

**O/0131/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3549988  
IN THE NAME OF ALCOHOL RESEARCH UK FOR THE MARK**

**DRY JANUARY**

**IN CLASSES 6, 9, 14, 18, 21, 28, 29, 30, 32, 35 AND 43**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 431445 BY  
BIG DROP BREWING COMPANY LIMITED**

## Background and pleadings

1. On 29 October 2020, Alcohol Research UK (“the applicant”) applied for the trade mark DRY JANUARY (application 3549988) for goods and services in classes 6, 9, 14, 18, 21, 28, 29, 30, 32, 35 and 43. Following publication, the application was partially opposed by Big Drop Brewing Company Limited (“the opponent”) in respect of the following goods and services:

Class 30: *coffee, tea, cocoa.*

Class 32: *Non-alcoholic drinks; water.*

Class 35: *Advertising, promotional activities, and marketing services in relation to the sale of beverages; retail services relating to the sale of food and beverages; provision of information, consultancy and advice relating to the aforesaid.*

Class 43: *Services for the provision of food and drink; restaurants, cafes, coffee shops, bars; hotel services; provision of information, consultancy and advice relating to the aforesaid.*

2. The grounds of opposition are that the application offends sections 3(1)(a), (b), (c) and (d), section 3(6) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In summary:

- Section 3(1)(a): against all the goods and services listed above. The mark fails to satisfy the definition of a trade mark in section 1(1) of the Act because its lack of distinctiveness, descriptiveness and generic nature mean that it cannot distinguish the goods and services of one undertaking from another;
- Section 3(1)(b): against all the goods and services listed above because the mark is a direct reference to abstaining from alcoholic beverages by ‘going dry’ during January. There are no additions to the words allowing the mark to identify the applicant’s goods as theirs alone and it has no such goods, nor

will the applicant sell such goods (the pleading does not identify services here, but they are listed below the pleadings as the goods and services which are opposed under section 3);

- Section 3(1)(c): against all the goods and services listed above, because the public will recognise the mark as a description and/or characteristic of a particular product with the intended purpose to reduce and/or abstain from alcoholic consumption during January. The mark indicates the kind and intended purpose of the goods (again, the pleading does not identify services here, but they are listed below the pleadings as the goods and services which are opposed under section 3);
- Section 3(1)(d): against all the goods and services listed above because use by other providers of signs being or predominantly consisting of DRY JANUARY in relation to the sale of non-alcoholic and low-alcoholic beverages to effect a reduction in alcoholic consumption during January predate the applicant's filing date. Use of such a sign has become customary for this purpose and registration should be refused for the goods and services listed above;
- Section 3(6): against all the goods and services listed above. The applicant neither produces, provides or sells non-alcoholic, low alcoholic beverages or beverages per se. Seeking registration for the contested goods and services prevents legitimate producers and sellers selling such products and providing the same during January and other times in the year. Registration should be refused to prevent an unfair monopoly arising and offending against section 3(6);
- Section 5(4)(a): against the goods and services above in classes 30, 32 and 35 on the basis that the opponent has used the sign #DRYJANUARY from November 2016 throughout the UK in relation to *non-alcoholic beverages, low alcoholic beverages, manufacture of and retail service connected to the sale of the aforesaid beverages*. Customers and potential customers would believe that the applicant's goods and services are connected or are from a

mutual source of origin to the opponent. This would cause confusion and damage to the opponent.

3. The applicant filed a defence and counterstatement, denying the grounds and pointing out that the application was accepted after the submission of evidence of acquired distinctiveness. The applicant states that it coined the trade mark and that it is associated with the applicant's activities. It states that it has taken steps to prevent third parties making unauthorised use of its trade mark and has licensed the use of its mark to some third parties. In relation to the section 3(6) ground, the applicant states that it is a charity which promotes the management of alcohol consumption and has run a campaign and provided related services and merchandise under its DRY JANUARY brand for many years. The application was filed with a bona fide intention to use the mark and it is used by the applicant or through licensees or other forms of consent.

4. Both parties filed evidence. Neither party asked to be heard but both filed written submissions in lieu of a hearing.<sup>1</sup> The opponent is represented by Birketts LLP and the applicant by Keltie LLP.

## **Evidence**

5. The opponent's evidence-in-chief comes from Mr Rob Fink, its CEO and founder. The purpose of his evidence is to show the opponent's use of the sign relied upon for the passing off ground, and other parties' use of the contested mark in a non-distinctive/descriptive and generic sense.<sup>2</sup>

6. The applicant's evidence comes from Mr Richard Piper, its CEO and from Ms Rosemary Cardas, its trade mark attorney.<sup>3</sup> Mr Piper's evidence is aimed at refuting the opponent's claims and evidence and includes the evidence filed at *ex officio* stage, following which the application, which had been objected to, was accepted. Ms Cardas' evidence adduces newspaper articles referred to in Mr Piper's evidence.

