



BES islands

Trademark registrations 2022

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General information

Prior to October 2010, the Netherlands dependent territories consisted of Aruba and the Netherlands Antilles. The Netherlands Antilles were dissolved on October 10, 2010. Before the dissolvment, the Netherlands Antilles comprised the Caribbean islands of Curaçao, Sint Maarten (Dutch side), Bonaire, Sint Eustatius and Saba. The Netherlands Antilles, Aruba and the Netherlands were already independent countries within the Kingdom of the Netherlands. As a result of the dismantling process of the Netherlands Antilles, Sint Maarten and Curaçao also became separate independent countries in the Kingdom of the Netherlands and obtained a status similar which Aruba already had since 1986. The islands Bonaire, Sint Eustatius and Saba, hereinafter referred to as the “BES islands”, transformed into public entities (similar to a municipality) within the Netherlands. The constituent islands of the former Netherlands Antilles now all have their own distinctive trademark legislation and administration. Aruba already has its own trademark legislation since 1989.

All former Netherlands Antilles trademark registrations and applications which were filed before 10 October 2010 have automatically been converted into trademark registrations for the territories Curaçao and Sint Maarten. For now, the Bureau for Intellectual Property of Curaçao will act as the Bureau for Intellectual Property for both Curaçao and Sint Maarten.

With respect to the BES islands the former Netherlands Antilles trademark registrations and applications had to be maintained by filing a confirmative depot before 10 October 2011. All former Netherlands Antilles trademark registrations that have not been confirmed have lapsed as of 10 October 2010.

The BES islands just like Curaçao, Sint Maarten and Aruba are not a member of the European Union and consequently Community trademark legislation does not apply on these islands.

Trademark legislation in the BES islands

National

On a local level, trademark protection in the BES islands is now governed by the Trademark Act for the BES islands (“Wet Merken BES”), the Regulation Implementing the Trademark Act for the BES islands (“Uitvoeringsbesluit Merken BES”) and the implementing Regulations under the Trademarks Act for the BES islands.

International registration

As a result of the dismantling process, international registrations which contained a designation of the former Netherlands Antilles continued to have effect in the three new territorial entities (Curaçao, Sint Maarten and the BES islands). Furthermore, international applications containing a designation of the Netherlands Antilles, which were pending, and which were registered with a date prior to 10 October 2010, were registered with respect to the three new territorial entities. In each case, the applicable legislation will be the corresponding legislation for the territorial entity concerned.

As from October 2010, international applicants and holders of international registrations may individually designate, or subsequently designate, under the Madrid Protocol, the territorial entities of Curaçao, Sint Maarten and/or the BES islands.



International

The relevant trademark conventions where to the BES islands are a party are as follows:

- Paris Convention for the Protection of Industrial Property (International Union);
- the Madrid Protocol concerning the International Registration of Trademarks;
- the Agreement on Trade-Related Aspects of International Property Rights (TRIP's);
- Nice agreement Concerning the International Classification of Goods and Services for the purpose of the Registration of Marks (10th edition);
- Trademark Law Treaty; and
- the Singapore Treaty on the Law of Trademarks.

The BES-Islands are a member of the World Trademark Organisation ("WTO") and the World Intellectual Property Organisation ("WIPO")

Trademark registration

A trademark owner can only claim exclusive rights to a trademark on the BES islands if the concerned trademark is duly registered with the Benelux Office For Intellectual Property ("BOIP"). The BOIP works under the authority of the Department of Caribbean Netherlands ("Rijksdienst Caribisch Nederland") and is responsible for the implementation of the Trademark Act for the BES islands. Protection of a trademark lasts for ten years following the date of application and is valid on the BES islands. After ten years a trademark registration is renewable for a successive ten-year period.

Under the Trademark Act for the BES islands, the exclusive right to a trademark is obtained by registration, which confers exclusive proprietary rights. Accordingly, without prejudice to priority rights, the proprietary rights to a trademark belong to the party who was the first to file an application for registration of the trademark concerned.

The exclusive rights to a trademark do not include the right to prevent the use in the course of trade of a similar sign which is protected on the basis of a prior right which only has local significance, if such prior right is recognized under the law of the BES islands.

Registrable trademarks

As trademarks may be registered words, including personal names, drawings, prints, seals, letters, numerals, shapes of goods or their packaging and all other signs that may serve to distinguish the goods or services of an enterprise, provided they are not excluded from protection and registration by law.

