

Netherlands Antilles

Contributing firm

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1. Legal framework

National

The Netherlands Antilles Trademark Act 1995 entered into force in 2001. A Netherlands Antilles trademark registration provides protection on the islands of Curaçao, Bonaire, (Dutch) St Maarten, Saba and Statia.

International

The Netherlands Antilles is one of the countries within the Kingdom of the Netherlands. The following relevant international treaties, to which the Kingdom of the Netherlands is a signatory, are extended to the Netherlands Antilles:

- the Paris Convention for the Protection of Industrial Property;
- the Nice Agreement on the International Classification of Goods and Services;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights; and
- the Madrid Protocol for the International Registration of Marks.

2. Unregistered marks

Protection

Pursuant to Article 22 of the Trademark Act, trademark rights can be invoked only once the trademark concerned is duly registered. In principle, protection cannot be claimed for unregistered marks, with the exception of generally known marks as mentioned in Article 6bis of the Paris Convention. The owner of an unregistered generally known mark can oppose the registration of its mark by a third party based on Article 8.e of the act.

Use requirements

There are no requirements concerning the use of unregistered marks.

3. Registered marks

Ownership

Any natural or legal person can apply for and own a Netherlands Antilles trademark.

Scope of protection

Article 5 of the act stipulates that the following signs can be registered as trademarks:

- designations;
- designs;
- prints;
- seals;
- letters;
- figures;
- shapes of goods or of packaging; and
- all other symbols that serve to distinguish the goods or services of an undertaking.

However, shapes determined by the nature of the goods that may have an influence on their actual value or which have a technical result cannot be considered as marks.

4. Procedures

Examination

An application for trademark registration must be filed with the Bureau for Intellectual Property (BIP) of the Netherlands Antilles, located in Curaçao. If the applicant is not registered or domiciled in the Netherlands Antilles, a local trademark attorney should be appointed for the purposes of representation before the BIP.

The BIP will examine the trademark only on absolute grounds (ie, failure to meet formal requirements, lack of distinctiveness, conflict with morality or public order) and will notify the applicant of a provisional refusal within two months of the date of filing the application. The applicant can challenge such

refusal within six months of the notification by the BIP.

Appeal against a final refusal of the BIP can be brought before the Joint Court of Justice of the Netherlands Antilles and Aruba.

Opposition

The Trademark Act does not provide for *ex parte* opposition proceedings. However, a third party can oppose the registration of an infringing mark in regular proceedings on the merits before the court of first instance. The decision at first instance may be appealed before the Joint Court of Justice of the Netherlands Antilles and Aruba. Cassation appeal is possible to the Supreme Court of the Netherlands in The Hague, the Netherlands.

Registration

In the absence of complications during the application proceedings, registration will follow with retroactive effect as per the filing date.

A Netherlands Antilles registration remains valid for a 10-year period as from the date of filing and can be renewed for consecutive 10-year periods. Renewal is a precondition for the continuation of rights conferred by the original registration. It is not required to file proof of use upon renewal.

The application for renewal can be filed as early as six months before the expiration date and ultimately six months following this date. Once six months have elapsed since expiration, no restoration options are available.

Removal from register

Nullification: Article 25 of the Trademark Act provides that an interested party can seek the nullification of a trademark registration in any of the following circumstances:

- The mark is not a trademark in the sense of Article 5 of the act, particularly if it lacks distinctiveness;

- The mark is descriptive for the goods and/or services for which the trademark is registered;
- The mark has become customary in the current language or in trade;
- The mark is contrary to good morals and/or public order;
- The mark could mislead the public as to the nature, quality or geographical origin of the goods or services;
- The mark is similar to an older collective trademark for similar goods or services which lapsed in the course of the three years prior to the application date;
- The mark is similar to an older trademark for similar goods or services which lapsed in the course of the two years prior to the application date, unless the owner of the older trademark has given its consent to the registration concerned or the older trademark has not been genuinely used in the Netherlands Antilles for an uninterrupted period of five years;
- The mark is confusingly similar to a generally known trademark in the sense of Article 6*bis* of the Paris Convention; or
- The trademark application mark was made in bad faith.

Revocation: A trademark can be revoked on the following grounds mentioned in Article 9.2 of the act:

- During an uninterrupted period of five years the trademark is, without a valid reason, not genuinely used in the Netherlands Antilles for the goods and/or services for which it is registered;
- The trademark has become a generic term due to the trademark owner's actions or omissions; or
- The trademark may mislead the public as to the nature, quality or geographical origin of the goods or services.

Surrender: The trademark owner may surrender its registration for some or all of

the goods or services for which the trademark concerned is registered.

5. Enforcement

Complexity

There are no specialized courts dealing with IP matters. A claim concerning the protection of trademark rights may be brought before the court of first instance in civil proceedings.

Pursuant to Article 23.1 of the act, the owner of a registered trademark may oppose the use of:

- identical signs for identical goods or services;
- confusingly similar signs for identical or similar goods or services;
- identical or similar signs for different goods or services if the earlier trademark is known in the Netherlands Antilles and if through such use unjustified benefit could be derived from, or harm could be done to, the distinctive character or the reputation of the earlier trademark; and
- identical or similar signs that are not used as trademarks if through such use unjustified benefit could be derived from, or harm could be done to, the distinctive character or the reputation of the earlier trademark and there is no valid reason for such use of the sign.

The following civil remedies are available:

- injunctive relief;
- damages;
- payment of profits;
- seizure of the infringing goods and subsequent destruction thereof in the event of bad faith; and
- nullification of a trademark registration.

Timeframe

Where a remedy is required urgently, injunctive relief may be sought in summary proceedings before the court of first instance. Depending on

the urgency of the matter, it may take from several days to several weeks to obtain a court decision in summary proceedings.

If the remedies are not considered urgent and/or if the remedies are of a declaratory nature (eg, nullification and cancellation of a registration), relief should be sought before the Court of First Instance in regular proceedings on the merits, which could take a year or longer.

Leave for the seizure of goods can be granted within hours, if necessary, to several days upon filing a petition thereto with the court of first instance. Summary proceedings or proceedings on the merits must be initiated within 14 days of the seizure.

6. Ownership changes – legalization requirements

The BIP does not require the legalization of documents proving ownership changes and rights transfers. However, documents demonstrating ownership change or the transfer of rights must be filed along with the application for the recordal thereof. This should be either an original document or a certified copy.

An ownership change or transfer of rights can be invoked against third parties only if recorded with the BIP.

7. Areas of overlap with related rights

To some extent there is an overlap between trademark rights and other IP rights, (eg, a trademark may also be protected under copyright laws). There are no specific laws in the Netherlands Antilles on the protection of industrial designs.

8. Online issues

There are no specific provisions regarding domain name rights. However, domain name rights can be protected under the provisions of the Trademark Act or the provision of tort (ie, unfair competition) as constituted in Article 6:162 of the Civil Code.

