



THE BELGIAN CENTRE FOR ARBITRATION AND MEDIATION

**DECISION OF THE THIRD-PARTY DECIDER**

**Complainant / Domain name holder**

**Case no. 44463 / domain name prontopro.be**

**1. The Parties**

1.1. Complainant: PRONTOPRO srl, Via Fabio Filzi 25, 20124 Milano, Italy

*Represented by:*

Ms. Alessandra Ferreri, SCF Studio Legale, Via Salvini 5, 20122 Milano, Italy

Hereafter referred to as "*the Complainant*"

1.2. Domain name holder: Flavio Rocchi, Via Lello da Velletri 9, 00049 Velletri, (RM) Italy

*Represented by:*

Ms. Alessandra Franchi, Dugardyn & Partners, Boulevard Brand Whitlock 132, 1200 Brussels, Belgium

Hereafter referred to as "*the Respondent*"

**2. Domain name**

Domain name: prontopro.be  
Registered on: 26 January 2018

*Hereafter referred to as "the Domain Name".*

**3. Procedure**

On 11 December 2018 the Complainant filed a complaint (hereinafter referred to as "the Complaint") with the secretariat of the Belgian Centre for Arbitration and Mediation (hereinafter referred to as "CEPANI") according to the CEPANI Rules for Domain Name Dispute Resolution ("the Rules") and the Dispute Resolution Policy of DNS BE, incorporated in its Terms and Conditions for domain name registrations under the ".be" domain operated by DNS ("the Policy").

On 18 January 2019 the Respondent filed a response in accordance with Article 10 of the Rules.

On 23 January 2019, CEPANI appointed Ms. Christine De Keersmaecker to act as third-party decider pursuant to the Rules (hereafter referred to as "Third-Party Decider"). The Third-Party Decider accepted this instruction and provided CEPANI with the declaration of independence in accordance with article 7 of the Rules.

Pursuant to article 7.2 of the Rules, CEPANI formally appointed the Third-Party Decider in an e-mail dated 23 January 2019 and provided her with an electronic copy of the case file, consisting of the completed complaint form and supporting documents (hereafter referred to as "the Complaint") as well as a copy of the completed response form and supporting documents (hereafter referred to as "the Response").

On the same day, CEPANI informed the Complainant and the Respondent of the appointment of the Third-Party Decider and notified them that the deliberations would be closed on 30 January 2019, with the final decision being due on 13 February 2019.

On 25 January 2019 the Complainant informed CEPANI that it did not consider it necessary to file any further pleadings or documents.

#### 4. Factual Background information

The Complainant is Prontopro srl., an Italian company focused on home services which matches, through its marketplace, service professionals (plumbers, painters, catering...) with customers who need these services.

The Complainant is the proprietor of two semi-figurative EU Trademarks:

•  with No. 013846621; and

•  with No. 016128142.

The Complainant also claims to own registered trademarks in Brazil (no. 912100346) and Chile (no. 1235165).

In addition, the Complainant is the owner of several domain names, of which the most important is <prontopro.it>, as well as several social media pages.

The Complainant became aware of the Respondent's registration of the Domain Name in October 2018. The Domain Name refers to an inactive website which is currently under construction.

The Complainant made several efforts to resolve the dispute amicably. The Complainant sent a warning message to the Respondent via LinkedIn on 29 October 2018. In the absence of a response the Complainant sent a cease and desist letter to the Respondent on 5 November 2018.

The Respondent replied to the LinkedIn message on 6 November 2018 in Italian.

On 23 November 2018 the Respondent's attorney replied to the cease and desist letter in Italian.

Since no amicable solution could be found, the Complainant filed the Complaint on 11 December 2019 with the request to transfer the Domain Name to the Complainant.

## **5. Position of the parties**

### **5.1. Position of the Complainant**

The Complainant argues that:

- i. The Domain Name is identical to the Complainant's trademarks, business name and domain names.
- ii. The Respondent has no rights or legitimate interest in the Domain Name because of the absence of any license or permission from the Complainant to use the Domain Name. Moreover, the Domain Name is not actively used since its registration.
- iii. The Domain Name was registered in bad faith since the Respondent knew or at least should have known of the existence of the Complainant's trademarks and business. Moreover, the Domain Name has been inactive since it was registered and the Respondent used false contact information.

