

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATIONS No 2051141A & No 2051141B  
TO REGISTER TRADE MARKS  
IN THE NAME OF DALJEEV SINGH DHILLON AND SUKHVINDER  
KAUR DHILLON  
IN CLASSES 29, 30 & 42

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER No 46112 & 46113  
BY HARKIRAT SINGH DHILLON

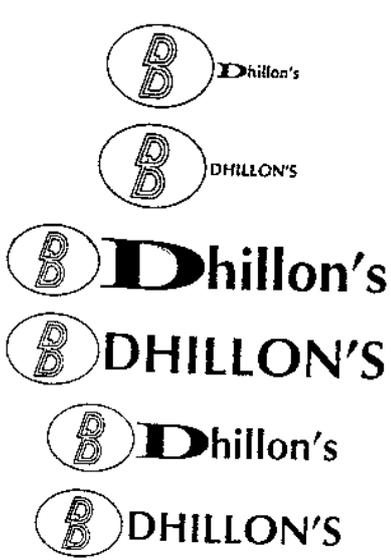
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATIONS No 2051141A & No20541141B  
 by DALJEEV SINGH DHILLON AND SUKHVINDER KAUR DHILLON  
 TO REGISTER TRADE MARKS IN CLASSES 29,30 & 42

AND IN THE MATTER OF OPPOSITION THERETO  
 UNDER NUMBER 46112 & 46113  
 by HARKIRAT SINGH DHILLON

**DECISION**

On 13 January 1996, Daljeev Singh Dhillon & Sukhvinder Kaur Dhillon of 4 Bryson Street, Falkirk, FK2 7BT, Scotland, applied under the Trade Marks Act 1994 to registration the following Trade Marks:

Application number	Marks	Class	Specification	Opposition number
2051141A		29	Meat, fish, poultry and game, seafoods, fruits, vegetables, fungi and nuts, all being dried, cooked, canned, pickled, preserved, peeled or frozen; prepared meals and food preparations; edible oils and edible fats; dairy products, jellies and egg products; food dressings; jams, preserves; marmalades; eggs; soups; fruit juices and vegetable juices; salads; snacks; potato chips and crisps; prepared foods made from any combination of the above goods	46112
		30	Coffee, tea, cocoa, sugar, rice, artificial coffee; flour and preparations made from cereals; bread; pastry and confectionery; pizzas, burgers, sandwiches, salad dressings, sauces, condiments, spices, curry; chocolate, coffee and tea-based beverages; biscuits, cakes; prepared meals and snacks made from any combination of the above goods.	
		42	Restaurant and cafe services; provision of food and drink; catering services	

2051141B	<p style="text-align: center;"><b>Dhillon's</b> <b>DHILLON'S</b> <b>DHILLON'S</b></p>	29	Meat, fish, poultry and game, seafoods, fruits, vegetables, fungi and nuts, all being dried, cooked, canned, pickled, preserved, peeled or frozen; prepared meals and food preparations; edible oils and edible fats; dairy products, jellies and egg products; food dressings; jams, preserves; marmalades; eggs; soups; fruit juices and vegetable juices; salads; snacks; potato chips and crisps; prepared foods made from any combination of the above goods	46113
30		Coffee, tea, cocoa, sugar, rice, artificial coffee; flour and preparations made from cereals; bread; pastry and confectionery; pizzas, burgers, sandwiches, salad dressings, sauces, condiments, spices, curry; chocolate, coffee and tea-based beverages; biscuits, cakes; prepared meals and snacks made from any combination of the above goods.		
42		Restaurant and cafe services; provision of food and drink; catering services		

5 On the 18 December 1996 Harkirat Singh Dhillon of Portdownie, Camelon, FK1 4QZ filed notice of opposition to each of the applications under the opposition numbers given above, subsequently consolidated. The grounds of opposition are in summary:

10 i) Dhillon is a common surname in the UK, and the fact that Dhillon is a phonetic equivalent of Dillon which is also a common surname in the UK, the marks are not capable of distinguishing the goods of the applications from the goods of others trading under the name Dhillon, and that the applications should be refused under the terms of Section 3(1)(a) of the Trade Marks Act 1994.

15 ii) The marks applied for are devoid of any distinctive character and the applications should be refused under Section 3(1)(b) of the Trade Marks Act 1994.

