



# Aruba

## Trademark registrations 2022

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## General Information

Aruba is an independent country within the Kingdom of the Netherlands since 1986. Following on this constitutional change Aruba has its own trademark legislation as of 1989.

## Trademark legislation in Aruba

### National

On a local level, trademark protection in Aruba is now governed by the Aruba Trademarks Ordinance 1989 (the "Aruba Trademark Act"), and the Regulation of the Bureau for Intellectual Property Aruba ("BIPA").

### International

Although Aruba is a member of the Madrid Agreement, but not of the Madrid Protocol, it is not possible to designate Aruba in an International registration, since the local law has not (yet) been adapted to the membership to the Madrid Agreement. Aruba is not a member of the European Union and consequently EU trademark legislation does not apply in Aruba.

The relevant trademark conventions where to Aruba is a party are as follows:

- Paris Convention for the Protection of Industrial Property;
- Berne Convention for the Protection of Literary and Artistic Works;
- Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of Registration of Marks;
- WIPO Convention;
- agreement on Trade-Related Aspects of Intellectual Property Rights;
- Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks;
- Trademark Law Treaty; and
- Vienna Convention on the Law of Treaties.

## Trademark registration

According to the Aruba Trademark Ordinance 1989 (the "Aruba Trademark Act") the first user of a trademark in Aruba has the right to exclusively use that trademark for those goods or services he has used it for during the last three years. Registration of a trademark is not required in Aruba. However, in the absence of proof to the contrary, the first applicant of a trademark registration is considered the first user of the trademark. The Bureau for Intellectual Property Aruba ("BIPA") is responsible for the registration of trademarks. Protection of a registered trademark lasts for ten years following the date of application. A registration is renewable for a successive ten year period.

### Registrable trademarks

As trademarks may be all signs that may serve to distinguish the goods or services of an enterprise, provided they are not excluded from protection and registration by law.

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.



### **Non-registrable trademarks**

The following trademarks are not registrable:

1. trademarks that lack a distinctive character;
2. trademarks being contrary to morality or to public order irrespective of the use that is made thereof;
3. trademarks consisting of or containing without authorization by the competent authorities, armorial bearings, flags or any other state emblems of any of the countries parties to the Paris Convention, or official signs and hallmarks indicating control and warranty adopted by those countries, provided the mark 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;
4. 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 parties to the Paris Convention are members, or any imitation thereof from a heraldic point of view; and
5. trademarks of which the registration is applied for in respect of goods or services for which the use thereof could lead to deceit of the public.

Furthermore, the law provides that, notwithstanding registration in the Register of Aruba, no protective rights will be acquired in respect of the following trademarks:

6. trademarks similar to an individual trademark, registered on behalf of a third party for similar goods or services, unless such third party gave his/her consent;
7. 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;
8. trademarks similar to a trade name which may cause confusion with the public in question about the origin of the goods and services.

### **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. Foreigners may apply for and obtain registration of trademarks to the same extent as parties being a national of or domiciled in Aruba. However trademark owners, not domiciled in Aruba are required to submit their application through an Aruban trademark agent.

### **Requirements for filing**

An application must be filed on prescribed form in triplicate, in the Dutch language 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. Letters and documentary evidence from abroad may be drawn up in French, Spanish or English. An authenticated translation into Dutch will be submitted of documentary evidence drawn up in another language.



An application must comprise:

1. the last name, given names and street address of the applicant;
2. the name of the agent;
3. if the trademark consists of just words or numbers, then these must be presented in capital letters in the center of the thereto destined section;
4. if the trade- or service mark comprises stylized words or numbers, a picture (max. 9 x 9 cm) of these figurative elements must be presented;
5. the classes of the Nice classification in which protection is desired and the specific goods and/or services for which protection will be claimed;
6. indicate if color(s)- up to maximum of 5 basic colors- is/are of essential importance to the trademark;
7. when priority based on the Paris Convention is claimed, the applicant needs to file a certified copy of the basic application;
8. an application fee has to be paid in order for the BIPA to accept the documents. If proof of filing is desired, please submit an additional photocopy on which to provide entry records; and
9. in the event of filing on behalf of a corporate body established in Aruba, proof thereof obtained at the Chamber of Commerce of Aruba should be submitted when filing the application.

