

# THE PATENT LAW

## 1. GENERAL PROVISIONS

### Article 1

This Law shall regulate the legal protection of inventions.

### Article 2

A patent shall mean a right granted for an invention in any field of technology, which is new, involves an inventive step and is susceptible of industrial application.

### Article 3

Foreign natural and legal persons shall, in relation to the protection of inventions in Montenegro, enjoy the same rights as domestic natural and legal persons, where such treatment derives from international agreements or from the principle of reciprocity. The reciprocity shall be proved by the person who claims that it exists.

### Article 4

In the proceedings before the administrative authority responsible for intellectual property affairs (hereinafter: responsible authority), a foreign natural or legal person must be represented by a representative listed in the *Register of Representatives* kept by the responsible authority, or by a domestic attorney.

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reproduced in a biological system (e.g. micro-organisms, plant and animal cell cultures, sequence of genes).

(4) The following, in particular, shall not be regarded as inventions, within the meaning of this Law:

- 1) discoveries, scientific theories and mathematical methods;
- 2) aesthetic creations;
- 3) schemes, rules and methods for performing mental acts, playing games or doing business;
- 4) computer programs, and
- 5) presentations of information.

(5) The provisions of paragraph 4 of this Article

- 3) a plant or animal variety or an essentially biological process for the production of a plant or animal, except:
  - a biotechnological process concerning a plant or animal, if the technical feasibility of the invention is not confined to a particular plant or animal variety;
  - a microbiological or other technical process, or a product obtained by means of such process.

(2) For the purposes of this Law:

- 1) “plant variety” shall have the meaning laid down in the law governing the protection of new plant varieties;
- 2) an “essentially biological process” for the production of plants or animals shall be a process consisting entirely of natural phenomena such as crossing or selection;
- 3) a “microbiological process” shall be a process involving or performed upon or resulting in microbi

- 2) the invention being displayed by the applicant or his legal predecessor at an exhibition officially recognized under the Convention on International Exhibitions,

## **5. PATENT GRANT PROCEDURE**

### **1. COMMON PROCEDURAL PROVISIONS**

#### **Article 14**

- (1) The legal protection of an invention shall be attained within the course of an administrative procedure conducted by the responsible authority, which shall also perform other administrative and professional tasks concerning the protection of inventions.
- (2) Administrative decisions taken within the course of the administrative procedure referred to in paragraph 1 of this Article shall be final and may be contested within the administrative dispute proceedings before the competent court.

#### **Article 15**

During the patent grant procedure, the responsible authority shall not make an application available for inspection to any person or body, before the application has been published, except on request or with the consent of the applicant.

#### **Article 16**

The administrative procedure before the responsible authority shall be subject to payment of fees and procedural costs, in accordance with special regulations on administrative fees, procedural costs and information service fees.

#### **Article 17**

- (1) The responsible authority shall keep a Patent Applications Register, a Register of Patents and a Register of Supplementary Protection Certificates.
- (2) The content and manner of keeping public re

## **2. PATENT APPLICATION**

### **Instigation of Patent Grant Procedure**

#### **Article 20**

- (1) The patent grant procedure shall be instigated by the filing of an application with the responsible authority.
- (2) Applications for the protection of inventions abroad shall also be filed with the responsible authority, if so provided by international agreements.
- (3) Legal protection of inventions in Montenegro shall also be granted in respect of

- (2) The responsible authority shall not investigate whether the applicant is entitled to protection.
- (3) If the inventor does not wish his name mentioned in the request for the grant of a patent and in other documents under this Law, the applicant shall be required to furnish the responsible authority with the inventor's written statement to that effect, within a period of three months from the date of the filing of the application at the latest.

### **Description of the Invention**

#### **Article 24**

- (1) An invention shall be described in a manner that is clear and complete enough for the invention to be carried out by a person skilled in the art.
- (2) If the invention concerns a biological material and cannot be carried out on the basis of the description of the invention, the description shall be deemed to fulfil the conditions laid down in paragraph 1 of this Article if a sample of the naturally reproducible biological material is deposited with a relevant depository institution not later than the filing date of the application.
- (3) The term "relevant depository institution" referred to in paragraph 2 of this Article shall mean an institution designated in accordance with the provisions the Budapest Treaty on the International Recognition of the Deposits of Microorganisms for the Purpose of Patent Procedure concluded on 28 April 1977.

### **Patent Claims**

#### **Article 25**

Patent claims shall define the subject matter for which protection is sought. They shall be clear, concise and fully supported by the description of the invention.

### **Abstract**

#### **Article 26**

An abstract shall briefly set out the essential content of the invention and shall serve exclusively to provide technical information.

