

Pursuant to Article 82 paragraph 1 item 2 and paragraph 1 of Article 91 of the Constitution of Montenegro, the Parliament of Montenegro in its 24<sup>th</sup> convocation at the seventh session of the second regular sitting in 2010, on 22 December 2010, hereby passes the

LAW  
ON LEGAL PROTECTION OF INDUSTRIAL DESIGN

( ‘Official Gazette of Montenegro’ , No. 80/10 and 27/13)

I. BASIC PROVISIONS

**Subject Matter**

Article 1

The present law shall govern the registration and legal protection of industrial design.

**Definition and Effect of the Design**

Article 2

Industrial design shall be the appearance of the whole or a part of a product, resulting from its features, in particular the lines, contours, colors, shape, texture and/or material the product is composed of and its ornamentations (hereinafter referred to as: the Design).

The product referred to in paragraph 1 of the present Article shall mean any industrial or handicraft item, including parts intended to be assembled into a complex product, product packaging, get-up, graphic symbols and typographic typefaces, excluding computer programs.

A complex product referred to in paragraph 2 of the present Article shall mean product composed of replaceable multiple parts permitting product disassembly and reassembly.

Designs registered with the International Bureau of the World Intellectual Property Organization in accordance with The Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as: the Hague Agreement) shall also be effective in Montenegro.

### **Equality of Foreign and National Persons**

#### Article 3

Foreign legal and natural persons shall have rights with respect to design registration and legal protection in Montenegro equal to those of national legal and natural persons, if this results from ratified international agreements or from the reciprocity principle.

Proof of the existence of reciprocity referred to in paragraph 1 of the present Article shall be provided by the person claiming reciprocity.

In any proceedings before a competent authority, a foreign legal or natural person shall be represented by a legal or natural person (hereinafter referred to as: the Representative) entered into the Register of Representatives maintained by the competent authority in charge of intellectual property matters (hereinafter referred to as: the Competent Authority) or a lawyer entered into the Montenegro Bar Association Register.

## II. DESIGN REGISTRATION REQUIREMENTS

### **Requirements for Design Protection**

#### Article 4

A Design may be protected if it is new and has an individual character.

A Design applied to or contained in a product which constitutes a component of a complex product shall be considered to be new and to possess individual character only if such component of the product, after being incorporated into the complex product, remains visible during normal use of that product and if the visible features of the component part of the product themselves meet the requirements concerning novelty and individual character.

Normal use referred to in paragraph 2 of the present Article shall mean the use by the end user of the product, excluding product maintenance, servicing or repair work.

### **Design Novelty**

#### Article 5

A design shall be considered new if no identical design has been made available to the public prior to the design registration application filing date (hereinafter referred to as: the Application) or if the priority right was claimed prior to the date of registered priority right.

A design shall be deemed to be identical if its features differ solely in immaterial details.

### **Individual Character of the Design**

#### Article 6

A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any other design which has been made available to the public prior to the registration application filing date or if the priority right was claimed prior to the date of registered priority right.

In assessing individual character of the design, the degree of freedom of the author of the design (hereinafter referred to as: the Designer) in creating the design shall be taken into consideration.

## **Disclosure**

### *Article 7*

Within the meaning of Articles 5 and 6 of the present Law, a design shall be deemed to have been made available to the public if it has been disclosed by means of registration or otherwise, exhibited, used in trade or otherwise disclosed prior to the date of filing the application for design registration or if the priority right was claimed prior to the date of registered priority right, except where these events could not reasonably have become known in the usual course of business to the groups in Montenegro specialized in the given sector.

Within the meaning of Articles 5 and 6 of the present Law, a design shall be deemed to have been made available to the public if it has been disclosed by means of registration or otherwise, exhibited, used in trade or otherwise disclosed prior to the date of filing the application for design registration or if the priority right was claimed prior to the date of registered priority right, except where these events could not reasonably have become known in the usual course of business to the groups in European Union specialized in the given sector.

The design shall not be deemed to have been made available to the public within the meaning of paragraph 1 of the present Article, if it has been disclosed to another person under conditions of confidentiality related to the industrial design.

The design shall not be deemed to have been made available to the public, within the meaning of Articles 5 and 6 of the present Law, if a design has been disclosed by the designer, his/her legal successor, or a third person as a result of an information received from the designer or his/her legal successor, or as a result of an action taken by the designer or his/her legal successor, provided

that the time period from the design disclosure date to the design registration application filing date or to the date priority right has been claimed, is less than 12 months, as in the case when the design has become available to the public as a result of abuse in respect of the author or his/her legal successor.

## **Design Register and Official Gazette**

### Article 8

Design Register (hereinafter referred to as: the Register) and application records shall be maintained by the competent authority.

The Register referred to in paragraph 1 of the present Article shall contain, in particular: the data about the author of the design, the design registration number, the design registration application filing date, the priority right claimed, the application disclosure date, design registration date, amendments, Register entry date, international registration data, design protection renewal data and the registered design lapse date.

Application records referred to in paragraph 1 of the present Article shall, in particular contain information referred to in Article 25 paragraph 1 of the present Law.

At the request of the interested party and upon payment of the prescribed administrative fees and duties, the competent authority shall issue an extract from the Register and the industrial design validity certificate.

The data from the Register shall be published in the Official Gazette of the competent authority.

The competent authority of the state administration in charge of intellectual property issues (hereinafter referred to as: the Ministry) shall prescribe in more detail the content and procedure for maintenance of the Register and the application records referred to in paragraph 1 of the present Article.

## **Relation to Other Laws**

### **Article 9**

Unless otherwise prescribed by the present Law, the provisions of the law governing general administrative procedure shall be applicable to the design registration and protection procedure.

An appeal against the decisions rendered by the competent authority may be filed with the Ministry.

In the procedure before the competent authority, the prescribed administrative fees and duties in keeping with the law governing administrative fees and duties, special procedural costs and information provision services fees, shall be charged.

The amount of special procedural costs and fees for information service provision shall be determined by the Government of Montenegro (hereinafter referred to as: the Government).

## **Protection Excluded Due to Technical Function**

### **Article 10**

Industrial design right shall not subsist with respect to appearance of a product that is solely dictated by its technical function.

Industrial design right shall not subsist with respect to appearance of a product that must necessarily be reproduced in its exact form and dimensions in order to permit the product to be mechanically connected to or placed in, around or against another product, so that either product may perform its function.