### **5.2. Position of the Respondent:**

- i. The Respondent and the Complainant operate in different sectors and countries. The Domain Name has a specific meaning in the IT world and has nothing to do with the use of the name <Prontopro> by the Complainant. Therefore, although the two names sound phonetically similar, there is no risk of confusion.
- ii. The Domain Name is composed by "pronto" and "probe". "Pronto" is a generic word that means "ready" and "probe" has a specific meaning in the IT sector. Together these words mean "prompt intervention computer security". The fact that the Domain Name has not actively been used yet, does not affect the legitimate interest of the Respondent. Only a long period of time can be an indication of lack of a right or legitimate interest, which is not the case here.
- iii. The Domain Name has not been registered in bad faith since it is created with a very specific purpose and the Respondent wasn't aware of the existence of the Complainant.

## **6. Discussion and findings**

Pursuant to Article 16.1 of the Rules, the Third-Party Decider shall rule on domain name disputes with due regard for the Policy and the Rules.

Pursuant to Article 10b (1) of the Policy, the Complainant must provide evidence of the following:

- *"the domain name is identical or confusingly similar to a trademark, a tradename, a social name or corporation name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the Complainant has rights; and*
- *the Respondent has no rights or legitimate interests in the domain name; and*
- *the Respondent's domain name has been registered or is being used in bad faith."*

6.1. The Domain Name is identical or confusingly similar to trademarks in which the Complainant has rights

Based on the evidence submitted by the Complainant, it is clear that the Complainant is the proprietor of among others the following trademarks:

-  with No. 013846621; and
-  with No. 016128142.

The Complainant also claims to own a Brazilian trade mark  with No. 912100346 and a Chilean trade mark  with No. 1235165 but does not provide any documents of evidence in this regard.

In addition, the Complainant is the owner of several domain names, of which the most important is <prontopro.it>, as well as several social media pages.

According to the CEPANI case law, the suffix ".be" is not relevant for establishing the identity or the similarity between a domain name and a trade mark (see CEPANI case of 4 September 2013, n° 44306, La Ruche Qui Dit Oui / Jean-Francois Bombeeck)

Both the semi-figurative EU trademarks no. 13846621 and no. 16128142 (which predate the registration of the Domain Name on 26 January 2018) consist mainly of the word <prontopro>. The Domain Name, abstraction made of the suffix ".be" and the graphical elements of the trademarks, is identical to this word.

The fact that a semi-figurative trademark is invoked cannot prevent the fact that there is a similarity between the trademark and the domain name. The Domain Name should be compared to the verbal elements of said trademark (see CEPANI case of 13 October 2016, n° 44411, Lenovo Ltd / Segreteria Associazione Genexi-Onlus).

The Third-Party Decider holds that the Complainant has rights in trademarks which are at least confusingly similar to the Domain Name and that the first condition is fulfilled.

## 6.2. The Respondent has no right or legitimate interests in the Domain Name

The Complainant has to prove that the Respondent has no rights or legitimate interests in the Domain Name.

However according to CEPANI case law it is sufficient, taking into account all the facts of the case, that the Complainant can credibly state that he is unaware of any reason or circumstance which could be indicative of such a right or legitimate interest (see CEPANI case of 13 may 2016, n° 44398, ALS Liga België vzw Ligue SLA Belgique asbl / Ocom IP B.V.).

Following article 10 b) 3) of the Policy, if a complaint is filed, the Respondent can demonstrate his rights or legitimate interests to the Domain Name by the following circumstances:

- prior to any notice of the dispute, the registrant used the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services or made demonstrable preparations for such use; or
- the registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if he has no trademark; or
- the registrant is making a legitimate and non-commercial or fair use of the domain name, without intent to misleadingly divert consumers for commercial gain or to tarnish the trademark, trade name, social name or corporation name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity at issue.

None of the above circumstances are applicable to the case at hand.

