

**THE LAW
ON AMENDMENTS TO THE LAW ON TRADEMARKS**

("Official Gazette of Montenegro", No.3/23)

Article 1

In the Law on Trademarks ("Official Gazette of Montenegro", No. 72/10, 44/12, 18/14, 40/16 and 2/17) in Article 2 paragraphs 2 and 3 shall be amended to read as follows:

A trademark shall protect a mark that is suitable for distinguishing goods or services of a legal or natural person from goods or services of another legal or natural person and which is entered in the register in a manner that allows to determine the exact and clear subject of protection of the mark which the trademark provides to the trademark holder.

The mark referred to in paragraph 2 of this Article may consist of words, personal names, slogans, letters, numbers, images, drawings, colors, color schemes, product shapes or product packaging, combinations of these signs, as well as sounds.

Article 2

In the title of Article 5, the comma and the words: "register of applications" shall be deleted.

In paragraphs 1 and 8 words: "and the register of applications" shall be deleted.

Paragraphs 2 shall be amended to read as follows:

The register shall contain information on:

- the applicant (personal name and address, i.e., name and headquarter),
- the appearance of the sign for which the application for registration has been submitted,
- list of goods and services,
- proof of the administrative fee payment,
- the date of submission of the application,
- the trademark application number and,
- the holder of the trademark, the requested priority right, the date of publication of the application, the appearance of the trademark,
- third parties who have given a reasoned opinion,
- the complainant, the date of entry of the trademark in the Register, the registration number,
- International registration, renewal of the trademark and the date of termination of the trademark and changes in the data contained in the Register.
- Paragraph 3 is deleted.

Paragraph 4 shall be amended to read as follows:

The register shall be kept in electronic form and be available to the public.

Paragraph 6 shall be amended to read as follows:

The competent authority shall publish the data on the trademark entered in the Register referred to in paragraph 1 of this Article in the Official Gazette.

In paragraph 7 words: "paragraph 6" is replaced by words:"paragraph 5".

Existing paragraphs 4 to 8 shall be paragraphs 3 to 7.

Article 3

In Article 6, paragraph 1, item 1 shall be amended to read as follows:

- 1) Which does not meet the requirements of Article 2 paragraphs 2 and 3 of this Law;

Item 6 shall be amended to read as follows:

6) Consisting exclusively of the shape or another characteristic of a product which:

- is the result of the nature of the products themselves,
- is necessary to obtain a technical result,
- gives the products intrinsic value;

Item 12 and item 13 shall be amended to read as follows:

(12) Which cannot be registered in accordance with the law of the European Union or regulations in Montenegro or international agreements to which the European Union or Montenegro is a member, and which provide protection to:

- designation of origin and geographical indication, or
- traditional expressions for wines, or
- guaranteed traditional specialties;

(13) Consisting of an earlier denomination of a plant variety or reproducing it in its essential elements, which is registered in Montenegro, in accordance with the law that are providing protection of plant variety rights and relating to plant varieties of the same or closely related kind;

After item 13, a new item shall be added to read:

(14) Consisting of an earlier denomination of a plant variety or reproducing it in its essential elements, which is registered in accordance with the law of the European Union or international agreements to which the European Union is a member that are providing protection of plant variety rights and relating to plant varieties of the same or closely related.

In paragraph 2, the words: "declare invalid" shall be replaced by the word "annul", and after the words: "applications for registration" a comma and the words: "i.e., before the date of submission of the request for annulment" shall be added.

Article 4

In Article 7, paragraph 6, after the words: "earlier trademark" the comma shall be deleted, and the words: "and registration of goods or services that are not similar was requested" shall be replaced by the words: "regardless of whether the goods or services for which the application for registration was submitted are identical, similar or not similar".

Article 5

Article 8 shall be amended to read as follows:

Based on the complaint of the trademark holder, the trademark cannot be registered:

- 1) on behalf of a representative who is entrusted to perform activities in a company within the limits of the authority to represent in accordance with the law and the founding act of the company (hereinafter: commercial representative) without the consent of the trademark holder;
- 2) if its use would constitute a violation of the right to personal name, portrait right, copyright or other industrial property rights;

- 3) which is identical or similar to the sign that was used in a good faith in trade before the date of filing the application for registration of a trademark, or the date of priority from Articles 23 and 24 of this law;
- 4) if it can be replaced with an earlier trademark registered in another state, provided that the applicant for the trademark did not act in good faith at the time of filing;
- 5) if the application for registration of a designation of origin or geographical indication has already been submitted in accordance with the law, before the date of filing the application for registration of the trademark or the priority date requested in the application, provided that designation of origin or geographical indication:
 - is registered, and
 - gives the person authorized in accordance with the law the right to prohibit the use of a later trademark;
- 6) if the application for registration of a designation of origin or geographical indication has already been submitted in accordance with the European Union law which prescribes the protection of designations of origin or geographical indications, provided that:
 - the application for registration of a designation of origin or geographical indication has already been submitted in accordance with European Union law before the date of filing the application for registration of a trademark or the priority date requested in the application, provided that it is registered later,
 - the designation of origin or geographical indication gives the person authorized in accordance with the law the right to prohibit the use of a later trademark;

Notwithstanding paragraph 1, item 1 of this Article, a commercial representative may register a trademark without the consent of the trademark holder, if that representative in the proceedings conducted before the competent authority states justifiable reasons to avoid violating the interests of the trademark holder.

Article 6

In Article 10, paragraph 2, item 3 shall be amended to read as follows:

(3) a sign that is identical or similar to its trademark, regardless of whether the goods or services in respect of which the trademark is used are identical, similar or not similar to the goods or services for which the trademark is registered, when the trademark has a reputation in Montenegro and when the use of that sign without good reason unfairly exploits the distinctive character or reputation of the trademark or harms them.

Paragraph 4 shall be amended to read as follows:

Notwithstanding paragraph 3 of this Article, the trademark holder shall be entitled to compensation for actions taken after the date of publication of the trademark application, and before the date of publication of the trademark registration, which will be prohibited after the publication of the trademark registration.

Article 7

Article 11 shall be amended to read as follows:

In accordance with the provisions of Article 10, paragraph 2 of this Law, without the approval of the trademark holder other persons may not:

- 1) affix a trademark on the goods, their packaging or means for marking the goods;
- 2) offer the goods, place them on the market, or stock them for the purpose of placing them on the market, or offer them or perform services under a trademark;

- 3) import or export goods under a trademark;
- 4) use a trademark on business documents or in advertising;
- 5) use the sign as a trade name or the name of a trade company or part of a trade name, or part of the name of a trade company;
- 6) Use the sign in comparative advertising in a manner that is contrary to the regulations on misleading and comparative advertising.