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<sup>1</sup> The applicant included more evidence with its submissions in lieu of a hearing, but this was not admitted, as stated in a letter from the Tribunal on 11 July 2023. It was removed from the official file.

<sup>2</sup> Witness statement and exhibits dated 9 January 2023.

<sup>3</sup> Witness statements and exhibits dated 23 March 2023 and 9 March 2023, respectively.

7. Mr Fink’s second set of evidence is filed in reply to the applicant’s evidence.<sup>4</sup> I will refer to the parties’ evidence and to the submissions where relevant to the issues I have to decide.

**Sections 3(1)(a), (b), (c) and (d) of the Act**

8. Sections 3(1)(a), (b), (c) and (d) state:

“3.— (1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

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

(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:

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.”

9. Section 1(1) of the Act states:

“In this Act “trade mark” means any sign which is capable—

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<sup>4</sup> Witness statement and exhibits dated 22 May 2023.

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

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

10. The relevant date for determining the above grounds of opposition is the date on which the application for the contested mark was filed: 29 October 2020.

### **Section 3(1)(a)**

11. I note that the opponent’s written submissions in lieu of a hearing do not address the section 3(1)(a) objection which was included in its pleadings. I cannot see anywhere on the Tribunal’s file that this ground was formally withdrawn, so I will deal with it.

12. Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *AD2000 Trade Mark*, said that section 3(1)(a) permits registration provided that the mark is ‘capable’ to the limited extent of “not being incapable” of distinguishing.<sup>5</sup> Consequently, if I am satisfied that the mark complies with sections 3(1)(b), (c) and (d) of the Act, the ‘incapable of distinguishing’ objection under section 3(1)(a) is bound to fail. Alternatively, if any of the grounds under section 3(1)(b), (c) or (d) succeed the outcome under section 3(1)(a) becomes moot. In any event, this ground of opposition fails for the reasons given by Arnold J (as the then was) in *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch):

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<sup>5</sup> [1997] RPC 168.

“44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4 , the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:

"80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services."

13. The mark is not incapable of distinguishing any goods or services. **The section 3(1)(a) ground fails.**

### **Section 3(1)(b)**

14. At paragraph 55 of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] E.T.M.R. 57, Case C-363/99, the Court of Justice of the European Union ("CJEU") described section 3(1)(c) as requiring "that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods."<sup>6</sup> The public interest underlying section 3(1)(b) of the Act is described in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (Case C-265/09 P): the mark "must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings". That is the essential function of a trade mark.

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<sup>6</sup> The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

15. Although it is well-established in law that the absolute grounds for refusing registration must be examined separately, there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act, as explained by the CJEU in *POSTKANTOOR*. At paragraph 70 of its judgment, the CJEU stated that:

“...it is thus not open to the competent authority to conclude that a mark is not devoid of any distinctive character in relation to certain goods or services purely on the ground that it is not descriptive of them.”

16. The principles to be applied under article 7(1)(b) of the Community Trade Mark Regulation, now article 7(1)(b) of the EUTM Regulation, which is identical to article 3(1)(b) of the EU Trade Marks Directive and section 3(1)(b) of the Act, were conveniently summarised by the CJEU in *BORCO* as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

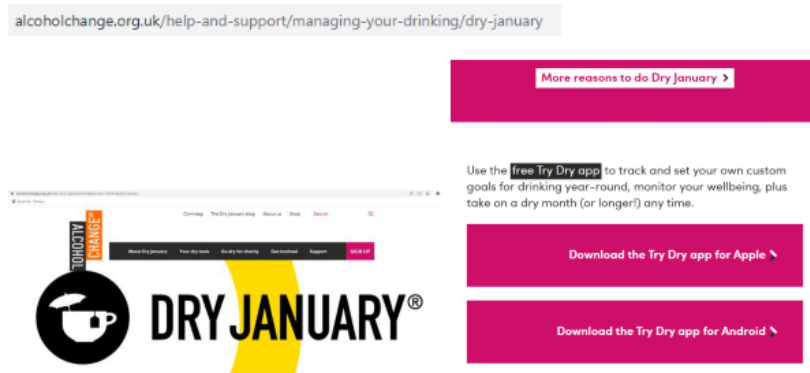
32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has

been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67).”

17. Mr Fink, the opponent’s witness, states that the applicant uses the following logo as a symbol for its campaign (launched in 2013) centred around people giving up alcohol for the month of January:



18. Exhibit RF1 comprises an undated screenshot from the applicant’s website showing the composite logo:



19. Mr Fink states that the opponent supported the applicant and its campaign by being the ‘official’ alcohol-free beer for the campaign for a year. Mr Piper, for the applicant, states in his evidence that this year-long sponsorship agreement took place between 1 December 2018 and 30 November 2019. Mr Fink states that through the applicant’s campaign, the opponent was able to promote its alcohol-free beers.