### **Content of a Patent Application Necessary to Be Accorded a Filing Date**

#### **Article 27**

In order to be accorded a filing date, an application filed with the responsible authority must contain, on that date:

- 1) an indication that a patent is being sought;
- 2) the given and family name or business name and address of the applicant;
- 3) a description of the invention, even if it does not fulfil the prescribed requirements.

**Division of a Patent Application**  
**Article 28**

- (1) The applicant may divide the subject matter of an application which has already been accorded a date of filing (original application) into two or more independent applications (divisional application) at his own discretion or at the request of the responsible authority.
  
- (2) The division of applications shall be allowed only until the taking of a decision on







**Certificate of Priority**  
**Article 37**

- (1) At the request of the applicant, the responsible authority shall issue a certificate of priority, such priority having been obtained with the recognition of the filing date of the application pursuant to Article 36 of this Law.
- (2) The content of the certificate of priority shall be governed by a specific regulation.

**Formal Examination**  
**Article 38**

- (1) Once the application has been recognized a filing date, the responsible authority shall examine whether it meets all the requirements for publication, notably:
  - 1) Has the application filing fee been paid;
  - 2) Has valid authorisation for the representative or a statement on the appointment of a common representative been filed, where appropriate;
  - 3) Does the application contain designation of the inventor or a statement to the effect that he does not wish to be mentioned in the application;
  - 4) If the applicant is a foreign national, has the application been filed through a representative, pursuant to Article 4 of this Law;
  - 5) the application contains all documents prescribed by Article 22 of this Law and they satisfy all formal requirements.
- (2) If the examination referred to in paragraph 1 of this Article shows that the application is not in conformity with the provisions of that paragraph, the responsible authority shall invite the applicant to correct the deficiencies within an appropriate time limit, providing reasons. Such time limit shall not be less than 60 or more than 90 days.
- (3) Upon substantiated request 5 -e



- (2) The substantive examination of a patent application shall be conducted within the limits set by the content of the patent claims.
- (3) The usefulness of the invention shall not be examined during the substantive examination procedure.

#### **Article 43**

- (1) If the responsible authority establishes that the subject matter of an application does not meet the requirements laid down in Article 42 of this Law, it shall inform the applicant stating reasons preventing the grant of a patent, and invite the applicant to comment on the reasons or to rectify any deficiencies identified, within an appropriate time limit. This time limit shall be not be less than 60 days nor more than 90 days.
- (2) Upon substantiated request by the applicant, the responsible authority shall extend the time limit referred to in paragraph 1 of this Article for a period as it deems appropriate, but not exceeding 90 days.

#### **Article 44**

- (1) An applicant, who has filed an application for the same invention in any other state, may furnish the responsible authority with a certified translation of the examination report issued in such state.
- (2) The responsible authority shall use the examination report directly in the proceedings upon the application filed.

### **Decision to Grant a Patent with Substantive Examination**

#### **Article 45**

- (1) If the responsible authority establishes in the substantive examination of the application that all requirements for the grant of a patent prescribed by this Law have been met, it shall communicate to the applicant a draft of the final wording of the patent claims intended to be adopted and shall invite the applicant to give his consent within a period of 30 days.
- (2) If the applicant fails to submit a written statement that he consents to the wording and number of claims, within the prescribed time limit, the responsible authority shall take a decision to grant a patent on the basis of the final wording of the claims it had communicated for approval.
- (3) If the applicant states that he does not approve the wording of the claims that the responsible authority intends to adopt, he shall be required to state the reasons for his disapproval and to file an amended wording of the claims. If the responsible authority accepts the reasons given or the amended wording of the claims, it shall take the decision to grant the patent. If the responsible authority does not accept the reasons given or the amended wording of the claims, it shall notify the

applicant, stating its reasons, and shall take a decision to grant the patent according to the final wording of the patent claims communicated for approval.

- (4) The decision to grant a patent shall be taken by the responsible authority, provided all the prescribed fees and costs have been paid.
- (5) On the date of issuance of the decision to grant a patent with substantive examination, the decision to grant a patent without substantive examination referred to in Article 40, paragraph 3 of this Law.
- (6) Where the applicant fails to pay the fees and costs referred to in paragraph 4 of this Article, the patent application shall be deemed withdrawn and a decision to that effect shall be taken.

### **Decision to Refuse to Grant a Patent** **Article 46**

If, as a result the substantive examination conducted under Article 42 of this Law the responsible authority establishes that all requirements for the grant of a patent have not been met or that the deficiencies identified have not been remedied, it shall take a decision to refuse the grant of a patent.