Shapes determined by the nature of the goods, that influence the actual value of the goods, or that yield a result in the industrial field, cannot be regarded as trademarks.

Trademarks may be registered in relation to goods and services. In principle, the provisions relating to trademarks for goods apply to service marks as well. An application for the registration of a trademark may be both for goods and services. Multiclass applications are accepted.



Non-registrable trademarks

The following trademarks are non registrable:

1. trademarks that lack a distinctive character;
2. trademarks consisting exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or of rendering of the services, or which have become customary in a current language of the BES islands, being Dutch, English, Spanish and Papiamentu, or in the bona fide and established practices of the trade in the BES islands;
3. trademarks being contrary to morality or to public order irrespective of the use that is made thereof
4. trademarks consisting of or containing without authorization by the competent authorities, armorial bearings, flags or any other state emblems of any of the countries which are a party to the Paris Convention, or official signs and hallmarks indicating control and warranty adopted by those countries, provided the trademark is intended to be used for goods or services identical or similar to those in respect of which control and warranty is indicated, or any imitation of these from a heraldic point of view;
5. trademarks consisting of or containing without authorization by the competent authorities, armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations of which one or more countries which are a party to the Paris Convention are members, or any imitation thereof from a heraldic point of view; and
6. trademarks of which the registration is applied for in respect of goods or services for which the use thereof of which the lead to deceit of the public.

Furthermore, the law provides that, notwithstanding registration in the trademark register - the Register for Caribbean Dutch Trademarks ("CaribIE register") - no protective rights will be acquired in respect of the following trademarks:

1. trademarks similar to a collective trademark registered for similar goods or services, in respect of which proprietary rights existed which lapsed less than three years ago;
2. trademarks similar to an individual trademark, registered on behalf of a third party for similar goods or services, in respect of which the registration expired less than two years ago, unless such third party gave his/her consent or did not fulfill the use requirement in respect of such trademark;
3. trademarks liable to be confused with a trademark that is a well-known trademark within the meaning of Article 6bis of the Paris Convention, owned by someone else, unless the owner of such trademark gave his/her consent;
4. trademarks for wines or spirits consisting of or containing geographical indications for the designation of wines or spirits, with respect to wines or spirits not originating from the geographical place so indicated, or if deposited in good faith before the geographical indication concerned became protected in the country of origin; and
5. trademarks whose registration was applied for in bad faith. A trademark is deemed to have been applied for in bad faith, in any of the following instances:
 - a. if the trademark has been applied for by an applicant who knew or ought to know that, within the preceding three years, that a third party has used, in good faith and in a normal manner, within the BES islands, a similar trademark in respect of similar goods or services, and the said third party has not given his/her consent; or
 - b. if the trademark has been applied for by an applicant who, as a result of direct relations with a third party, knew that within the preceding three years the said third party has used, in good faith and in a normal manner, outside the BES islands a similar trademark in respect of similar goods or services, unless such third party has given his/her consent or the said knowledge about the use of the trademark was acquired only after the applicant had started to use the trademark within the BES islands.



Applicant

Any person, either individual or legal entity, may apply for and obtain registration of a trademark. It is not a requirement that the applicant for registration has an enterprise to which the trademark relates, and so it is possible, for instance, that a trademark is registered by a holding company, and is used by its subsidiary. Use of a trademark or even a bona fide intention to use a trademark is not a prerequisite for its registration. However, the right to a trademark may lapse in case of non-use, without valid reasons, during an uninterrupted period of five years. Foreigners may apply for and obtain registration of trademarks to the same extent as parties being a national of or domiciled in the BES islands.

Requirements for filing

An application must be filed on prescribed form in English or Dutch, signed by the applicant (if signed on behalf of a corporate body, name and capacity of the signatory must be mentioned below the signature), or signed by an agent who is authorized thereto.

