

DISPUTE RESOLUTION SERVICE

D00020644

Decision of Independent Expert

Mr. Dirk Linnenweber

and

Mr. Malcolm Hill

1. The Parties:

Lead Complainant: Mr. Dirk Linnenweber
Alte Bahnhofstrasse 29
Bochum
44892
Germany

Respondent: Mr. Malcolm Hill
East Farm Barn
Low Catton
York
YO41 1EA
United Kingdom

2. The Domain Name:

hillaudio.co.uk

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in

the foreseeable future, that need be disclosed as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties.

01 October 2018 11:27 Dispute received
02 October 2018 14:53 Complaint validated
02 October 2018 15:02 Notification of complaint sent to parties
15 October 2018 11:20 Response received
15 October 2018 11:21 Notification of response sent to parties
18 October 2018 02:30 Reply reminder sent
19 October 2018 11:15 Reply received
19 October 2018 11:15 Notification of reply sent to parties
19 October 2018 11:51 Mediator appointed
25 October 2018 16:13 Mediation started
13 November 2018 17:08 Mediation failed
13 November 2018 17:08 Close of mediation documents sent
23 November 2018 01:30 Complainant full fee reminder sent
26 November 2018 09:54 Expert decision payment received

4. Factual Background

Since February 4, 2009 the Complainant has been the registrant of EU community figurative trade mark No. 6694954 in class 9:



On September 15, 2009 the Complainant registered the Mark as United States trademark No. 3,681,991, disclaiming the exclusive right to use "AUDIO" and claiming priority from February 24, 2008, the date of filing of the EU application.

The Respondent registered the Domain Name on June 23, 2018. It resolves to a website with the home page headline "Hill Audio A history in Sound", followed by the text:

"Hill Audio is a brand of professional audio products created by audio design pioneer Malcolm Hill, and owned by Malcolm Hill Associates. Starting in 1969, Hill was initially known as Hill PA systems; in 1980 the suffix 'PA systems' was replaced in favour of the more relevant 'Audio'. With Malcolm Hill Associates providing the product design, premises and finance, long term associate Robert Lingfield formed Hill Audio Ltd, to manufacture **Hill** products under license. The Hill Audio product range includes amplifiers, mixing consoles and speaker systems. Together with Malcolm Hill Associates, the next decade saw massive expansion, plus the introduction of many

innovative products, and the development of an international distributor network”.

5. Parties' Contentions

Complainant (summary)

The Complainant has used the Mark since 2009 through licensing to companies in which he owns shares, namely Adelto Limited, a Hongkong company, and Adelto Technologies Limited, a UK company formed in January 2013. These companies design, manufacture and distribute electronic and electric products for the audio and lighting industry and are the only global commercial suppliers of HILL AUDIO branded products.

The Complainant has made the web community aware of his EU and wider online use of the Mark via holding the following domain names:

hill-audio.com	registered 2007-07-03
hill-audio.de	registered 2013-08-14
hill-audio.fr	registered 2013-09-05
hill-audio.es	registered 2013-09-03
hill-audio.it	registered 2013-09-04
hill-audio.pt	registered 2018-08-19
hill-audio.co.uk	registered 2013-08-09
hill-audio.uk	registered 2017-09-28
hill-audio.com.au	registered 2017-09-02
hill-audio.cn	registered 2017-05-10

The Domain Name in the hands of the Respondent is an Abusive Registration because:

- (i) it is an infringement of the Complainant's registered trademarks;
- (ii) it is primarily and intentionally registered to create the deception that the Mark is owned by the Respondent, since the statement on the website to which the Domain Name resolves: "Hill Audio is a brand owned by Malcolm Hill Associates" is untrue, and an explicit and intentional infringement of the Complainant's registered trademarks;
- (iii) it disrupts the Complainant's and his licensees' business by indicating in a sub-headline on the website that "counterfeit" Hill Audio products exist. Since the Respondent does not offer any products for sale on the website, and thus the Complainant is the only commercial supplier of "Hill Audio" marked products, this statement implies that the Complainant's licensees' products are counterfeit, when they are in fact original designs based on the Complainant's licensees' product IP. This statement is thus untrue and defamatory;

