

Law on Amendments to the Law on Patents

(“Official Gazette of Montenegro”, No. 125/21)

Article 1

In the Law on Patents (“Official Gazette of Montenegro”, No. 42/15 and 2/17) Article 14 shall be changed to read as follows:

“Administrative dispute

Article 14

Decision of the competent authority is subject to initiating administrative dispute.”

Article 2

In Article 57 paragraph 1 word “case” shall be replaced with the word “request”, and the words: “upon a request of the interested person” shall be deleted.

In paragraph 2 words: “interested person” shall be replaced with the words: “applicant for granting of a compulsory license”.

In paragraph 3 words: “interested person” shall be replaced with the words: “applicant for granting of a compulsory license”.

In paragraph 4 words: “an interested person” shall be replaced with the words: “the applicant for granting of a compulsory license”.

Article 3

The title of the chapter XIV shall be changed to read as follows:

“EXTENDED EUROPEAN PATENT APPLICATIONS AND EUROPEAN PATENTS”.

Article 4

In Article 142 paragraph 2 item 1 words: “for which the European Patent Office (hereinafter referred to as the EPO) acts as a designated or elected office” shall be replaced with the words: “for which the European Patent Office is designated or elected office, and which has been accorded an international date of filing”.

Article 5

After Article 150 new chapter and 16 new articles shall be added to read as follows:

“XIVa. EUROPEAN PATENT APPLICATIONS AND EUROPEAN PATENTS

Effects of European Patent Applications and European Patents in Montenegro

Article 150a

- (1) A European patent application and a European patent shall, subject to the provisions of this Law, have the same effect and be subject to the same conditions as a national patent application and a national patent.
- (2) For the purposes of this Article and Articles 150b to 150p and Article 153a of this Law:
- 1) "European patent application" means an application for a European patent filed under the EPC, as well as an international patent application filed under the PCT for which the European Patent Office is designated or elected Office, and which has been accorded an international date of filing, and in which Montenegro is designated;
 - 2) "European patent" means a European patent granted by the European Patent Office on a European patent application in accordance with the EPC, and designating Montenegro;
 - 3) "National patent application" means a patent application filed under this Law with the competent authority;
 - 4) "National patent" means a patent granted on the basis of a national patent application.

Filing of a European Patent Application

Article 150b

- (1) A European patent application may be filed with the European Patent Office or with the competent authority.
- (2) A European patent application filed with the competent authority shall have the same effect as if it had been filed on the same date with the European Patent Office, provided that it has been transmitted by the competent authority to the European Patent Office in due time.
- (3) A European divisional patent application shall be filed directly with the European Patent Office.
- (4) If the competent authority finds at first sight that an application filed by a national or a person residing in Montenegro concerns an invention of significance for the defence and security of Montenegro within the meaning of Article 124 of this Law, it shall not transmit the European patent application to the European Patent Office in accordance with paragraph (2) of this Article, but shall act in accordance with applicable special regulations on secret inventions.
- (5) The European patent application, which is to be filed with the competent authority in accordance with the provisions of paragraphs 1 to 4 of this Article, may be filed in any of the languages referred to in Article 14, paragraphs 1 and 2 EPC.

Fees and Procedural Costs for European Patent Applications

Article 150c

The fees and procedural costs payable in respect of European patent applications shall be paid in accordance with the provisions of the EPC and the applicable Rules and Regulations to the EPC.

Effects of a European Patent Application

Article 150d

- (1) A European patent application, which has been accorded a filing date and designating Montenegro, shall be equivalent to a regular national patent application, where applicable, with the priority claimed for a European patent application, whatever the outcome of the application may be.
- (2) A published European patent application shall confer upon the applicant the same rights as would be conferred by a national patent application in Montenegro, from the date on which a translation of the claims of the published European patent application into the Montenegrin language is communicated by the applicant to the person using the invention in Montenegro.
- (3) The European patent application shall be deemed not to have had the effect referred to in paragraph 2 of this Article *ab initio*, if it has been withdrawn, deemed to have been withdrawn, finally refused, or if the designation of Montenegro has been withdrawn or deemed to be withdrawn.