An application must comprise the following:

1. the last name, given names (in full) and street address of the interested party, if the latter is a natural person. If a corporate body is involved, its legal form must be indicated, as well as the name and address of that body's agent;
2. a statement of the categories of goods and services (11th edition, Nice Agreement);
3. in case a collective trademark or a shape mark is involved, an indication that a collective mark or a shape mark is concerned, and, with respect to the collective trademark, a copy of the regulations concerning the use and control of the trademark are also required to obtain a filing date. The regulations must always be written in Dutch, or English;
4. the trademark and an indication that the trademark is a verbal mark, a figurative trademark, a semi-figurative trademark, a shape mark or any other type of trademark. If you wish to register a verbal mark, specify the trademark in the appropriate space, using block capitals. If you wish to register a figurative mark place an image of the trademark within the appropriate space:
 - a. the image must be sufficient quality to allow for electronic processing (scanning);
 - b. the image must be a photo (graphic) image of professional quality on matte paper with a rectangular or square format; and
 - c. the height and width of the image should not be larger than 8 cm and no smaller than 1.5 cm. Maximum printing format 8 x 8 cm.
5. an indication of the color or colors in words; where appropriate, accompanied by the corresponding color code;
6. when priority based on the Paris Convention is claimed, a certified copy of the basic application needs to be filed. Furthermore the country, date, number and holder of the filing on which this right of priority is based must be indicated;
7. a list of goods and/or services for which registration is desired, namely a description of the goods and/or services, with indication of the international class(es). The 11th edition of the Nice Classification applies in the BES islands;
8. an application may relate to goods or services of more than one class of the International Classification (Nice, 11th edition), provided that an additional class fee is due for each class over the third. Registration of a trademark for both goods and services may be applied for in one application;
9. payment of the required fees (and proof thereof in case the payment has been made by means of transfer or deposit), and
10. if the application is signed on behalf of a legal entity, the signatory's authorization to sign such document shall be stated on the document.

**Filing by fax**

The application for registration, as well as the application for renewal of a registration, and other documents which are signed may be sent by e-mail, post or telefax to BOIP.

Appointment of representative

Applicants that have no seat, nor are domiciled in the Kingdom of the Netherlands do not have to appoint an agent. However if they decide to appoint an agent or an attorney specialized in intellectual property, he/she shall reside or have a registered office within the Kingdom of the Netherlands.

Power of attorney

It is not required to attach a power of attorney with the application if the applicant decides to designate an agent or an attorney to assist him with the registration of a trademark. Any agent or an attorney shall be presumed to have a power of attorney to do so. If the BOIP has reason to doubt the correctness of a representative's authorization it may require a power of attorney within one month. This period may be extended upon request with one month. The failure to respond within the original or extended period shall result in the application being disregarded.

Filing authority

Applications for registration of a trademark are to be filed and dealt with by the BOIP, under the authority of the Minister of Economic Affairs, Agriculture and Innovation ("Minister van Economische Zaken, Landbouw en Innovatie").

Classification

The classification of goods and services, applied in the BES islands in respect of the registration of trademarks, is the International Classification established under the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks (11th edition). The goods and/or services for which registration is desired must be described precisely and in accordance with the International Classification of Nice.

Availability search

It is recommended that the applicant, before filing an application for registration should consult the Register for Caribbean Dutch Trademarks ("CaribIEregister") in order to evaluate the possibility of conflicts with prior rights. The BOIP does not conduct an availability search.

Examination for registration**Formal examination**

The BOIP will examine whether the requirements for obtaining a filing date have been complied with. As soon as possible after filing the application form the applicant will be notified of the filing date or of the grounds explaining why a filing date could not be established. After a filing date has been accorded, the trademark will be examined whether the other formal requirements have been met. If the application does not comply with one or more of those requirements, the applicant will be informed thereof with indication of the requirements concerned, and will be given one month to comply with those requirements. This term may be extended on request or ex officio, provided that it cannot be extended beyond six months from the date of dispatch of the first notification. If the requirements are not met within the prescribed term, the application will lapse.

For the BES-Islands there is no examination on formal grounds.



Registration

Registration of a trademark in the Register for Caribbean Dutch Trademarks ("CariblEregister") cannot be refused based on anticipations (nor on absolute or relative grounds). If an application meets the formal requirements the registration of the trademark will be effected. The legal date of registration of a trademark shall be the same as the official date of filing, irrespective of the actual date on which the registration is affected. Registration will take place in the language of the application.

Opposition

Ex parte opposition proceedings are not provided for the BES islands. After registration, the cancellation on both relative and absolute grounds of a trademark may be demanded in proceedings on the merits before the Court of First Instance. In these proceedings it is possible to request for an injunction and/or damages.