20. Mr Fink states that the words, DRY JANUARY, have become generic within the low and no-alcohol sector and that abstaining from alcohol is often considered to be a ‘dry spell’. The opponent has used #DryJanuary to promote its beverages during January since at least 2016 and Mr Fink states the opponent has made use of the words with and without the hashtag since 2017. Examples are shown from the opponent’s Twitter feed at Exhibit RF8:


 **Big Drop Brewing Co.** @bigdropbrewco · Jan 9, 2020 ...  
🚫 ⚠️ Want to know where to get Big Drop this **Dry January**? Then look no further. Here is the ultimate Big Drop trail from London and beyond.  
[bigdropbrew.com/big-drop-and-d...](http://bigdropbrew.com/big-drop-and-d...)  
And remember, life is all about the balance 🙌  
[#DryJan](#) [#CraftBeer](#)

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 **Big Drop Brewing Co.** @bigdropbrewco · Jan 6, 2018 ...  
[@knackeredmutha](#) has unearthed heaps of options for you if you're doing [#dryjanuary](#) or you just want to cut back a bit [#dryjanuary](#)

Booze-free G&T that tastes real and won't make you break **Dry January**  
[dailym.ai/2qvFPkd](http://dailym.ai/2qvFPkd) via [@MailOnline](#)

👁️ 🗨️ ↻ 3 ❤️ 5 ↗

 **Big Drop Brewing Co.** @bigdropbrewco · Nov 25, 2017 ...  
Always happy to help guys - some great new low alcohol beer options available that are perfect if you're driving, doing **dry January** or just want to cut back a bit!

21. Similar examples of use by the opponent are given in Exhibit RF10 (Instagram, 1 January 2019), Exhibit RF 11 to 27 (Instagram, January 2019 and January 2020) Exhibit RF28 (Facebook 2017 to 2019) such as:<sup>7</sup>

 **bigdropbrewco** 🍷 🍷 BIG DROP GIVEAWAY TIME 🍷 🍷  
To mark the end of Dry January (you're so nearly there), we're giving away our fresh new merch to one lucky winner (and their mate)...🔥🔥🔥🔥  
How to enter:  
1. Like this post  
2. Tag a mate who's helped you keep on track this month (each tag counts as an entry so go BIG)  
2. BOTH must follow [@bigdropbrew](#) on IG  
The competition ends Monday 3rd February.  
GO GO GO 🙌  
[#Competition](#) [#CraftBeer](#) [#LiveBig](#) [#BigDropCrowdfund](#)  
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<sup>7</sup> Exhibits RF27 and RF28 (pages 61 and 63).



**Big Drop Brewing Co.**

10 January 2019 · ⚙️

What a deal! Ocado have a [#dryjanuary](#) deal on Big Drop. 6 bottles for £6!  
<https://buff.ly/2sf9BYg> [#Tryanuary](#)



**Big Drop Brewing Co.**

21 January 2017 · ⚙️



"If you're trying to abstain from alcohol this month, we feel your pain. Dry January was either invented by the devil himself as some sort of preparatory template for purgatory, or concocted by drinks companies safe in the knowledge that everyone consumes three times as much alcohol in February to make up for it." — [MR PORTER](#)

22. Exhibit RF9 shows use by Billy Franks Jerky on their 2020 Twitter feed which was a collaboration with the opponent and Exhibit RF 29 is from Lucky Saint's social media feeds where [#dryjanuary](#) is one of a number of descriptive or non-distinctive hashtags used on 10 January 2019:



luckysaintbeer A huge thank you to Mark [@spectacularmark](#) for taking the time to talk all things Lucky Saint for The Spectacular Marketing Podcast. Great to spend time talking about the journey so far and future aspirations for our brand. Link in bio.