Notwithstanding paragraph 2, the industrial design rights may, under the conditions set out in Articles 5 and 6 of the present Law, subsist with respect to a design enabling multiple assembly or connection of mutually interchangeable products within a modular system.

## **Industrial Design Protection Exclusion**

### **Article 11**

The following designs may not be registered and protected:

- 1) Those which are contrary to public interest or accepted moral norms;
- 2) Designs not meeting the criteria referred to in Articles 2, 4, 5, 6 and 7 of the present Law;
- 3) If the applicant or design holder is not authorized to acquire the design pursuant to the present Law;
- 4) If the design is in conflict to an earlier design disclosed to the public following the application filing date or if the priority right has been claimed, following the date of the registered priority right and which has been registered in Montenegro earlier or for which registration has been filed earlier;
- 5) If in the process of creating a design a sign for distinguishing goods or services has been used, while the owner of the earlier right was entitled to prohibit such usage;
- 6) which constitutes an unauthorized use of a work protected under the Law governing copyright and related rights;
- 7) which constitutes improper use of any element specified in Article 6.ter of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the Paris Convention), or marks, emblems or coats of arms that are not covered by Article 6.ter of the Paris Convention and which are of particular interest for Montenegro.

## **Rights of Designers**

### **Article 12**

The right to the industrial design protection shall be vested in the designer, or his legal successor.

A person providing only technical assistance in the process of creating a design shall not be considered a designer.

If two or more persons jointly created a design, all designers shall be entitled to industrial design protection rights.

If the design has been developed by a person while performing his/her regular work related activities or when acting on order and instructions of their employer, the employer shall be entitled to file an application unless otherwise stipulated in the contract.

### **Designer Indication**

#### Article 13

Designer shall be entitled to be cited in all documents in the process of registration and in the Register as the designer, in much the same way as does the applicant or holder of the design.

If more than one designer or a team of designers jointly created a design, all designers individually or the team of designers shall be entitled to the rights referred to in paragraph 1 of the present Article.

### **III. SCOPE AND LIMITATIONS OF INDUSTRIAL DESIGN RIGHTS**

#### **Scope of the Industrial Design Rights**

#### Article 14

Scope of protection of registered design shall include any design which does not produce a different overall impression on the informed user.

When determining the scope of rights to the design the degree of freedom of the designer in creating a design shall be taken into consideration in terms of Article 6, paragraph 2 of this Law.



## **Exclusive Rights**

### Article 15

The holder of the industrial design rights shall have the exclusive right to use the registered industrial design and to prevent any third party not having his consent from using it.

The use referred to in paragraph 1 of the present Article shall include in particular: making, offering, putting on the market, importing, exporting or using the product containing the design or a product to which the design has been applied or stocking such a product for those purposes.

Should the disclosure of the registered design be deferred pursuant to Article 35 of the present Law, for the duration of the deferment of publication, the holder of design shall be entitled to prevent other persons from taking actions referred to in paragraph 2 of the present Article, only if such actions are aimed at copying the registered design.

## **Limitation of Exclusive Rights**

### Article 16

The holder of industrial design rights may not prevent other person from performing the following activities:

1) Activities performed for private, non-commercial and experimental purposes;

2) Reproduction for the purpose of making citations or teaching, provided such activities are compatible with the fair business practices and provided they do not unduly jeopardize the normal exploitation of the industrial design, as well as provided that the source from which the industrial design has been obtained has been specified.

Exclusive rights to a design shall not pertain to:

1) equipment of ships and aircrafts registered in another country, when these temporarily residing in Montenegro.

- 2) Import of spare parts and accessories to Montenegro, for ships and aircraft repair purposes under item 1 of this paragraph;
- 3) execution of repairs of ships and aircrafts as referred in item 1 of this paragraph.

### **Earlier Use of the Design**

#### Article 17

A person who has been able to prove that prior to the application filing date or prior to the priority right registration date, if claimed on the territory of Montenegro, he/she has already commenced in good faith with the use of the protected industrial design in manufacturing, or has made all the necessary preparations to commence with the use of the design included in the scope of protection, provided that such design is not the result of copying of a protected industrial design, shall have right of prior use.

Pursuant to the right of prior use, another person shall be entitled to use the industrial design only for purposes it was initially used for in the manufacturing or for the purpose of necessary preparations for the commencement of use of design prior to the application filing date or prior to the priority right registration date, if the priority right has been claimed.

The person entitled to the right of prior use of the design shall not be entitled to transfer the right of industrial design use by virtue of a license agreement.

The right of prior use shall not be transferable, unless such right is transferred together with a company, part of the company, company operational unit (workshop) or branch of the company in which the use of such industrial design has been prepared or commenced, in keeping with paragraph 1 of the present Article.

### **Exhaustion of Rights**

#### Article 18

If the holder of industrial design rights in Montenegro puts in the market a product comprising a protected industrial design and/or a product designed in accordance with a protected industrial design, or if the holder of the industrial design right authorizes another person in Montenegro to put such product in the market, the holder of industrial design rights shall not be entitled to prevent third parties from further disposing of that product which has been purchased in the course of legal trade.

The exhaustion of rights referred to in paragraph 1 of the present Article shall not apply in the event there exists a legitimate interest on the part of the holder of the industrial design right to oppose further trading in the product comprising the protected industrial design, or the product which has been designed in accordance with the protected industrial design, in particular if a defect has meanwhile occurred in the product or other changes appeared in the features of the product.

The exhaustion of rights referred to in paragraph 1 of the present Article may be extended beyond Montenegro in keeping with ratified international treaties.

### **Relation to Other Forms of Protection**

#### Article 19

Provisions of the present Law shall not affect any existing rights with respect to trademarks or other distinction signs, unregistered designs, typographies, patents and provisions governing civil law protection or competition protection.

### **Copyright and Legal Protection of Designs**

#### Article 20

Registered design may also enjoy protection pursuant to the legislation governing the copyright as of the date of its creation, or as of the date of fixation in a certain form.

## **IV. PROPERTY RIGHTS PERTAINING TO INDUSTRIAL DESIGN**

### **License**

#### Article 21

The holder of the industrial design rights may grant rights to registered industrial design on the basis of a license agreement.

At the request of the industrial design rights holder or the licensee, the license agreement referred to in paragraph 1 of the present Article, shall be entered into the Register.