Alteration after registration

The picture, sign or figure of which a registered trademark consists may not be modified, nor during its registration, nor at the occasion of the renewal thereof.

Certificate of registration

As soon as the registration has been affected a certificate of registration will be provided to the applicant.

Publication

Upon registration, all particulars thereof are published in the Register for Caribbean Dutch Trademarks ("CariblEregister"). Publication will be done in the language of the registration. At present, there is no publication of the application prior to registration.

All particulars regarding registrations of trademarks in the BES islands - including renewal, amendment, assignment, grant or cancellation of licenses, pledge or seizure, nullity - are published.

Renewal of trademarks

If a trademark owner wishes to renew his registration, after the previous registration period has been expired or will expire soon, the owner has to apply for renewal and pay the renewal fee(s) within a period of six months prior to the expiration of the running period of protection. Renewal may still be applied for and the required renewal fee(s) be paid during a grace period of six months after expiration of the registration period, provided that an extra fee is due for payment of the renewal fee(s) during the grace period. The renewal period runs from six months before until six months after the date of expiration.

Requirements

The requirements for renewal are:

1. an application on a prescribed form, signed by the applicant or agent, shall contain:
 - a. the full name and address of the owner of the registration;
 - b. the name and address of the agent;
 - c. if the list of goods and services has been limited since the last publication, mentioning the goods and/or services for which the registration must be renewed, as far as possible, in the terms of the alphabetical list appertaining to the Nice International Classification and, at all events, grouped according to the classes and in the order of sequence of the classes of the Nice International Classification; and
 - d. the number and date of the last registration.



2. renewal representations of the trademark, in principle, are to be filed only if deemed necessary by the BOIP; and
3. evidence of payment of the renewal fee and of the additional class (above the third class) fees due (if any).

When the documents for renewal of the registration appear to be incomplete, the applicant will be informed thereof as soon as possible and be given an opportunity to comply with the requirements within one month after filing the application for renewal. This period may be extended on request or ex officio, provided that it cannot be extended beyond six months from the date of filing the application for renewal. When the application for renewal is not brought in order within that period, renewal shall not be affected.

Renewal takes place in the same language as the original registration, except if the BOIP, pursuant to a request thereto, decides otherwise. After renewal, a certificate of renewal will be sent to the owner of the registration.

Recordal of amendments

Change of name and/or address

Requirements

The requirements for the recordal of change of name and/or address are:

1. an application, signed by the owner of the registration or agent, containing:
 - a. the registration number;
 - b. the name and address of the owner of the registration; and
 - c. the name and address of the agent.
- d. copy of any document evidencing the change of name

Recordal of assignment

Assignment of a registered trademark is possible either with or without the goodwill of the business concerned and either for all of the goods and/or services, for which the trademark is registered, or for only part of these goods and/or services. The assignment must be in writing. The assignment of a registered trademark may not be restricted to a part of the BES islands, but must always apply to the whole territory of the BES islands. If not, the assignment will be subject to nullification. The assignment of a trademark must be recorded in the Register for Caribbean Dutch Trademarks ("CaribIEregister") in order to be valid against third parties.

Requirements

The requirements for the recordal of assignment are:

1. an executed Deed of Assignment (or a certified copy thereof) or any document proving the assignment, such as an original declaration signed by both parties confirming the existence of said assignment. The assignment does not need to be notarized or legalized; and
2. an application, signed by the owner of the registration or agent, containing:
 - a. the registration number;
 - b. the name and address of the owner of the registration; and
 - c. the name and address of the agent.

Recordal of license

Both exclusive and non-exclusive licenses under a registered trademark may be recorded against the concerned trademark registration.



A license may be restricted to part of the goods or services for which the trademark is registered. Likewise, a license under a trademark may be restricted as to its duration and/or the territory within which the trademark may be affixed by the licensee.

As applies for assignments, a license under a trademark must be recorded in the Register for Caribbean Dutch Trademarks ("CaribIEregister") in order to be effective against third parties.

For the purpose of fulfilling the use requirement, the use by a licensee is equivalent to use by the owner of the trademark. Although the license, strictly speaking, does not have to be recorded in order to attribute the use of the licensee to the trademarkowner, it is nevertheless strongly recommended that the license will be recorded against the trademark registration.