- (iv) the email address <malcolmhill@hillaudio.co.uk> is used to make defamatory and/or maliciously false statements to the general public about the Complainant and his licensees and their businesses. The Domain Name is abused to create an impression of authenticity for abusive emails of the Respondent, with the sole intent of damaging the Complainant's trade mark value and disrupting his licensees' business. The Complainant's Exhibit 09 is an email sent by the Respondent on September 14, 2018 from that email address to numerous recipients stating:

“TO WHOM IT MAY CONCERN

We are Hill Audio – the renowned professional audio brand first established in England in the 1970's.

It has come to our attention that counterfeit Hill Audio products are being distributed by an outfit called Adelto.

These products are nothing to do with Hill Audio, despite 'Adelto' copying our genuine logo and stealing the Hill reputation in their catalogues and brochures...”;

- (v) the Domain Name is used to send unsolicited emails to the general public in breach of GDPR rules and does not disclose the true operator of the website content in breach of the Companies (Trading Disclosures) Regulations 2008. By the intentional deception about trade mark ownership, this exposes the Mark to a reputation of non-compliance and is an abusive attempt to damage the Complainant's trade mark value;
- (vi) the Domain Name attempts via its website content to redirect the site visitor to another similarly named site “www.hillproaudio.co.uk” which offers products for sale in competition with the Complainant's licensees. The Domain Name in the hands of the Respondent is thus an intentional instrument of harm to the Complainant's licensees' business, in which the Complainant holds a share. The Complainant's Exhibit 10 is a screenshot of the Respondent's website showing the following content:

“Sadly, in 1992, at a time of general economic recession and extreme price competition from Far East manufacturers, Hill Audio Ltd went into administration. The business assets were purchased from the administrator by Millbank, a subsidiary of Atapco. Following an action in the High Court, a Supreme Court order determined that ownership of the Hill Audio name, style and designs remained with Malcolm Hill Associates, the licensor.

Although most Hill Audio production was wound down at this time, Malcolm Hill Associates continued (as Malcolm Hill

Audio) with the manufacture of the Hill Chameleon, and then to gradually introduce new Hill designs.
New generation Hill designs are manufactured by Hill Pro Audio Ltd., York, UK, under license from Malcolm Hill Associates: www.hillproaudio.co.uk.
malcolmhill@hillaudio.co.uk”

The Complainant seeks transfer to him of the Domain Name.

Respondent (summary)

The 'Hill Audio' name is, and has been for some 40 years, recognised by the international music and professional audio industries as identifying products created by the Respondent, who owns all rights in the name 'Hill Audio' and has not authorised the sale of products bearing the name 'Hill Audio' by the Complainant or his agents.

The Complainant has no lawful interest in that name and is an impostor.

Malcolm Hill Associates is a business partnership owned by the Respondent and Philippa Hill, his wife. The Domain Name is primarily intended as the official tribute to the (almost) 50-year story of Hill. A secondary intention is to direct those people interested in 'Hill' products to the current licensee, Hill Pro Audio Ltd, which manufactures and supplies 'Hill' products through trade distributors. The UK distributor since 2003 is Rock-tech Projects Ltd.

'Hill' is a UK brand of professional audio products, created by the Respondent, a pioneer audio engineer, in the early 1970s. The Respondent created the 'Hill Audio' trade name in 1980. By the mid-1980s 'Hill' and 'Hill Audio' were firmly established, enjoying a significant international reputation within the music and professional audio industries.

The Wikipedia entry for the Respondent (Exhibit MH-01) says:

“Malcolm Hill is a speaker designer. He has focused on public address systems used at large-scale events. Since the early 1970s, Hill's design philosophy has been the "Faithful Reproduction of the Original Sound". Throughout the '80s and '90s, Hill Speaker Systems were used by many international touring artists. They found use in theatres, arenas, and stadiums around the world, to include Wembley Stadium and Madison Square Garden. In the mid-'90s, under the banner "faith comes through hearing", Hill designed the PowerCube, a compact self-powered speaker...”