## **6. CONTENT, ACQUISITION AND SCOPE OF RIGHTS**

### *Content of Rights*

#### **Article 51**

The patent holder shall have the exclusive right to prevent third parties not having the owner's consent from the acts of:

- 1) making, using, offering for sale, placing into circulation, or importing for these purposes the product made by means of the protected invention;
- 2) using the patented process;
- 3) offering the patented process for sale;
- 4) producing, offering for sale, placing into circulation, using, importing or storing for such purposes a product directly obtained by the patented process;
- 5) offering for sale or supplying products that constitute essential elements of an invention to parties unauthorized to use such invention, if the offeror or supplier knows or has demonstrable grounds to know that such products are intended for the use of an invention owned by someone else.

### **Content of Rights Conferred by Patents in the Field of Biotechnology**

#### **Article 53**

- (1) If the patent concerns biological material possessing specific characteristics which are the result of a biotechnological invention, the rights laid down in Article 51, item 2 of this Law, shall extend to any biological material derived from that biological material through propagation or multiplication, in an identical or divergent form and possessing those same characteristics.
- (2) If the patent concerns a product containing or consisting of genetic information, the rights laid down in Article 51, item 2 of this Law shall extend to all other material in which the product is incorporated, provided it contains genetic information that performs its function, except the human body at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene in which the product is incorporated, provided it contains genetic information that performs its function.
- (3) If the patent concerns a process that enables a production of biological material possessing specific characteristics as a result of the biotechnological invention, the rights laid down in Article 51, item 2 of this Law shall also extend to biological material directly obtained

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### **Article 53**

The protection referred to in Article 52 of this Law shall not extend to biological material obtained from the propagation or multiplication of biological material placed on the market by the owner of the patent or with his consent, where the propagation or multiplication necessarily results from the application for which the biological material has been marketed, provided that the material obtained is not subsequently used for other propagation or multiplication.

### **Acquisition of a Patent**

#### **Article 54**

A patent shall be obtained by means of publication of its grant in the *Official Bulletin* and shall have effect as of the filing date of the application.

### **Rights Deriving from a Patent Application**

#### **Article 55**

- (1) By publication of a patent application, or by granting the patent without substantive examination of patentability, for which substantive examination has been requested pursuant Article 41 of this Law, the applicant shall be conferred provisional rights, the content of which shall be identical to those of a patent and which shall be valid from the date of publication of the application, i.e. grant of a patent without substantive examination of patentability, to the date of publication of a patent granted subsequent to substantive examination of patentability.
- (2) In the event that a patent has not been granted subsequent to substantive examination of patentability, the rights deriving from the application or the grant of the patent without substantive examination, as the case may be, shall be deemed not to have existed.

### **Scope of Protection**

#### **Article 56**

- (1) The scope of protection acquired by a patent shall be determined by the content of the claims, whereby the description and drawings shall be used to interpret the claims.
- (2) If the subject matter of a patent is a process, the rights conferred by the patent shall extend to the products directly obtained by such process.

#### **Article 57**

- (1) During the period the patent is pending, the scope of protection shall be determined by the wording of the claims contained in the application published in accordance with this Law.



(2) If a patent is granted upon the claims that have been amended during the procedure, the amended claims shall determine the scope of protection, provided

**Limitation of Rights to Facilitate International Traffic**  
**Article 61**

A patent shall have no effect against a person who uses devices made on the basis of a protected invention where such devices constitute an element in the structure or equipment of a vessel, aircraft or land vehicle or serve exclusively for the operation of such vessel, aircraft or land vehicle belonging to a state that is a party to the Paris Convention or member of the World Trade Organisation, when it enters the territory of Montenegro temporarily or accidentally.

**Compulsory Licences**  
**Article 62**

(1) If an owner of a patent refuses to license the right of commercial use of a protected invention to other persons or sets unreasonable conditions for such licensing, the state administrative authority responsible for the field in which the invention shall be employed may, after considering the merits of each individual case, grant a compulsory licence upon application of the interested person if:

- 1) patent holder himself or a person authorised by him does not use the protected invention or uses it insufficiently in Montenegro;
- 2) the commercial use of an invention that has been subsequently protected in the name of another person is not possible, without the use of the protected invention in whole or in part.