If a license is recorded, the registration of the trademark can be cancelled voluntarily only upon the request made by the owner of the registration and the licensee jointly.

Requirements

The requirements for the recordal of license are:

1. a certified copy of an executed license agreement or any document proving the license, such as an original declaration signed by both parties confirming the existence of the license . The license agreement does not need to be notarized or legalized; and
2. an application signed by the owner of the registration or agent, containing:
 - a. the registration number;
 - b. the name and address of the owner of the registration; and
 - c. the name and address of the agent.

Recordal of pledge / seizure

A registered trademark may be the object of a pledge or seizure. Pledge and seizure are to be recorded in the Register for Caribbean Dutch Trademarks ("CaribIEregister") in order to be effective against third parties. If a pledge or seizure is recorded, the registration of the trademark can be cancelled voluntarily only upon the request made by the owner of the registration and the pledgee or creditor jointly.

Requirements

The requirements for recordal of pledge are:

1. a certified copy of an executed pledge agreement or any document proving the pledge, such as an original declaration signed by both parties confirming the existence of said pledge. The pledge agreement does not need to be notarized or legalized; and
2. an application signed by the owner of the registration or agent, containing:
 - a. the registration number;
 - b. the name and address of the owner of the registration; and
 - c. the name and address of the agent.

Recordal of merger

Requirements

The requirements for the recordal of merger are:

1. a certified copy of the documents evidencing the merger, such as an excerpt of the Chamber of Commerce. The document does not need to be legalized.



Use requirement

A registered trademark should be normally used in order to prevent the lapse of the exclusive rights to the trademark. The exclusive rights to a trademark could be declared null and void by the Court if, without a valid reason, the trademark is not used in a normal manner for the goods and/or service for which the trademark has been registered during any uninterrupted period of five years. However, it is possible to avert revocation by (timely) resumption of use.

In a lawsuit, the Court may place the burden of proof as to use, wholly or partly upon the owner of the trademark.

The question whether the use of a trademark can be classified as 'normal use' shall be determined by considering all the circumstances of the case. Generally, the use of a trademark constitutes normal use if it was performed for the purpose of acquiring a sale of the products concerned. A more nominal use, for instance by 'token sales', will not be sufficient.

The use of a registered trademark by another person with the consent of the owner will accrue to the owner. Use of a trademark in a form differing in elements which do not alter the distinctive character of the trademark in the form in which it was registered may be considered sufficient use. Affixing in the BES islands, a trademark on goods destined solely for export out of the BES islands or on the packaging of such goods is considered relevant use.

Loss of trademark rights

Nullity of a trademark

The nullity of the registration of a trademark may be invoked, either in an action for nullification before the competent Court, or as a defense against any action taken by the registered owner of the trademark, by any of the following:

1. by any interested party, including the Public Prosecutor, and at any time, if the registered trademark:
 - a. consists of a sign which, according to its nature, cannot be considered to constitute a trademark in the sense of the law; or
 - b. falls under any of the categories mentioned above, under 'non-registrable trademarks', items 3, 4, 5, 6, 7 or 10.
2. by any interested party, including the Public Prosecutor, during five years from the date of application; in case the filing of a trademark corresponds to a collective trademark, filed for similar goods or services to which a right that lapsed in the course of the three years preceding that filing, was attached;
3. by the owner of the older trademark concerned, or by any interested third party jointly with the owner:
 - a. at any time (but see provision on forfeiture of rights in case of acquiescence), if the registered trademark is:
 - i. identical to a trademark, filed by a third party at an earlier date and for the same goods or services and to which rights existed at the time of filing of the later trademark are still in force;
 - ii. identical or similar to a trademark, filed by a third party at an earlier date for the same or similar goods or services to which rights existed at the time of filing of the later trademark which are still in force, where there exists in the public mind a likelihood of association of the trademarks; or
 - iii. similar to another trademark registered for non-similar goods or services which has a reputation in the territory of the BES islands to which rights existed at the time of filing of the later trademark which are still in force, where use without due cause of the younger trademark takes unfair advantage of, or is detrimental to, the distinctive character of the reputation of the older trademark.