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[#founderstory](#) [#podcast](#) [#founderfeature](#) [#entrepreneur](#)  
[#journey](#) [#beergram](#) [#drinkstagram](#) [#businessgoals](#)  
[#thisislondon](#) [#dryjanuary](#) [#aspirations](#) [#drinkwell](#)  
[#neversettle](#) [#moderation](#) [#makeyourownluck](#) [#brandbuilding](#)  
[#thinkbig](#) [#alcoholfree](#) [#beverages](#) [#beer](#)

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and without a hashtag:



**Lucky Saint Retweeted**



**Chick 'n' Sours** [@chicknsours](#) · Jan 3, 2019



As the first weekend of January approaches, meet Lucky Saint. It's a low-alcohol, unfiltered lager that's been crafted to deliver everything a great lager should - but at 0.5% A.B.V. 💡 ⚡

⋮

Dry January could be surprisingly easy. Available at Haggerston and Seven Dials now 🍷

23. Exhibit RF30 shows similar use by Athletic Brewing in January 2019 but some of the screenshots appear to show use in the US, rather than the UK. It is the perception of the average consumer in the UK at the relevant date which is relevant. For this reason, Mr Fink's evidence in Exhibit RF33, which refers to use in the US and Ireland, is not compelling. I acknowledge that, as he states, US and Irish internet posts are accessible to people in the UK, but that is true of the internet the world over. There is no evidence that UK consumers have seen the posts or that they follow the website of the Seattle Times. However, I note that Mr Piper states that the applicant has worked with Athletic Brewing (although he does not say when) and that the company sponsored Barnsley Football Club, so it appears that this particular evidence may include UK use. Examples are:



**Athletic Brewing** ✓ @AthleticBrewing · Jan 1, 2019

Pretty wild stats from the WSJ- Power your **#DryJanuary** with Athletic beers. **#AthleticJanuary**



**Athletic Brewing** ✓ @AthleticBrewing · Jan 8, 2019

What does going All Out mean? 2019 is the perfect year to find out.  
[athleticbrewing.com/blog-2/AllOut/](http://athleticbrewing.com/blog-2/AllOut/)

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**#athleticjanuary #dryjanuary #dryjanuary2019 #nacraftbeer #nacraft #newyearnewyou #weekendwarrior #athleticbeers #nonalcoholicbeer #ctbeer #stout #allout #craftstout**



**Athletic Brewing** ✓ @AthleticBrewing · Jan 1, 2019

Make no compromises this year. **Dry January** fueled by Athletic.  
**#athleticjanuary**

Shop online or find a store on our storefinder.

.

**#dryjanuary #dryjanuary2019 #healthy #healthyfood...**  
[instagram.com/p/BsGnGXfAraJ/...](https://instagram.com/p/BsGnGXfAraJ/)



**athleticbrewing** ● You'll find that there's no better replacement for great tasting beers than... great tasting beers. Join us in doing a Dry January fueled by Athletic beers and see what a month of cutting out alcohol and cutting down calories does for you... Stock up by ordering online or heading to our nearest retail partner (check out our online store locator on our website). **#athleticjanuary** .

24. I note that the last example (from 30 December 2018) says “doing a Dry January”, not just ‘doing Dry January’. This does not convey an image of a particular challenge, known to be the responsibility of a single undertaking, but refers to a January which is dry.

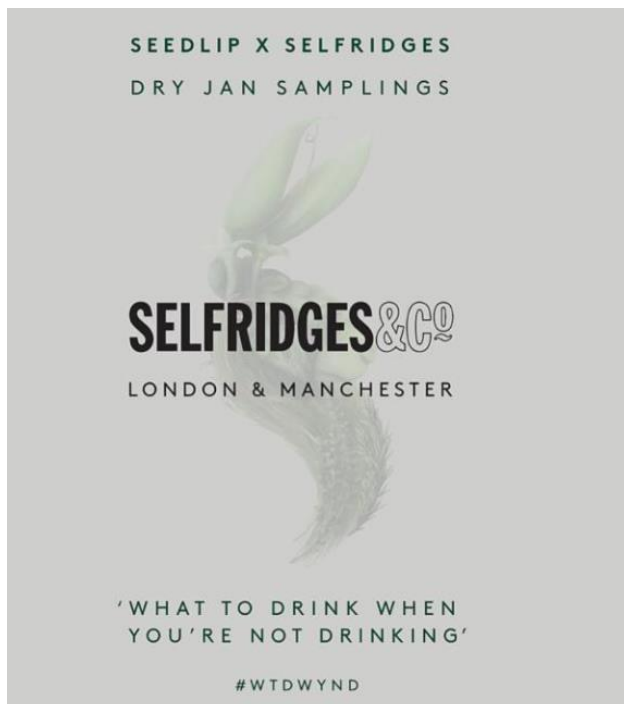
25. Exhibit RF31 comprises use on Instagram by Nirvana Brewing in January 2017, January 2019 and January 2020, along similar lines to the opponent’s use as #dryjanuary amongst other descriptive tags, such as #alcoholfreebeer and #London:



26. Exhibit RF32 comprises the same sort of use by other third parties before the relevant date. Some of these are from the US and Ireland, according to Mr Piper (Sun King Brewery and Kinsale). I note that a screenshot from Seedlip's Instagram page from January 2016 refers to a 'dry' bar:<sup>8</sup>



27. Another screen shot says:<sup>9</sup>



And an Instagram post on 2 January 2019 said:



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<sup>8</sup> Page 92.