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- (2) In the event of national or any other exceptional need, the provisions of Article 62, paragraph 2 of this Law shall not apply. Nevertheless, the right holder shall be notified of the compulsory licence grant proceedings as soon as possible.
- (3) The decision on the application of an interested person for the grant of a compulsory licence in the public interest shall be taken by the Government of Montenegro (hereinafter referred to as: the Government), after it reviews the merits of each individual case.
- (4) A compulsory licence may be terminated if and when circumstances that have led to its grant cease to exist and are unlikely to recur. Upon substantiated request, the Government shall re-examine the further existence of such circumstances.
- (5) In order to rectify an anti-competitive practice, the Government may refuse the termination of a compulsory licence in the public interest, if and when circumstances which have led to its grant are likely to recur.

### **Article 66**

The holder of a compulsory licence in the public interest shall be required to pay the patent owner remuneration referred to in Article 63. However, in the event that such licence has been granted in order to rectify anti-competitive practice, when determining the total amount of remuneration, the need to remedy such practice shall be taken into account.

The compulsory licence in the public interest shall be subject to the provisions of Article 64, paragraphs 1, 2, 3, 4, 5 and 7 and Article 65, paragraph 4 of this Law. However, the Government may choose not to apply the provisions of Article 64, paragraph 5, if the compulsory licence in the public interest has been granted in order to remedy an anti-competitive practice.

### **Compulsory Licence Granted to Plant Breeders**

#### **Article 67**

- (1) Where a plant breeder cannot obtain or exploit a right of protection of plant variety without infringing a prior patent concerning a biotechnological invention, he may file an application with the responsible authority for a non-exclusive compulsory licence for the use of the invention protected by the patent insofar as the licence is necessary for the exploitation of the protected plant variety, subject to payment of an appropriate royalty. If such a licence is granted, the holder of the patent shall be entitled to a compulsory cross-licence to use the protected plant variety on reasonable terms.
- (2) Where the holder of a patent concerning a biotechnological invention cannot exploit it without infringing a prior right of protection of plant variety, he may file an application with the responsible authority for a non-exclusive compulsory licence for the use of the plant variety protected by that right, subject to payment of an appropriate royalty. If such a licence is granted, the holder of the variety

right shall be entitled to a compulsory cross-licence to use the protected biotechnological invention on reasonable terms.

- (3) The compulsory license referred to in paragraphs 1 and 2 of this Article can not be exclusive.
- (4) An applicant for the compulsory licence referred to in paragraphs 1 and 2 of this Article must prove that:
  - 1) he has unsuccessfully made efforts to obtain a contractual licence;
  - 2) the plant variety or the biotechnological invention constitutes significant technical advance of considerable economic interest relative to the invention claimed in the patent or the protected plant variety.
- (5) The compulsory licence referred to in paragraphs 1 and 2 of this Article may only be assigned with the company or the part thereof, where it is used.

### **Limitation of Rights Concerning Biotechnological Material Article 68**

- (1) By purchasing protected plant propagating material from the owner of a patent or with his consent, a farmer shall obtain authorisation to use the product of his harvest for further propagation or multiplication on his own farm, under conditions prescribed by the law on the protection of plant varieties, whereas products obtained thereby may not be used for commercial purposes.
- (2) By purchasing protected animal reproductive material or animals from the owner of a patent or with his consent, a farmer shall obtain authorisation for animal breeding or for the propagation of reproductive material, whereas material obtained thereby may not be used for commercial purposes.

### **Article 69**

Administrative acts effected by the responsible authorities pursuant to the provisions of Articles 62, 65 and 67 of this Law, shall be final. An administrative dispute against such acts may be instituted before the competent court.

## **8. DURATION AND TERMINATION OF A PATENT**

### **1. DURATION OF RIGHT**

#### **Patent Term Article 70**

The term of a patent shall be 20 years from the filing date of the application.

## **Maintenance of Rights Conferred by a Patent Application and a Patent Article 71**

- (1) Prescribed fees shall be payable for the maintenance of rights conferred by the application for a patent and by the patent granted.
- (2) The fees under paragraph 1 of this Article shall be paid for the third year and each subsequent year, calculated from the filing date of the application.
- (3) Where an applicant or a patent holder fails to pay the fee referred to in paragraph 1 of this Article, the fee may be validly paid within an additional time period of six months, provided a prescribed additional fee is paid at the same time.

## **2. TERMINATION OF RIGHTS**

### **Non-Payment of Fee Article 72**

Where an applicant or a patent holder fails to pay the prescribed fee for the maintenance of rights, such rights shall terminate on the day following the due date referred to in Article 71.

### **Renounce of Patent Rights Article 73**

- (1) If an owner of a patent files a declaration in writing with the responsible authority renouncing his right to a patent, such right shall lapse on the day following the filing of the declaration.
- (2) If any right of a third party with respect to the patent has been entered in the Register, the holder of the patent cannot renounce his right without prior written consent from the party in whose name a licence, pledge or any other right has been entered.