The following circumstances, invoked by the Complainant, substantiate the fact that the Respondent has no rights or legitimate interests in the Domain Name:

- There has never been an active use of the Domain Name although it must be taken into consideration that the Domain Name has only been registered on 26 January 2018.
- The mere registration of a domain name does not in itself establish a right or legitimate interest in it.
- The Domain Name is identical to the earlier trademarks of the Complainant.
- The Respondent has no business relation with the Complainant and has not received any license or consent to use the trademark <Prontopro> in a domain name.
- It is impossible to find any connection between the Domain Name and a web-portal related to cyber security which would explain, according to the Respondent the choice for the use of "pro" from "probe" in the Domain Name. The combination of the Italian word <pronto> and the Latin word <pro> is very specific and has no direct and demonstrable relation with cyber security.

The Respondent invokes the following explanations or circumstances in order to demonstrate a right or legitimate interest in the Domain Name:

- the Domain Name was registered to create a web-portal related to the European General Data Protection Regulation (GDPR) and cyber security. The reasons for the delay of the project given by the Respondent are:
  - It is a process that requires specific competences and skills, technical support and financial investments that the Respondent cannot bear alone. The

- Respondent claims to have followed specialized courses, however with very limited documents of proof thereof, and that he has started looking for partners;
  - The inability to dedicate full time to the project considering his professional activity;
  - He is father of 3 small children.
- The Domain Name will be used in connection with cyber security which explains the choice for the terms Pronto and Probe:
  - Pronto is a generic term in Italian meaning "ready";
  - Probe has a specific meaning in the IT sector.

The Third-Party Decider is of the opinion that the Complainant can credibly state that he is unaware of any reason or circumstance which could be indicative of a right or legitimate interest in the head of the Respondent while the Respondent cannot provide any credible arguments following which he would possess a right or legitimate interest in the term "prontopro".

On balance, the Third-Party Decider concludes that the second condition is also met.

### 6.3. The Respondent's Domain Name has been registered or is being used in bad faith

Following article 10 b) 2) of the Policy, the evidence of a bad faith registration or use of a domain name can inter alia be demonstrated by the following circumstances:

- circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark, trade name, registered name or company name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity, or to a competitor of the complainant, for a price that exceeds the costs that the registrant can show are directly related to the acquisition of the domain name; or
- the domain name was registered in order to prevent the owner of a trademark, a trade name, a registered name or a company name, a geographical designation, a name of origin, a designation of source, a personal name or a name of a geographical entity to use the domain name and that the registrant has engaged in a pattern of such conduct; or
- the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- the domain name was intentionally used to attract, for commercial gain, Internet users to the registrant's web site or other on-line location, by creating confusion with the complainant's trademark, trade name, registered name or company name, geographical designation, name of origin, designation of source, personal name or name of a geographical entity as to the source, sponsorship, affiliation, or endorsement of the registrant's web site or location or of a product or service on his web site or location.
- the registrant has registered one or more personal names without the existence of a demonstrable link between the registrant and the registered domain names

The enlisted circumstances are not exclusive and bad faith can be evidenced by any means including presumptions and other evidence showing, with a reasonable degree of certainty, the existence thereof (see CEPINA case of 9 January 2009, n° 44149, Lenslogistics AB / Lenson AB). Bad faith must be reasonably proven (see CEPINA case of 23 September 2005, n° 44068,

*Vueling Airlines v. Eclark Howard*: CEPINA case of 17 August 2004, n° 44049, *N.V. DR Oetker v. N.V. FML*) and may be proven by any means, including presumptions and circumstances that indicate with a reasonable degree of certainty the existence of bad faith, excluding any reasonable doubt (CEPINA case of 2 December 2005, n° 4471, *Hotel Rsvation Service Robert Ragge GmbH v. Hydrant Refuelling System*; CEPINA case of 5 March 2001, n° 44030, *S.A. Le Petit-fils de L.U. Chopard et Cie v. Joël Glecer (Orlogio NV)*).