There are thousands of 'Hill' products in use around the world, showing that the 'Hill Audio' name is recognised around the world as identifying the Respondent's products. The Respondent has owned all rights in 'Hill' and 'Hill Audio' continuously from creation to the present day. These rights are protected as well-known names and trade names under the WIPO Paris Convention Art 6bis and Art 8.

In 1994 the right of the Respondent to prohibit the use of the name 'Hill Audio' by Atapco was tested in the High Court and settled by Court Order in favour of the Respondent.

The Respondent is a victim of bad faith trademark filings and has sought to remedy the vulnerability of his non-registered marks by registering the mark



(audio; class 9) on August 24, 2018, UK No.3305398, and applying on August 28, 2018 to register the mark



(audio; class 9), UK No.3334440. The Complainant has filed an opposition to that application.

The core of this dispute is reputation. The Complainant has assumed the 'Hill Audio' identity and appropriated the 'Hill' reputation. On July 2, 2007, some 8 months prior to applying to register the Mark, the Complainant, as VP of Engineering of Adelto Ltd, sent an e-mail to the Respondent's son, stating *inter alia*:

“...the Hill Audio brand, operated by your father, enjoyed an excellent reputation in the pro audio field before it ceased business... We would hence like to discuss the possibilities of collaboration in terms of acquiring the brand rights of Hill Audio, which are presumably owned by your father...” (Exhibit MH-32).

In further correspondence with the Respondent, the Complainant explored "the benefits of using the 'Hill' name" and stated he was considering 'Hill' as "the option of choice" (Exhibit MH-33). The Respondent had no further contact with the Complainant until April 2018, when, alerted by a customer, the Respondent discovered that, whilst seemingly engaged in the amicable correspondence mentioned above, the Complainant had in fact assumed the 'Hill Audio' identity by registering the domain name hill-audio.com and preparing to apply to register the Mark, all without the Respondent's knowledge or permission.

There can be no doubt that the Complainant knew the 'Hill Audio' name had been established for many years prior to his applications for domain name and trademark registration, and that the Respondent owned all rights in the name. The intention of the Complainant was to 'free ride' on the Respondent 's reputation, including by

falsely describing the Complainant's products as "true descendants of the original" (Exhibit MH-41).

When visited in May 2018, the Complainant's website at <www.hill-audio.com> contained multiple images of original 'Hill' products and brochures, reproduced without permission. By adopting these tactics, the Complainant's use of hill-audio.com imputes a lawful connection with the Respondent, the genuine owner of 'Hill', which is not true.

The Complainant's European and United States registrations of the Mark have no effect as they are liable to be declared invalid on the grounds of 'bad faith' and on the grounds of the 'earlier right' owned by the Respondent. It follows that all claims to rights associated with the Complainant's registered trademarks must fail.

There is no infringement, as such an action would be an unlawful prejudice of the Respondent's prior rights of some 30 years.

The Complainant's use of hill-audio.com is likely to confuse internet users, and to impute a lawful connection with the Respondent. The sub-heading "beware counterfeits" at the top of the Respondent's homepage is a fair warning to persons interested in 'Hill Audio' products that there are counterfeit products being offered for sale in the market. The website carries a link to the Respondent's licensee Hill Pro Audio Ltd for those interested in current 'Hill' products.

The Respondent has never used the email address malcolmhill@hillaudio.co.uk to contact the general public. All addressees have been persons known to be interested in Hill Audio. Emails sent from this address concerning the dispute with the Complainant were sent before the Complainant removed offending content from his website, and therefore have been permitted communications.

The email address is in the Respondent's own name. All statements have been true and supportable, and as such there can be no defamation or deception by the Respondent. The purpose of all related emails is to support and protect the 'Hill' and 'Hill Audio' reputation, which by necessity involves drawing attention to the 'bad faith filing' and deception perpetrated by the Complainant.

