a basis for international registration.

Evidence Submitted with the Request for International Registration of a Trademark

Article 20

The list of goods and services referred to in Article 49 paragraph 2 item 2 of the Law shall be submitted as an attachment to the request for international registration of the trademark, if it is too long to be entered in the request for international registration of the trademark.

The list of goods and services in the international trademark application should be identical with the list of goods and services in the national application which serves as a basis for international registration of the trademark.

By exception from paragraph 2 of this Article, the list of goods and services in the international trademark application may be shorter than the list of goods and/or services in the application which serves as a basis for international registration of the trademark.

Where the applicant abandons protection of certain goods and services in one or more countries, he/she shall explicitly state so in the application.

Effectiveness

Article 21

This Regulation shall enter into force on the eighth day from the date of its publication in the *Official Gazette of Montenegro*.

No: 0901-2056/4
Podgorica, 17th October 2011