

INTELLECTUAL PROPERTY OFFICE (MONTENEGRO)

The International Bureau has been informed by the Intellectual Property Office of Montenegro of the following:

“Article 153 of the Patent Law of Montenegro (“The European Patent Office as Designated or Elected Office”) provides that “Any international application in which Montenegro, pursuant to the provisions of the Treaty, has been designated or elected for the granting of a national patent, shall be deemed to be the request for extension of the European patent to Montenegro, within the meaning of this Law, and the European Patent Office shall act as designated or elected Office under the Treaty.”

“Accordingly, PCT applicants who desire patent protection in Montenegro should pursue such protection via the European Patent Office under the extension agreement between Montenegro and the European Patent Organisation (see <https://www.epo.org/about-us/foundation/extension-states.html> and <https://www.epo.org/law-practice/legal-texts/official-journal/2016/etc/se4/p547.html>).

“Article 141 of the Patent Law of Montenegro (“Extension of the Effect of the European Patent”) provides in paragraph (2)(1): “European patent application” shall mean an application for a European patent filed under the European Patent Convention, (hereinafter referred to as the EPC), as well as an international application filed under the Patent Cooperation Treaty (hereinafter referred to as the PCT), for which the European Patent Office (hereinafter referred to as the EPO) acts as a designated or elected office and in which Montenegro is designated.”

“Article 142 of the Patent Law of Montenegro (“Request for Extension”) provides in paragraphs (1) and (2): “(1) European patent application and a European patent granted upon such application shall be extended to Montenegro at the request of the applicant. (2) The request for extension under paragraph 1 above shall be deemed to be filed with any European patent application filed on or after the date on which the Agreement between the Government of Montenegro and the European Patent Organisation on Extension of European Patents (hereinafter: “Extension Agreement”) enters into force.”

“Article 145 of the Patent Law of Montenegro (“Effect of Extended European Patents”) provides in paragraphs (1) and (2): “(1) Subject to paragraphs 2 to 6 of this Article, an extended European patent shall, from the date of publication of the mention of the grant of the European patent by the EPO, confer the rights identical to those conferred by a national patent under this Law. (2) Within 3 months from the date on which the mention of the grant of the European patent has been published, the holder of the patent shall furnish the competent authority with a translation of the claims of the European patent into Montenegrin language and shall pay the prescribed publication fee and the costs of the printing of the translation of patent claims of the granted European patent.”

“What this means for PCT applicants seeking patent protection in practice is the following:

“1) An extension of the European patent application and a European patent granted upon such application is deemed to be requested in any PCT application filed on or after 1 March 2010 (the entry into force of the Extension Agreement between the EPO and Montenegro).

“2) The applicant should enter the regional phase before the EPO as there is no national phase in place before the Intellectual Property Office of Montenegro (see here: www.wipo.int/pct/guide/en/gdvol2/annexes/ep.pdf).

“3) An extension fee needs to be paid to the EPO within the period for performing the acts required for entry into the EP regional phase.

“4) The substantive examination of the application will be performed by the EPO up to and including the decision to grant or refuse.

“5) From the date of publication of the mention of the grant of the European patent by the EPO, the extended European patent will confer the rights identical to those conferred by a national patent under the Patent Law of Montenegro, provided the holder of the patent, within 3 months from the date on which the mention of the grant of the European patent has been published, furnishes to the Intellectual Property Office of Montenegro a translation of the claims of the European patent into the Montenegrin language and pays the prescribed publication fee and the costs of the printing of the translation of patent claims of the granted European patent.

“6) Montenegro will publish in its national register the relevant data about the granted European patent extended to its territory.

“Montenegro has been invited by the Administrative Council of the European Patent Organisation to accede to the European Patent Convention. It is the intention of Montenegro, once it has acceded to the European Patent Convention and thus become an EPC Contracting State, to formally “close its national route” under PCT Article 45(2).”