### **Death or Dissolution of a Right Holder Article 74**

- (1) A right shall cease to exist on the day of the death of a natural person or on the day of dissolution of a legal person who is the holder of the patent, unless it has been transferred to heirs or successors in rights.
- (2) Paragraph 1 of this Article shall apply *mutatis mutandis* to patent applicants as well.

### 3. RESTITUTION OF RIGHTS

#### Article 75

- (1) If, in spite of having taken all due care required by given circumstances, the applicant or the holder of a patent fails to perform any procedural step within the prescribed time limit, resulting in the loss of rights conferred by the patent application or granted patent, the responsible authority shall allow the restitution of such rights if the applicant or the holder of the patent:
  - 1) files an application for the reestablishment of rights and completes the omitted act within the prescribed time limit;
  - 2) states the reasons that have impeded the performance of the omitted act in due time.
- (2) The application for the restitution of rights shall be filed within three months from the date on which grounds for the omission ceased to exist or, if the applicant learned about the omission subsequently, from the date on which he found out about the omission, but not later than 12 months from the date of non-observance of the time limit.
- (3) The responsible authority cannot refuse the application referred to in paragraph 1 of this Article, fully or partially, without prior notification to the applicant specifying grounds for refusal and inviting him to comment in writing, within a period of 2 months.
- (4) An application for the restitution of rights cannot be filed for non-observance of time limits for the performance of the following procedural acts:
  - 1) the filing of the application under paragraph 1 of this Article;
  - 2) the filing of a request for the extension of a time limit;
  - 3) the payment of fees and expenses pursuant to Article 16 of this Law;
  - 4) the filing of a request for substantive examination pursuant to Article 43 of this Law;
  - 5) the filing of a translation pursuant to Articles 121 and 122 of this Law;
  - 6) any procedural steps involving several parties in the proceedings before the responsible authority.
- (5) Any person acting in good faith, who has, in the course of production, started exploiting an invention which is the subject matter of a published application, or has made all necessary preparations to initiate such exploitation within the period between the loss of rights and the publication of the notification on the restitution of rights, shall be entitled to continue exploiting the invention for production purposes only in his own production plant or in the plant of any other person for his own needs.
- (6) The content of the application, conditions and procedures concerning the application under paragraph 1 of this Article shall be regulated by a specific regulation.

## **9. SUPPLEMENTARY PROTECTION CERTIFICATE**

### **Article 76**

Any medicine for human or animal use or a plant protection product, whose placing into circulation is subject to a permit, may, under the conditions provided for by this Law, be subject to protection by the Certificate on Supplementary Protection (hereinafter referred to as: the certificate)

### **Subject Matter of Protection and Legal Effects**

#### **Article 77**

- (1) The subject matter of protection conferred by a certificate shall extend only to the medicine for human or animal use and plant protection product covered by the permit for placing such products into circulation as medicine for human or animal use or plant protection product (hereinafter referred to as: the permit), for each and any use of the product that has been authorised before the expiry of the certificate.
- (2) The certificate shall confer upon the holder the rights identical to those conferred by the patent. These rights shall be subject to the same limitations.

### **Entitlement to a Certificate**

#### **Article 78**

- (1) A Certificate shall be granted to the holder of the patent covering the product or to his successor in right.
- (2) The holder of two or more patents covering the same product may be granted only one certificate for that product. Where there are two or more applications for a certificate filed by different persons who are holders of different patents covering the same product, the same certificate for the product may be granted to each of these persons individually.

### **Conditions for Obtaining a Certificate**

#### **Article 79**

Upon the application of the patent holder, a certificate shall be granted if the following conditions are fulfilled: the product is identical to those conferred



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- (2) The application referred to in paragraph 1 of this Article must contain details on the applicant for revocation and on the patent holder, an indication that nullification is being sought, the reference number of the decision and patent registration number, grounds for claiming nullification and relevant evidence.

**Procedure Upon Application for the Nullification of a  
Decision to Grant a Patent  
Article 88**

- (1) Where the application for nullification of a decision to grant a patent is not made up in accordance with Article 87 of this Law, the responsible authority shall invite the applicant to remedy deficiencies as to form within 30 days from the date of receipt of the notification.
- (2) If the applicant fails to amend the application as to form within the time limit specified in paragraph 1 of this Article, the responsible authority shall reject the application.
- (3) The responsible authority shall forward a copy of the valid application for nullification of the decision to grant a patent, together with the evidence furnished, to the holder of the patent, requesting him to reply within a period of not less than 30 and not more than 60 days.
- (4) During the nullification proceedings, the responsible authority shall invite the parties, as many times as may be necessary, to file their comments on the submissions of the opposite party within the time limit specified in paragraph 3 of this Article.
- (5) All written communications of the responsible authority and replies thereof shall be submitted to all parties to the proceedings.
- (6) During the nullification procedure, the responsible authority shall conduct a hearing only if it finds it to be necessary for the establishment of facts relevant for the taking of a decision on the application.