The hillaudio.co.uk and hillproaudio.co.uk sites do not offer 'Hill' products for sale to the public; all sales are via trade distributors. 'Hill' products are only supplied to the professional market and are priced accordingly. The Respondent regards the suggestion of sales competition as extremely unlikely.

However, the Complainant's assumption of the 'Hill Audio' identity and deceptive use of hill-audio.com has introduced confusion in the market, which is potentially harmful to the Respondent's reputation.

The Respondent requests that all domains held by the Complainant using the name 'Hill Audio' be transferred to the Respondent.

Complainant's Reply

The Complainant's trade mark registrations are valid and unchallenged. The Respondent does not own 'all rights' in the name HILL AUDIO. The Complainant has commercially used the 'Hill Audio' trade mark without interruption since 2008.

The Respondent tries to create the impression of owning rights in the Complainant's registered trademark 'Hill Audio' by quoting historic events, incidents and circumstances. The Respondent refers to product designs sold commercially under similar trade names prior to 1992 but fails to provide proof of his involvement. He refers to Hill Audio Limited and Atapco Security and Communications Limited trading under similar names prior to 1994 but fails to provide proof of being a participating member (which he was not), and he exhibits testimonials of people with whom he became acquainted in the 1970s/1980s who do not represent the current purchasing public. In summary, all statements and Exhibits of the Response with relevance to the use of similar trade names refer to a period prior to 1994. The existence and current 2nd hand trading of products using similar trade names, but made prior to 1992, still allocates such products to a period of commercial use of trade naming prior to 1992.

When the Complainant applied for registration of the Mark on February 24, 2008, and when the Mark was registered on April 2, 2009, neither the Respondent nor any other 3rd party owned rights in the 'Hill Audio' trade mark by registration, and any rights that anyone could have potentially claimed by use of a similar trade name had to be regarded as having ceased if no such use took place in the 5 years prior to the Complainant's registration of the Mark. No objections were raised during the registration process.

Any events, incidents, circumstances and products commercially sold as new under a similar trade name prior to February 24, 2003 are hence irrelevant to the current ownership of the Mark. This renders the majority of the Respondent's statements and Exhibits, which all date back to 1994 or earlier, irrelevant to this domain name dispute. The reference to and reliance upon the WIPO convention is equally misplaced.

The order of the English High Court in the action between Atapco Security and Communications Limited and the Respondent, only the facing page of which has been produced, is a consent order setting out terms of a settlement reached between the parties and is not an adjudication or ruling by the Court. Furthermore, it is dated 1994, 15 years prior to the date of the Complainant's EU registration of the Mark.

In 2007 the Complainant contacted the Respondent to enquire about acquiring any rights remaining in the Hill Audio trade name. It was established that no trading use had been made of the name since the demise of the company Hill Audio Limited in 1992, in which the Respondent was not a participating member. The name had not been registered as a trademark. At a meeting between the Complainant and the Respondent on 10 July 2007 it became clear that the Respondent did not own any

rights in the trade name, registered or unregistered. Any goodwill that Hill Audio Limited might have enjoyed had evaporated through the long period of non-use, and in any event was not owned by the Respondent.

Calling the Complainant's registration of the Mark a case of registration in bad faith is a statement of malicious falsehood. The applications followed a process of due diligence. No application/proceedings have been brought by the Respondent for cancellation of the Complainant's registered trademark. More than 5 years have passed since registration of the Mark by the Complainant. The applications for registration were not made in bad faith.

The Respondent admits that he registered the Domain Name in full awareness of the Complainant's registered trade mark rights, intentionally disregarded these rights and hence purposely infringed on the Complainant's registered trade mark rights. He further admits to having used the Domain Name for publication of untrue statements about the trade mark ownership. He even further admits having used the Domain Name for publication of emails containing libels and malicious falsehoods to the general public and fails to prove that any such addressee would have had a legitimate interest in receiving such emails. The abuse of the Domain Name is hence evident by the Respondent's own admission.