Effects of a European Patent

Article 150e

- (1) Subject to paragraphs 2 to 6 of this Article, a European patent designating Montenegro shall, from the date of publication of the mention of the grant of the European patent by the European Patent Office in the European Patent Bulletin, confer the same rights as those conferred by a national patent under this Law.
- (2) Within 3 months from the date on which the mention of the grant of the European patent has been published in the European Patent Bulletin, the holder of the patent shall submit the request to the competent authority to enter the European patent into the Register of Patents, to furnish the competent authority with a translation of the claims of the European patent into the Montenegrin language and to pay the prescribed publication fee and the costs of the printing of the translation of the claims of the granted European patent.
- (3) Where, as a result of an opposition or a request for limitation filed with the European Patent Office, a European patent is maintained with amended claims, the holder of the patent shall furnish the competent authority with a translation of the amended claims into Montenegrin language and shall pay the prescribed publication fee, within three months from the date on which the notice of the decision of the European Patent Office to maintain the European patent in amended form has been published.
- (4) Where the text of claims contains reference signs used in the drawings, such drawings shall be attached to the translation referred to in paragraph 2 and 3 of this Article.
- (5) The competent authority shall publish any translation filed in a timely manner as provided under paragraphs 2 and 3 of this Article.
- (6) If the translation specified in paragraphs 2 and 3 of this Article is not filed in a timely manner or if the fee prescribed in paragraphs 2 and 3 of this Article has not been paid in due time, the European patent shall be deemed void *ab initio* for Montenegro.
- (7) A European patent and the European patent application on which it is based shall be deemed not to have had *ab initio* the effects referred to in paragraph 1 of this Article and in Article 150d,

paragraph 2 of this Law, to the extent that the patent has been revoked or limited in opposition, limitation or revocation proceedings before the European Patent Office.

(8) A decision to enter the European patent in the Register of Patents shall be taken by the competent authority.

(9) Data to be disclosed in accordance with paragraphs 2 and 3 of this Article shall be prescribed by the Ministry.

Authentic text of European Patent Applications or European Patents

Article 150f

(1) The text of the European patent application or the European patent in the language of the proceedings before the European Patent Office, shall be the authentic text in any proceedings conducted in Montenegro.

(2) Notwithstanding the provisions of paragraph 1 of this Article, a translation furnished in accordance with Article 144, paragraph 2 or Article 145, paragraph 2 and 3 of this Law, shall be regarded as authentic, except in revocation proceedings, where the application or the patent in the language of the translation confers narrower protection than that conferred by it in the language of the proceedings.

(3) The applicant for or holder of a European patent may file at any time a corrected translation of patent claims of European patent applications or European patent.

(4) The corrected translation of the claims of a published European patent application shall have no legal effect in Montenegro until it has been communicated to the person using the invention in Montenegro.

(5) The corrected translation of the claims of a European patent designating Montenegro shall not have any legal effect until mention of it has been published by the competent authority as soon as possible after payment of the prescribed fee for the publication.

(6) Any person who, in good faith, uses or has made effective and serious preparations for the use of an invention, the use of which would not constitute infringement of the application or patent in the original translation, may, after the corrected translation takes effect, continue such use in the course of his business or for the needs thereof without payment.

Prior rights and rights arising on the same date

Article 150g

(1) With respect to national patent application and a national patent, a European patent application and a European patent designating Montenegro shall have the same effect on the state of art, as the national patent application and the national patent.

(2) A national patent application and a national patent shall have, with respect to a European patent designating Montenegro, the same effect on the state of art as they have with respect to a national patent.

Simultaneous Protection

Article 150h

Where a European patent designating Montenegro and a national patent have the same filing date or, where priority has been claimed, and the same priority date has been granted to the same person or his successor in rights, the national patent shall have no effect to the extent that it covers the same invention as the European patent designating Montenegro, as from the date on which the time limit for filing an opposition to the European patent has expired without an opposition having been filed, or as from the date on which the opposition procedure has resulted in a final decision to maintain the European patent.

Conversion of European Patent Application into a National Patent Application Article 150i

(1) The competent authority shall carry out a procedure for the grant of a national patent upon the request of an applicant for or holder of a European patent in the following cases:

1) where the European patent application is deemed to be withdrawn under Article 77, paragraph 3 EPC,

2) where the translation of a European patent application under Article 14, paragraph 2 of the EPC has not been filed in due time, pursuant to Article 90, paragraph 3 EPC.

(2) In the case referred to in paragraph 1 item 1 of this Article, a request for conversion of the European patent application into a national patent application shall be filed with the competent authority.

(3) The competent authority shall, subject to the provisions on secret inventions, transmit the request for conversion of a European patent application into a national patent application directly to the central industrial property offices of the Contracting States specified therein.

(4) In the cases referred to in paragraph 1 item 2 of this Article, a request for conversion of the European patent application into a national patent application shall be filed with the European Patent Office, which shall transmit it to the competent authority, if Montenegro is specified therein.

(5) The request for conversion of the European patent application into a national patent application shall be deemed to be filed once the conversion fee has been paid and the proof of payment has been submitted to the competent authority.

(6) The effect of the European patent application referred to in Article 66 EPC shall lapse if the request for conversion is not filed in due time.

(7) Within two months from the filing date of the request for conversion of a European patent application into a national patent application, the applicant shall furnish the competent authority with a translation of the original text of the European patent application into the Montenegrin language and shall pay the prescribed fee for the publication of the mention of the conversion.

(8) The competent authority shall publish any translation filed in a timely manner under paragraph 7 of this Article.