The entry into the License Agreement Register, referred to in paragraph 1 of the present Article, shall be done by a special decision.

The data contained in the decision on the entry into the License Agreement Register shall be published in the Official Gazette.

The regulations issued by the Ministry shall prescribe in more detail the content of the request referred to in paragraph 2 of the present Article and the documentation submitted together with the request.

### **Assignment**

#### Article 22

The holder of the industrial design rights may assign to another person the right to the industrial design by virtue of an agreement, either entirely or in part.

The assignment of the industrial design right shall be entered into the Register upon request of one of the contracting parties.

The entry of the assignment of the industrial design rights into the Register shall produce legal effect in relation to third parties.

The data contained in the decision on the entry of the assignment of the industrial design rights into the Register shall be published in the Official Gazette.

The regulations of the Ministry shall prescribe in more detail the content of the request referred to in paragraph 2 of the present Article and the documentation submitted together with the request.

### **Pledge, Enforced Execution and Bankruptcy**

#### Article 23

A registered industrial design may be a subject of a pledge based on a pledge agreement and subject to enforced execution.

The pledge right shall be entered into the Register at the request of a pledger or the pledgee.

The court in charge of enforced execution *ex officio*, shall be obliged to notify the competent authority on the launching of the design enforced execution procedure for the purpose of entry into the Register.

Pledge and enforced execution shall be published in the Official Gazette.

Pledge and enforced execution shall produce legal effect in relation to third parties following the entry into the Register.

Where the registered design is subject of bankruptcy, the information on initiating the bankruptcy proceeding shall be entered into the Register and published in the Official Gazette at the request of the competent court.

Regulations governing pledge shall be applicable to pledge or enforced execution procedures.

The regulations issued by the Ministry shall prescribe in more detail the content of the request referred to in paragraph 2 of the present Article and the documentation submitted together with the request.

### **Rights from the application**

#### Article 23a

The provisions of Articles 21, 22 and 23 of this Law shall be applied to the rights from the application for registration of the design.

## V. INDUSTRIAL DESIGN REGISTRATION PROCEDURE

### **Initiation of the Industrial Design Registration Procedure**

#### Article 24

The industrial design registration procedure shall be initiated by filing an application to the competent authority.

At the request of the applicant or holder of a design or ex officio, a correction of the name or address of the applicant or the holder of the design, correction of errors in the text or transcript or correction of some other obvious mistake may be done, if such changes do not extend design which protection is required or which is protected.

An application to which the filing date has been accepted shall not be subsequently amended by extending of the design for which protection is required.

The applicant may withdraw from the registration procedure at any point in time, either entirely or partially, and the competent authority shall render an official decision thereof.

The industrial design registration application and documentation shall not be available to the public without the applicant's consent prior to the industrial design disclosure date.

### **Application Content**

#### Article 25

The application shall include:

- 1) Industrial design registration request;
- 2) Information about the applicant;

3) The industrial design depiction (appearance) suitable for reproduction;

4) Indication of the product containing the design or to which the design will be applied;

5) Information on the authorized representative if the applicant has a representative;

6) Information on the joint authorized representative in case of joint applications.

If the subject of the application is a two-dimensional design and should the application include a request to defer the design publication pursuant to Article 35 of the present Law, the depiction of the design referred to in paragraph 1 item 3 of the present Article, may be substituted with a sample.

In addition to data referred to in paragraph 1 of the present Article the application may contain the following:

1) Product appearance description or sample;

2) Request to defer the registered industrial design publication in keeping with Article 35 of the present Law;

3) Product classification according to the International Classification prescribed by the Locarno Agreement on Establishing International Classification of Industrial Designs (hereinafter referred to as: the International Classification);

4) Information about the designer or a team of designers or statement made by the designer or team of designers that he/she or they do not wish to be listed in the application;

5) Information on the priority right referred to in Articles 29 and 30 of the present Law.

The application containing elements referred to in paragraph 1 items 1, 2 and 3 of the present Article shall bear the application filing date and shall be entered into application records.

Should the application not contain elements referred to in paragraph 4 of the present Article, the competent authority shall notify the applicant thereof instructing him/her to remedy the detected deficiencies within the time period of sixty days from receiving the notification.

Should the applicant fail to remedy the detected deficiencies within the time period referred to in paragraph 5 of the present Article, the competent authority shall render a decision acknowledging the date when the deficiencies have been remedied as the application filing date.

Should the applicant fail to rectify the application within the time period referred to in paragraph 5 of the present Article, the application shall be considered withdrawn, and the competent authority shall render a conclusion to that effect.

The time limit referred to in paragraph 5 of the present Article may be extended at the request of the applicant for a period not to exceed sixty days.

Where a multiple application has been filed, the competent authority shall examine whether the application meets the conditions referred to in paragraph 4 of the present Article and Articles 26 and 27 of the present Law.

Proof of payment of administrative fees and duties shall be submitted with the application.

The Ministry shall prescribe in more detail the content of the request and application.

## **Multiple Applications**

### Article 26

Should the application contain a request for the registration of multiple designs (hereinafter referred to as: Multiple Application), all the product which should contain the design or to which the design should be applied must be classified into the same product class in keeping with the International Classification.

The multiple application shall contain the overall number of designs for which registration is sought.

Following the registration, all designs contained in a multiple application may be processed independently.

A design may independently be the subject of exercising of rights, subject of license agreement, subject of pledge and enforced



execution, bankruptcy, refusal, extension of protection, transfer of rights, deferment of publication or nullification.

## **Division of Multiple Applications**

### **Article 27**

The applicant filing an application containing the request for registration of multiple designs may file a request seeking division of a multiple application into several individual or multiple separated applications.

Each of the separated applications referred to in paragraph 1 of the present Article shall be issued a new application number and registered in the applications records, but shall retain the date of the filing of the original multiple application and the right of priority thereof.

A decision shall be rendered with respect to the division of the application, which shall indicate the number(s) of new applications, industrial designs remaining in the original multiple application, as well as the industrial designs which are to remain in the separated application(s).

The Ministry shall prescribe particulars of the request referred to in paragraph 1 of the present Article and documentation submitted with the request.

## **Priority Right**

### **Article 28**

As of the filing date of an orderly and complete application the applicant shall enjoy a priority right over all other persons who have subsequently filed an application for the identical or similar industrial design.