The Respondent's Exhibit MH-43 shows that a UK company, Hill Event Technology, was registered on March 13, 2014 and was renamed Hill Pro Audio Limited on January 14, 2015. This company is partly owned by the Respondent and might represent a potential further infringement of the Complainant's registered trade mark rights. It is a self-serving document of no relevance or value to this procedure.

The Respondent's Exhibit MH-21 issued by a UK company, Rock-Tech Projects Ltd, uses the term 'Hill Audio' without permission of the Complainant and falsely declares products made and sold under different trade names as 'Hill Audio' products. The document is generated by a business associate of the Respondent and as such is a self-serving document of no relevance or value to this procedure.

The Respondent's Wikipedia page is a self-serving document of no relevance or value to this procedure. The authors are colleagues or associates of the Respondent, and the entry has been several times edited by Wikipedia editors for reasons such as 'remove promo, remove non-noteworthy and unreliably sourced or unsourced, copy edits' and 'remove unsourced and useless list'.

The Complainant's lawyers have issued to the Respondent a formal letter before action pursuant to the pre-action protocol for defamation dealing with the published libels and malicious falsehoods of the Respondent, which are repeated in the Response. This is not the appropriate forum to deal with such matters.

The Complainant filed a Notice of Opposition to the Respondent's UK trademark application No. 3334440 because it infringes on the Complainant's registered trade mark rights, as does the registration of the Domain Name. However, these are two

different cases and the opposition proceeding is not directed towards the Domain Name, hence the Notice of Opposition (Complainant's Reply Exhibit EX-14) was not included in the original Complaint.

6. Discussions and Findings

To obtain an order for the transfer of the Domain Name, the Complainant needs to prove, on the balance of probabilities, that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration (DRS Policy, Paragraph 2).

As to Rights, despite the Respondent's assertions that the Complainant's EU and US registrations of the Mark are liable to be declared invalid, their current registered status suffices to establish that the Complainant has rights in the Mark for the purposes of this proceeding.

But for the inconsequential ccTLD suffixes in the Domain Name, "co.uk", which may be disregarded, I find that the Complainant's Mark



is similar to the Respondent's Domain Name < hillaudio.co.uk >. The Complainant has established this element.

Abusive Registration is defined in DRS Policy, Paragraph 1 as a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights;
- or
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

DRS Policy, Paragraph 5.1 sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration, including:

5.1.1.3: Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant; and

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

DRS Policy, Paragraph 8.1 sets out a non-exhaustive list of factors which, if established by the Respondent, may be evidence that the Domain Name is not an Abusive Registration, including:

8.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or

8.1.1.3 made legitimate non-commercial or fair use of the Domain Name.

Both parties claim exclusive rights in the Hill Audio name, the Complainant since 2009, the Respondent since 1980. In support of their contentions, more than 70 Exhibits have been submitted, including trademark registration certificates, certificates of incorporation, testimonials, advertisements, editorials, legislative provisions, photos of equipment and screenshots from websites associated with the parties.

Although only the facing page of the consent order of the English High Court in the action brought by Atapco against the Respondent and Malcolm Hill Associates has been produced (Exhibit MH-29), it shows that Atapco, the parent of Millbank, which acquired the assets of Hill Audio Ltd when that company went into administration, agreed in 1994 to abandon all use of the Hill Audio name in favour of the Respondent and Malcolm Hill Associates. Hence it is clear that the Respondent's rights in the Hill Audio name survived the demise of Hill Audio Ltd.

Examples of evidence supporting the Respondent's contentions are testimonials that the Hill Audio brand has been and remains presently well-known (Exhibits MH-05 and MH-09) and an email from Hill Pro Audio stating that it has manufactured Hill products under licence from the Respondent since 2015 (Exhibit MH-43). This was 3 years before the Respondent says he became aware that the Complainant had registered the Mark.

