

The background of the cover is an abstract painting with thick, expressive brushstrokes. The color palette is diverse, featuring vibrant yellows, greens, oranges, reds, and blues, all layered and blended together. The texture is highly visible, suggesting the use of heavy paint and a palette knife or brush.

World  
Trademark  
Review

# Anti-counterfeiting 2008

A Global Guide



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## Legal framework

### National

The domestic legislative instruments which provide protection for IP rights holders in Aruba are as follows:

- the Trademark Act;
- the Copyright Act;
- the Civil Code;
- the Penal Code; and
- the Code of Penal Procedure.

### International

The following international IP treaties, to which the Kingdom of the Netherlands is a signatory, are extended to Aruba (which is part of the kingdom):

- the Paris Convention for the Protection of Industrial Property;
- the Berne Convention for the Protection of Literary and Artistic Works;
- the Nice Agreement on the International

- Classification of Goods and Services; and
- the Trademark Law Treaty (not yet in force).

### Trademarks

Pursuant to the Trademark Act, the first user of a trademark is exclusively entitled to the trademark rights in connection therewith. Registration is not required. In the absence of proof to the contrary, the party first applying for a trademark registration will be considered the first user of the trademark. If a third party claims to be entitled to the registered trademark on the basis of first use, this third party can initiate a nullification and cancellation action based on the Trademark Act. Nullification and cancellation action in extraordinary proceedings must be filed before the Court of First Instance within six months of publication of the alleged infringing trademark in the official trademark journal entitled *MarcAruba*. After expiration of this term, the alleged owner of the prior rights to the trademark may start regular proceedings on the merits before the Court

of First Instance, requesting a declaratory judgment that it is the first user and therefore the exclusive owner of the trademark. Based on this declaratory judgment, it can request nullification and cancellation of the infringing registration. Since the owner of the registered trademark is presumed to be the first user, the burden of proof will fall on any third party claiming to be entitled to the registered trademark.

In the event of the commercialization of counterfeit merchandise, the trademark owner can initiate a civil action against the infringer. The civil action against the infringer should be based on the general tort provision in Article 6:162 of the Civil Code in conjunction with the Trademark Act. The Trademark Act only provides for a nullification and cancellation action against an infringing registration. It does not provide for an action against the commercialization of counterfeit merchandise. Trademark infringement can also be reported to the police. Subsequently, the public prosecutor will evaluate whether prosecution should follow.

## “ If the rights holder consistently reports counterfeiting activities to the local police department and the public prosecutor, these agencies will be forced to look into the relevant activities and to consider whether to initiate prosecutions ”

### Copyrights

In the Copyright Act, ‘copyright’ is defined as the exclusive right of the author of a literary, scientific or artistic work – or, as the case may be, his or her assignees – to publish and reproduce such work, subject to the limitations provided by law. This protection remains valid for 50 years following the death of the author. If the author is a legal entity, the period of protection commences on the date on which the work was first made public. No formalities are required to obtain protection. A copyrighted work, however, can be deposited with the Bureau for Intellectual Property of Aruba, for evidence purposes.

The definition of ‘literary, scientific or artistic works’ in the Copyright Act includes, among other things, works of art applied to industry, such as:

- designs on cigarette packs;
- clothing designs; and
- designs embroidered on clothing.

Although at the time of writing there was no specific law dealing with the protection of computer software, there was sufficient case law to assume safely that computer software is also protected under the Copyright Act.

Copyright infringement can also be reported to the police and may then be prosecuted, depending on whether the public prosecutor deems this to be appropriate.

An important element of copyright disputes in Aruba involves counterfeit merchandise. Civil remedies are based on the Copyright Act and Article 6:162 of the Civil Code. Copyright infringement can also be reported to the police and may, subsequently, be prosecuted depending on the evaluations and priorities of the public prosecutor.

### Border measures

#### Customs action

Article 350 of the Penal Code forbids the deliberate importation (where this takes place without a clear intention to re-export) of goods or packaging materials bearing a false or imitated mark. This does not include counterfeit goods in transit. As to copyrights, the Copyright Act contains penal provisions that apply to the importation of pirated copyrighted works. Again, these provisions do not apply to counterfeit merchandise in transit.

Customs is in charge of investigating the import of counterfeit goods; the public prosecutor is ultimately in charge of prosecutions relating to the import of counterfeit goods. Besides the imposition of fines and terms of imprisonment, it is also possible to have the counterfeit goods confiscated under the Civil Code.

Due to the workload of the public prosecutor, and to the fact that civil remedies are usually available and may lead to better results in the short term, the public prosecutor does not always give priority to counterfeiting cases.

### Criminal prosecution

#### Key points

As noted, Article 350 of the Penal Code prohibits the deliberate importation (where this takes place without a clear intention to re-export) of goods or packaging material bearing a false or imitated mark. It also precludes:

- any intentional offer to sell, buy, deliver or distribute goods or packaging material bearing a false or imitated mark; and
- the possession of such goods or packaging for sale and distribution.