<sup>9</sup> Page 94.

28. Page 96 of Exhibit RF32 shows a screenshot from Belle & Co's Instagram page on 2 January 2020, with the following use of "January doesn't need to be so dry after all...":

**belleandcobubbly** After the festive season, everyone needs a break...

We salute those of you who have decided to cut out alcohol from your life for a whole month. January doesn't need to be so dry after all... That's why we're here to offer you an alcohol-free alternative for those days you feel like giving up on your pledge.

Stay strong, you've got this! 🍷💪

#DryJanuary #BelleAndCo #AlcoholFree #Bubbly

29. Mr Piper refutes the opponent's evidence that DRY JANUARY is descriptive. He states that the applicant coined the term and has invested significantly in its promotion for over a decade, also policing its use and licencing it to others. Mr Piper states that the various usage shown in Mr Fink's evidence are clearly references to the applicant's DRY JANUARY campaign. Lucky Saint was the official beer for the campaign, although this was after the relevant date (2022-2023). In relation to the third party use shown by Mr Fink in Exhibit RF32, Mr Piper states that the applicant has not authorised use of its trade mark by any of the brands and either has or will contact them to address the unauthorised use. He gives some details of the applicant's previous policing of its trade mark activities, stating that the outcome in the majority of cases is that the infringing or unauthorised activity ceases. Mr Piper provides some anonymised extracts from such correspondence. I note one response said "We were completely unaware that this was a registered trademark and have already removed all mentions (of both Dry January/Dry Jan) from the website ...".

30. Mr Fink's Exhibits RF2 to RF7 are statistical reports from searches on Google for DRY JANUARY prior to the relevant date. The worldwide results are irrelevant as the issue is the perception of the UK average consumer. The UK results have no context and I find them unhelpful in that regard. The opponent acknowledges that

the applicant has a campaign called Dry January and it is not clear whether the UK searches relate to that rather than generic use.

31. Mr Piper's evidence includes the evidence filed to overcome an objection raised under section 3(1)(b) at the *ex officio* examination stage of the contested application, before it was published for opposition purposes. The applicant submits that this evidence was carefully considered by the *ex parte* hearing officer. Of course, the opponent was not involved in the *ex parte* hearing. That is why applications are published for opposition. In determining these *inter partes* proceedings on behalf of the registrar, I am required to act in a quasi-judicial role, approaching the matter with a clean slate.<sup>10</sup> I will look at the evidence, re-filed in these proceedings, afresh.<sup>11</sup>

32. The witness statement filed after the *ex parte* hearing also came from Mr Piper and is dated 25 October 2021. I note that on page 1 of the witness statement, there is a subtitle "History of DRY JANUARY, our flagship campaign". The opponent's predecessor (pre-merger), Alcohol Concern, launched a campaign to encourage people to abstain from drinking alcohol for the month of January in 2013. Support from high profile figures featured in the press, as shown in Exhibit 5 which includes an article in the Daily Telegraph dated 14 January 2013 about Alastair Campbell. In the same exhibit, an article on the BBC website, also dated 14 January 2013, said:

"It's the only time of year in the UK when a lot of people bond over not drinking. This year two charities have given their blessing to temporary teetotalism. Alcohol Concern has launched Dry January while Cancer Research UK is pushing its Drylathon."

33. The article about Alastair Campbell says "It is one reason why he is supporting Alcohol Concern's Dry January campaign." Later in the article, it says:

"Dry January: how to sign up

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<sup>10</sup> See also paragraph 11 of *Trocadero Plc v Nicholas Dynes Gracey*, Mr Simon Thorley QC, sitting as the Appointed Person, BL O/440/99.

<sup>11</sup> Re-filed as Exhibit RP24A to Mr Piper's evidence-in-chief.

Dry January, launched by Alcohol Concern, aims to raise awareness among drinkers – particularly regular tipplers among the middle-aged and middle classes – of the long-term effects alcohol can have on health.”

34. Slides from a launch event for the 2014 campaign show the following use of the contested mark:



35. An article on the [campaignlive.co.uk](http://campaignlive.co.uk) website on 23 December 2014 said:

“The Government plans to harness the ‘Dry January’ phenomenon that has sprung up in recent years with a marketing campaign aimed at encouraging social drinkers to give up alcohol for a month.”

36. The words DRY JANUARY appear with the cup device, as shown above, beneath which the article says:

“In a first, Public Health England has teamed up with charity Alcohol Concern, which owns the trademark for the term ‘Dry January’, to run a £500,000 digital, press and radio campaign, created by M&C Saatchi.”