#### **Appointment of representative / Power of attorney**

Applicants that have no seat nor are domiciled in Aruba must appoint an agent, who is either a trademark agent admitted by and registered at the BIPA, or an attorney at law practicing within Aruba. Foreign applicants must elect domicile with that agent.

In that event the trademark attorney has to mandatorily submit simultaneous the filing, under penalty of non-acceptance:

- a power of attorney given to him by the one claiming to be title bearer of the trade- or service mark;
- a signed true declaration that it concerns a corporate body, indicating under the laws of which country or state it has been established, signed by authorized executives at the corporate body or by the empowered attorney;
- this declaration – if clearly stated – can be included in power of attorney.

A general power of attorney can be registered with the BIPA and is valid for unlimited years. To register a power of attorney a fee has to be paid.

#### **Filing authority**

Applications for registration of a trademark are to be filed and dealt with by the BIPA, under the authority of the Ministry of Justice.

#### **Classification**

Aruba has adopted the 11th edition of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks. 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 conduct an availability search among prior registrations in Aruba as a preliminary search on a voluntary basis, in order to evaluate the possibility of conflicts with prior rights. An availability search may be requested on payment of the required fee by any party. The results of the search will normally be available after one month. It is possible to request for an accelerated availability search which will take approximately two weeks on payment of the required extra fee. If the applicant does not choose for an availability search before registration, the BIPA will also conduct a limited novelty (availability) search after the application for registration has been filed.

### **Examination**

The BIPA will first examine whether the requirements for obtaining a filing date have been fulfilled. The applicant will be notified of the filing date or of the grounds explaining why a filing date could not be established within one month from filing. After a filing date has been accorded, it will be examined whether the other formal requirements have been met. If any of those requirements are not satisfactorily fulfilled, the applicant will be informed thereof with indication of the requirements concerned. If the requirements are not met within the prescribed term, the application will lapse.

The BIPA shall also examine whether:

1. the trademark applied for is eligible for registration;
2. the trademark has a distinctive character and is not exclusively descriptive;
3. the trademark is contrary to morality or to public order;
4. the trademark is a trademark of which the registration is not allowed in view of Article 6ter of the Paris Convention; and
5. the registration of the mark is applied for goods or services in respect of which use of the mark may lead to deceit of the public.

In case it is established by the BIPA that the trademark is not registrable *per se*, registration will be refused. Before refusal of the registration, the BIPA will inform the applicant within one month from the filing of the application of its intention to refuse the registration. The applicant will be given the opportunity to file a reply within a certain period of time. If no reply is filed within the set term, or if the reply is not sufficient, registration will be totally or partially refused and the applicant shall be notified thereof. The notification shall contain the grounds for refusal. The refusal must relate to the entire mark, but may be limited to only one or some of the goods or services for which registration is applied for.

If the decision to either entirely or partially refuse registration has become final, the application of the mark will be null in so far as registration is refused.

Furthermore the BIPA can raise an objection against the registration of a trademark if:

1. the trademark corresponds with an existing trademark, registered by a third party or of which a third party has earlier filed a trademark application for; or
2. the trademark is known in Aruba as belonging to a third party or being the commercial name of a third party and therefore confusion may arise with the public to the origin of the goods or services.

Before refusal of the registration, the BIPA will inform the applicant within one month from the filing date of its objections. The applicant will be given a certain period of time to resolve the objections. If the objections are not resolved within the period set, the registration will be refused and the applicant shall be notified thereof. The notification shall contain the grounds for refusal.