Following the payment of the required administrative fees and duties, the competent authority shall issue a priority right certificate at the request of the applicant or the industrial design holder.

## **Union Priority Right**

### Article 29

An applicant having filed orderly and complete application effective in any member state of the Paris Union for the Protection of Industrial Property (hereinafter referred to as: the Paris Union) or the World Trade Organization member state, shall be entitled to claim the initial application filing date when filing an application in Montenegro for identical industrial design, provided that the application in Montenegro has been filed within six months of the initial application filing date (hereinafter referred to as: the Union Priority Right).

The application of an applicant claiming the Union Priority Right referred to in paragraph 1 of the present Article shall contain information on the date of filing, application filing number and the state in which such application has initially been filed.

The applicant shall prove the Union Priority Right by filing the priority right certificate issued by a competent authority of the Paris Union member state or World Trade Organization member state, and the translation of that certificate into the Montenegrin language.

## **Exhibition Priority Right**

### Article 30

The applicant who has exhibited a product, containing the industrial design or to which that particular industrial design has been applied, at an official or officially recognized international exhibition in any member state of the Paris Union or in any member state of the World Trade Organization, may request that the date when the product has been exhibited for the first time be acknowledged as the first filing date of the application, provided that the application in Montenegro has been filed within six months

from that date (hereinafter referred to as the exhibition priority right).

Within the meaning of paragraph 1 of the present Article, an international exhibition shall mean any exhibition pursuant to the Convention on International Exhibitions.

The applicant claiming exhibition priority right shall attach to the application the certificate issued by the competent authority of a member state of the Paris Union or member state of the World Trade Organization that the fair or exhibition was international in its character, indicating data on the type of exhibition, venue, date of opening and closing of the exhibition and the date of the first exhibiting the product stated in the application and the translation of that certificate into Montenegrin language.

### **Order of Application Examination**

#### Article 31

The applications shall be examined in the order determined by the date of their filing.

Notwithstanding the provision of paragraph 1 of the present Article, the application may be examined in an expedited procedure:

- 1) In case of the procedure initiated before a court or an inspection authority, or customs related procedure at the request by the court or the competent authority;
- 2) If the application for international registration of an industrial design has been filed.

### **Formal examination of the application**

#### Article 32

The competent authority shall, upon the entry of the application into the records of applications, examine whether the application meets

the requirements of Article 25 and Article 26 of this Law, if multiple applications have been submitted.

If the competent authority finds that the application does not meet the requirements of paragraph 1 of this Article, it shall invite the applicant to remove the shortcomings within 60 days of receipt of the notification.

If multiple applications has been submitted, and products in which the design shall be included or to which design shall be applied cannot be classified in the same class of products according to the International Classification, the competent authority shall invite the applicant to separate application on more individual or multiple applications within 60 days of receipt of notice.

At the request of the applicant the period refered to in paragraphs 2 and 3 of this Article may be extended for another 30 days.

If the applicant within the period refered to in paragraphs 2, 3 and 4 of this Article do not remove the shortcomings, i.e. do not separate application in accordance with paragraph 3 of this Article, the competent authority shall reject the application.

### **Decision on rejection of design registration**

#### Article 32a

The competent authority shall issue the decision of rejecting registration of design if it finds that:

- 1) design is in contrary to the public interest;
- 2) design does not meet the requirements of Article 2, paragraph 1 of this Law;

3) design presents an unauthorized use of any element referred to in Article 11 paragraph 1 item 7 of this Law.

The competent authority may issue the decision on partial rejection of design registration for the reasons set out in paragraph 1, items 2 and 3 of this Article if that design meets the requirements for registration and if identity of a design is retained.

If the competent authority finds the reasons for rejection of design registration referred to in paragraph 1 of this Article, it shall invite the applicant to comment on the reasons for rejection and submit proof of new facts that might affect the decision of the competent authority within 60 days of receipt of the invitation.

At the request of the applicant, deadline referred to in paragraph 3 of this Article can be extended for another 60 days.

## **Design Registration**

### Article 33

Where the application was found to meet the registration requirements referred to in Article 32 of this Law and there are no reasons for rejection of design registration referred to in Article 32a of this Law, the competent authority shall call on the applicant to pay administrative fees and duties for the industrial design registration, the costs of industrial design publication and the fee for maintenance or industrial design protection for the first five years of registration, within a time period of thirty days from the day the notification has been received.

Should the applicant fail to submit proof of the payments within the time period referred to in paragraph 1 of the present

Article the application shall be considered as having been withdrawn.

### **Entry of an Industrial Design into the Industrial Design Register**

#### Article 34

The issuance of the decision on the registration of the industrial design, entitles the applicant to the industrial design.

The date of issuing the decision on the registration of the industrial design shall be considered as the date of entry into the Register.

Data from the decision referred to in paragraph 1 of the present Article shall be published in the Official Gazette.

The regulations issued by Ministry shall prescribe the particulars referred to in paragraph 3 of the present Article which are published by the Official Gazette.

### **Deferred Publication of the Registered Design**

#### Article 35

The applicant may submit a request accompanying the application, to defer the publication of the registered industrial design for a period of thirty months from the application filing date or from the acknowledged priority right, if the priority right has been claimed.

If the deferment of the industrial right registration publication has been sought, the information that the given industrial design has been registered, information on the industrial design holder, application filing date and a note stating that the deferment of publication of the registered industrial design has been sought, shall be published in the Official Gazette.

The industrial design holder shall be entitled to request the publication of the design prior to the deadline expiry referred to in

paragraph 1 of the present Article following the payment of the prescribed administrative fees and duties.

In case of multiple applications the industrial design publication deferment may be sought only for certain designs listed in the application.

In the case referred to in paragraph 1 of this Article the competent authority shall, after the expiry of the deferment period for publication or other date provided for in paragraph 3 of this Article, request the holder of design to submit, for publication of design, graphical display or photos within 30 days of receipt of the notification, in accordance with Article 25 paragraph 1 item 3 of this Law.

If the holder of design does not comply with the notification referred to in paragraph 5 of this Article, it shall be deemed that the design, starting of the date of application for registration, does not have legal effect.

### **Entry of Changes into the Register**

#### Article 36

At the request of a holder of industrial design rights the competent authority shall render a decision entering changes which occurred following the industrial design registration in the appropriate Register of the competent authority, in particular changes in the name or address of the holder of the industrial design right and assignment of rights.