The holder of a trademark which is well known in Montenegro shall also have the rights referred to in paragraph 1 of this Article and Article 10 of this Law in accordance with Article 6bis of the Paris Convention.

The provisions of paragraph 1 of this Article and Article 10 paragraphs 1 and 2 of this Law shall not affect the application of the provisions on protection against the use of the sign, except for the purposes of distinguishing goods or services, if the use of that sign without justifiable reason unfairly exploits the distinctive character or reputation of the trademark or it harms them.

The holder of a registered trademark, regardless of the rights of the holder obtained before the date of filing the application or the priority date of the registered trademark, has the right to demand that third parties be prevented from importing goods which are not in free circulation into the territory of Montenegro where the trademark is registered if these goods, including their packaging:

- comes from third countries, and
- without approval, it bears a trademark that is identical to the trademark registered for that goods or that cannot be distinguished from that trademark by its essential characteristics.

The right of the trademark holder referred to in paragraph 4 of this Article shall cease to be valid if during the procedure for determining infringement of a registered trademark initiated in accordance with customs regulations on the application of intellectual property rights, the declarant or owner of the goods proves that the registered trademark holder is not authorized to prohibit the placing on the market in the country of final destination.

If there is a risk that packaging, labels, tags, security or authenticity marks or other markings on which the trademark is affixed may be used in connection with goods or services and that such use would infringe the rights of the trademark holder in accordance with paragraph 1 of this Article and Article 10 paragraph 2 of this Law, the holder of that trademark shall have the right to request from the administrative body responsible for customs affairs and the administrative body responsible for inspection affairs to prohibit:

- 1) affixing a sign identical or similar to a trademark on the packaging, labels, tags, security or authenticity marks, or on other markings on which the trademark may be affixed,
- 2) offering or placing on the market or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity marks or other means on which the trademark is affixed.

Article 8

In Article 12 paragraph 1, after the word shall, the words: “without delay and in the case of publication in printed form” shall be added.

Article 9

In Article 13, paragraph 1 shall be amended to read as follows:

If the trademark is registered in the name of the commercial representative of the trademark holder without the consent of the trademark holder, and the commercial representative does not state justified reasons in terms of Article 8 paragraph 2 of this Law, the trademark holder shall have the right to prohibit the use of the trademark."

Article 10

Articles 16 shall be amended to read as follows:

The Right of the Holder of the Later Registered Trademark

Article 16

In proceedings for infringement of the right, the holder of the trademark shall not be authorized to request a ban on the use of a later registered trademark if that trademark is not annulled in accordance with Article 52, Article 52a paragraphs 1 and 2 and Article 52b paragraph 3 of this law.

If the holder of the trademark is not authorized to request a ban on the use of a later registered trademark in accordance with paragraph 1 of this Article, the holder of the later registered trademark shall have no right to request a ban on the use of the earlier registered trademark.

Article 11

Articles 17 shall be amended to read as follows:

Using the Trademark after Registration

Article 17

If in the period of five years from the day of completion of the trademark registration procedure, the right holder did not actually use the trademark for goods or services for which it was registered or if it ceased to be used in a continuous period of five years, the provisions of Articles 17a, 33, 52b and 53 of this Law will apply, unless there are justified reasons for not using the trademark.

The use of the trademark referred to in paragraph 1 of this Article shall also be the use in a form that differs in elements that do not change the distinctive character of the trademark in the form in which it is registered, as well as placing the trademark on goods or their packaging or services only for export purposes.

The use of a trademark with the consent of the right holder or the person authorized to use the collective trademark shall be considered to be the use by the right holder.

Notwithstanding paragraph 1 of this Article, if the defendant requests a ban on the use of the trademark, the trademark holder shall have to prove that during the five years prior to the filing date the trademark was in actual use in relation to the goods or services for which it is registered and which are stated as reasons for the lawsuit or that there are justified reasons for not using the trademark, provided that the trademark registration procedure was completed at least five years before the date of filing the lawsuit.

The date of commencement of the deadline referred to in paragraph 1 of this Article shall be entered in the Register.

Article 12

Article 20 shall be amended to read as follow:

The application shall contain:

- 1) request for trademark registration;
- 2) information on the applicant;
- 3) the appearance of the sign which the applicant intends to protect with a trademark;
- 4) list of goods or services for which registration is requested;
- 5) proof of payment of the administrative fee;
- 6) Power of attorney to represent, if the application was submitted through a representative.

Goods and services from application referred to in paragraph 1, item 4 of this Article shall be classified into classes according to the International Classification of Goods and Services established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter: Nice Classifications).

The applicant shall clearly and precisely identify the goods and services for which the trademark protection is sought, so that the scope of the protection can be determined exclusively on the basis of the application.

Identification of goods and services referred to in paragraph 3 of this Article shall be performed in accordance with the Nice Classification.

Classes and designations of goods and services whose identification is performed in accordance with the Nice Classification shall include all goods and services listed in that class or designation.

Goods and services that are not covered by the class or designation referred to in paragraph 5 of this Article shall not be considered the subject of the application for registration of a trademark or registered trademark.

If the applicant requires the registration of more than one class, then the applicant classifies the goods and services according to the classes of the Nice Classification, each group being preceded by the class number to which that group of goods or services belongs and lists them according to the order of classes.

Goods and services referred to in paragraph 3 of this Article shall not be considered mutually:

- similar because they appear in the same class of the Nice Classification,
- different because they appear in different classes of the Nice Classification.

The application form referred to in paragraph 1 of this Article shall be prescribed by the Ministry.

Article 13

In Article 21, paragraph 3 and Article 26a, paragraph 6, the words: "register of applications" shall be replaced by the word "Register".

Article 14

In Article 23, paragraph 1, after the words: "Paris Convention", the words: "for the protection of industrial property (hereinafter: The Paris Convention)" shall be added.

Article 15

In Article 27, paragraph 1, the words: “register of applications” shall be replaced by the word “Register”.

In paragraphs 2 and 5 and Article 28, paragraph 4, the words: “60 days” shall be replaced by the words: “30 days”.

Article 16

Articles 30 shall be amended to read as follows:

Opinion of Other Persons

Article 30

After publishing the application referred to in Article 29 of this Law, legal and natural persons or associations of producers of goods or service providers, traders and consumers may submit to the competent authority in writing a reasoned opinion (hereinafter: opinions) on the absolute reasons for refusing registration referred to in Article 6 of this Law, within 90 days from the day of publication of the application.