If the BIPA has no objections against the registration of the trademark, a notification shall be sent to the applicant within one month from the filing date, to the applicant requesting payment of a registration fee. The registration fee must be paid within one month as of the notification otherwise the application will be deemed not to be submitted. Upon receipt of the registration fee the BIPA shall register the trademark within two weeks and a certificate of registration shall be sent to the applicant.

#### **Appeal**

Within two months from the notification of refusal, the applicant may lodge an appeal against the decision of the BIPA to refuse the application. The appeal is to be lodged with the Court of First Instance of Aruba and may be lodged on applicant's behalf by an authorized trademark agent.

#### **Opposition**

Ex parte opposition proceedings are not provided for in Aruba. After registration, the cancellation of a trademark may be demanded in proceedings on the merits before the Court of First Instance. In these proceedings is a possibility to request for an injunction and/or damages.

#### **Alteration after registration**

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

#### **Publication**

Upon registration, all particulars thereof are published in the MarcAruba ("Merkenblad"), which is published every 16th day of that month. At present, there is no publication of the application prior to registration. The MarcAruba is available at the BIPA.

All particulars regarding registrations of trademarks in Aruba, including renewal, amendments, granting or cancellation of licenses, nullity, etc. are officially published in the MarcAruba ("Merkenblad").

#### **Renewal**

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

#### **Requirements**

The requirements for renewal are:

1. an application on a prescribed form in triplicate, signed by the applicant or agent, containing:
  - a. the full name and address of the owner of the registration;
  - b. the name of the agent;
  - c. if the trademark consists of words or numbers only, please type these in capital letters in the center of the thereto destined section;
  - d. if the trade or service mark comprises stylized words or numbers, a picture (max 9 x 9 cm) of the figurative elements should be submitted;



- e. if the list of goods and/or services has been limited since the last publication, then a new list of the goods and/or services in precise terms must be presented. 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 International Classification;
  - f. if signed on behalf of a corporate body, name and capacity of the signatory must be mentioned below the signature; and
  - g. the number and expiration date of the last registration.
2. in the event of filing on behalf of a corporate body established in Aruba, proof thereof obtained at the Chamber of Commerce of Aruba should be submitted when filling the application;
  3. a power of attorney, signed by the applicant for renewal. If a general power of attorney already has been filed that is still valid, the agent may refer to that general power of attorney when filling the renewal application;
  4. a certified copy of the application of the registration; and
  5. evidence of payment of the renewal fee.

If the BIPA raises objections against the renewal, the applicant will be informed thereof within one month from filing the renewal. Subsequently, the applicant will be given the opportunity to resolve the objections within two months. If the objections are not resolved within said period the renewal will be refused and the applicant shall be notified thereof. The notification shall contain the grounds for refusal.

If the BIPA does not have any objections against the renewal, then the renewal shall be effected within one month after filing an application for the renewal. After the renewal a notification shall be sent to the owner of the registration.

## Recordal of amendments

### Change of name and/or address

Recordal of a change of name and/or address requires:

- 1 an original power of attorney signed on behalf of the trademark owner (stating the new name and/or address). No legalization or notarization of the power of attorney is required; and
2. a declaration signed by the trademark owner, stating that (i) the former name and/or address has changed to (ii) the new name and/or address and (iii) the date as of when the change took place.

### Recordal of assignment

Assignment of a registered mark 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 mark was registered, or for only part of these goods and/or services. The assignment must be in writing. The assignment of a registered mark may not be restricted to a part of Aruba only, but must always apply to the whole territory of Aruba subject to nullification. The assignment of a mark must be recorded in the Register in order to be valid against third parties.

### The recordal of assignment requires:

- 1 an original Deed of Assignment (or a certified copy thereof) or any original document proving the assignment, such as an original declaration signed by both parties confirming the existence of the said assignment; and
- 2 a (copy of) a power of attorney signed on behalf of the assignee.

Neither the assignment nor the power of attorney needs to be notarized or legalized.



