



Press and Information

Court of Justice of the European Union

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Advocate General's Opinion in Case C-376/11
Pie Optiek v Bureau Gevers

According to Advocate General Trstenjak an undertaking can register its trade marks as .eu domain names only if it is established in the EU

Although a resident licensee can carry out such a registration and, moreover, was eligible for priority registration during the sunrise period, only a person who is himself entitled to use the trade mark on a commercial basis qualifies as a licensee

On 7 December 2005, registration opened for Internet domain names under the .eu¹ Top Level Domain. Registration is on a 'first come first served' basis. However, during the first four months (the 'sunrise period') only holders of prior rights and public bodies were eligible to apply. Moreover, a distinction was made between different holders of prior rights. Thus the first two months were reserved for holders of national and Community trade marks and geographical indications, although this also applied to their licensees. EURid², the body responsible for registration, registers, according to the relevant regulation, domain names requested by any undertaking established in the EU.

The US company Walsh Optical offers contact lenses and spectacle-related items for sale via its website www.lensworld.com. A few weeks before the start of the sunrise period, it arranged for 'Lensworld' to be protected as a Benelux trade mark (which has since been cancelled). In addition it entered into a 'Licence Agreement' with Bureau Gevers, a Belgian intellectual property consultancy. According to that agreement, Bureau Gevers was to obtain a .eu domain name registration in its own name but on behalf of Walsh Optical. Accordingly, on 7 December 2005, the first day of the sunrise period, Bureau Gevers filed an application with EURid for registration of the domain name 'lensworld.eu' which, on 10 July 2006, was allocated to Bureau Gevers.

On 17 January 2006, the Belgian company Pie Optiek, which offers contact lenses and spectacles for sale via the website www.lensworld.be, also filed an application with EURid for the domain name 'lensworld.eu'. Pie Optiek too had arranged beforehand for 'Lensworld' to be protected as a Benelux figurative mark. However, in view of the request already made by Bureau Gevers, EURid refused Pie Optiek's application. Pie Optiek now claims that Bureau Gevers' actions were speculative and abusive. The Cour d'appel de Bruxelles, before which the dispute was brought, is asking the Court of Justice to outline in more detail the definition of an eligible licensee during the first phase of the sunrise period.

In her Opinion released today, Advocate General Trstenjak takes the view that despite being described as a 'Licence Agreement', the agreement entered into by Walsh Optical and Bureau Gevers is not a licence but a contract for the provision of services, as Bureau Gevers was to obtain registration of the domain name 'lensworld.eu' for the benefit of Walsh Optical alone – albeit in its own name – in return for payment. It was thus merely required to perform a service. The essential elements of a licence (the licensee's right to use the trade mark – in this case 'Lensworld' – itself on a commercial basis and to defend it vis-à-vis third parties) were absent, however. Bureau Gevers cannot, therefore, be regarded as a licensee eligible to benefit from the sunrise period.

¹ On the basis of Regulation (EC) No 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain (OJ 2002 L 113, p. 1) and Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (OJ 2004 L 162, p. 40).

² ASBL European Registry for Internet Domains.

Advocate General Trstenjak goes on to underline the European Union legislature's decision of principle, that only undertakings and organisations which are themselves established in the EU may request a .eu domain name. The .eu Top Level Domain is intended to provide a clearly identified link with the EU, the associated legal framework, and the European market place. It should enable undertakings, organisations and natural persons within the EU to register in a specific domain which will make this link obvious.

Against that background, a non-resident undertaking cannot be allowed to circumvent the rules on eligibility by obtaining registration of a .eu domain name by means of a legal construction such as the commissioning of a third party organisation that is established in the European Union and thus an eligible party.

Since the agreement entered into by Walsh Optical and Bureau Gevers must, in legal terms, be categorised not as a licence agreement but as a contract for the provision of services, and consequently Bureau Gevers was not an eligible party during the sunrise period, EURid must, on its own initiative, revoke the domain name 'lensworld.eu' allocated to Bureau Gevers.

NOTE: The Advocate General's Opinion is not binding on the Court of Justice. It is the role of the Advocates General to propose to the Court, in complete independence, a legal solution to the cases for which they are responsible. The Judges of the Court are now beginning their deliberations in this case. Judgment will be given at a later date.

NOTE: A reference for a preliminary ruling allows the courts and tribunals of the Member States, in disputes which have been brought before them, to refer questions to the Court of Justice about the interpretation of European Union law or the validity of a European Union act. The Court of Justice does not decide the dispute itself. It is for the national court or tribunal to dispose of the case in accordance with the Court's decision, which is similarly binding on other national courts or tribunals before which a similar issue is raised.

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The [full text](#) of the Opinion is published on the CURIA website on the day of delivery.

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