**Decision on the Application for Revocation of the Decision to Grant a Patent**

**Article 89**

- (1) Based on the conducted procedure for the revocation of a decision to grant a patent, the responsible authority shall either take a decision to revoke the decision on the grant of the patent in whole or in part, or refuse the corresponding application.
- (2) The responsible authority shall publish particulars on the revoked patent in the *Official Bulletin* within three months from the date on which the decision becomes final.

## **2. NULLIFICATION OF THE SUPPLEMENTARY PROTECTION CERTIFICATE**

### **Article 90**

- (1) A supplementary protection certificate shall be nullified:
  - 1) if it was granted contrary to the conditions set out by this Law;
  - 2) if the patent covering the subject matter protected by the certificate terminates within the meaning of Articles 72, 73 and 74 of this Law;
  - 3) if the patent covering the subject matter protected by the certificate has been annulled, in whole or partially, to the extent that the product for which the certificate was granted is no longer protected by the patent claims or, after the patent has expired, if justifiable grounds for nullification exist.
- (2) Procedural provisions of this Law applicable to the application for the nullification of a decision to grant a patent shall apply *mutatis mutandis* to the nullification of a supplementary protection certificate.

## **11. PROTECTION OF RIGHTS UNDER THE CIVIL LAW**

### **1. INFRINGEMENT PROCEEDINGS**

#### **Article 91**

The holder of a patent granted without substantive examination pursuant to Article 40 or holder of a patent granted after substantive examination pursuant to Article 46 of this Law, or a holder of an exclusive licence for such a patent shall be entitled to instigate a litigation against any person infringing his right by means of any unauthorized actions referred to in Articles 51 and 52 of this Law.

#### **Claims**

#### **Article 92**

- (1) An action instigating a litigation may include the following claims:
  - 1) establishment of the fact that a patent infringement exists;
  - 2) prohibition of acts constituting patent infringement;
  - 3) compensation for damages caused by infringement;
  - 4) publication of the court decision at the expense of the defendant;
  - 5) seizure and/or destruction, without compensation of any sort, of products made or obtained by means of patent infringement;
  - 6) seizure and/or destruction, without compensation of any sort, of material or articles (equipment, tools) predominantly used in the creation of infringing products.
- (2) If an infringement of rights was committed intentionally or out of gross negligence, the plaintiff may claim, as a compensation damages referred to paragraph 1, item 3 of this Article, an amount equal to triple the amount of usual royalties he would have received for the exploitation of the invention.

- (3) In considering the claims referred to in paragraph 1, items 5 and 6 of this Article, the court shall take into account the need to maintain proportionality between the gravity of the infringement and the measures ordered, as well as the interests of any third parties.
- (4) The applicant of the patent application for which substantive examination has been requested shall be entitled to comp



- (2) Person referred to in paragraph 1 of this Article who does not provide information shall be held liable for any damages arising therefrom.

## **2. AN ACTION TO ESTABLISH THE RIGHT TO PROTECTION**

### **Article 98**

- (1) The inventor, his successor in rights or employer within the meaning of Article 109 of this Law, shall be entitled to file an action and instigate a litigation requesting the court to establish his right to the protection of a given invention in place of or, as joint holder, together with the person who has already filed an application for the invention.
- (2) If the inventor has already been granted a patent, his successor in rights or employer referred to in paragraph 1 of this Article may request the court to establish that he holds the right to the patent in place of or, as joint holder, together with the person registered as the holder of the patent.
- (3) An action referred to in paragraph 1 of this Article may be filed before the decision is taken to grant a patent with substantive examination, and the action referred to in paragraph 2 of this Article may be filed until the patent is

- (1) An inventor shall have the right to file an action and request the court to establish his inventorship and order the entry of his name in the patent application and in other relevant documents and registers kept by the responsible authority in accordance with the provisions of this Law, if any other person has been designated as the inventor in the application for a patent or in any other document provided for by this Law.
- (2) There shall be no time limit for filing the action under paragraph 1 of this Article.
- (3) In the event of the death of the inventor, his heirs shall be entitled to file an action referred to in paragraph 1 of this Article.