20 The applicants filed a counterstatement denying all the grounds of opposition. Both sides asked for costs. Both sides filed evidence in these proceedings, and the matter came to be heard on 27 July 2000 when the applicants were represented by Ms McFarland of Counsel instructed by Messrs Fitzpatricks, whilst the opponent was represented Mr Speck of Counsel instructed by Messrs RGC Jenkins & Co.

Evidence was filed by both parties in each of the opposition cases prior to their consolidation. However, the evidence was identical apart from minor variations in the vocabulary. The evidence summary is written as though only one set of evidence was filed.

## OPPONENT'S EVIDENCE

This takes the form of two statutory declarations. The first, dated 1 July 1997, is by Mr Robert Lionel Cook an independent consultant offering legal and commercial services. Mr Cook states  
5 that he was instructed by the opponent's agents to research the number of entries in various UK telephone directories for the surnames' Dhillon and Dillon.

Mr Cook states:

10 "Our survey showed that there were well over two thousand listings for the name Dillon and over three-hundred and fifty entries for the name Dhillon. The origin of these figures was a print-out from a British Telecom computer disk (1996 edition) storing the information contained in all their telephone directories. The list does not include 'ex-  
15 directory' numbers and listings in the Hull area - which has its own telephone system and directory."

At exhibit RLC1 Mr Cook provides the computer print out referred to, together with photocopies of extracts from several BT telephone directories. No analysis of these extracts is provided. It is assumed that they cover all the personal and business entries for Dhillon and Dillon in the UK  
20 (except for Hull).

The second statutory declaration, dated 5 November 1997, is by Harkirat Singh Dhillon, also known as Harry Dhillon. Mr Dhillon provides a potted history of the partnership that used to exist between him, his wife and the two applicants and to an agreement regarding the termination  
25 of the partnership but these matters are not germane to these proceedings, apart from the claim that the trading name DHILLON & DHILLON was used from 1985 whilst the partnership with the applicants was from 1990 - 1995 inclusive. I note however that Mr Dhillon believes that he has built up goodwill in the name Dhillon.

30 In support of the grounds of opposition, Mr Dhillon states:

35 "Objections to applications Nos. 2052241A and 2051141B have come from many areas of the United Kingdom. Dhillon is a common Asian surname and many business men and women throughout the United Kingdom, and the world, have used this name under which to trade. One man does not and should not have the exclusive and sole right to the ownership of this name. It is unfortunate that the journal in which applications Nos 2051141A and 2051141B were advertised for opposition, that is the Trade Marks Journal, is not widely read or popular with small businesses in the Asian community in the United Kingdom, which businesses are using the name Dhillon, and therefore not all  
40 individuals have had an opportunity to object to the said applications. Furthermore, not many of the small Asian business owners in the United Kingdom speak or read good English. Accordingly, the owners of these small businesses were not aware of the said applications or that the registrations of these applications might jeopardise their businesses."

45 Mr Dhillon claims that since the dissolution of the partnership he has "continued to trade under the name "Four In One" and I also use the name "Harry Dhillon's Four In One" or "Dhillon's

Four In One”. The name “Harry Dhillon” has been associated with “Four In One” since the name “Four In One” was first used in 1985 for the chain of hot food take-away restaurants operated by myself and my wife.”

5 At exhibit HSD4 Mr Dhillon produces photographs of take away food restaurant fronts and interiors which have the name “Harry Dhillon’s H-D” as well as the name, in larger print, FOUR IN ONE, and in one instance TWO IN ONE. There is also a picture of a shop in Camelon, Falkirk which has name HARRY DHILLONS solus. The location of each of the shops is provided and also the date when the shop began operations. However, it is not clear when the photographs were taken and whether there had been any change to the facias and interior signs since the shops opened.

15 Mr Dhillon produces at exhibit HSD5 a copy of a notice which he says was published in “Des Pardes Weekly” on 12 September 1997, and also two letters received in response. Exhibit HSD5 actually consists of a photocopy of a notice in what appears to be Sanskrit, although beneath the telephone number appearing in the notice is “DHILLON’S SURNAME PROTECTION COMMITTEE”. One of the two letters received in response is a general objection to the application from Joga Singh Dhillon. The other letter is from a D. S. Dhillon who says he trades as “Dhillon’s Food & News”. This appears to be the name of a retail store. The letter is dated 6 September 1997. Both letters are clearly in reply to the applicant’s notice.