- a. during three years from the date of lapse of an earlier registration, if the registered trademark is similar to an individual trademark, filed by a third party at an earlier date for similar goods or services; which registration of the trademark has lapsed by expiration of its term of protection less than two years before filing of the later trademark, except if the third party has given his/her consent or the use requirement for the earlier trademark has not been complied with;
- c. during five years from the date of the application for registration, if the registered trademark is confusingly similar to a trademark being well-known in the sense of article 6bis of the Paris Convention and belongs to a third party who has not given his/her consent, even if the trademark is not registered in the BES islands; or
- d. during five years from the date of the application for registration if the registered trademark has been filed in bad faith.

The nullification of the registration of a trademark in any of the above cases has a retrospective effect from the date of filing of the trademark. Nullification must, if the grounds for the lapse relate only to a part of the goods or services, be restricted to the part of the goods or services concerned. However, it shall always relate to the entire sign constituting the trademark.

The Public Prosecutor may invoke the nullity of the registration of a collective trademark if the regulations for use and control of the trademark are contrary to public order, or do not contain the provisions prescribed by law. Furthermore, the Public Prosecutor may invoke the nullity of any amendments to the regulations for the use and control of a collective trademark, if these are contrary to public order or the provisions of the law, or if these would lead to a weakening of the guarantees offered to the public by the regulations.

The Court shall ex officio declare the registration null in deciding nullification cases.

Lapse of a trademark

In the following instances, the exclusive rights to a trademark may be declared lapsed by the competent Court, upon the request of an interested party, even though the registration is maintained:

1. in so far as the trademark, without legitimate reasons, has not been normally used within five years from the filing of the application for registration, within the territory of the BES islands for the goods or services for which it is registered, or if such use of the trademark, without legitimate reasons, has been discontinued for five consecutive years or longer. However, the lapse can no longer be invoked, if the required normal use of the trademark has been commenced or resumed between expiration of the five-year period of non-use and the bringing of a claim for a declaration of lapse because of non-use;
2. in so far as the trademark, as a consequence of the behaviour (activity or inactivity) of the owner of the trademark, has become in the normal use of language the common name (generic name) of a product or service (for instance where the owner himself/herself uses the trademark as a generic name for the product or service in question, or when he/she fails, to a reasonable extent, to act against misuse of the trademark); and\
3. in so far as the trademark, as a consequence of the use made thereof for the goods or services for which it is registered, is liable to mislead the public, in particular with regard to the nature, quality or geographical origin of those goods or services.

The lapse in all the above cases is retrospective from the date on which the actual conditions for the lapse of the rights to the trademark were fulfilled. The lapse must be restricted to the part of the goods or services concerned, if the grounds for the lapse relate to a part of the goods or services only. Lapse shall, however, always relate to the entire sign constituting the trademark.



If lapse of the exclusive rights to a trademark on account of non-use can no longer be invoked due to late use or resumed use, the owner of the trademark cannot invoke the nullity of a registration of another younger trademark whose registration was applied for during the period that the rights to the older trademark could be declared lapsed on account of non-use, nor take action against use of such younger trademark for identical or similar goods or services. This implies that in such case, two identical or similar trademarks may exist side by side.

The exclusive rights to a trademark will lapse automatically in any of the following events:

1. voluntary cancellation of the registration; or
2. expiration of the term of the registration of the trademark where the same is not renewed.

The owner of the registration of a trademark may at any time request the cancellation of his/her registration. If a license, pledge or seizure has been recorded, however, the owner of the trademark can request cancellation only jointly with the licensee, the pledgee or the creditor respectively. The cancellation shall always be effective for the whole territory of the BES islands. However, the voluntary cancellation may be restricted to one or some of the goods or services for which the trademark is registered.

In addition to the grounds mentioned above, the exclusive rights to a collective trademark may also be declared lapsed on request by any interested party including the Public Prosecutor if the owner of the collective trademark uses the trademark himself for goods or services originating from his/her own enterprise or from enterprises in the control or supervision of which he/she participates directly or indirectly, or consents to or tolerates a use of the trademark in contravention of the provisions of the regulations for use and control of the trademark.

In case The Court declares that the exclusive rights to a trademark have lapsed, it will also ex officio order the cancellation of its registration.

Collective trademarks which have lapsed, been declared null or cancelled, or whose registration has not been renewed and which have not been registered a new collective trademark in the name of the owner of the lapsed registration on application filed within three years from expiration of the registration period, may not be used under any circumstances during three years after recordal of the lapse, the nullity declaration or the cancellation, or within three years from expiration of the term of registration respectively, except by a party who is entitled to invoke an older right to a similar individual trademark.