37. I note that the trade mark register records that the applicant owns a trade mark registration in classes 16, 25, 36 and 41, filed on 11 October 2013, which is for the words and the cup device; another, also for the words and cup device, applied for on 3 March 2022, in classes 6, 9, 14, 18, 21, 28, 29, 30, 32, 35 and 43; a comparable mark, in classes 16, 25, 36 and 41, for the words and cup device, applied for on 11

April 2014; and a comparable mark for the words only, in classes 16, 25, 36 and 41, filed on 28 April 2014.<sup>12</sup>

38. A press release on Public Health England's website on 19 January 2014 announced that entity's encouragement to the public to participate in Alcohol Concern's DRY JANUARY challenge:

“To sign up for Alcohol Concern's Dry January and register for tips and tools to make the most of the month, please visit the Dry January website (<https://alcoholconcern.org.uk/dry-january>).”

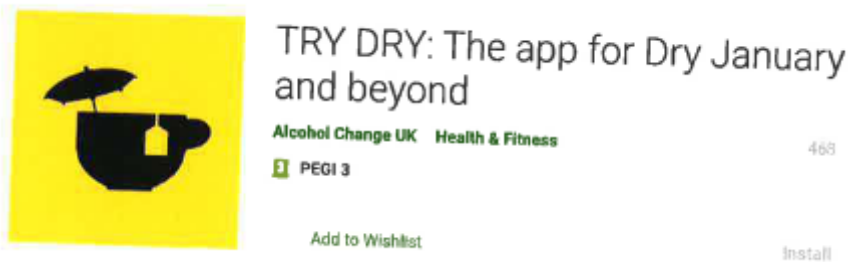
39. An article in the BBC Good Food magazine, anticipating January 2021 and referring to previous years of abstinence for charity during January, specifically says at the beginning “Dry January is a campaign run by Alcohol Change UK.” Similarly, an article in The Guardian, on 19 January 2018, referring to abstinence in January of previous years, refers to “campaigns such as Dry January, run by the charity Alcohol Concern....” An article in The Scotsman, dated 3 January 2021, refers to Alcohol Change UK as the charity behind the event of Dry January. There is a list of 2687 media mentions in Exhibit 11a which Mr Piper states mention the applicant's ownership of the DRY JANUARY campaign. Exhibit 11b is said to contain a subset of those articles with links to the articles themselves. The exhibit is another list. If parties wish articles to be viewed, the articles themselves must be adduced as evidence. The Tribunal says in all its letters inviting parties to file evidence that hearing officers will not open website links.<sup>13</sup>

40. Mr Piper states that since 2018, people taking part in its abstinence campaign have been able to download a free TRY DRY: THE DRY JANUARY APP. Prior to that, it was called Dry January and Beyond. Images of the app are shown in Exhibit RP14:

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<sup>12</sup> 3025919, 3761412, 9127787347 and 912826863. On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing European Trade Mark registration.

<sup>13</sup> The difficulties of weblinks as evidence without durable support were explained by the General Court of the European Union in Case T-317/05, *Kustom Musical Amplification v OHIM*.



41. Mr Piper states that the applicant has a number of local authority, corporate and charity partners. This fact alone does not assist me in deciding how the average consumer will perceive the mark in relation to the contested goods and services. However, I note the use by Breast Cancer Now in 2018 like this:<sup>14</sup>



42. The evidence relating to the charity Crisis is undated, but as elsewhere, it identifies the applicant's name with the Dry January challenge.<sup>15</sup> I note that a newspaper article publicising Sefton's local authority's partnership with the applicant's predecessor in 2013 started with "Sefton drinkers are being challenged to start the new year with a "Dry January", by giving up booze for 31 days". It goes on in the next paragraph to refer to the applicant's predecessor being behind the campaign. The logo used in the local authority's publicity is the word and cup device combination.<sup>16</sup> This is also what appears on the applicant's social media pages.

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<sup>14</sup> Exhibit RP18.

<sup>15</sup> Exhibit RP19.

<sup>16</sup> Exhibit RP20.

43. Mr Fink exhibits an article from the British Medical Journal of General Practice from 2016:<sup>17</sup>

“Dry January is now a household term, as Alcohol Concern launches its Dry January campaign for the fourth year, we hope even more people will take part in 2016.”

44. The article goes on to say that the campaign is a behaviour change campaign.

45. Mr Piper has filed evidence attached to his witness statement of 23 March 2023 which comprises a copy of the applicant’s campaign highlights for January 2023.<sup>18</sup> It refers to articles in the media, which Ms Cardas has exhibited in full.<sup>19</sup> The evidence dates from over two years after the relevant date but does include material about previous years, in terms of ‘sign-ups’ to the campaign. It shows use of DRY JANUARY with and without the cup device, such as:



46. The applicant’s evidence all relates to an educational campaign. I do not need to determine the grounds of opposition in relation to such services, as they are not before me or included in the present application. I also note that the evidence from the applicant invariably shows use of the words as being identified with the applicant or its predecessor, Alcohol Concern. I will come back to this later in my decision.