The persons referred to in paragraph 1 of this Article shall not be parties to the proceedings. After receiving the opinions referred to in paragraph 1 of this Article, the competent authority shall submit them to the applicant for registration of the trademark, who may rule on them within 15 days from the date of receipt of the opinions.

If the applicant for trademark registration does not respond to the opinions within the period referred to in paragraph 3 of this Article, the competent authority shall issue a decision on refusal or registration of the trademark, which shall be published in the Official Gazette.

The competent authority may, ex officio, before registration, re-initiate the examination of the absolute reasons for refusal of registration referred to in Article 6 of this Law.

Article 17

Articles 31 shall be amended to read as follows:

Objection to Trademark Registration

Article 31

Objection for refusal to register a trademark in the case referred to in Articles 7 and 8 of this Law shall be submitted to the competent authority, within 90 days from the day of publishing the application in the Official Gazette.

The objection referred to in paragraph 1 of this Article may be filed by the holder of the earlier trademark or the assignee who has the approval of the trademark holder, holder of personal name, portrait right, copyright or other industrial property right referred to in Article 8 paragraph 1 item 2 of this Law, a stakeholder when an objection is submitted on the basis of Article 8, paragraph 1, item 3 and 4 of this Law and persons who are:

- 1) in accordance with the law governing the protection of geographical indications, authorized to exercise the rights referred to in Article 8, paragraph 1, item 5 of this Law;

- 2) on the basis of legal regulations of the European Union which provide protection of designations of origin and geographical indications, authorized to exercise the rights referred to in Article 8, paragraph 1, items 5 and 6 of this law.

If, on the day of publishing the trademark application, the procedure for revocation of the previous trademark or the procedure for annulment of the trademark has been initiated, the competent authority shall suspend the procedure of reviewing the objection until the decision in these proceedings becomes final.

An objection may be filed on the basis of one or more previous rights referred to in Article 8, paragraph 1, item 2 of this Law, provided that they all belong to the same holder.

An objection may be filed for goods or services or only for a part of goods or services in respect of which a previous right has been protected or for which an application has been filed.

The deadline for submitting objections referred to in paragraph 1 of this Article may not be extended.

An administrative fee shall be paid for filing an objection referred to in paragraph 1 of this Article.

Article 18

In Article 33, in introductory sentence paragraph 2, the words: “on the day of publication of the application” shall be replaced by the words: “on the date of filing the application or on the date of priority of the later trademark”.

Article 19

In Article 33b, paragraph 2, the words: “longer than six months” shall be replaced by the words: “shorter than 24 months”.

At the end of paragraph 3, the full stop shall be replaced by a comma and the words: "or if the procedure is not completed in another way" shall be added.

In paragraph 6, the words: “refusal of the objection or decision on refusing registration of the trademark.” shall be replaced by the words: “suspend the proceedings on the opinion.”.

Article 20

In Article 34, paragraph 2, the words: “60 days” shall be replaced by the words: “two months”.
In paragraph 4 comma and words: “request for return into previous condition from Article 38 of this Law ” shall be deleted.

Article 21

In Article 37, paragraph 1, after the word services, the comma shall be replaced by a full stop, and the words: “correction of errors in the text or transcript or correction of another obvious error” shall be deleted.

After paragraph 1, three new paragraphs shall be added to read as follows:

If the entry of the trademark in the Register, or the published application, or the registration of the trademark or the decision of the competent authority contains an obvious error, the competent authority shall correct the error ex officio or at the request of the party.

The competent authority shall issue a decision which deletes the previous entry of the trademark in the Register or the previous publication of the application, i.e., by which it corrects

the previous decision containing an obvious error with a new decision and publishes the correction of incorrectly published data.

An administrative fee and reimbursement of costs shall not be paid for the submission of a request for correction of errors referred to in paragraph 1 of this Article.

In paragraph 5 the words: “paragraphs 1 to 4” shall be replaced by the words: “paragraphs 1 to 7”.

Existing paragraphs 2 to 6 shall be paragraphs 5 to 9.

Article 22

Articles 38 shall be amended to read as follows:

Highlighting Multiple Requests for Entry in the Register, Removal or Change of Rights in the Register

Article 38

The applicant or the holder of the trademark, may submit to the competent authority multiple requests related to entry in the register, removal or change of rights in the register, stating the numbers of applications or registration to which the request refers.

The applicant referred to in paragraph 1 of this Article shall submit evidence of payment of the prescribed administrative fee and reimbursement of costs, for each application or registration contained in that application.

Article 23

Articles 39 shall be amended to read as follows:

License

Article 39

The holder of the trademark may, on the basis of the license agreement, assign the right to use the trademark for goods or services or only for a part of the goods or services.

The license may be exclusive or non-exclusive.

An exclusive license is a license on the basis of which the license assignee acquires the exclusive right to use the trademark, if that right is explicitly agreed.

A non-exclusive license is a license under which the license assignee does not acquire the exclusive right to use the trademark.

The agreement referred to in paragraph 1 of this Article shall be entered in the Register at the request of the trademark holder or license assignee, if the following documentation has been submitted to the competent authority with the request:

- a certified copy of the license agreement or the agreement on the assignment of the registered license, which shows the contracting parties and the rights to be licensed, or the rights from the registered license to be assigned, or
- certified statement on assigning or transferring the registered license, signed by the licensor and the license assignee.

The data on the license agreement entered in the Register in the manner referred to in paragraph 5 shall be changed or deleted at the request of the trademark holder or the license assignee.

The trademark holder may invoke the rights from the trademark against the license assignee who does not comply with the provisions of the license agreement in relation to:

- the duration of the license agreement,
- registration of the determined manner in which the trademark may be used, in terms of Article 11 of this Law,
- the scope of goods and services for which the license is assigned,
- the territory in which the mark may be used or the quality of the goods produced or services offered by the license assignee.

A trademark cannot be subject to a compulsory license.

Entries in the Register from paragraphs 5 and 6 of this Article shall be made by a decision.

Entries of the license agreement in the Register shall be published in the Official Gazette.

Article 24

Articles 40 shall be amended to read as follows:

Trademark Assignment

Article 40

The holder of the trademark may assign to another person the trademark for goods or services or only for a part of the goods or services for which it is registered.

When transferring a share, or merging a company, the trademark of that company shall also be assigned, unless otherwise determined by the agreement between the companies.

In case of assignment of the trademark in relation to only a part of the goods or services for which the trademark is registered, the procedure of separation of registration shall be performed in accordance with Article 36 of this Law.

The procedure for registration of the assignment of a trademark shall be initiated by a request, accompanied by:

- 1) the proof of legal basis of the required registration;
- 2) the power of attorney, if the procedure for registration of the assignment of a trademark, license or pledge is initiated through an agent;
- 3) the proof of payment of the administrative fee for registration of the assignment of rights, license or pledge.

