



Press and Information

Court of Justice of the European Union

**PRESS RELEASE No 104/12**

Luxembourg, 19 July 2012

Judgment in Case C-376/11

Pie Optiek SPRL v Bureau Gevers SA, European Registry for Internet Domains ASBL

## **A person authorised solely to register a .eu domain name for the proprietor of a trade mark is not a 'licensee of prior rights'**

*Licensees who may apply for registration of a trade mark as a .eu domain name during the 'Sunrise Period' do not include persons not authorised to use that trade mark commercially in a manner consistent with its functions*

Registration of .eu Top Level Domain names<sup>1</sup> opened on 7 December 2005 and is carried out 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. However, the same preferential treatment was available to their licensees. According to the relevant legislation, EURid<sup>2</sup>, the body responsible for registration, registers domain names requested by any undertaking established in a State of the EU.

The United States company Walsh Optical offers contact lenses and spectacle-related items for sale via its internet site. A few weeks before the start of the sunrise period, it had the Benelux trade mark 'Lensworld' registered. In addition it entered into a 'License 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 is active in the internet sale of contact lenses, spectacles and other optical products, also filed an application with EURid for the domain name 'lensworld.eu'. Shortly beforehand, it had also applied for registration of the Benelux figurative mark containing the word sign 'Lensworld'. However, EURid refused Pie Optiek's application on the ground that Bureau Gevers' application took precedence. Pie Optiek now claims that Bureau Gevers' actions were speculative and abusive.

In that context, the cour d'appel de Bruxelles (Belgium), which is hearing the case on appeal, is asking the Court of Justice to clarify the concept of an eligible 'licensee' during the first phase of the sunrise period.

First of all, the Court notes that the term 'licensee' is not defined under EU law. In that context, the Court observes that the .eu Top Level Domain was created with the aim of increasing the visibility of the internal market in the virtual market place based on the internet, by providing a clearly identified link with the EU, and by enabling undertakings, organisations and natural persons within the EU to register in a specific domain which will make this link obvious.

<sup>1</sup> 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 of 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).

<sup>2</sup> European Registry for Internet Domains ASBL

It is in light of this objective that domain names requested by any undertaking having its registered office, central administration or principal place of business within the EU, any organisation established within the EU, without prejudice to the application of national law, and any natural person resident within the EU must be registered in the .eu Top Level Domain. Such undertakings, organisations and natural persons are parties eligible to have one or more domain names registered in the .eu domain.

With regard to holders of prior rights, only those having their registered office, central administration, principal place of business, or residence in the EU are eligible to have one or more domain names registered in the .eu domain during the sunrise period. Likewise, licensees of prior rights are eligible only if they satisfy the test of presence in the EU and if the prior right concerned is, at least partly and/or temporarily, available to them instead of to the holder.

It would be contrary to the objectives of the legislation concerned for a holder of a prior right who does not satisfy the test of presence in the EU to be allowed to obtain a .eu domain name through a person who satisfies that presence test but to whom that right is not – even partly or temporarily – available.

Furthermore, the Court considers that a contract by which the contractual partner, described as ‘licensee’, undertakes, in return for remuneration, to use reasonable efforts to file an application and obtain the registration of a .eu domain name for the proprietor of a trade mark is more akin to a contract for services than to a licence agreement. That is all the more so if such a contract does not confer on that licensee any right to use that trade mark commercially.

It follows that such a contract cannot be regarded as a licence agreement in trade mark law. Consequently, a contractual partner tasked with registering a .eu domain name for the proprietor of the trade mark in question cannot be considered a ‘licensee of prior rights’ within the meaning of the applicable legislation.

---

**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.

---

*Unofficial document for media use, not binding on the Court of Justice.*

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

Press contact: Christopher Fretwell ☎ (+352) 4303 3355