Changes referred to in paragraph 1 of the present Article shall not alter the appearance and scope of the industrial design protection.

Changes entered into the Register shall be published in the Official Gazette.

The regulations issued by the Ministry shall prescribe in more detail the content of the request referred to in paragraph 1 of the

present Article and the documentation submitted together with the request.

## **Continuation of the Procedure**

### Article 37

The applicant or another person who has failed to perform an action within a specified period of time may file a request with the competent authority for the continuation of the procedure.

The procedure continuation request may be filed within a time period of sixty days from the expiry of the deadline within which the action should have been undertaken.

The competent authority shall allow the continuation of the procedure, provided that the loss of right has not come into effect, provided that the applicant effects payment of prescribed administrative fees and duties for the continuation of the procedure and provided that the applicant undertakes the action within the time period referred to in paragraph 2 of the present Article.

The continuation of the procedure may not be requested for failing to observe the filing deadlines for the following: *restitutio in integrum* request referred to in Article 38 of the present Law, industrial design renewal application referred to in Article 39 of the present Law, priority right acknowledgement application referred to in Articles 29 and 30 of the present Law and the request referred to paragraph 2 of the present Article.

Should the competent authority approve the request for the continuation of the procedure referred to in paragraph 1 of the present Article, it shall be considered that the consequences of failing to observe the filing deadlines have not come into effect and shall nullify official decisions it had rendered in respect of failure to observe the filing deadlines.

### ***Restitutio in integrum***

### Article 38



The applicant or industrial design rights holder who was, due to justified reasons, unable to perform a certain action in the procedure before a competent authority, may request *restitutio in integrum* if the omission resulted in the loss of rights.

The request for *restitutio in integrum* referred to in paragraph 1 of the present Article shall be submitted in writing within a time period of sixty days from the day reasons for omissions have ceased to exist.

The request for *restitutio in integrum* referred to in paragraphs 1 and 2 of the present Article may not be submitted following the expiry of a time period of one year from the day of omission having taken place.

The applicant filing the request for *restitutio in integrum* shall be obliged to provide reasons due to which he/she has been prevented from performing the given activities.

Proof of payment of the prescribed administrative fees and duties shall accompany the request for *restitutio in integrum*.

The request for *restitutio in integrum* may not be filed following the expiry of the time period referred to in paragraph 2 of the present Article and Articles 29, 30 and 37 of the present Law.

## VI. DURATION, RENEWAL AND CESSATION OF THE INDUSTRIAL DESIGN RIGHTS

### **Duration of Protection of a Registered Industrial Design**

#### Article 39

The protection of industrial design rights shall last for five years commencing from the application filing date and shall be subject to renewal periods of five years, not to exceed twenty five years.

The industrial design rights holder seeking the industrial design protection renewal shall be obliged to submit the request for the industrial design protection renewal accompanied by proof of payment of required administrative fees and duties prior to the

expiry of the previous period of protection during the last six months ending on the last day of the month in which the cessation of protection occurs.

Application for renewal of design validation can be filed within six months after the expiry of the period referred to in paragraph 2 of this Article, provided that the payment of the prescribed administrative fee has been done.

The new industrial design protection period shall commence on the day of expiry of the previous five year period.

The industrial design protection renewal shall be entered into the Register and shall be published in the Official Gazette.

The regulations issued by the Ministry shall prescribe in more detail the content of the request referred to in paragraph 2 of the present Article and the documentation submitted together with the request.

## **Cessation of Protection**

### **Article 40**

The industrial design right shall cease:

- 1) With the expiry of the protection time period referred to in paragraph 39 of the present Law;
- 2) If the right holder abandons the right in writing, on the day of filing the statement of abandonment;
- 3) Based on a court decision, or a decision of a competent authority, on the day indicated in such decision;
- 4) If the legal person has been dissolved, or if the natural person who is the holder of right has died, on the day of dissolution of the legal person or death of natural person, unless the design right has been transferred to legal successors of such persons.

If the right in favor of a third person has been entered in the Industrial Design Register (license, pledge or similar right), the industrial design rights holder may not renounce the right without written consent of the person whose name has been entered in the Register.

Should the holder of the industrial design right fail to pay the administrative fees and duties charged for the maintenance of the validity of the registered industrial design within the prescribed time period, and the license, lien, or any other right in favor of a third person has been entered in the Industrial Design Register, the competent authority shall notify such person that administrative fees and duties have not been paid and that he/she may make due payment within six months following the beginning of the year for which administrative fees and duties are due and thus maintain validity of the entered right.

Cessation of the design validity shall be entered in the Register and published in the Official Gazette.

Following information on cessation of the design shall be published in the Official Gazette:

- 1) the registration number of design;
- 2) information about the holder of design (first name, last name, address and nationality in the case of a natural person, or the name and address, if it is a legal entity), and
- 3) the date of cessation of design.

## **VII. INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS**

### **International Registration Procedure**

#### Article 41

The international industrial design registration shall be done in accordance with the Hague Agreement.

The application for international industrial design registration shall be filed directly to the International Bureau of the World Intellectual Property Organization (hereinafter referred to as: the International Bureau).

The prescribed international industrial design registration fees shall be payable directly to the International Bureau.

The provisions of the present Law, excluding Article 34 thereof, shall be applicable to the requests seeking expansion of effectiveness of the international registration to the territory of Montenegro, pursuant to Article 8 of the Hague Act of the Hague Agreement and Article 12 of the Geneva Act of the Hague Agreement.

If there is a reason for rejection of design registration upon a request referred to in paragraph 4 of this Article, the competent authority shall invite the applicant to explain the reasons for rejection of the registration, within four months from the date of receipt of written notice.

## **VIII. UNREGISTERED INDUSTRIAL DESIGN**

### **Novelty and Duration of Protection of Unregistered Designs**

#### Article 42

An industrial design which has not been registered with the competent authority (hereinafter referred to as: the Unregistered Design) shall be considered new if an identical industrial design was not made available to the public prior to the date when the unregistered industrial design was made available to the public.

The protection right for an unregistered industrial design shall last for three years from the date when the design was made available to the public in Montenegro for the first time.

An unregistered design shall be deemed to have been made available to the public, if it has been published, exhibited or used in trade in goods or otherwise disclosed in the course of regular business activities to the groups specialized in the given sector in Montenegro.