Registration of the license or pledge may be requested on the basis of a request referred to in paragraph 4 of this Article, provided that the holder of the trademark and the license or pledge assignee are the same person.

The assignment of the trademark shall be entered in the Register and published in the Official Gazette.

The application form and more detailed documentation submitted with the application referred to in paragraph 4 of this Article shall be prescribed by the Ministry.

Article 25

Articles 41 shall be amended to read as follows:

Pledge, Enforced Performance and Bankruptcy

Article 41

A trademark may independently be the subject of a pledge on the basis of a pledge agreement, the subject of other rights in rem or the subject of enforcement, in relation to the company that is the holder of such trademark.

At the request of the pledge creditor or pledge debtor, the pledge right shall be entered in the Register.

The court ex officio or the public executor who conducts the enforcement, shall inform the competent authority without delay about the initiated enforcement on the trademark, for the purpose of entry in the Register.

The registration referred to in paragraph 2 of this Article may also be initiated at the request of the person referred to in paragraph 2 of this Article.

The competent authority shall issue a decision on the registration referred to in paragraph 2 of this Article.

The registration of the pledge and the fact that enforcement has been initiated against the trademark shall be published in the Official Gazette.

After the submission of the notification by the competent court or the bankruptcy trustee, the data on the bankruptcy shall be entered in the Register and published in the Official Gazette.

The detailed content of the request for registration of the license and pledge and the documentation attached to the request shall be prescribed by the Ministry

Article 26

After Article 41a, a new article shall be added to read as follows:

The Effect of Registration on Third Parties

Article 41b

Based on the request for registration, removal or change in the Register submitted in accordance with the provisions of Articles 39 to 41a of this Law, that registration, removal or change shall have effect towards third parties after the entry in the Register.

Article 27

In Article 43, paragraph 1, the words: "10 years" shall be replaced by the words: "ten years".

After paragraph 5, two new paragraphs shall be added to read as follows:

If the license is entered in the Register, the renunciation of the trademark shall be entered in the Register only if the holder of the trademark proves that they have informed the license assignee of their intention to renounce.

The renunciation of the trademark shall be entered in the Register and the competent authority shall issue a decision on the registration after expiration of the three-month period, from the day on which the holder proved to the competent authority that he informed the license assignee of the intention to renounce or before the expiration of that period immediately after obtaining the consent from the license assignee.

The previous paragraphs 6 and 7 shall become paragraphs 8 and 9.

Article 28

In Article 44, paragraph 1 shall be amended to read as follows:

A collective trademark shall mean a trademark which is described as such in the trademark application and which is suitable for distinguishing goods or services, members of the association which is the holder of that trademark from the goods or services of another legal or natural person.

Article 29

Article 46 shall be amended to read as follows:

Submitting an Application for a Collective Trademark

Article 46

Applicants for the registration of a collective trademark may be an association of producers, service providers or traders, as well as legal entities under public law that may exercise rights, assume obligations, conclude contracts or perform other legal actions on their own behalf.

In the event of infringement of a collective trademark the holder of the collective trademark shall have the right to claim damages on behalf of persons authorized to use the trademark, if those persons have suffered damage as a result of unauthorized use of the trademark

Persons referred to in paragraph 1 of this Article shall be considered state bodies, state administration bodies, administrative bodies, local self-government bodies, local government bodies, legal entities and other entities exercising public authority.

Article 30

After Article 47, a new article shall be added to read as follows:

Rejection of the Application for a Collective Trademark

Article 47a

The application for registration of a collective trademark shall be rejected by the competent authority if:

- 1) it does not meet the conditions provided for in Article 6 of this Law, except in the case of protection of a geographical indication by a collective trademark;
- 2) it has not been submitted in accordance with the provisions of Article 44, paragraph 1 or Article 46 of this Law;
- 3) the general act on the collective trademark is not in accordance with the law;
- 4) there is a likelihood of misleading the public as to the character or meaning of the trademark, especially if there is a likelihood of misleading that it is considered to be something other than a collective trademark.

The competent authority shall not reject the application if the applicant amends the general act on the collective trademark in a way that it meets the conditions referred to in paragraph 1 of this Article.

Opinions of third parties on the application for registration of a collective trademark, in accordance with Article 30 of this Law, may also be based on the reasons for rejecting registration of a collective trademark prescribed by paragraph 1 of this Article.

Article 31

In Article 48 paragraph 2, the words: "Article 47" shall be replaced by the words: "Articles 47 and 47a".

Article 32

Article 50c shall be amended to read as follows:

Proving the Use of an Internationally Registered Trademark

Article 50c

In order to prove the use of an internationally registered trademark in proceedings on objection, annulment or revocation of a trademark, the date on which the statement of the competent authority on recognition of protection of international trademark registration in Montenegro is published in the Official Gazette of the International Bureau shall be taken.

If within one year from the date of notification of the International Bureau on the request for extension of protection of international registration on the territory of Montenegro, the competent authority has not notified the International Bureau of temporary rejection of protection, nor has it submitted a statement recognizing the protection of the international registration of the trademark, in determining the date from which such trademark has to be used, the first day after the expiry of that period shall be taken.

If upon the expiration of the deadline referred to in paragraph 2 of this Article, the procedure for requesting extension of protection of an internationally registered trademark in the territory of Montenegro is not completed, the date of international registration shall be the date when the competent authority notified the International Bureau of its decision to grant protection.

Article 33

Articles 51 shall be amended to read as follows:

Annulment of a Trademark Based on Absolute Reasons

Article 51

If the trademark has not been registered in accordance with Article 6 of this Law, the competent authority may annul the registered trademark, in whole or in part.

The procedure for annulment of a registered trademark may be initiated by the competent authority ex officio or at the request of interested persons, if the applicant did not act in good faith when filing the application.

In case the registration of the trademark has not been performed in accordance with Article 6 of this Law, the request may be submitted by any interested person.

The interested person referred to in paragraph 3 of this Article is a natural or legal person, group or body established to represent the interests of producers, service providers, traders or consumers, who may sue and be sued in their own name.

If the trademark is not registered in accordance with Article 6 of this Law, the trademark shall be annulled if the reasons for annulment exist when the decision on annulment of the trademark is adopted.

If the trademark is not registered in accordance with Article 6, paragraph 1, item 2 to 5 of this Law, the trademark shall not be annulled if the holder of the trademark proves that the

trademark has acquired a distinctive character in relation to the goods or services, for which it was registered before the date of filing the request for annulment.