## **12. TRANSFER OF RIGHTS**

### **Licence Agreement and Assignment of Rights**

#### **Article 101**

- (1) The right to file an application, rights conferred by an application or a patent may be transferred, in whole or in part, by means of an agreement on transfer of rights



- (2) Applications referred to in paragraph 1 of this Article shall be filed with the authority responsible in national defence.

**Procedure in Respect of the Application**  
**Article 103**

If the state administrative authority responsible for defence establishes in its examination of an application filed that it has ceased to have elements of secrecy, it shall forward the application to the responsible authority. Such application shall retain the filing date accorded to it by the state administrative authority responsible for national defence.

**Procedure Following the Grant of a Patent**  
**Article 104**

If the state administrative authority responsible for defence establishes, subsequent to the grant of a patent for a secret invention, that the invention has ceased to be secret, it shall forward the file concerning the invention to the responsible authority, which shall enter the patent in the appropriate Register, publish the information on the granted right and issue an appropriate certificate to the right holder, in accordance with the provisions of this Law.

**Right to Exploitation**  
**Article 105**

- (1) The state administrative authority responsible for defence or state administrative authority responsible for internal affairs shall have the exclusive right to use and dispose of a secret invention.
- (2) The inventor shall be entitled to a single lump sum compensation for the protected secret invention, regardless of whether or not the invention is used.

**Publication of a Secret Invention and Its Protection Abroad**  
**Article 106**

- (1) A secret invention shall not be published.
- (2) A national of Montenegro may claim protection for a secret invention abroad only subject to approval of the state administrative authority responsible for national defence.

**14. INVENTIONS MADE IN THE COURSE OF EMPLOYMENT**

**Article 107**

An invention shall be deemed to have been made in the course of employment if it is:

- 1) an invention made by an employee in the course of his regular duties or specially assigned tasks concerning scientific and technical research and development, or an invention made under a research contract concluded with the employer;
- 2) an invention which does not fall under the provisions of item 1 of this Article, but is made by an employee in connection with the activities of his employer or with the use of material and technical facilities, information and other working conditions provided by the employer;
- 3) an invention made by an employee within a period of one year from the termination of his employment, which would have constituted an invention under items 1 and 2 of this Article had it been made in the course of employment.

**Right to Protection**  
**Article 108**

- (1) The right to protection of an invention pursuant to Article 107, paragraph 1 shall belong to the employer, unless otherwise provided by contract between the inventor and employer.
- (2) If an invention made in the course of employment has been protected in the name of the employer, the inventor

- (2) In case of a dispute regarding the amount, method and time of payment of the remuneration, the court shall decide, upon request of the inventor or employer, taking into account the extent to which the invention contributed to the increase of profits or savings within the company.
- (3) The employee may not renounce his right to remuneration in advance.

**Procedure**  
**Article 111**

- (1) An inventor who comes up with an invention in the course of employment shall be required to submit a written report to the employer immediately upon the creation of the invention, informing him thereof.
- (2) The content of the report referred to in paragraph 1 of this Law shall be regulated by specific regulation.
- (3) If the report does not contain the prescribed elements, the employer shall set an appropriate time limit for the inventor to remedy deficiencies therein.

**Article 112**

- (1) Within a period of two months from the receipt of the valid report referred to in Article 111 of this Law, the employer shall be required to communicate to the employee in writing whether he considers the invention to be an invention within the meaning of Article 107, items 1 and 2 of this Law.
- (2) If the employee fails to deliver the report within the meaning of Article 111 of this Law to the employer, the time limit under paragraph 1 of this Article shall run from the date on which the employer has obtained information of the invention.

**Article 113**

- (1)

- (4) If the employer decides to withdraw a filed application, he shall communicate this to the inventor in writing and shall assign to him rights conferred by the application.
- (5) In the event of commercial use of the invention under paragraphs 3 and 4 of this Article, articles 109 and 116 of this Law shall apply *mutatis mutandis*.

#### **Article 114**

In the event of failure to observe the time limit referred to in Article 112 of this Law, the inventor shall be entitled to protect the invention in his own name.

#### **Article 115**

- (1) An employee who creates an invention referred to Article 107, item 2 of this Law cannot file an application with the responsible authority before he receives the communication referred to in Article 112 of this Law from the employer or before the expiry of the time limit for such communication.
- (2) If the employee referred to in paragraph 1 of this Article decides to withdraw an application filed, he shall communicate this to the employer in writing and shall assign to him rights conferred by the application.

#### **Article 116**

- (1) With regard to the use of an invention protected in the name of the inventor, the employer shall be required to state, within a period of six months from the receipt of the valid report on the invention under Article 111 of this Law, whether he is interested in obtaining an exclusive licence from the inventor.
- (2) Until the expiry of the time limit referred to in paragraph 1 of this Article, the inventor shall not be entitled to assign the right to the invention to any third party or to grant a licence for the use of the invention.

