

Trade Mark bill disappoints

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The Trade Marks (International Treaties and Enforcement) Amendment Bill is currently before Select Committee in New Zealand. The Bill deals with the proposed accession by New Zealand to the Madrid Protocol, the Nice Agreement and the Singapore Treaty among other things.

Of note are provisions in the Bill that seek to abolish the recordal of registered licences under a trade mark. Despite requesting feedback in 2006 as to whether New Zealand should align more closely with the Australian Trade Marks Act and its licensee recordal provisions, the majority of submissions made were ignored and the Bill now foreshadows a complete repeal of licensee registration. Furthermore, no mechanism exists in the Bill to advise existing licensee(s) of the cancellation of their licensed rights or to mandate that a historical record of such licensee recordals remain.

While the Bill provides for the alteration and removal of memoranda entered against a trade mark at the request of the owner, there is still no provision for secured parties to record security interests on the register. Nor does there appear to be any way a security rights holder can prevent an owner removing a memorandum that has been entered to that effect.

The Bill does, however, address a potential loophole where trade mark owners could seek to circumvent provisions permitting parallel importation and provides greater investigatory and prosecution powers to the National Enforcement Unit and Customs. Unfortunately, funding has not commensurately increased to reflect the number of suspected counterfeit products being detained by Customs, which has risen by over 400% since July 2000.

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