Article 34

Articles 51a shall be amended to read as follows:

Annulment of a Trademark Based on Relative Reasons

Article 51a

If the registration of the trademark has not been performed in accordance with Articles 7 and 8 of this Law, the competent authority may annul the registered trademark, in whole or in part.

If the registration of a trademark has not been performed in accordance with Article 7 of this Law, the request may be submitted by the holder of the earlier trademark, as well as by license assignees who have the approval of the holder of that trademark.

If the registration of the trademark has not been performed in accordance with:

- 1) Article 8, paragraph 1, items 1, 2 and 3 of this Law, the request may be submitted by the person whose right has been violated,
- 2) Article 8, paragraph 1, item 4 of this law the request may be submitted by the person whose right has been violated and the interested person,
- 3) Article 8, paragraph 1, items 5 and 6 of this Law, the request may be submitted by persons in accordance with:
 - a. regulations providing for the protection of designations of origin and geographical indications;
 - b. European Union law providing for the protection of designations of origin and geographical indications.

When the holder of any of the rights from Articles 7 or 8 of this Law, on which the request for annulment of a trademark is based, has previously filed request for annulment of a trademark, they may not file a new request for annulment of a trademark on the basis of any other right from those articles to which they could refer in the first request.

The trademark cannot be annulled if the holder of any of the rights from Articles 7 or 8 of this Law, on which the request for annulment of a trademark is based, has explicitly approved the registration of the trademark prior to the filing of that request.

If on the date of filing the request for annulment of the trademark on the basis of the earlier trademark the procedure on the request for revocation or annulment of the earlier trademark is in progress, the competent authority shall issue a decision on termination of the procedure on the request for annulment of the trademark until the decision from the previously initiated revocation or annulment proceedings becomes final.

An application for annulment of a trademark may be filed on the basis of one or more previous rights, provided that they all belong to the same holder.

Article 35

After Article 51a, a new Article shall be added to read as follows:

Annulment of a Collective Trademark

Article 51b

The competent authority may annul the registered collective trademark:

- 1) for the reasons specified in Articles 51 and 51a of this law,
- 2) when the collective trademark is not registered in accordance with Article 47a of this Law.

Notwithstanding paragraph 1, item 2 of this Article, a registered collective trademark shall not be annulled if the holder of the trademark meets the conditions referred to in Article 47a of this Law by amending the general act.

The procedure for annulment of the collective trademark referred to in paragraph 1 of this Article may be initiated by the competent authority ex officio or at the request of the interested person.

Article 36

Articles 52 shall be amended to read as follows:

Lack of distinctive character or reputation of the earlier trademark which prevents the annulment of the trademark

Article 52

A request for annulment of a trademark based on an earlier trademark will not be accepted on the date of filing the request for annulment, if the request would not be accepted on the date of filing the application for a later trademark or on the day of priority of the later trademark if:

- 1) the earlier trademark may be annulled in accordance with Article 6, paragraph 1, items 2 to 5 of this Law, and has not yet acquired the distinctive character referred to in Article 6, paragraph 2 of this Law;
- 2) the request for annulment of the trademark is submitted in accordance with Article 7, paragraph 6 of this Law, and the earlier trademark has not yet gained a reputation in Montenegro in accordance with this Law;
- 3) the request for annulment of the trademark is submitted in accordance with Article 7, paragraph 1, item 2 of this Law, and the earlier trademark has not yet acquired sufficient distinctiveness, which would justify the likelihood of misleading the public.

Article 37

Articles 52a shall be amended to read as follows:

Inability to file an application for annulment

Article 52a

The holder of an earlier trademark referred to in Article 7 of this Law, who knowingly allows the use of a later trademark for a continuous period of five years, shall not have the right to request annulment of the later trademark in relation to goods or services for which that later trademark is used, unless the application for registration of a later trademark was filed in good faith.

The provision of paragraph 1 of this Article shall also apply to the right holders referred to in Article 8 of this Law.

In the cases referred to in paragraphs 1 and 2 of this article holder:

- 1) of the later trademark has no right to oppose the use of the earlier trademark,
- 2) of the earlier trademark has no right to oppose the use of the later trademark.

Article 38

After Article 52a, three new articles shall be added as follows:

Proving the use of the trademark in annulment proceedings

Article 52b

In proceedings for annulment of a trademark based on a registered trademark with an earlier filing date or an earlier priority date, if the holder of the later trademark requests so, the holder of the earlier trademark shall have to prove that the earlier trademark, during the five years preceding the filing request for annulment, was in actual use in accordance with Article 17 of this Law in relation to goods or services for which it is registered and which are stated as reasons in the request or that there are justified reasons for non-use, provided that the earlier trademark on the date of filing the request for annulment of the trademark has been registered for at least five years.

The competent authority shall invite the holder of the earlier registered trademark to respond on the request referred to in paragraph 1 of this Article within 60 days from the day of receipt of the invitation.

If the holder of the earlier trademark does not respond to the request for proving the use within the period referred to in paragraph 2 of this Article or does not prove the use or justified reasons for non-use of the earlier trademark, the competent authority shall reject the request by a decision.

If the holder of the earlier trademark responds to the request for proving the use of the trademark within the period referred to in paragraph 2 of this Article, the competent authority shall forward the statement to the holder of the disputed trademark and invite him to declare himself within 60 days from the day of receipt of the invitation.

After the expiration of the deadline referred to in paragraph 4 of this Article, the competent authority shall decide on the merits of the request for annulment of the trademark on the basis of available facts from previously submitted documentation and statements.

If the earlier trademark was used only in relation to the part of the goods or services for which it was registered, for the purposes of examining the justification of the request for annulment of the trademark, it shall be considered to be registered only for that part of the goods or services.

Annulment Procedure

Article 52c

The competent authority shall reject the request for annulment of the trademark by a decision if it has not been submitted:

- 1) in accordance with the conditions from Articles 51, 51a and 51b of this law, or
- 2) by the holder of the earlier trademark and the license assignee or if the request has not been submitted in accordance with Article 51a paragraph 4 of this Law.

If the conditions for initiating annulment procedure are met, the competent authority shall notify the trademark holder whose annulment is requested in the initiated trademark annulment

procedure, and provide him with a copy of the request and invite him to respond within 60 days of receiving the invitation.

The deadline referred to in paragraph 2 of this Article may, at the request of the trademark holder whose annulment is requested, be extended by a maximum of 60 days.

If the holder of the trademark whose annulment is requested does not respond to the request for annulment within the period referred to in paragraph 3 of this Article, the competent authority shall annul the trademark for those goods or services in respect of which the procedure was initiated.