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<sup>17</sup> Exhibit RF34, second witness statement of Mr Fink.

<sup>18</sup> Exhibit RP25.

<sup>19</sup> Exhibit RAC1.

47. The applicant stresses that it came up with the campaign and the name for it. That no one else is using a term, or has not registered it, does not mean that a term is distinctive. When oven chips were first invented, nobody else had used the term because oven chips didn't exist, but that did not mean that 'oven chips' was distinctive as a trade mark.<sup>20</sup> It was not distinctive because it described the goods: it was the apt name for them. It does not need a great deal of analysis in the context of the goods and services which are at issue to arrive at an understanding of what DRY JANUARY means. It means going dry in January, dry being a common way of expressing abstinence from alcohol. For example, the Instagram post from Seedlip in January 2016 shows a comment from a bar in Edinburgh which states that it is a dry bar. Belle & Co said "January doesn't have to be so dry at all" on 2 January 2020. It is a compressed expression, comparable to 'headache tablets'. Nobody takes a headache tablet to get a headache, but everyone understands that the term denotes 'headache relieving tablets'. In case BL O/342/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, considered an application for WE CREATE SPACE, in relation to storage services. He upheld the Registrar's refusal of the application under section 3(1)(b):

"The expression does not cease to be a statement about the activities of the service provider merely because the way in which space creation occurs – that is to say, the mechanism or the methodology of it - is not thereby explained in any detail. A terse explanation is none the less an explanation. There is, in the present case, no verbal manipulation or engineering of the kind which has in other cases been recognised as sufficient to turn explanatory phraseology into a sign possessed of a distinctive character. For these reasons, I determine that the appeal should be dismissed under Section 3(1)(b)."

48. In *BREXIT TRADE MARK*, Mr James Mellor QC, sitting as the Appointed Person (as he then was), considered an appeal against the registrar's refusal under

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<sup>20</sup> *McCain International Ltd v Country Fair Foods Ltd and another* [1981] RPC 69.

section 3(1)(b) of BREXIT for a range of goods in class 32.<sup>21</sup> The applicant submitted that the mark was imaginative (at the relevant date, it was a known word, the application having been filed two days after the referendum on the UK's membership of the EU). Mr Mellor stated:

“33. Care is required when considering terms of this nature for registration as trade marks. One has to ask why the term is well-known and, in particular, whether it is well-known as a trade mark or, alternatively, for some reason unconnected with use of the term to signify the origin of goods or services. The reason why it is necessary to exercise care is because a term that is already well-known but unused as a trade mark may be characterised (in loose terms) as ‘distinctive,’ but the issue is whether one has in mind the right sort of distinctiveness.”

49. Mr Mellor went on to say:

“35. When considering an objection under section 3(1)(b) or its equivalent, the mark under examination must be considered absent use. It is not legitimate to assume that the mark benefits from being put on a label attached to the goods i.e. in the usual position where the public expect to see a trade mark, or to consider the situation where the consumer experiences the mark on a subsequent occasion - because this involves an implicit assumption that the mark has already been understood by the average consumer as a trade mark.”

50. In relation to a term which is well-known, he said:

“38. Returning to the concept of a term which is very well known but which conveys a non-origin message, it seems to me to be clear that before such a term can be said to possess distinctive character, it would need to acquire a secondary meaning in addition to its well-known meaning. The secondary meaning would have to convey a trade origin message. Under any normal

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<sup>21</sup> BL O/262/18.

circumstance, this type of secondary meaning can only be acquired by use of the mark in such a way as to educate the public that it is a trade mark.”

51. Addressing the applicant’s point about BREXIT being imaginative and distinctive, Mr Mellor stated:

“42. ...The term BREXIT is imaginative and very memorable. It is also distinctive in the sense that the term is very well-known in that it denotes the event and/or the process of the UK leaving the EU. In my view, to the extent that the term can be characterised as distinctive, it is not the distinctiveness required for registration as a trade mark. In my view, absent the public being educated through use to perceive the term as a trade mark (i.e. as conveying a trade origin message) the term would not convey that message to the average consumer when used in relation to beer, it would simply signify the event or the process and in that sense, it would be seen as commemorative of the event or the process.”

52. The relevant date is 29 October 2020, nearly eight years after the applicant (and its predecessor) launched its campaign. That, of itself, does not mean that the mark was distinctive in a trade mark sense at the relevant date, rather than an apt term to designate the contested goods and services. It is how the relevant consumer perceived the words DRY JANUARY at the relevant date in relation to the contested goods and services which is key. The opponent has shown how DRY JANUARY was being used by others in relation to drinks, considerably prior to the relevant date. A lot of the use is non-distinctive, listed as simply one of a number of descriptive or non-distinctive hashtags on Instagram. Seedlip, in 2016, referred to its “DRY JAN SAMPLINGS”.