The Complainant argues that the Domain Name is registered in bad faith because the Respondent had actual or constructive knowledge of the Complainant's trademarks at the time he registered the Domain Name. The Complainant states that the Respondent could not have ignored this since its trademarks are very popular in Italy and the home country of the Respondent is Italy. Moreover, according to the Complainant, the Respondent is the owner of the Domain Name <marmocchio.it> which is a web portal that links demands from young parents to the answers and advises from a variety of professionals (paediatricians, midwives...). The Complainant argues that the basic idea of this web portal is a clear replica of the Prontopro web pages of the Complainant.

It must be taken into consideration that a mere Google search to the words "prontopro" immediately leads to the website [www.prontopro.it](http://www.prontopro.it), owned by the Complainant, and that a mere search in the EUIPO trademark register leads to the earlier trademarks of the Complainant. A reasonable prudent professional would have verified this before registering a domain name (see CEPINA case of 23 September 2009, n° 44167, *Papier Present BVBA v. EXIP*).

There is no concrete evidence that the Respondent was aware of the business of the Complainant so that the above does not constitute on its own evidence of bad faith but he should have been aware. The words "pronto" and "pro" are generic words. In this regard reference must indeed be made to the fact that even monetizing generic terms, in the absence of bad faith on the side of the Respondent, is not a breach of the Policy, and should not be sanctioned unless specific circumstances demonstrate that the Respondent tried (or can be assumed to try or to have tried) to harm the rights or interests of a definite holder of a prior right (see CEPINA case of 23 September 2009, n° 44167, *Papier Present BVBA v. EXIP*).

The Complainant further invokes a passive holding of the Domain Name. The Third-Party Decider has visited the Domain Name on 9 February 2019 and has determined that no active webpage is connected to the Domain Name. The mere passive holding of a domain name is not sufficient to meet the conditions of art. 10 b) 1 (iii) of the Policy. Therefore other circumstances are required. (see CEPANI case of 13 October 2016, n° 44411, *Lenovo Ltd/ Segretaria Associazione Genexi-Onlus*).

Added to the passive holding of the Domain Name, according to the Complainant the following circumstances support the fact that the Respondent has registered the Domain Name in bad faith:

- The Respondent refuses to transfer the Domain Name to the Complainant.
- As referred in the complaint the Whois database mentioned no email address for the Domain Name and the phone number listed was always out of range. Incorrect contact information may be taken into account as an additional element for the determination of bad faith (see CEPINA case on 18 March 2015, n° 44369, *Engagor NV / S J Maikel*)

The Respondent on the other hand states that he has registered the Domain Name using the platform that he used for the registration of domain names when he lived in Italy. During the

registration process, probably to undated data, the former Italian address of the Respondent was kept in the system and his email address would also be correct. The respondent states that he did not try to hide his identity and also responded to the messages of the Complainant.

The Respondent, who has filed extensive arguments via its lawyer, can demonstrate that he made minor preparations with regard to the business for which the Domain Name will be used. This is confirmed by the background of the website which is currently under construction.

The Respondent and the Complainant are no competitors, the Respondent does not offer the Domain Name for sale and there are no indications that the Respondent would have registered the Domain Name in order to prevent the Complainant to use the Domain Name. The Respondent has not registered any other domain names "prontopro" so that no pattern can be demonstrated. It is however correct that the Respondent, if he would have acted as a reasonable prudent professional, should have been aware of the business of the Complainant and that he has so far not made any commercial use of the Domain Name. This is even more the case since he is an Italian citizen and Italy his former country of residence.

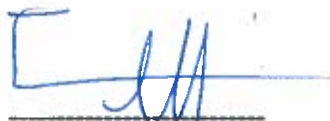
On balance, the Third-Party Decider is however of the opinion that these circumstances do not lead to a conclusion that the Complainant succeeds in delivering evidence showing, with a reasonable degree of certainty, and excluding any reasonable doubt, the existence of bad faith.

As a consequence, according to the Third-Party Decider, the third condition is not met.

## 7. Decision

The Third-Party Decider denies that the Domain Name has to be transferred to the Complainant.

Brussels, 12 February 2019.



Christine DE KEERSMAEKER  
The Third-party Decider