The Complainant acknowledges that the Respondent once had rights in the Hill Audio name but claims they had ceased more than 5 years before the Complainant registered the EU Mark. The Respondent claims he has always had such rights; that the Complainant registered the Mark in bad faith and, in effect, has been masquerading as the Respondent. Given these conflicting assertions, which are likely to be raised in the opposition proceedings concerning the Respondent's UK application to register the mark



and in the foreshadowed defamation proceedings over the Respondent's website and emailed statements, the Expert is unable to find, on all the evidence presented

by the parties, that the Complainant has discharged his burden of proof, on the balance of probabilities, that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The most significant factor leading the Expert to this outcome concerns the events of July 2007, some 8 months before the Complainant applied in the EU to register the Mark. The Complainant concedes that he contacted the Respondent to enquire about acquiring any rights remaining in the Hill Audio trade name. The Complainant's initial approach was by email on July 2, 2007 (Exhibit MH-32). According to the Complainant, he registered the domain name hill-audio.com on July 3, 2007 and met the Respondent on July 10, 2007. The Complainant asserts that it was established that no trading use had been made of the name since the demise of the company Hill Audio Limited in 1992 and that, at the meeting, it became clear that the Respondent did not own any rights in the trade name and that any goodwill that Hill Audio Limited might have enjoyed had evaporated through the long period of non-use, and in any event was not owned by the Respondent.

As to the Complainant's assertion that it became clear that any rights of the Respondent had evaporated, the Respondent exhibits an email dated July 12, 2007 (Exhibit MH-33) in which the Complainant stated:

"I am happy to hear that you share the vision of great opportunities in reviving the Hill Audio brand. Tweaking the name a bit is a possibility, as long as we can refer to the Hill Audio legacy. I am however happy that we can move forward on this, so that it is time to quantify the benefits of using the Hill name, which will allow me to present the concept to my other partners. For that purpose, you may be able to help me with some brief answers to the below questions:" [These are not copied in the Exhibit].

In the Expert's view, the word "revive" in this context could mean "bring back from the dead", so is capable of being interpreted as recognition by both parties that the Hill Audio brand had by then ceased to exist. However, the word could also mean in this context "restore interest in", so is capable of being interpreted as recognition by the Complainant that the brand had not ceased to exist but that there could be benefits from renewing interest in it.

The Complainant does not deny the Respondent's assertion that there were no further discussions between the parties following the events of early July, 2007. On one view of those events, the Respondent acknowledged that his rights had ceased to exist and agreed that the Complainant was free to use the name Hill Audio. On another view, the Complainant acknowledged by his email of July 12, 2007 that the Respondent's rights continued to exist; expressed a wish to collaborate with the Respondent but proceeded a few months later unilaterally to apply for and to register the Mark without the Respondent's consent, having registered the domain name hill-audio.com before communicating with the Respondent.

Taking the evidence as a whole, the Expert is not persuaded, on the balance of probabilities, that the Respondent has at any time lost his rights in the Hill Audio name nor that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Rather, the Expert accepts that, for many years before being aware of the Complainant's cause for complaint, the Respondent has been legitimately connected with the Hill Audio mark, which is identical to the Domain Name. Under DRS Policy, Paragraph 8.1 these factors may be evidence that the Domain Name is not an Abusive Registration and the Expert so finds.

Accordingly, the Complainant has not established Abusive Registration.

The remaining issues between the parties are more appropriately addressed through defamation proceedings and trademark cancellation, opposition and infringement proceedings.

The Respondent seeks transfer to him of the Complainant's domain names. This is a remedy that is not available in these proceedings, which relate only to the Respondent's Domain Name.

If the Complainant did register the Mark in bad faith, a finding of Reverse Domain Name Hijacking would be appropriate in these proceedings. However, the Mark remains on the register and has not been formally challenged by the Respondent so any finding of bad faith registration of the Mark is a matter for a court to decide. Under these circumstances the Expert makes no finding of Reverse Domain Name Hijacking.

7. Decision

The Complaint is denied.

Signed

Dated: December 13, 2018