#### APPLICANTS’ EVIDENCE

25 This consists of three statutory declarations. The first, dated 29 January 1998, is by Daljeev Singh Dhillon, also known as Tony Dhillon. Mr Dhillon also provides details relating to the defunct partnership and also provides opinions regarding the claims to confusibility. However, none of these issues are germane to the grounds of opposition.

30 In response to the statements regarding the commonality of the surname Dhillon, Mr Dhillon states:

35 “I reject the opponent’s claim that the surname ‘Dhillon’ is common. I am advised by our trade mark attorneys that, for trade mark registration purposes, a surname is considered common if it occurs more than 100 times in the London Telephone Directory or if it is the phonetic equivalent of a surname occurring more than 200 times in the London Telephone Directory. I have had checks made of the Greater London Telephone Directory and the telephone directories for Glasgow, Edinburgh, the Falkirk area, Dundee and Aberdeen in Scotland and none of these directories contains entries for the surname ‘Dhillon’ or similar sounding surnames in excess of the limits referred to above.”

At exhibit DSD6 Mr Dhillon provides copies from the directories named.

45 Mr Daljeev Singh Dhillon’s second statutory declaration is dated 29 January 1998. Mr Dhillon refers to the previous partnership with his brother, his brother’s wife, himself and his wife and in particular to the dissolution document. However, this does not relate to the grounds of opposition and so is not germane to the issues in suit.

The third statutory declaration, dated 4 February 1998, is by Paul Stephen Edghill a commercial investigator who works for PSE Consulting International. Mr Edghill states that he was instructed by the applicants' trade mark agents to "research available United Kingdom telephone subscriber listings for the surnames' Dhillon, Dhilon, Dhilhon, Dillan and Dillon."

5

Mr Edghill claims that he analysed the 1997 edition of the British Telecom Phone Disc and ascertained the following:

Surname	number of UK entries	Comments
DHILLON	364	
DHILON	1	
DILLAN	6	
DHILHON	24	
DILLON	2433	48 Listings of Dillons Convenience Stores Ltd, 234 listings of Dillons Newsagents Group and 64 listings of Dillons Book Stores Plc.

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At exhibit PSE1 Mr Edghill provides copies of the Phone Disc printouts. He then provides a geographical breakdown from which I have extracted the following:

Area	Dhillon	Dhilon	Dillan	Dhilhon	Dillon	Total
Greater London	89	1	2	0	193	
Manchester	6	0	1	0	146	
Liverpool		0	0	0	98	
N Ireland	0	0	0	0	162	
Birmingham & West Midlands	72	0	0	23	84	
Glasgow	24	0	0	0	155	
Edinburgh		0	0	0	34	
Other areas in Scotland		0	0	0	124	

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That concludes my review of the evidence. I now turn to the decision.

## DECISION

At the hearing the opponent withdrew the opposition to application number 2051141A, and also withdrew the grounds of opposition under Section 3(1)(a) with regard to application number  
5 2051141B.

The relevant statutory provisions are Sections 1(1) & 3(1) of the Trade Marks Act 1994, which are as follows:

10 *1 (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.*

15 *A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.*

*3). 1 The following shall not be registered -*

20 *(b) trade marks which are devoid of any distinctive character,*

25 *(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

*(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.*

30 *Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

35 I begin by considering the law. Unlike the previous Act of 1938, which contained specific exclusions from registration of personal names and surnames in Section 9(1) of the Act, the current Act contains no such exclusion. Indeed “personal names” are specifically listed as examples of the signs that may constitute a trade mark under Section 1(1).

40 The current Act has completely different origins to the previous law. It is intended to implement a European Directive No 104/89, the stated purpose of which is to approximate the trade mark laws of Member States in order to remove barriers to a single market. A significant number of Member States, including major trading nations such as Germany, France and Italy have long regarded personal names, including surnames, as inherently distinctive and therefore registrable  
45 without evidence of acquired distinctiveness through use. The Community Trade Mark Office adopts a similar practice under the identical legislation contained in Article 7(1) of Council Regulation 40/94.

The opponent's objection is that the mark consists of the surname "Dhillon", and is too similar to another surname "Dillon". Personal names and surnames are not included in the list of signs excluded from registration under Section 3(1)(c) of the Act on the grounds that they may serve, in trade, to designate characteristics of goods/services and must, therefore, be kept free for use  
5 by other traders on public policy grounds. As the European Court of First Instance (second chamber) explained in paragraph 23 of its decision in the BABY DRY trade mark case (1999 ETMR 767), the signs excluded under Section 3(1)(c) are deemed by the legislature to be incapable of distinguishing.

