

Netherlands Antilles

Contributing firm
VanEps Kunneman VanDoorne

Authors

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Legal framework

National

The following national laws are relevant to anti-counterfeiting:

- the Trademark Act 1995. A Netherlands Antilles trademark registration provides protection on the islands of Curaçao, Bonaire, (Dutch) St Maarten, Saba and Statia;
- the Copyright Act 1913;
- the Civil Code;
- the Penal Code; and
- the Code of Criminal Procedure.

International

The following relevant international IP 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 Protocol relating to the Madrid Agreement on the International Registration of Marks.

Trademarks

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

An application for trademark registration must be filed with the Bureau for Intellectual Property 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 bureau.

The bureau will examine the trademark only on absolute grounds (ie, lack of formalities, lack of distinctiveness or conflict with morality or public order), and will notify the applicant of its provisional refusal within two months of the date of filing the application.

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 pre-condition for the continuation of rights conferred by the original registration. It is not necessary to file proof of use upon renewal.

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 well-known marks as mentioned in Article *6bis* of the Paris Convention.

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.

In the event of commercialization of counterfeited merchandise the trademark

owner can take civil action against the infringer. Civil action can be based on the Trademark Act and on the general tort provision in Article 6:162 of the Civil Code. Trademark infringement can also be reported to the police. Subsequently, the public prosecutor will evaluate whether prosecution should follow.

Copyrights

In the Copyright Act, 'copyright' is defined as the exclusive right of the author (or assignees) of a literary, scientific or artistic work 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. However, for evidence purposes the copyright owner can file the work with the bureau in an 'I-Envelope'. The work must be filed in duplicate. One copy remains with the bureau; the other copy is returned to the owner in a dated envelope, which can be opened once evidence of the date of first publication is required, for example in court proceedings.

The definition of 'literary, scientific or artistic works' in Article 10 of the Copyright Act includes, among others, works of art applied to industry, such as designs of cigarette packs, designs of clothing or designs embroidered on clothing. Although as yet there is no specific law dealing with the protection of computer software, there is sufficient case law to assume that computer software is also protected in the Netherlands Antilles under the Copyright Act.

A significant number of copyright disputes in the Netherlands Antilles involve counterfeit merchandise. Civil action can be based on the Copyright Act and/or the general tort provision in 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

Article 350 of the Penal Code prohibits the intentional import, without clear intention to re-export, goods or packaging materials bearing a false or imitated mark. This does not include counterfeit goods in transit. As for copyrights, the Copyright Act contains penal provisions that apply to the import of counterfeit copyrighted works, which

provisions again do not apply to counterfeits in transit.

Customs is in charge of investigating and preventing the import of counterfeit goods, while the public prosecutor is responsible for taking action against those suspected of involvement. Besides fines and imprisonment for offenders, it is also possible to have the counterfeit goods confiscated under the Civil Code.

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

Criminal prosecution

Key points

As noted, Article 350 of the Penal Code prohibits the intentional import, without clear intention to re-export, 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 or distribution.

In case copyright infringement is involved, criminal action can also be based on the Copyright Act, which includes penal provisions.

Investigations into the import of counterfeit goods are carried out by Customs and the investigation of commercialization of such goods within the Netherlands Antilles is done by the police department. As to counterfeits within the local market, the trademark owner or copyright owner first has to report the criminal offence to the police. The police will then conduct an investigation. The results of the investigation will be handed over to the public prosecutor, who will ultimately evaluate and decide whether the infringer should be prosecuted.

Preliminary measures

Pursuant to the Code of Criminal Procedure, 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.

Also, the aggrieved party can demand compensation during the criminal proceedings. However, the maximum amount of damages is limited to NAG50,000 (approximately \$28,000) and the claim must be substantiated. If the actual amount of damages is higher, civil proceedings for compensation may be lodged.

Civil enforcement

Key points

Pursuant to Article 23.1 of the Trademark 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 mark 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 concerned.

Based on the Copyright Act, the copyright owner can commence an infringement action when the protected work is published and/or reproduced without the owner's permission.

Preliminary measures

Preliminary measures may consist of sending a cease and desist letter to the infringer, and placing notifications in the local newspapers warning the infringer and granting a short deadline to stop the sale of counterfeit products. If the infringer refuses to comply with the demands set forth in the cease and desist letter and/or the newspaper ads, other remedies as mentioned in the next paragraph are available.

Actions/remedies

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

- in case of trademark infringement, nullification of a trademark registration.

In case of an urgent interest, 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 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 may be granted within hours (if need be) or several days upon filing 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 in which the underlying claim is lodged.

Parallel imports

Pursuant to Article 23.8 of the Trademark Act, a trademark owner in the Netherlands Antilles cannot in principle oppose imports or parallel imports of a trademarked product that has been put onto the market by the rights holder or with its permission anywhere in the world. However, this does not apply if the rights holder has valid grounds to oppose the further trade of the products, particularly when the condition of the product has altered or deteriorated after the product has been put onto the market.

Anti-counterfeiting online

The same laws and regulations described in the previous paragraphs also apply to the unauthorized commercialization of infringing goods via the Internet. However, whether Netherlands Antilles law will apply depends on the international private laws of the countries involved and the treaties adopted by those countries.

Preventative measures/strategies

Use of local counsel and investigators

There is limited capacity of investigation agencies in the Netherlands Antilles. To a certain extent, local counsel may be willing to assist in investigating the market for possible counterfeits.

Most of the time, local distributors will detect infringement and subsequently report this to the trademark or copyright owner.

Controlling contractual relationships with third parties

It is possible to license Netherlands Antilles trademarks and copyrights. Trademarks can be licensed only in writing. It is recommended to record the licence with the Bureau for Intellectual Property in order to be able to invoke the licence against third parties. An independent claim can be instituted by the licensee only if it has obtained the power to do so from the trademark owner.

Copyright licensing does not have to be in writing; it can also be granted orally or tacitly. [WTR](#)

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Kimberley de l'Isle obtained her law degree from the University of Aruba in 2003 and joined VanEps Kunneman VanDoorne that same year. After leaving the firm in 2005, she rejoined in September 2007. She was co-chair of the Junior Bar Association of Aruba from 2004 to 2005 and is a member of the Curaçao Bar Association and the International Trademark Association.

Ms de l'Isle specializes in general practice, IP law and labour law. She speaks Dutch, English, Spanish and Papiamentu.



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Ms Jansch specializes in intellectual property matters (especially trademark and copyright), ICT, telecommunications, e-commerce, contract law (distribution, franchising, licensing) and litigation. She speaks Dutch, English and German.