Assignment of a registered trademark must be recorded in the Register to be effective on third parties. A recordal of assignment can be requested by both parties jointly, or by the recipient person individually.

#### **Recordal of license**

Both exclusive and non-exclusive licenses under a registered mark may be recorded against the concerned trademark registration. A license may be restricted to part of the goods or services for which the trademark was 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 order to be effective against third parties.

For the purpose of fulfilling the use requirements use of a trademark by a licensee is equivalent to use by the owner of the trademark. Although the license, strictly speaking, does not have to be recorded to make use by the licensee, it is nevertheless strongly recommended that the license be recorded. Without recordal of the license against the trademark registration, the license is not effective on third parties.

#### **The recordal of license requires:**

1. a certified copy of an executed license agreement or any original document proving the assignment, such as an original declaration signed by both parties confirming the existence of the said license as per the attached assignment form. The license agreement must provide a period of time for which the license is granted; and
2. a (copy of) a power of attorney signed on behalf of the licensee.

Neither the license agreement nor the power of attorney needs to be notarized or legalized.

#### **Recordal of merger**

The recordal of a merger requires:

1. a certified copy of the documents evidencing the merger, such as an excerpt of the Chamber of Commerce; and
2. a power of attorney signed on behalf of the trademark owner; the signature needs to be legalized.

#### **Use requirement**

A non-registered trademark should be used during the last three years in order to prevent the lapse of the exclusive rights to the mark. 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 mere nominal use, for instance by 'token sales', will not be sufficient.

The use of a 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 Aruba, a trademark on goods destined solely for export out of Aruba 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. An action for nullification has to be invoked within six months after publication of the registration. After six months it is still possible to invoke the nullity of the registration if the exclusive right to that trademark appears from a conclusive judgment.

The competent Court can void a registration of a trademark at any time if:

1. the trademark corresponds with an existing trademark, whereto the exclusive right of the trademark belongs to a third party; or
2. the trademark is known in Aruba as belonging to a third party, or being the commercial name of a third party and therefore confusion may arise with the public to the origin of the goods or services.

The Public Prosecutor may also demand the nullity of a trademark registration if the trademark falls under any of the categories mentioned above, under 'Non-registrable trademarks'. The Court will ex officio declare the registration null in deciding nullification cases.

## Lapse of trademark rights

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

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

Protection of a trademark lasts for ten years following the date of application. A registration is renewable for a successive ten-year period.

The lapse of the exclusive right of a trademark will be recorded in the Register.

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

## Infringement

### Infringing acts

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

1. any use in the course of trade, consisting of a sign identical to the registered mark in respect of the goods and/or services for which the mark is registered;
2. any use in the course of trade, consisting of a sign identical or similar to the registered mark in respect of goods or services identical or similar to those for which the mark is registered, where there exists a likelihood of association on the part of the public between the sign and the mark; and
3. any use in the course of trade, without due cause, consisting of a sign being identical or similar to the mark, in respect of goods or services which are not identical or similar to those for which the mark is registered,

if the mark has a reputation in the territory of Aruba and where use of such sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark.



The civil action against the infringer should be based on the general tort provisions, article 6:162 of the Civil Code of Aruba 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.

The following acts performed under any of the above conditions without the consent of the trademark owner, are, among others, considered infringing use of the sign:

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

#### **Remedies**

In case of infringement of the exclusive rights to a 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 mark 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.

An infringement action against third parties may be instituted by the owner of the trademark registration before the Court of First Instance of Aruba.

### **Well-known and reputed marks**

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

### **Specific aspects of regional trademark registration**

Aruba does not form part of the European Community (European Union), Community Trade Marks which extend to The Netherlands and the other member countries of the European Union therefore do not extend to Aruba. Also Benelux trademark registrations are not valid in Aruba. To obtain trademark protection in Aruba, local trademark registration must be sought in Aruba.

**For more information about trademark registrations on Curaçao, please contact:**



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