10 The question under Section 3(1)(b) is whether the mark is devoid of any distinctive character. In *British Sugar Plc v James Robertson and Sons Limited (TREAT)* 1996 RPC 281, Mr Justice Jacob said -

15 "What does *devoid of any distinctive* character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat"  
20 is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character."

This appears to suggest that Section 3(1)(b) is intended to exclude those marks that are unpossessed of the distinctive character necessary perform the essential function of a trade mark.  
25 Accordingly, if a personal name or surname has sufficient distinctive character to distinguish the goods of one undertaking it is not excluded from registration on the grounds that personal names and surnames should be kept free for use as, or as part of, trade marks on grounds of public policy.

30 Mr Speck referred me to the case of *Shredded Wheat (1938)* 55 RPC 125 in the House of Lords where Lord Russell said:

35 "A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else."

This quotation follows the approach set out by Lord Parker in the case of *W and G du Cros (1913)* 30 RPC 660 at 672. The following remarks of Lord Parker subsequently came to be accepted as the classic test of distinctiveness under the previous trade mark acts:

40 "The applicant's chance of success in this respect must, I think, largely depend on whether other traders are likely, in the ordinary course of their business and without improper motive, to desire to use the same mark, or some other mark nearly resembling it, upon or in connection with their own goods."

45 This test was later described as a test of "distinctiveness in law" (see *York Trailers* 1984 RPC 231).

In Procter and Gamble's Application 1999 RPC 673, Robert Walker L.J. noted the different origins of the new law and said:

5 "I would accept that Lord Parker's observations about distinctiveness must since the 1994 Act be treated with considerable caution, especially so far as they concern distinctiveness in law."

I also take account of the comments of the Appointed Person, Mr Geoffrey Hobbs, Q.C. in the MR LONG case [1998] RPC 401 at page 405, where he said:

10 "The conditions which a sign must satisfy in order to be registrable under the 1994 Act are drawn from Council Directive 89/104 of December 21, 1988. Section 1(1) of the Act (implementing Article 2 of the Directive) confirms that personal names are eligible to be regarded as signs capable of registration. Different persons having the same name nevertheless share the right to use it in accordance with honest practices in industrial or commercial matters under section 11(2)(a) of the Act (which gives effect to Article 6(1)(a) of the Directive). And section 3(1)(b) of the Act (which implements Article 3(1)(b) of the Directive) prohibits the registration of trade marks which are devoid of any distinctive character. These provisions indicate to my mind that surnames are neither automatically eligible nor automatically ineligible for registration under the Act. In each case the question to be determined is whether the surname put forward for registration possesses the qualities identified in section 1(1) of the Act and none of the defects identified in section 3. For the reasons I gave at greater length in *AD2000* trade mark [1997] RPC 167 I think that in order to be registrable a surname or any other sign must possess the capacity to communicate the fact that the goods or services with reference to which it is to be used recurrently by the applicant are those of one and the same undertaking. When assessing whether a surname possessed that capacity at the relevant date (the date of the application) it is, of course, necessary to bear in mind that surnames, as such, are naturally adapted to identify all individuals so named."

30 I intend to follow this approach. Since that case, the Court of Appeal has indicated that, in assessing the capacity of a mark to distinguish, it is appropriate to gauge the matter by reference to the likely reaction of the average consumer of the relevant goods and services (see *Bach Flower Remedies* 2000 RPC 13). The average consumer is deemed to be reasonably observant and circumspect.

40 In judging the capacity of a mark, which is also a surname, to distinguish the goods or services of one undertaking it is necessary to consider the factors that will influence the average consumer's perception of the mark as a sign that identifies the goods and services of one or many undertaking(s). Prominent amongst these factors will be:

- a) the commonness of the surname, and
- b) whether the trade in the goods and services is one in which a very large number of traders are engaged, or whether it is a trade in which relatively fewer traders are involved.

45 The combined effect of these factors will usually determine whether the average consumer is likely to expect all the goods/services offered under the mark to be commercialised by, or under the

control of, a single undertaking, or whether the average consumer would instead believe that a number of undertakings are coincidentally trading under the same name.

