

## **ADMINISTRATIVE PANEL DECISION**

Gelbe Seiten Zeichen-GbR v. Nicole Menth  
Case No. D2025-0776

### **1. The Parties**

The Complainant is Gelbe Seiten Zeichen-GbR, Germany, represented by Bird & Bird LLP, Germany.

The Respondent is Nicole Menth, Paraguay, self-represented.

### **2. The Domain Name and Registrar**

The disputed domain name <gelbeseitenparaguay.com> is registered with Realltime Register B.V. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 25, 2025. On February 25, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 26, 2025, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent ( Privacy Service Realltime Register B.V.) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 27, 2025, providing the registrant and contact information disclosed by the Registrar, and requesting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 27, 2025.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 28, 2025. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2025.

On March 1 2025 and March 3, 2025, the Respondent sent two email communications to the Center. The Center acknowledged receipt of these communications on March 3, 2025. On March 21, 2025, the Center

notified the Parties of the commencement of the panel appointment process.

The Center appointed Assen Alexiev as the sole panelist in this matter on March 26, 2025. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is a long-time publisher of business, telephone and address directories under the brand “Gelbe Seiten” (in English, “Yellow Pages”). The Complainant’s Gelbe Seiten publications are also available online at < gelbeseiten.de”> and through its Gelbe Seiten mobile application.

The Complainant is the owner of many trademark registrations for the sign “GELBE SEITEN” (the “GELBE SEITEN trademark”), including the following registrations:

- the German trademark GELBE SEITEN with registration No. 1177265, registered on June 5, 1991 for services in International Classes 35 and 41; and
- the European Union trademark GELBE SEITEN with registration No. 004876603, registered on June 19, 2008 for goods and services in International Classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.

The disputed domain name was registered on December 8, 2024. It is currently inactive. At the time of filing of the Complaint, the disputed domain name directed to a website that contained a telephone and business directory of different Paraguay-based services advertised in Spanish and German.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its GELBE SEITEN trademark which is incorporated in the disputed domain name in its entirety. According to the Complainant, the inclusion of the geographic term “Paraguay” in the disputed domain name does not eliminate the confusing similarity with the GELBE SEITEN trademark, and the public will assume that the disputed domain name leads to a website showing a special edition for Paraguay of the Complainant’s publication, moreover since the website at the disputed domain name uses the Complainant’s trademark and advertises a business and telephone directory for Paraguay.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has not been authorized by the Complainant to use the GELBE SEITEN trademark and there has never been any relationship between the Parties. According to the Complainant, the disputed domain name falsely suggests an affiliation with it, and the Respondent is trying to take advantage of the Complainant’s reputation for its own benefit.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, the Respondent has registered the disputed domain name to attract, for commercial gain, Internet users to the website at the disputed domain name by creating a likelihood of confusion with the GELBE SEITEN trademark and with the Complainant company name and domain name. The Complainant points out that the website at the disputed domain name displays a telephone and business directory, which is the core business of the Complainant for which it uses the GELBE SEITEN trademark, and adds that the same website is in Spanish and German and includes many references to the GELBE SEITEN trademark

such as the text: “Wenn Sie gern in den Gelben Seiten stehen möchten, melden Sie sich”, translated in English as: “If you would like to be listed in the Yellow Pages, please contact us”. The Complainant maintains that the Respondent thus unfairly exploits the reputation of the Complainant’s GELBE SEITEN trademark.

## **B. Respondent**

The Respondent did not formally reply to the Complainant’s contentions.

In its informal letters to the Center, the Respondent disputes the Complaint and denies having acted in bad faith. The Respondent submits that it is based in Paraguay and that the website is for Paraguay, where the laws of Germany and of the European Union have no force. The Respondent adds that it has a registered company in South America with the name: “Páginas Amarillas Paraguay - Actividades publicitarias”, which name is not subject to any trademark protection.

