

## SCHEDULE 4

Article 5

### Transformation applications and concurrent registrations

#### **Transformation applications**

1.—(1) A transformation application is an application to register a trade mark under the Act where—

- (a) the mark was the subject of an international registration and the international registration was the subject of a request for extension; and
- (b) the international registration was cancelled at the request of the Office of origin under Article 6(4) of the Madrid Protocol.

(2) But an application shall only be treated as a transformation application where the goods and services cited in it are identical to some or all of the goods and services included in the international registration.

(3) Any application made under the Act which is a transformation application shall state that it is made by way of transformation.

(4) Such an application may only be made before the end of the period of three months beginning with the date on which the international registration was cancelled.

(5) A transformation application may only be made by the person who was the holder of the international registration immediately before it was cancelled.

(6) Where on or before the date the transformation application was made, the trade mark is protected as an international trade mark (UK), the mark shall be registered under the Act; and it shall have the date of filing of the cancelled international trade mark (UK).

(7) Where on that date the trade mark is not so protected, the transformation application shall be treated as an application to register under the Act and it shall have the date of filing of the request for extension relating to that mark.

(8) Where in relation to the international registration a right of priority was claimed on the basis of a Convention application, the transformation application shall have the same right of priority.

#### **Concurrent registrations**

2.—(1) This paragraph applies where at the time protection is conferred on an international trade mark (UK) there is a concurrent registered trade mark.

(2) A registration is concurrent where—

- (a) the proprietor of the registered trade mark is the holder of the protected international trade mark (UK);
- (b) the registered trade mark is the same as the protected international trade mark (UK);
- (c) the goods and services in relation to which protection is conferred by the international trade mark (UK) include all those for which the registered trade mark is registered.

(3) The protected international trade mark (UK) shall be treated as being registered under the Act as of the date of registration of the registered trade mark.

(4) The priorities claimed in respect of the registered trade mark may also be claimed in respect of the international trade mark (UK).

(5) The provisions of this paragraph shall continue to apply after the registered trade mark lapses or is surrendered, but shall cease to apply if or to the extent that it is revoked or declared invalid.

**Status:** This is the original version (as it was originally made). This item of legislation is currently only available in its original format.

(6) On the application of the holder of the protected international trade mark (UK) the registrar shall note the international registration in the register against the registered trade mark.

(7) For the purposes of paragraph (6), the holder of the international trade mark (UK) shall make an application to the registrar using Form TM28.