(9) If the fee referred to in paragraph 7 of this Article has not been paid in due time, or if the translation of the original text of the European patent application into the Montenegrin language is not filed in a timely manner, the request for conversion shall be deemed not to be filed, about which the competent authority shall make a decision.

Renewal Fees Article 150j

- (1) Renewal fees for European patents shall be paid to the competent authority for the years following the year in which the mention of the grant of the European patent was published in accordance with special regulations.
- (2) To the payment of the renewal fees under paragraph 1 of this Article, the provisions of Article 141 paragraph 2 of the EPC shall be applied mutatis mutandis.

Disposal of European Patent Application and European Patent Article 150k

The provisions of this Law on assignment of rights, licence, pledge and compulsory licences shall apply to European patent applications and European patents with effect to the territory of Montenegro.

Protection of Infringement Article 150l

Provisions of this Law on civil law protection of rights in case of infringement shall apply to European patent applications and European patents in which Montenegro is designated.

Revocation of the European patent Article 150 m

- (1) Subject to the provision of Article 138 EPC, a European patent may be revoked in the procedure before the competent authority in accordance with this Law, with effect for Montenegro.
- (2) If a request for revocation of a European patent is filed with the competent authority after the initiation of the opposition procedure before the European Patent Office under Article 99 EPC or the procedure concerning a request for limitation or revocation under Article 105a EPC, the competent authority shall stay the procedure concerning the request for revocation until the final outcome of the aforementioned procedures before the European Patent Office.

Application of the European Patent Convention Article 150n

- (1) The provisions of this Law shall apply to the European patent applications and European patents designating Montenegro unless otherwise expressly stipulated by the EPC.
- (2) In case of conflict between the EPC and this Law, the EPC shall prevail.

Extended European Patent Applications and European Patents Article 150o

- (1) The provisions of Articles 141 to 150 and Articles 151, 152, 153 as well as Article 154 of this Law shall apply to the European patent applications filed on or after 1 March 2010, but prior to

the date of entry into force of the European Patent Convention in Montenegro, and European patents granted upon such applications.

(2) All proceedings initiated under the provisions referred to in paragraph (1) shall be completed in accordance with them.

European Patent Applications and European Patents Article 150p

The provisions of Articles 150a to 150j, Article 150m, Article 150n, Articles 151, 152a, 153a as well as Article 154 of this Law shall apply to the European patent applications filed on or after the date of entry into force of the European Patent Convention in Montenegro, and European patents granted upon such applications.”

Article 6

In title of Article 152 after the word “applications” the following words shall be added: “filed prior to the entry into force of the EPC in Montenegro”.

In paragraph 1 after the word “application” the following words shall be added: “filed prior to the entry into force of the EPC in Montenegro”.

Paragraph 2 shall be amended to read as follows:

“Prior to the entry into force of the EPC in Montenegro, the international application may be filed with the competent authority as receiving Office if the applicant is a citizen of Montenegro or natural person who has permanent residence in Montenegro, or a legal entity constituted according to the Montenegrin law or having its seat in Montenegro.”

Article 7

After Article 152 new article shall be added to read as follows:

“The Receiving Office for the International Applications filed as of the entry into force of the EPC in Montenegro Article 152a

(1) Nationals of Montenegro or natural persons who have permanent residence in Montenegro, or a legal entity constituted according to the Montenegrin law or having its seat in Montenegro may opt, as of the entry into force of the EPC in Montenegro, to file an international application either with the European Patent Office or with the International Bureau of the World Intellectual Property Organization, respectively acting then as receiving Office within the meaning of Articles 2(xv) and 10 PCT.

(2) International application may, as of the entry into force of the EPC in Montenegro, be filed in the Montenegrin language solely with the International Bureau of the World Intellectual Property Organization acting as receiving Office under Rule 19.1(a)(iii) PCT.

(3) If an international application is filed in the Montenegrin language with the European Patent Office, the European Patent Office will promptly transmit it to the International Bureau of the World

Intellectual Property Organization under Rule 19.4(b) PCT and it will be considered to have been received by the European Patent Office on behalf of the International Bureau of the World Intellectual Property Organization as receiving Office under Rule 19.1(a)(iii) PCT in accordance with Rule 19.4(a) PCT.”

Article 8

In Article 153 after the word “application” the following words shall be added: “filed on or after 1 March 2010, but prior to the date of entry into force of the EPC in Montenegro”.

Article 9

After Article 153 new article shall be added to read as follows:

“Designation or Election of Montenegro in International Applications filed as of the entry into force of the EPC in Montenegro

Article 153a

Any designation or election of Montenegro in any international application filed as of the date of entry into force of the European Patent Convention in Montenegro shall be considered as a request for the grant of a European patent having effect in Montenegro in accordance with the EPC.”

Article 10

In Article 154 words: “Article 152” shall be replaced with the words: “Article 152 and 152a”.

Article 11

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