Panel Decision for dispute CAC-ADREU-000331

Case number	**CAC-ADREU-000331**
Time of filing	**2006-03-21 09:41:43**
Domain names	**insight.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Mrs Suzanne Louise Phillips**

Respondent

Organization / Name	**EURid**

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceedings which are pending, or have been decided, and which relate to the disputed Domain Name.

FACTUAL BACKGROUND

On December 7, 2005, De Webmakers filed an application for the registration of the domain name “INSIGHT.” De Webmakers was the second applicant for said domain name.

On January 5, 2006, as Documentary Evidence De Webmakers submitted the Benelux trademark registered by Insight BV and a License declaration regarding this Benelux trademark between Insight BV and De Webmakers.

EURid accepted the application of De Webmakers to register the domain name INSIGHT. This acceptance within the first phase registration (Sunrise period) is the subject of the dispute.

A. COMPLAINANT

Complainant sought the following remedies:
1. The annulment of EURid's decision to register the Domain Name in the name of De Webmakers;
2. The attribution of the Domain Name to the Insight Direct UK Limited.

The Complainant believes that the Registry’s decision to attribute the Domain Name to De Webmakers conflicts with regulations.

De Webmakers is not the holder of a registered national or Community trademark for the word INSIGHT. Therefore, De Webmakers filed the application for the Domain Name on the basis of the license declaration contained in the Documentary Evidence.

The Complainant contends that there is no obvious commercial connection between the business activities of De Webmakers and either the services for which the Mark is registered or the business activities of Insight BV. De Webmakers and Insight BV operate in separate and distinct business areas, and there is no overlap between the services for which the Mark is registered and the services provided by De Webmakers.

Furthermore, the Complainant contends that given Insight BV filed two applications in its own name for the Domain Name, it was inconsistent to grant a license under the Mark to De Webmakers.

Based on the lack of a commercial connection, the complainant suspects that there is no genuine license in place between De Webmakers and Insight BV for use of the Mark. If true, De Webmakers application for the Domain Name does not satisfy the requirements of Article 12(2), third paragraph of Regulation (EC) No. 874/2004.

The Complainant asks the Panel to order the Registry to investigate whether or not a genuine license under the Mark was in place at the time of the application of De Webmakers for the Domain Name.

B. RESPONDENT

The Respondent contends that the application of De Webmakers (the “Applicant”) for the domain name INSIGHT was made on the grounds of a registered Benelux trademark, and the license declaration regarding this Benelux trademark between Insight BV and the Applicant and was submitted in due time.

The Respondent has accepted the application for the domain name INSIGHT on the first-come-first-serve basis.

The Respondent contends that the disclosed Documentary Evidence clearly shows that
• Insight BV is the holder of a valid Benelux trademark consisting of the marking INSIGHT; and
• Insight BV (Licensor) has licensed this trademark to the Applicant (Licensee).
The license states that the "Licensor authorises Licensee to apply during the Phased Registration Period for the Domain Name (INSIGHT)".

Therefore, the Respondent contends that the Applicant has been authorized to use a prior right to apply for the INSIGHT domain name, and so, the Registry's decision is not in breach of the regulations.

DISCUSSION AND FINDINGS

According to article 10.2 of Commission Regulation (EC) No. 874/2004 of 28 April 2004, the holders of prior rights which are recognized or established by national or Community law shall be eligible to apply to register domain names during the period of phased registration prior to the general registration of .eu domain.

The Panel finds that De Webmakers provided sufficient documentary evidence to prove that the Insight BV is the holder of a valid Benelux trademark, INSIGHT. The Panel also finds that Insight BV licensed the trademark to De Webmakers. In addition, the license declaration contains explicit authorization to apply during the Phased Registration Period for the Domain Name INSIGHT.

A registered Benelux trademark and the license declaration regarding this Benelux trademark between Insight BV and the Applicant shall be considered a prior right.

In accordance with article 14 of Commission Regulation (EC) No. 874/2004, the Registry shall register the domain name on the first-come-first-serve basis if it finds that the applicant has demonstrated a prior right.

The Panel will not order the Registry to investigate further whether or not a genuine license under the Mark was in place at the time of the application by De Webmakers for the Domain Name.

Therefore, the decision of the Respondent to accept the application of De Webmakers for the Domain name INSIGHT does not conflict with Commission Regulation (EC) No. 874/2004

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders

the Complaint Denied

PANELISTS

Name	**Premysl Libal**

DATE OF PANEL DECISION 2006-06-13

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contends that the decision of the Registry to attribute the Domain Name INSIGHT to De Webmakers is in conflict with regulations.

De Webmakers is not the holder of a registered national or Community trade mark, and it submitted its application on the basis of a license declaration between the trademark owner, Inside BV, and De Webmakers.

The Complainant sought the annulment of EURid's decision to register the Domain Name in the name of De Webmakers and the attribution of the Domain Name to the Complainant, Insight Direct UK Limited.

The Panel finds that De Webmakers provided sufficient documentary evidence to prove that Insight BV is the holder of a valid Benelux trademark, INSIGHT. The Panel also finds that Insight BV licensed the trademark to De Webmakers. In addition, the license declaration contains explicit authorization to apply during the Phased Registration Period for the Domain Name INSIGHT.

The Panel decided that EURid’s decision to accept the application by De Webmakers for the Domain name INSIGHT does not conflict with Commission Regulation (EC) No. 874/2004; and, therefore, the complaint is denied.