#### **Article 117**

The use of an invention made in the course of employment cannot start before the issue of remuneration under Article 110 of this Law is settled or before the court takes a final decision.

### **Confidentiality Requirement**

#### **Article 118**

- (1) The employer and inventor shall maintain the confidentiality of an invention made within the course of employment until the publication of the patent application or until the invention becomes available for public in some other manner.

- (2) If the employer displays justifiable interest for the invention not being published, the obligation of the employee to keep it confidential shall continue upon the termination of his employment with that employer.

## **15. THE EUROPEAN PATENT APPLICATION AND THE EUROPEAN PATENT**

### **Extension of the Effect of the European Patent**

#### **Article 119**

EPO on the payment of the prescribed extension tax, but not before the expiry of 18 months from the filing date or, if priority has been claimed, from the earliest priority date.

- (3) A request for extension may be withdrawn at any time. The request shall be deemed to be withdrawn if the prescribed extension fee has not been paid in due time or if the European patent application has been ultimately refused, withdrawn or deemed to be withdrawn. The responsible authority shall publish a notice concerning these changes, as soon as possible, if the request for extension has already been published in accordance with paragraph 2 of this Article.
- (4) The content of the notice under paragraphs 1 and 2 of this Article shall be regulated by a specific regulation.

### **Extension Fee Article 121**

- (1) The extension fee under Article 120 of this Law shall be paid to the EPO within the time limits provided for under the EPC for the payment of the designation fee.
- (2) The extension fee may also be validly paid within the additional period provided for in the EPC for the payment of the designation fee, provided that a 50% surcharge is paid within this period.
- (3) EPC Rules relating to fees shall apply *mutatis mutandis* to the payment of extension fees. Validly paid extension fees cannot be refunded.

### **Effects of European Patent Applications Article 122**

- (1) European patent application, which has been recognized a filing date, shall be equivalent to a regular national patent application, with priority claimed for a European patent application, if such claim has been made, whatever the outcome of proceedings relating to the application may be.
- (2) A published European patent application shall confer upon the applicant the same provisional protection under this Law as the one conferred by a national patent application, from the date on which a translation of the claims of the published European patent application into the language officially used in Montenegro is communicated by the applicant to the person using the invention in Montenegro.
- (3) European patent application shall be deemed not to have had the effect referred to in paragraph 2 of this Article *ab initio*, if the request for extension has been withdrawn or is deemed to have been withdrawn.







**16. INTERNATIONAL PATENT APPLICATION  
PURSUANT TO THE PATENT COOPERATION TREATY**

## **17. CONDITIONS FOR THE ENTRY INTO THE REGISTER OF REPRESENTATIVES**

### **Article 133**

- (1) Natural persons who are nationals and residents of Montenegro, who have command of one language of international communication and who represent clients as their profession, may be entered into the Register of Representatives if they meet one of the following requirements:
  - 1) they are law faculty graduates having passed a special expert examination with the responsible authority;
  - 2) they are graduates of any technical faculty, having passed a special expert examination with the responsible authority;
  - 3) they are graduates of any technical faculty or law faculty, having at least five years of experience of working in the field of intellectual property with the responsible authority.
- (2) Legal persons having corporate headquarters in Montenegro and employing at least one law faculty graduate and one graduate of any technical faculty, meeting conditions referred to in paragraph 1 of this Article, may also be entered into the Register of Representatives.

## **18. FINAL AND TRANSITIONAL PROVISIONS**

### **Article 134**

- (1) Registered patents and petty patents granted under the Law on Patents (“Official Gazette of Serbia and Montenegro” No.32/04 an 35/04) that are valid on the day this Law enters into force shall remain valid and shall be subject to the provisions of this Law.
- (2) The provisions of this Law shall also apply to those applications for patents and petty patents that have been filed and pending prior to the date on which this Law enters into force.

### **Article 135**

Provisions of this Law regulating Supplementary Protection Certificate shall be enforced from the date Montenegro becomes member of the European Union.

### **Article 136**

On the day this Law comes into effect, the provisions of the Law on Patents (“Official Gazette of Serbia and Montenegro” No.32/04 an 35/04) shall cease to be effective.

### **Article 137**

- (1) This Law shall enter into force on the eighth day from the day of publication in the “Official Gazette of Montenegro”.
- (2) This Law shall become effective on the day of entry into force of the Agreement between the Government of Montenegro and the European Patent Organisation (Cooperation and Extension Agreement).