The industrial design shall not be deemed to have been made available to the public if it has been disclosed to a third person under conditions of confidentiality related to the industrial design.

Provisions of Articles 6, 10 and 11 of the present Law shall be applicable to unregistered industrial designs.

## **IX. CIVIL LAW PROTECTION**

### **Declaration of Invalidity of the Industrial Design Registration**

#### Article 43

Any legal or natural person shall be entitled to file a lawsuit with a competent authority aimed at declaring the industrial design registration invalid either in whole or in part, in the course of duration of the right.

The lawsuit referred to in paragraph 1 of the present Article may be filed where a design has been registered contrary to the provisions of Article 11 paragraph 1 items 1, 2 and 3 of the present Law.

The court shall be obliged to submit to the competent authority the final judgment declaring the industrial design registration invalid either in whole or in part.

### **Contending the Industrial Design Right**

#### Article 44

A designer or his/her legal successor shall be entitled to file a lawsuit with the court seeking declaration that he/she is the holder of the industrial design registered to the defendant's name contrary to the provisions of Article 12 of the present Law, or that the he/she is the industrial design holder together with the person to whom the industrial design has been registered.

Following the receipt of the final court decision, the competent authority shall enter the plaintiff into the Register at his/her request as a holder of the industrial design.

### **Lawsuit for Acknowledging Authorship**

#### Article 45

By filing a lawsuit with the court, the person who considers himself/herself as being the author of the industrial design or his/her legal successor, may seek the declaration that he/she is the author of the industrial design registered to the defendant's name contrary to the provisions of Article 13 of the present Law, and that he/she be entered into all documents and the Register as the author of the design.

The plaintiff referred to in paragraph 1 of the present Article may request that the judgment be published at the expense of the defendant, seek compensation for moral and material damage as well as payment of costs and expenses of the court proceedings.

The period for filing the lawsuit referred to in paragraph 1 of the present Article shall not have a time limit.

### **A request for determination and a request for cessation of violation**

#### Article 46

Any person who has, unlawfully performing some of the actions referred to in Article 15 of this Law, violated design, a holder of design may file a lawsuit before the competent court to require finding of a violation of design.

A holder of design may file a lawsuit against the person referred to in paragraph 1 of this Article asking for cessation of the violation and prohibition of such or similar violations in the future, under the threat of payment of fine.

A holder of design may file a lawsuit against the person who has, by taking some actions, caused serious danger that design will be violated in terms of Article 15 of this Law, for cessation of these actions and prohibition of violation of design, under the threat of payment of fine.

The requirements referred to in paragraphs 1, 2 and 3 of this Article may be set against a person who, in the course of his/her business activities, provides services that are used in operations for execution of violation of design or who threatens to violate design.

Lawsuits referred to in paragraphs 1 and 2 of this Article may be filed within five years from the date of the executed violation of design.

If the plaintiff proves that the person referred to in paragraphs 1 and 2 of this Article acted intentionally, lawsuits referred to in paragraphs 1 and 2 of this Article may be filed for the entire duration of design protection.

The lawsuit referred to in paragraph 3 of this Article may be filed within five years from the date of the execution of action which threatens to violate design.

### **Request for confiscation and destruction of objects**

#### Article 46a

A holder of design may file a lawsuit against any person who has, by unlawfully performing some of the actions referred to in Article 15 of this Law, violated the design, requesting removal of products performing violation of design from the market, their confiscation or destruction.

The measure referred to in paragraph 1 of this Article a holder of design may require in relation to the tools, equipment and other items that are mainly used for manufacturing or creating of products which violate a design.

The measures referred to in paragraphs 1 and 2 of this Article a court shall determine at the expense of the defendant, unless there are special reasons for not deciding in that way.

In determining the measures referred to in paragraphs 1 and 2 of this Article a court shall take into account all the circumstances of the case, in particular that they are proportionate to the nature and intensity of the injury, as well as the interests of third parties.

Lawsuits referred to in paragraphs 1 and 2 of this Article may be filed within five years from the date the violation has been committed.

**Claim for damages, usual compensation and return of without merits acquired benefits**

Article 46b

A holder of design may claim damages from an individual who, due to unauthorized exercise of any of the actions referred to in Article 15 of this Law, caused damage according to the general rules on damages, in accordance with the law regulating obligations.

Instead of claim for damages referred to in paragraph 1 of this Article, when the circumstances of the case justify that and if the defendant acted without authorization, a holder of design may claim for payment of compensation in the amount which, due to the circumstances, he could require under the license agreement if it is concluded.

If proves that the defendant acted intentionally or careless, a holder of design may, by lawsuit, require a triple amount of compensation referred to in paragraph 2 of this Article.

From a person who has, without grounds in legal business or law by taking some actions referred to in Article 15 of this Law, violated the design and thus gained the benefit, a holder of design may,



regardless of the guilt of the defendant, require by lawsuit the return or reimbursement of the value of gained benefits according to the general rules on gaining without grounds, in accordance with the law governing the obligations.

Lawsuits referred to in paragraphs 1 and 4 of this Article may be filed within the time limits prescribed by the law governing the obligations.

Lawsuits referred to in paragraphs 2 and 3 of this Article may be filed within three years from the date when the plaintiff was informed about the violation and the offender, i.e. not later than five years from the date the violation occurred.

### **The request for publication of the verdict**

#### Article 46c

In the cases of Articles 46, 46a and 46b of this Law, a holder of design may require the final verdict, which has partially or fully adopted the Prosecutor's request, to be published in the media at the expense of the defendant.

The court shall, within the limits of the claim, decide in which media the verdict will be published, as well as the scope of the verdict publication (in whole or in part).

If the court decides that only a part of the verdict should be published, it shall determine, within the limits of the claim, that at least utterance should be published and if necessary that part of the verdict emphasising the type of violation and the person who committed the violation of design.

### **Provisional measures for violation of design**

#### Article 47

At the request of a holder of design who makes it credible that a violation of design occurred or that there exists an imminent risk of violation of design, the court may order any provisional measure which aims to stop or prevent a violation, in particular:

- 1) to order the opponent of the securing to stop or desist from execution of actions which violate a design, and this order a court may also impose against an intermediary whose services are used by third parties in order to perform a violation of design;
- 2) to order an interim seizure or withdrawal from the market of products which violate design or tools, equipment and other objects which are mainly used for manufacturing or creating of products which violate a design.