The Respondent submits that the terms “yellow pages” are no longer protected by trademark law and no one has monopoly rights over them, and that the German Patent and Trademark Office has deleted the “Yellow Pages” trademark from its register. According to the Respondent, the term “yellow pages” is only a general description for certain services, and all providers of trade books can now call their directories “yellow pages”.

The Respondent adds that it has not used just the words “yellow pages”, but the combination “Yellow pages Paraguay”. Accordingly, this combination is not a protected term and it is not forbidden to create an advertising page for Paraguay that also uses the terms “yellow” and “pages”.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

The Complainant has submitted evidence and has thus established its rights in the GELBE SEITEN trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The official information about this trademark registration shows that it is currently valid. The Respondent’s allegations that this trademark has been invalidated are not supported by any details or evidence. The Panel understands that the English translation of the trademark is “YELLOW PAGES”, but the usage of the term “yellow pages” in different languages and its legal treatment under the trademark law of various countries, whatever it may be, does not change the fact that GELBE SEITEN is a long-standing and valid trademark of the Complainant.

The Panel finds the GELBE SEITEN trademark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the GELBE SEITEN trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “Paraguay”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the GELBE SEITEN trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The disputed domain name wholly reproduces the Complainant’s GELBE SEITEN trademark with the addition of the geographical term “Paraguay”. It would therefore appear to German-speaking Internet users as related to a directory of businesses operating in Paraguay, and German-speaking Internet users are more likely to be aware of the Complainant’s trademark. The associated website contains listings of various businesses located in Paraguay, and a significant part of the content on the website is in German, which shows that it includes German speakers in its target audience and that the Respondent speaks German. The Respondent has not given any explanation why it thought it would be beneficial for its business to include the German language words “gelbe” and “seiten” in the disputed domain name, and why a significant part of the listings and other texts on the associated website are in German. The Respondent also claims having “a registered company in South America with the name: “Páginas Amarillas Paraguay - Actividades publicitarias”, but this claim is not supported by any registration details or other evidence, so no conclusions can be made about it.

In view of the above, and in the absence of any plausible explanation or contrary evidence, it therefore appears as more likely than not that the Respondent has chosen the disputed domain name and activated the associated website not independently from the Complainant’s trademark, but with knowledge of this trademark and in an attempt to attract German-speaking Internet users to the disputed domain name and to the associated website by exploiting the popularity of the Complainant’s trademark and of its services offered under the same trademark particularly among such Internet users. Such conduct cannot be regarded as giving rise to rights or legitimate interests of the Respondent in the disputed domain name.

The Panel therefore finds that the second element of the Policy has been established.

## **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The disputed domain name is confusingly similar to the Complainant’s GELBE SEITEN trademark and resolved to a website that displays listings of various businesses offering their services in Paraguay, which fell within the scope of protection of the Complainant’s trademark and coincides with the Complainant’s own offerings. It is likely that German-speaking Internet users will regard the disputed domain name as related to a directory of businesses operating in Paraguay, and German speakers are more likely to be aware of the

Complainant's trademark. The fact that a significant part of the business listings on the associated website is in German showed that it targets German speakers and that the Respondent is one of them. The Respondent has not provided any plausible explanation as to why it decided to include the German language words "gelbe" and "seiten" in the disputed domain name, and why a significant part of the listings and other texts on the associated website are in German.

Considering the above, the Panel finds that it is more likely than not that the Respondent was aware of the Complainant's trademark when registering the disputed domain name and that it has registered and used it not for a purpose unrelated to the Complainant, but in an intentional attempt to attract, for commercial gain, Internet users to the website at the disputed domain name by creating a likelihood of confusion with the Complainant's GELBE SEITEN trademark as to the affiliation or endorsement of the Respondent's website by the Complainant.

The Panel therefore finds that the Complainant has established the third element of the Policy.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <gelbeseitenparaguay.com> be cancelled.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: March 29, 2025