5 The Registrar considers “trade” in this context to include the placing of goods on the market under a mark and providing services under a mark. As Jacob J. recently observed in the case of Euromarket Designs Incorporated v Peters and Another (25 July 2000):

10 “.....if you buy Kodak Film in Boots and it is put into a bag labelled “Boots” , only a trade mark lawyer might say that Boots is being used as a trade mark for film.”

15 The common use of surnames merely as names of retail outlets for goods is not, therefore, likely to influence the average consumer when he or she comes to weigh up the likelihood of more than one business using the same personal name or surname as a trade mark for their goods.

20 The mark in suit, 2051141B consists of a series of three marks all of which are the surname **Dhillon’s**. It was claimed by Ms McFarland that the mark was stylised, and that the opponent’s advisers had referred to it in this manner. However, I do not consider the use of a “D” which is of a different font and is thicker than the rest of the word sufficient, in this instance, to constitute stylisation. I regard the series of marks as consisting of the one word “Dhillon’s” in upper and lowercase.

25 Regarding the commonness of the name DHILLON, I note that the opponent claims that there were “over three hundred and fifty entries” in the 1996 British Telecom directory. Some of these would have been business names. The same business can have more than one entry in the telephone directory. Even without this, 350 listings of a surname in the whole of the UK does not suggest that the name is common in this country.

30 The Trade Marks Registry’s practice at the relevant date was that a surname was regarded as uncommon if there less than one hundred entries in the London telephone directory. The opponent has not contested the claim by the applicants that in 1997 there were only 89 entries for the name “Dhillon” for the Greater London area. The Registrar uses the Greater London Area because it is thought to be representative of the commonness of surnames throughout the UK. I note that, although it is uncommon even in London, the name “Dhillon” appears proportionally more common in London than in the UK generally.

35 The opponent contended that the mark in suit is phonetically identical to the surname DILLON which, according to the applicants’ own evidence, would be regarded by the Registry as a common surname. It was also claimed that there would be visual confusion with the surname DILLON. No evidence has been provided as to the pronunciation of the mark in suit. The opponent claimed it would be pronounced DILL - LON, however, in my view it could equally be pronounced DIE - LON.

40 The Registry practice on phonetic equivalents is quite clear. Where the mark applied for is merely the phonetic equivalent of a common surname (e.g. Dugglass) it may be accepted unless it is a recognised alternative spelling of the common surname. The opponent did not contend that the mark in suit was a recognised alternative spelling of the surname DILLON, and even if they had I would have rejected such a notion.

5 The reason for this practice can be found in BULER trade mark 1966 RPC 141. Essentially it is because, unlike many other types of words, the public is used to distinguishing between similar surnames on the basis of small differences in spelling or pronunciation. This has implications for the scope of protection. If the reason that “Dhillon” has distinctive character is that, unlike “Dillon”, it is not a common surname, it follows that use of “Dillon” should not be taken as capturing the distinctive character of “Dhillon.”

10 Further, the registration of “Dhillon” should not prevent other traders with that name using their names in accordance with honest commercial practices, even in respect of the goods and services for which the mark is to be registered. Section 11(2)(a) of the Act provides a defence in this respect. However, it has been held on numerous occasions that this not a reason to register a non-distinctive mark and I do not rely upon the defences available under Section 11 in reaching my decision.

15 The application covers the provision of various foodstuffs under Classes 29 & 30 and also the provision of restaurant and cafe services, food and drink and catering services under Class 42. Even leaving aside mere retailers of food and drink, there are a large number of undertakings engaged in the trade in the goods and services covered by the application and from whom such goods/services can be said to originate.

20 There is no evidence of other traders providing relevant goods under the name “Dhillon” at the relevant date. The only evidence of another trader providing services under the name “Dhillon” prior to the date of the application is the opponent’s evidence of its own trade. The applicants’ trade appears to have common roots. Taken by itself that would not be sufficient reason to refuse the application on absolute grounds. There are no relative grounds of opposition. And given the uncommonness of the surname DHILLON in this country it is my opinion that, prima facie, the average consumer would expect the goods and services specified in the application, to be commercialised under the control of a single undertaking if they were placed on the market under the mark “Dhillon.” The ground of opposition under Section 3(1)(b) therefore fails.

30 The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponent to pay the applicants the sum of £1270. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

35 Dated this 26 day of October 2000

40  
45 George W Salthouse  
For the Registrar  
The Comptroller General