When the registration of an individual trademark has lapsed because it has expired, during two years thereafter, the same or a similar trademark cannot be legally registered by a third party for similar goods or services, unless the owner of the lapsed registration gave his/her consent.



Infringement

Infringing acts

The following acts performed by a third party without the consent of the owner of a registered trademark are considered trademark infringement:

1. any use in the course of trade, consisting of a sign identical to the registered trademark in respect of the goods and/or services for which the trademark is registered;
2. any use in the course of trade, consisting of a sign identical or similar to the registered trademark in respect of goods or services identical or similar to those for which the trademark is registered, where there exists a likelihood of association on the part of the public between the sign and the trademark;
3. any use in the course of trade, without due cause, consisting of a sign being identical or similar to the trademark, in respect of goods or services which are not identical or similar to those for which the trademark is registered, if the trademark has a reputation in the territory of the BES islands and where use of such sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark; or
4. any use in the course of trade, without due cause, made of a sign being identical or similar to the registered trademark, other than for the purpose of distinguishing goods or services, where such use of such sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.

The following acts, performed by a party with a sign, under any of the conditions mentioned above without the consent of the owner of the registered trademark, are, among others, considered infringing use:

1. affixing the sign to goods or their packaging;
2. offering or exposing goods for sale, putting goods on the market, or stocking goods for those purposes under the sign;
3. importing or exporting goods under the sign, except where importation is concerned with the apparent purpose of re-exportation; or
4. using the sign on business papers or in advertising.

The exclusive rights to a trademark which is worded in Dutch or English shall extend by right to its translation into any other of these languages. The judgment whether similarity results from translation into one or more foreign languages belongs to the Court.

Similarity may exist between goods and services. On judging the matter of similarity of goods and/or services, the classification applied on the registration of trademarks will not be taken into consideration.

Non-infringing acts

The following are non-infringing acts:

1. exhaustion: not considered as infringement is use of a registered trademark for goods which have been brought into the trade under that trademark by the owner or with his/her consent, except if there are legitimate grounds which justify that the owner of the trademark opposes the further commercialization of the goods, in particular, if the condition of the goods has been altered or deteriorated after they were brought into the trade. Furthermore, the law provides that, if a trademark in different States belongs to different owners, the owner of the trademark in the BES islands cannot prevent the importation of goods bearing the trademark or a similar trademark originating from another State, nor claim compensation of damages in respect of such importation, if the trademark has been affixed to the goods in that other State by or with the consent of the owner;



2. the exclusive rights to a trademark do not include the right to prevent a third party from using in commerce:

- a. his/her own name and address;
- b. any indication concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of manufacture, or any other characteristics of the goods or services; or
- c. the trademark itself, if this is necessary to indicate the intended purpose of a product, in particular as an accessory or spare part, provided in all three cases, however, that such use is in accordance with honest practices in industrial and commercial matters.

3. prior rights: the exclusive rights to a trademark do not include the right to prevent the use in the course of trade of a similar sign which is protected on the basis of a prior right which has local significance only, if and in so far as such prior right is recognized under the civil law of the BES islands.

Remedies

In case of infringement of the exclusive rights to a registered trademark the owner thereof may request an injunction, and may claim compensation for all damages sustained by the infringing use. In addition to or instead of a claim for compensation of the damages, the owner of the trademark may claim the surrender of the profits obtained by the infringing use and the rendering of an account in relation thereto. However, such claim will be refused, if the Court finds that the infringing use was not made in bad faith or that in view of the circumstances of the case, such claim should not be accepted.

The owner of the registered trademark is entitled to claim as his/her property, any movable goods that have infringed upon his/her exclusive trademark rights, or goods having been used in producing such goods, or to demand that these goods will be destroyed or rendered unfit for use. The Court may order that the surrender of the goods can take place only against payment by the plaintiff of compensation as established by the Court. The owner of the registered trademark may also claim the payment of the amounts of money likely to have been obtained by the infringement. In the cases referred to in this paragraph, the claim will be refused, if the infringement was not made in bad faith.

The Court may, if so requested by the owner of the registered trademark, order the defendant in infringement proceedings, to inform the owner of the trademark of all what is known to him/her with regard to the origin of the goods with which infringement has been committed and to furnish to the owner all data relating thereto.