If the holder of the disputed trademark responds within the period referred to in paragraph 3 of this Article, the competent authority shall examine the justification of the reasons stated in the request for annulment, in relation to goods or services, or part of goods or services in respect of which the disputed trademark is registered.

In the procedure of examination of the request, the competent authority may invite the parties in the procedure to submit additional documentation regarding the filed request and a statement within 60 days from the day of receipt of the invitation.

The deadline referred to in paragraph 6 of this Article, at the request of the parties to the procedure may be extended by a maximum of 60 days.

If the party in the procedure does not respond to the invitation within the period referred to in paragraphs 2 and 3 of this Article, the competent authority shall make a decision based on the facts from the previously submitted documentation.

If in the procedure of examining the merits of the request for annulment of a trademark registered in the name of a commercial agent in which the assignment of such a trademark is requested in accordance with Article 13 paragraph 2 of this Law, the reasons for annulment of the trademark are determined, the competent authority shall, instead of annulling the trademark, issue a decision on the assignment of the trademark in favor of the holder of the trademark and enter the assignment of the trademark in the Register.

Legal effect of annulment

Article 52d

Persons referred to in Article 51 paragraphs 2 and 3, Article 51a paragraphs 2 and 3 and Article 51b paragraph 3 of this Law may file a request for annulment of a registered trademark to the competent authority during the term of the trademark right, as well as after the expiration of the term of the trademark right.

When the reasons for annulment of a trademark exist in relation of only some goods or services for which the trademark is registered, the annulment of the trademark shall cover only those goods or services.

When the competent authority makes a decision on the annulment of a trademark, it shall be considered that the trademark does not produce legal effect to the extent that the trademark has been annulled.

The competent authority shall enter the annulment of the trademark in the Register and publish it in the Official Gazette.

Article 39

In Article 53 paragraphs 1 and 3 the word “court” shall be replaced by the word “authority”. Paragraph 2 is amended to read:

“The competent authority will reject the request for revocation of the trademark, if the use of the trademark was started or continued after the expiration of a continuous period of five years in which the trademark was not used, and before the request for revocation of the trademark was submitted, unless the start of continuation of the use of the trademark occurred after the owner of the trademark found out that a request for the revocation of the trademark would be submitted and if the use was started or continued within a period of three months before the request for revocation was submitted”.

After paragraph 3, two new paragraphs shall be added to read as follows:

In addition to the reasons for annulment of the trademark referred to in paragraph 3 of this Article, the rights of the holder of the collective trademark shall also be revoked on the basis of a request submitted to the competent authority, if:

- 1) the holder of the collective trademark does not take measures to prevent the trademark from being used in a manner that is not in accordance with the conditions of use set out in the general act, including all its changes entered in the Register;
- 2) the manner in which authorized persons use the collective trademark misleads the public in terms of Article 47a paragraph 1 item 4 of this Law;
- 3) the amendment of the general act entered in the Register is not in accordance with Article 47 of this Law, unless the holder of the trademark succeeds in meeting the conditions specified in that Article by further amendments to the general act.

The holder of a trademark shall have the right to request a ban on the use of the trademark, only to the extent that the rights of the holder at the time of filing the infringement lawsuit are not subject to the possibility of revoking the trademark.

Article 40

After Article 53, a new article shall be added to read as follows:

Trademark revocation procedure

Article 53a

The competent authority shall examine whether the request for revocation of the trademark was submitted in accordance with Article 53 of this Law.

If the applicant has filed a request for revocation of the trademark before the expiration of a period of five years, from the date of registration of the trademark whose revocation is requested or if it has not been filed in accordance with Article 53 of this Law, the competent authority shall reject the request by a decision.

If the conditions referred to in paragraph 1 of this Article are met, the competent authority shall notify the holder of the trademark whose revocation is requested of the filed request for revocation, submit the request and invite the holder to state the opinion on the request within 60 days from the date of receipt.

If the holder of the trademark whose revocation is requested does not respond to the request within the period referred to in paragraph 3 of this Article, the trademark shall be revoked by a decision for goods or services in respect of which the request was submitted.

If the holder of the trademark whose revocation is requested responds to the request, the competent authority shall forward the statement to the applicant for revocation of the trademark and invite him to respond within 60 days from the day of receipt of the invitation.

If the applicant for revocation does not respond within the deadline referred to in paragraph 5 of this Article, the competent authority shall make a decision based on the facts from the previously submitted documentation and statements.

Deadlines from paragraphs 3 and 5 of this Article may, at the request of the holder of the disputed trademark, be extended for a maximum of 60 days.

In the procedure of examining the justification of the reasons for revoking the trademark, the competent authority may invite the parties in the procedure to submit additional documentation regarding the filed request and statement within 60 days from the day of receipt of the invitation.

The deadline referred to in paragraph 8 of this Article may, at the request of the parties to the procedure, be extended by a maximum of 60 days.

If the party in the procedure does not respond to the invitation within the period referred to in paragraphs 8 and 9 of this Article, the competent authority shall issue a decision based on the facts from the previously submitted documentation.

Article 41

Article 54 shall be amended to read as follows:

Legal effect of Revocation of a Trademark Article 54

The request for revocation of the registered trademark may be submitted by interested persons.

When the reasons for revocation of the registered trademark exist only in relation to goods or services for which the trademark is registered, the decision on revocation of the registered trademark shall cover only those goods or services.

When a trademark is revoked, the trademark shall be considered not to have legal effect from the date of filing the request for revocation.

At the request of one of the parties in the procedure, the decision on the request for revocation of the registered trademark may determine the earlier date of revocation of the trademark from the date of filing the request for revocation, on which date one of the reasons for revocation of the trademark appeared from Article 53 of this Law.

The competent authority shall enter the revocation of the registered trademark in the Register and publish it in the Official Gazette.

Article 42

In Article 55, after paragraph 4, a new paragraph shall be added to read as follows:

Paragraph 4 of this Article shall also apply in case of non-compliance with measures adopted in accordance with Articles 55a, 56 and 57 of this law.

The previous paragraphs 5 to 8 shall become paragraphs 6 to 9.

Article 43

Article 55b shall be amended to read as follows:

The holder of the trademark may claim damages from a person who caused damage by unauthorized actions referred to in Articles 10 and 11 of this law, by suing, in accordance with the law on obligations.

Against a person who has, without grounds in legal business or in law, by undertaking some of the actions from Articles 10 and 11 of this Law violated the trademark and thus gained some benefit, the trademark holder may, regardless of the defendant's guilt, file a lawsuit to recover or reimburse the value of the benefits according to the general rules of acquisition without grounds in accordance with the law on obligations.

Claims under paragraphs 1 and 2 of this Article shall not be mutually exclusive and may be submitted within the deadlines determined by the law on obligations.