At the request of a holder of design who makes it credible that a violation of design occurred when conducting business activities in order to obtain commercial or economic benefits, and that there exists a risk of irreparable damage because of such violation, in addition to the provisional measures referred to in paragraph 1 of this Article, the court may order:

- 1) confiscation of movable and immovable property owned by the opponent of the securing that are not directly related to the violation;
- 2) prohibition of disposal of funds at financial institutions and disposal of other assets of the opponent of the securing.

For the determination and enforcement of provisional measures referred to in paragraph 2 of this Article, the court may require the opponent of the securing or other persons who have that information, the delivery of banking, financial and other economic data, or access to other necessary data and documents.

The court shall ensure the protection of confidentiality of data and documents referred to in paragraph 3 of this Article and prohibit their misuse.

### **Determination of provisional measures without notice**

#### Article 47a

Provisional measures referred to in Article 47, paragraph 1 of this Law, the court may order without notifying opponent of the securing if a holder of design makes it credible that otherwise temporary measure will not be effective or there exists a risk of irreparable damage, and provisional measures referred to in Article 47, paragraph 2 of this Law, if a holder of design makes credible that the provisional measure will not be effective or that, given the particularly difficult circumstances of the violation, these measures are necessary.

In the cases referred to in paragraph 1 of this Article, the court shall deliver a decision on provisional measure to the opponent of the securing immediately upon its execution.

With a decision ordering a provisional measure, the court shall determine its duration, as well as the time period in which a holder of design must file a lawsuit in order to justify these measures, if the lawsuit has not been filed.

The deadline for filing a lawsuit referred to in paragraph 3 of this Article may not be longer than 20 working days or 31 calendar days, calculating from the date of delivering a decision to a holder of design, depending on which period expires later.

The provisions referred to in Article 47 and this Article shall not affect the ability to order provisional measures in accordance with

the other provisions of this Law and the law governing the enforcement proceedings.

### **Provisional measures for securing of evidence**

#### Article 48

At the request of a holder of design who makes it credible that his design is violated or in immediate danger of violation, the court may order any provisional measure for the securing of evidence, and in particular it may order:

- 1) to the opponent of the securing to give a detailed description of the objects for which a holder of design makes it credible that they perform violation of design, with or without taking of samples;
- 2) seizure of the objects for which a holder of design makes it credible that they perform violation of design;
- 3) seizure of products, tools, equipment and other items that were used for the production and distribution of objects for which a holder of design makes it credible that they perform violation of design, as well as business documents relating thereto.

Provisional measures referred to in paragraph 1 of this Article, the court may order without notifying opponent of the securing if a holder of design makes it credible that otherwise provisional measure will not be effective or there are risks of irreparable damage.

In the cases referred to in paragraph 2 of this Article the court shall deliver a decision on the provisional measure to opponent of the securing immediately upon its execution.

With the decision ordering a provisional measure, the court shall determine its duration and the time period in which a holder of

design must file a lawsuit in order to justify that measure, if the lawsuit has not been filed.

The deadline for filing a lawsuit referred to in paragraph 4 of this Article may not be longer than 20 working days or 31 calendar days, calculating from the date of receipt of the decision to a holder of design, depending on which period expires later.

The provisions referred to in paragraphs 1 to 5 of this Article does not affect the ability to order provisional measures in accordance with the other provisions of this Law and the law governing enforcement of proceedings, as well as measures for securing of evidence, all in accordance with the law governing civil proceeding.

### **Securing of evidence in civil proceeding**

#### Article 49

When one party in litigation for protection of design against violation in accordance with the provisions of 46 to 50c of this Law refers to certain evidence, claiming that it is with the other party or under his control, the court shall invite that party to submit such evidence within a specified time period.

When a holder of design, as a plaintiff in the lawsuit for protection of design against violation in accordance with the provisions of Articles 46 to 50c of this Law, makes it credible that a violation of design occurred when conducting business activities in order to obtain commercial or economic benefits, the court shall at his/her request require from defendant to provide banking, financial and similar business documents, papers and other evidence found at him or under his control, within a specified time period.

When the party that has been requested to submit evidence referred to in paragraphs 1 and 2 of this Article denies that these evidences are in his/her possession or under his/her control, the court may, in order to establish this facts, present evidences.

Regarding the rights of a party to withhold the submission of evidence, the provisions on withholding the witnessing shall be applied in accordance with the law governing the civil proceedings.

The court shall, regarding all the circumstances, by its own belief, conclude of what importance is the occasion in which a party, having the evidence in possession or under control, does not want to comply with the court decision to submit evidence or, contrary to the court's belief, denies that the evidence is in his/her possession or under his/her control.

## **Obligation to provide information**

### **Article 50**

A holder of design, who initiated litigation to protect a design against violation, may require the submission of data on the origin and distribution channels of products which violate a design.

The request referred to in paragraph 1 may be filed against:

- 1) a defendant in a civil proceeding referred to in paragraph 1 of this Article;
- 2) a person who, in the course of his/her commercial activities, possesses products for which a holder of rights makes it credible that they perform violation of design;
- 3) a person who, in the course of performing his/her commercial activities, provides services for which a holder of rights makes it credible that they perform violation of design;
- 4) a person who, in the course of performing his/her commercial activities, provides services that are used in the actions for which the

holder of rights makes it credible that they perform violation of design;

5) a person who, from a person who is, referred to in items from 1 to 4 of this paragraph, designated as a person involved in the production or distribution of products or services for which a holder of rights makes it credible that they perform violation of design.

The request referred to in paragraph 1 of this Article may be filed as a claim, lawsuit, or request for determination of provisional measures.

The request referred to in paragraph 1 of this Article includes in particular the following information:

1) names, i.e. titles and addresses of manufacturers and distributors, suppliers and other previous holders of goods, as well as wholesalers and retailers to which these goods are intended;

2) quantities of produced, manufactured, delivered, received or ordered products, as well as the prices obtained for these products.

A person, against whom the request referred to in paragraph 1 of this Article has been filed, may refuse to submit the data for reasons from which according to the provisions of the law governing litigation this person may refuse to testify.

If the person, against whom the request referred to in paragraph 1 of this Article has been filed, refuse to provide information without justifiable reason, he/she shall be responsible for damage in accordance with the provisions of the law governing the obligations.