A licensee is normally not entitled to obtain an injunction in case of infringement of the licensed trademark, except in cases where the infringement would also constitute an independent illicit act towards licensee. The licensee may, however, intervene in an action for the compensation of damages brought by the owner of the trademark, in order to directly obtain compensation of the damages sustained by him/her or to be awarded a proportional share of the profits earned by the defendant party through the infringement. Without prejudice to the foregoing, the owner of the trademark may institute a claim for compensation of damages or surrender of profits on behalf of the licensee. A licensee may bring an action for award of damages or surrender of profits on his/her own only if this has been explicitly stipulated. Furthermore, provided he/she has obtained the authorization of the owner of the trademark for this purpose, a licensee may claim as his/her property the movable goods that have infringed upon the licensed trademark, or goods having been used in producing such goods, or may demand that these goods will be destroyed or rendered unfit for use, and he/she may claim the payment of the amounts of money likely to have been obtained by the infringement, in so far as these claims are intended to protect the rights to the execution of which the licensee is entitled. Any claim referred to in the foregoing sentence will be refused, if the infringement was not made in bad faith.



The owner of the registration of a licensed trademark may institute an infringement action against a licensee who acts contrary to the provisions in the license agreement concerning the duration of the license, the form covered by the registration in which the trademark may be used, the goods or services for which the license has been granted, the territory within which the trademark may be affixed, or the quality of the goods or services brought into the trade or rendered by the licensee. This also implies that goods brought into the trade under the trademark by a licensee contrary to any of said provisions, for instance goods brought into the trade outside the licensed territory, or after expiration of the term of the license, would not be considered brought into the trade by or with the consent of the owner of the registration of the trademark.

No infringement action can be based on a trademark which is not registered, and no compensation of damages can be obtained with regard to acts performed before the filing of the application for registration. Nothing in the trademark law, however, is deemed to affect rights of action of the person entitled to a sign not being considered as a trademark against illegal use of that sign.

Tolerance of a younger identical or similar trademark (acquiescence)

The owner of exclusive rights to a trademark who during five consecutive years has tolerated the use of a trademark that was filed later, while being aware of that use, can no longer on the basis of his/her older right, with regard to the goods or services for which the younger trademark was used, invoke the nullity of the registration of the younger trademark or prevent use of the younger trademark for identical or similar goods or services, unless the application for registration of the younger trademark was filed in bad faith. If the right to invoke nullity and to take infringement action has been thus forfeited, the owner of the younger trademark will not be entitled to prevent the use of the older trademark. So, the result in such case may be that two identical or similar trademarks will exist side by side. It is therefore important that in case of infringement or of registration of an identical or similar trademark action is taken in due time, in order to avoid forfeiture of the right to take action.

Well-known and reputed trademarks

If a trademark could be considered well-known in the BES islands, then pursuant to article 6bis of the Paris Convention the rights to the well-known trademark may be invoked against third parties.

Trademarks and trade names

Trademark vs. trade name

The law stipulates that the exclusive right to a trademark shall not include the right to oppose the use, in economic traffic, of a concurrent symbol (trade name) that derives its protection from an older right of local significance only, if and insofar as such right is recognized pursuant to ordinary civil law.

Trade name vs. trademark

There is no separate law in the BES islands which applies to the protection of trade names, neither is it legally required to register a trade name with the trade register of the Chamber of Commerce. However, to a large extent protection can be claimed based on the law of tort.



Trademarks and domain names

The law stipulates that without prejudice to the application of ordinary civil law concerning liability in respect of unlawful acts, the trademark holder, based on his exclusive right, can oppose any use, made without a valid reason in economic traffic, of a trademark or a corresponding symbol other than for distinguishing goods or services (e.g. a domain name), if through such use unjustified benefit can be derived from the distinguishing ability or the reputation of the trademark, or its distinguishing ability or reputation can thus be harmed.

Specific aspects of local trademark registration

The BES islands does not form part of the European Community (European Union). Community Trademarks which extend to The Netherlands and the other member countries of the European Union therefore do not extend to the BES islands. The same applies for Benelux registrations. To obtain trademark protection in the BES islands, local trademark registration must be sought in the BES islands.

For more information about trademark registrations on the BES-Islands please contact:



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