When determining the amount of damages, the court shall take into account all circumstances, such as negative economic consequences: lost benefit and gained benefit generated by the person who committed the violation, as well as non-material damage caused to the holder of the trademark by unauthorized actions referred to in Articles 10 and 11 of this law which infringe the trademark.

Instead of determining the amount of damages in accordance with paragraph 4 of this Article, the court may, when it deems it appropriate, determine damages against the person who committed the violation in the amount of compensation that would be required in those circumstances if the person who made an infringement had sought authorization to use the trademark.

Article 44

Article 59b shall be amended to read as follows:

In addition to the holder of the trademark, or the person authorized by him, the protection of the trademark from damage in accordance with Articles 55 to 59 of this Law may be requested by the license assignee to the extent to which he has acquired the right to use the trademark, as well as by the professional organization for the protection of rights that has the right to represent the holder of intellectual property rights in accordance with the law.

The license assignee may initiate procedure for trademark infringement, only with the consent of the trademark holder.

The exclusive license assignee may initiate procedure if the trademark holder, after written notice, does not initiate procedure for trademark infringement within a period which may not be longer than 15 days.

The license assignee, in order to obtain compensation for the damage he has suffered, has the right to intervene in the infringement procedure initiated by the trademark holder.

The provisions of this Article relating to the license assignee shall apply to the person authorized to use the collective trademark.

Article 45

Article 59d shall be amended to read as follows:

“Submission request for annulment or revocation of a trademark

In the request for annulment or revocation of the trademark was submitted to the competent authority after the request for the protection of the trademark from infringement in the sense of Art. 55 to 59 of this law, the competent court, assessing all the circumstances of the case,

in accordance with the regulations governing the civil and enforcement proceedings, will make a decision whether to stop the trademark protection proceedings and under what conditions.”

Article 46

Articles 62b shall be amended to read as follows:

Inspection Supervision Procedure Article 62b

The law governing inspection supervision shall apply to issues of inspection supervision that are not specifically regulated by this Law.

The inspection supervision procedure shall be initiated ex officio or upon a written request for protection of the trademark from damage (hereinafter: request for protection) which may be filed by the trademark holder or a person authorized by him in accordance with general regulations on representation and the license assignee to the extent to which he has acquired the right to use the trademark, under the conditions and in the manner prescribed by Article 59b paragraphs 2 to 4 of this Law (hereinafter: the applicant).

The request for protection can be individual, when it refers to a certain type and quantity of goods, or general, when it refers to all quantities of certain goods for a certain period of time. The request for protection shall have to contain data on the basis of which the goods that infringe the trademark can be identified and proof that the applicant is one of the persons referred to in paragraph 2 of this Article, and if it is a general request, the time period to which the request relates.

The applicant for protection may also submit:

- 1) details on the basis of which the consignment or packaging can be identified;
- 2) information on the place where the goods are located, or the intended destination;
- 3) name of the manufacturer, importer, owner or holder of the goods;
- 4) information on the expected date of delivery or dispatch of goods;
- 5) information on the means of transport;
- 6) sample of goods, photographs, etc.

The competent inspector shall, within three days from the day of receipt of a valid request for protection, inform the applicant about the receipt of that request.

The competent inspector shall inform the applicant in writing about the performed supervision upon the request for protection and any measures taken, within three days from the day of the performed supervision.

If the request for protection proposes urgent measures and if the request for protection contains sufficient information on the delivery of goods for which there is a reasonable suspicion that it violates the trademark, the competent inspector shall, within three days from receiving a valid request for protection inform the applicant about the performed supervision and any measures taken.

The applicant shall inform the competent inspector about the termination of the right to a trademark, if that right ceases during the procedure upon request.

Article 47

Articles 62c shall be amended to read as follows:

Security, costs of procedure, compensation for damage and destruction of temporarily seized goods

Article 62c

When in the procedure of inspection supervision, it is assessed that the trademark had been damaged in the production or trade of goods, the competent inspector shall be authorized to:

- 1) temporarily prohibit the production or performance of activities;
- 2) temporarily confiscate the goods.

In case of taking measures from paragraph 1 of this Article, the competent inspector shall immediately, and no later than two days from the day of taking measures, inform the applicant in writing that they can initiate trademark protection procedure before the competent court and the applicant shall, no later than 15 days from the day of receipt of the notification, inform the competent inspector about the initiated procedure before the competent court or a certain temporary measure.

The notification referred to in paragraph 2 of this Article shall contain information on the name or address, or name or headquarters of the person from whom the goods were seized, and preferably on the personal name and address of the owner, importer and manufacturer of seized goods, as well as information on quantity and type of the goods and other data of importance.

If the competent inspector assesses that, given the circumstances of the case, it is justified, he may, in the procedure initiated on the request for protection, condition the determination of the measures referred to in paragraph 1 of this Article by providing appropriate security to the applicant for the purpose of compensation of storage costs for temporarily seized goods or damage resulting from the applicant's omission or unjustified seizure of items.

The costs of the procedure initiated upon the request for protection, which ended favorably for the subject of supervision, shall be borne by the applicant, otherwise they shall be borne by the subject of supervision.

The competent inspector shall not be responsible for compensation for damage caused by unjustified temporary confiscation of goods upon the request for protection.

If it is determined in the procedure that the goods were confiscated unjustifiably upon the request for protection, the applicant shall compensate the owner of the goods, or the person from whom the goods were confiscated, for the damage caused by the temporary confiscation of goods.

Temporarily confiscated goods shall be returned to the person from whom they were confiscated if:

- 1) the applicant, within the period referred to in paragraph 2 of this Article, fails to submit to the competent inspector proof of the initiated procedure before the competent court or a certain temporary measure;
- 2) the procedure was initiated before the competent court, and the court did not order a temporary measure banning the production and trade of goods.

At the request of the applicant or the person from whom the goods were confiscated, the competent inspector shall enable the taking of samples of goods in the amount required as evidence in the procedure before the competent court.

The competent inspector may destroy temporarily seized goods:

- 1) by a court order, or

- 2) ex officio, if the owner, or the person from whom the goods were temporarily confiscated, is not available to the competent inspector 30 days from the day of confiscation of goods.

The competent inspector may also destroy temporarily confiscated goods if:

- 1) the applicant, within three days from the date of receipt of the notification on the obligation to initiate procedure with the competent court referred to in Article 62c paragraph 2 of this Law, notifies the competent inspector in writing that there is a reasonable suspicion that the right to a trademark has been violated, proposes the destruction of the goods in question and that he will not initiate procedure before the competent court, and
- 2) the person from whom the goods were temporarily confiscated agrees with the proposal of the applicant to destroy the goods, or if that person does not file a complaint to the competent inspector on the proposal of the applicant to destroy the goods within three days from the day of receiving notification of the competent inspector on the submission of the proposal from item 1 of this paragraph.