The provisions of this Article do not affect the application of Articles 48 and 49 of this Law, as well as the regulations on the use of classified information in civil and criminal procedures, rules governing liability for misuse of the right to obtain information, and regulations governing the processing and protection of personal data.

### **Alternative measures**

#### Article 50a

At the request of the defendant in civil proceedings referred to in Articles 46 to 50c of this Law who proves that he/she has not been acting intentionally, the court may impose, instead of measure demanded by a holder of design, the payment of monetary compensation to the holder of design, if the execution of that measure to the defendant shall cause disproportionate harm and if monetary compensation, considering all the circumstances of the case, may be considered a reasonable and satisfactory compensation for the violation of design.

### **Persons authorized to submit requests for the protection of rights**

#### Article 50b

Besides a holder of design, i.e. a person authorized by him/her in accordance with the general regulations on representation, the protection of design against violation in accordance with the provisions of Articles 46 to 50c of this Law may be required by the holder of an exclusive license to the extent that he/she has acquired the right to use the design, as well as by the professional organizations for the protection of the rights which right to represent holders of rights of intellectual property has been regularly recognizing in accordance with law.

### **The urgency and application of other laws' provisions**

#### Article 50c

Proceedings referred to in Articles 46 to 50c of this Law shall be urgent.

The provisions of the law governing litigation or enforcement proceedings shall be applied to the procedures referred to in Articles



46 to 50c of this Law, in all matters that are not regulated by this Law.

Costs of proceedings referred to in Articles 46 to 50c of this Law shall be compensated in accordance with the provisions of the law governing litigation or enforcement proceedings.

## **X. REPRESENTATION**

### **Requirements for a Representative**

#### Article 51

An industrial design representative may be:

1) A natural person with Montenegrin citizenship residing in Montenegro, having university degree and having successfully passed the industrial design representative exam before a competent authority;

2) Law office or a lawyer entered into the Montenegro Bar Association Register unless otherwise provided by ratified international treaties;

3) Legal person with its legal seat in Montenegro employing at least one employee meeting the criteria referred to in paragraph 1 of the present Article or having cooperation with such person based on other type of contractual relationship and providing registration services before competent authorities as its registered business activity.

### **Register of Representatives**

#### Article 52

Competent authority shall maintain the Register of Industrial Design Representatives.

Persons meeting the requirements referred to in Article 51 of the present Law shall be entered into the Register of Industrial Design Representatives.

Entry into the Register of Industrial Design Representatives shall be subject to the payment of the prescribed administrative fees and duties.

The industrial design representative exam referred to in Article 51 paragraph 1 item 1 of the present Law shall be taken before a panel of experts of the competent authority.

The curriculum and the manner of taking the industrial design representative exam, the panel composition, examination fee and content of the Register of Industrial Design Representatives shall be determined by the Ministry.

### **Removing a Representative from the Register of Industrial Design Representatives**

#### Article 53

A representative shall be removed from the Register of Industrial Design Representatives:

- 1) At his/her own request;
- 2) If a final court judgment has been passed prohibiting him/her from performing representation activities;
- 3) If he/she has been convicted to a prison sentence exceeding six months, of which he/she must duly notify the competent authority.

## **XI. TRANSITIONAL AND FINAL PROVISIONS**

### **Initiated Procedures**

#### Article 54

Procedures initiated prior to the effectiveness of the present Law shall be finalized in keeping with the present Law, if this is more favorable to the party.

The Industrial Design Register established prior to the effectiveness of this Law shall be harmonized with the present Law within a time period of six months from the date of effectiveness of the present Law.

Industrial Design Application Register established prior to the effectiveness of the present Law shall become a record of applications and shall be harmonized with this Law, within a time period of six months from the date of effectiveness of the present Law.

### **Recognized Rights**

#### Article 55

Industrial designs registered and entered into the Industrial Design Register with the Serbia and Montenegro Intellectual Property Institute (herein after referred to as: Serbia and Montenegro Institute), and/or Serbia Intellectual Property Institute (herein after referred to as: Serbia Institute) until 28 May 2008, shall be valid in Montenegro without requiring the payment of the fee until the expiry of their validity, and/or until the expiry of the time period for which the Serbia Institute has been paid the rights maintenance fee, if their holders have submitted the application for entry into the Register within the time period of one year from the effectiveness date of the present Law.

Industrial designs for which the competent authority has issued the industrial design validity certificate in a form of a note affixed to the copy of the certificate issued by Serbia and Montenegro Institute or Serbia Institute, the competent authority shall enter such designs into the Register without requiring that a separate request be filed, within a time period of one year from the effectiveness date of the present Law.

The competent authority shall issue the rights validity certificate for industrial designs for which rights validity applications have been filed and it shall enter those industrial

designs into the Register within a time period of one year from the effectiveness date of the present Law.

Industrial design validity renewal applications, assignment applications and applications for the change of name and address for industrial designs referred to in paragraph 1 of the present Article shall be deemed as applications for the entry into the Register.

Industrial design rights referred to in paragraph 1 of the present Article shall be established on the basis of design documentation and/or certificate issued by the Serbia Institute.

## **By-laws**

### Article 56

By-laws for the enforcement of the present Law shall be adopted within six months from the date of the present Law taking effect.

Until the adoption of the by-laws referred to in paragraph 1 of the present Article, the provisions of the by-laws adopted on the basis of the Law on the Legal Protection of Designs („Official Gazette of Serbia and Montenegro”, No. 61/04) shall be applicable, unless they are contrary to the provisions of the present Law.

## Deferred application

### Article 56a

The provision referred to in Article 7, paragraph 2 of this Law shall be applied from the date of accession of Montenegro to the European Union.

## **Cessation of the Application of the Law**

### **Article 57**

The Law on the Legal Protection of Designs („Official Gazette of Serbia and Montenegro” No. 61/04) shall cease to be applicable as of the date of the present Law taking effect.

## **Entry into force**

### **Article 58**

This Law shall enter into force on the eighth day from the date of its publication in the “Official Gazette of the Montenegro”.

SU-SK No. 01-692/7

Podgorica

22 December 2010

PARLIAMENT OF MONTENEGRO  
IN ITS 24<sup>TH</sup> CONVOCAATION

SPEAKER OF THE PARLIAMENT

Ranko Krivokapić