If copyright infringement is involved, criminal action can also be based on the Copyright Act, under which penal provisions are also available.

Investigation of the import of counterfeit goods is carried out by Customs, while the investigation of the commercialization of counterfeit goods in Aruba is the responsibility of the police. As to counterfeits in the local market, the trademark or copyright owner first has to report the criminal offence to the police. The police will then conduct an investigation, the results of which will be handed over to the public prosecutor who will ultimately evaluate and decide whether the infringer will be prosecuted.

### Preliminary measures

Pursuant to the Code of Criminal Proceedings, the authorities may seize counterfeit goods pending the outcome of the investigation.

### Remedies

The available remedies are fines and imprisonment. Furthermore, the Court of First Instance can order the infringing goods to be confiscated or removed from circulation.

The aggrieved party can also demand compensation in criminal proceedings; however, damages can be claimed only up to a maximum of Afl50,000 (approximately \$28,000) and the claim must be substantiated. If the rights holder believes that it has incurred losses in excess of this limit, civil proceedings for compensation can be lodged.

### Civil enforcement

#### Key points

There are two grounds on which a trademark

infringement action can be based:

- total or partial similarity with a trademark used for the same kind of goods; and
- confusion on the part of the public regarding the origin of the goods.

Based on case law, when evaluating the similarity between the trademarks, the judge should place more weight on any points of similarity than on points of difference. The judge should also take into consideration other relevant circumstances, such as:

- the distinguishing capacity of the trademark; and
- the extent to which the trademark is known and recognized.

Based on the Copyright Act, the author of a copyrighted work can commence an infringement action based on:

- unlawful publishing of his protected work; and/or
- unlawful reproduction of his work.

#### **Preliminary measures**

Preliminary measures may consist of sending a cease and desist letter to the infringer and placing notifications in local newspapers warning the infringer and giving the infringer a short deadline to stop the infringement. If the infringer refuses to comply with the demands set out in the cease and desist letter and/or the newspaper notification, other actions/remedies are available, as set out below.

#### **Actions/remedies**

The following civil remedies are available when trademark infringement is detected:

- injunctive relief;
- damages;
- payment of profits;
- seizure of infringing goods and their subsequent destruction; and
- nullification and cancellation of a trademark registration.

Where there is a need for urgent action, injunctive relief may be sought in summary proceedings before the Court of First Instance. Depending on the urgency of the subject 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 declaratory in nature (eg, nullification and cancellation of a registration), relief should be sought before the Court of First Instance in regular proceedings on the merits. Such

proceedings can take a year or more.

Leave for the seizure of goods can be granted within hours, if the need arises, to several days on the filing of a petition with the Court of First Instance. Within 14 days of the seizure, the judgment creditor must initiate either summary proceedings or proceedings on the merits on which the underlying claim is based.

#### **Parallel import**

Parallel import is not regulated. As to trademarks, the principle of worldwide exhaustion is adopted in case law.

#### **Anti-counterfeiting online**

##### **Unauthorized internet commerce**

The laws and regulations described above also apply to the unauthorized commercialization of infringing goods via the Internet. However, in order to ascertain whether Aruba law applies, it would have to be determined whether the relevant goods are being offered by a natural or legal person residing in Aruba.

##### **Internet security**

There are no specific laws or regulations on internet security in connection with anti-counterfeiting online.

##### **Online investigation strategies**

It is possible to conduct online searches in respect of the possible commercialization of infringing goods. However, there are no specific laws or regulations on online investigation strategies in connection with anti-counterfeiting online.

#### **Preventive measures/strategies**

##### **Use of local counsel and investigation**

Local distributors are usually the eyes and ears of the rights holder in the local market. Trademark or copyright owners can request local distributors of merchandise to perform periodic investigations in the local market. If counterfeits are detected, the trademark or copyright owner can consider taking action against the infringer as discussed above.

##### **Controlling contractual relationships with third parties**

By controlling contractual relationships with third parties (eg, through licensing and manufacturing), it is possible to act preventively against counterfeiting. Such control can be achieved by the inclusion of provisions in relevant agreements, under which the range of use of the trademark is specifically regulated.

#### **Cooperation with national anti-counterfeiting agencies**

The prevention of counterfeiting can also be achieved by means of close cooperation with the local police and Customs. If the rights holder consistently reports counterfeiting activities to the local police department and the public prosecutor, these agencies will be forced to look into the relevant activities and to consider whether to initiate prosecutions. Close cooperation with the Bureau for Intellectual Property of Aruba can also be helpful in these cases, as the bureau is then able to bring the issue of counterfeiting to the attention of the local authorities. [WTR](#)

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Angeline J Martijn obtained her law degree from the University of Aruba in 2003. That year, she joined a law firm in Aruba where she assisted national and international clients in the general commercial practice. On June 1 2007 she joined VanEps Kunneman VanDorne, where she specializes in general law, contract law, labour law and IP law.

Ms Martijn is a member of the International Trademark Association. She speaks Dutch, English, Spanish and Papiamentu.