If the person from whom the goods were temporarily confiscated has filed a complaint to the applicant's proposal for destruction of goods, or if that person has not given consent for the destruction of goods, the competent inspector shall immediately notify the applicant.

If the person from whom the goods were confiscated did not file a complaint to the applicant's proposal for destruction of goods or if the person did not give consent for destruction of goods within the period referred to in paragraph 11 item 2 of this Article, the competent inspector may consider that the person from whom the goods were confiscated agrees with the destruction.

The costs of destruction of temporarily confiscated goods shall be borne by the person from whom the goods were confiscated.

Article 48

In Article 62d, paragraph 1, in the end of item 4, fullstop is replaced by semi – colon and two new items shall be added to read as follows:

- 5) using the sign as a trade name or the name of a company or part of a trade name, or part of the name of a company (Article 11, paragraph 1, item 5);
- 6) using the sign in comparative advertising in a manner contrary to the regulations on misleading and comparative advertising (Article 11, paragraph 1, item 6).

Article 49

After Article 63, a new article shall be added to read as follows:

„Initiated procedures for annulment and revocation of a trademark

Article 63a

Procedures for annulment and revocation of a trademark initiated to the day this Law enters into force shall be terminated in accordance with the Law on Trademarks (“Official Gazette of Montenegro”, No. 72/10, 44/12, 18/14, 40/16 and 2/17).

Article 50

In Article 65a, the words: "Provision of Article 15, paragraph 2" shall be replaced by the words: "Provisions of Article 6, paragraph 1, items 13 and 14 and Article 15, paragraph 2."

Article 51

Article 65b shall be amended to read as follows:

From the day of Montenegro's accession to the European Union:

- 1) the following shall be considered an earlier trademark referred to in Article 7, paragraph 1 of this Law:
 - a) the European Union trademark and the European Union trademark application,
 - b) the European Union trademark for which seniority is required, in relation to the trademarks referred to in Article 7, paragraph 2, items 1 and 2 of this Law, and in case the later trademark has been the subject of renunciation or was allowed to expire;
- 2) the registered trademark identical or similar to the earlier European Union trademark shall not be registered, regardless of whether the goods or services for which registration is requested are identical, similar or not similar to goods or services for which the earlier European Union trademark was registered when that earlier trademark has a reputation in the European Union even if the use of the later trademark without good reason would unfairly exploit or damage the distinctive character or reputation of the earlier European Union trademark;
- 3) a national trademark shall mean a trademark registered in the procedure before the competent authority in accordance with the provisions of this Law;
- 4) national trademark application shall be an application for trademark registration submitted to the competent authority in accordance with the provisions of this Law;
- 5) European Union trademarks applications filed before the day of Montenegro's accession to the European Union and European Union trademarks acquired before the date of Montenegro's accession to the European Union shall have effect on the territory of Montenegro;
- 6) no complaint to the registration of a national trademark shall be accepted, and a national trademark cannot be annulled because it conflicts with an earlier European Union trademark if the holder of the earlier European Union trademark did not actually use the European Union trademark in the European Union in relation to goods or services for which it is registered or if it ceased to be used for a continuous period of five years, unless there are justified reasons for non-use;
- 7) if, in accordance with the European Union Trademark Regulation, for the European Union trademark a seniority of a national trademark registration is required or an international trademark registration having effect in Montenegro, which the holder has renounced or allowed to expire, annulment or revocation of the trademark that is the basis of seniority requirements may be determined subsequently in accordance with this Law, provided that the annulment and revocation could have been declared at the moment when the renunciation of the trademark occurred or its expiration, in which case the seniority shall cease to produce legal effect;

- 8) the data that the seniority of the European Union trademark has been requested in relation to the nationally registered trademark shall be entered in the register of trademarks, as well as the data that the seniority has ceased to produce effect;
- 9) the seniority of the national trademark in relation to the European Union trademark shall be recognized if:
 - a) the national trademark was acquired before the date of accession of Montenegro to the European Union, and
 - b) the national trademark has priority over the European Union trademark for which seniority is required;
- 10) the competent authority shall, acting upon the request for conversion of European Union trademark applications or European Union trademark into a national trademark application forwarded to the competent authority by the European Union Intellectual Property Office, conduct the trademark registration procedure in accordance with the provisions of this Law;
- 11) upon receipt of the request referred to in item 10 of this paragraph, the competent authority shall invite the applicant to submit a translation of the European Union trademark application into Montenegrin within 60 days from the day of receipt of the invitation;
- 12) if the conditions referred to in item 11 of this paragraph are met, and the conversion of a registered European Union trademark into a national application is requested, the competent authority shall enter such trademark in the trademark registrar, provided that the applicant has paid the prescribed administrative fees and costs of procedure for the maintenance of the trademark in value during the first ten-year period and for the publication of trademark data;
- 13) if the conditions from item 11 of this paragraph are met, and the conversion of the European Union trademark application into a national application is requested, the competent authority shall conduct the national trademark registration procedure provided that the applicant has paid the prescribed administrative fees and costs of the procedure;
- 14) the holder of a national trademark acquired before the date of accession of Montenegro to the European Union, or acquired on the basis of a national trademark application submitted before the date of accession of Montenegro to the European Union, may, by a lawsuit, request a ban on the use of the European Union trademark in Montenegro which in accordance with item 5 of this paragraph has effect on the territory of Montenegro, if the use of the European Union trademark is contrary to the use of the national trademark, where the holder has to prove that the European Union trademark is contrary to the national trademark;
- 15) the provisions on legal protection in the event of infringement of a national trademark shall apply accordingly to legal protection in the event of infringement of a European Union trademark;
- 16) in infringement procedures, the trademark holder shall not be authorized to request prohibition of use of a later registered European Union trademark if the later trademark would not be annulled in accordance with Article 60 paragraphs 1, 3 or 4, Article 61 paragraphs 1 or 2 or Article 64 paragraph 2 of the Regulation on the European Union Trademark in which case the provisions of Article 16 paragraph 2 of this Law shall apply;

- 17) The Commercial Court shall be the competent court for deciding in the first instance in disputes regarding the trademark of the European Union, in accordance with the law regulating the establishment, organization and jurisdiction of courts;
- 18) The Court of Appeal shall be the competent court for deciding in the second instance in disputes regarding the trademark of the European Union, in accordance with the law regulating the establishment, organization and jurisdiction of courts.

Article 52

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