53. I note the applicant’s evidence that it pursued unauthorised use of its mark. It is notable that one of the responses from a third party said that they did not realise that DRY JANUARY was a trade mark. Pursuit of others using a term in a non-distinctive or descriptive way does not make a mark distinctive *per se* for the contested goods or services. In *CLUBCARD Trade Marks*, Mr Iain Purvis QC, sitting as the Appointed Person, considered an application by Tesco Stores Limited to register CLUBCARD

in classes 9, 16, 35 and 36.<sup>22</sup> He observed that the fact that the applicant had pursued others using 'clubcard' for a retail loyalty card was not relevant, nor was it relevant that the third party, having received a threat of infringement proceedings, had ceased usage.

54. The manner in which the evidence shows that the words DRY JANUARY have been used by others prior to the relevant date does not signify trade origin: theirs or the applicant's. DRY JANUARY was not used in a distinctive way to signify the contested goods or services as being those of one undertaking. It is reasonable to assume that other traders will use the words in marketing a promotion for their drinks, e.g. at a retailer, in a pub, restaurant or café, for consumers to enjoy whilst having a dry January. It is natural language to say "I'm having a dry week/month", and if that month is January, it is a dry January. Even if more words would be used, it would be a compressed expression, as set out above.

55. I find that DRY JANUARY is *prima facie* objectionable under section 3(1)(b) for the contested goods and services for the reasons. The term is apt to signify a period of abstinence from alcohol in January: to have a dry January. Use of the words in relation to drinks, the sale of or the provision of which assist that endeavour, would not be seen as a trade mark. Use of the words in relation to advertising, promotional activities and marketing services in relation to the sale of beverages signifies to a consumer, likely a business consumer, that the undertaking providing the services provides particular assistance in marketing beverages to consumers having a dry January, when pubs and restaurants need to make more effort to attract customers who are detoxing after the excesses of the festive season. The objection extends to the services which relate to food as well as beverages, and to consultancy, information and advice therefor, since food and drink are frequently provided together, and would be part of a menu or retail choice for consumers having a dry January.<sup>23</sup>

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<sup>22</sup> BL O/531/14.

<sup>23</sup> See, for instance, the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *The Range Cooker Co. PLC v Fourneaux de France Limited*, BL O/240/02.

**56. *Prima facie*, I find that the opposition under section 3(1)(b) succeeds against all the contested goods and services.**

### **Section 3(1)(c) of the Act**

57. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P)

[2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that

that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

58. Paragraph 50 of *Technopol* refers to characteristics designating a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. Paragraph 40 states that the list of characteristics in the legislation which is equivalent to section 3(1)(c) is not exhaustive, "since any other characteristics of goods or services may also be taken into account". In *Burgerista Operations GmbH v Burgista Bros Limited and Ors*, Hacon J said:<sup>24</sup>

"14. To establish their case under art.7(1)(c), the Defendants did not have to show that burgerista designated any of the goods or services in the Trade

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<sup>24</sup> [2018] EWHC 35 (IPEC).

Mark specification exactly. Designation of a characteristic will do and this includes ancillary characteristics. What this can mean was demonstrated by the CJEU in Case C-363/99, *Koninklijke KPN Nederland NV v Benelux Merkenbureau* [2004] ECR I-1619; [2005] 3 WLR 649. A characteristic of a post office is that it sells items such as stamps; therefore POST OFFICE may not be registered for postage stamps or other goods characteristically sold in a post office, see the judgment at [54]-[57] and [102].”

59. Earlier in this decision, I said that DRY JANUARY is apt to signify a period of abstinence from alcohol in January, when one has a dry January. I find that use of the words in relation to drinks, the sale of and the provision of which assist that endeavour signifies a characteristic which would be recognised as a description by the average consumer, which is the general public of an age to drink alcohol. Use of the words in relation to advertising, promotional activities and marketing services in relation for the sale of beverages signifies to a consumer, likely a business consumer, that the undertaking provides particular assistance in marketing beverages to consumers having a dry January. As earlier, the objection extends to the services which relate to food as well as beverages, consultancy, information and advice therefor, since food and drink are frequently provided together, and would be part of a menu or retail choice for consumers having a dry January.

60. *16Harleyco Limited v Harley Hospital Ltd* concerned several marks consisting of Harley preceding various medical words, for medical goods and services. Mr Iain Purvis QC, sitting as the Appointed Person said:<sup>25</sup>

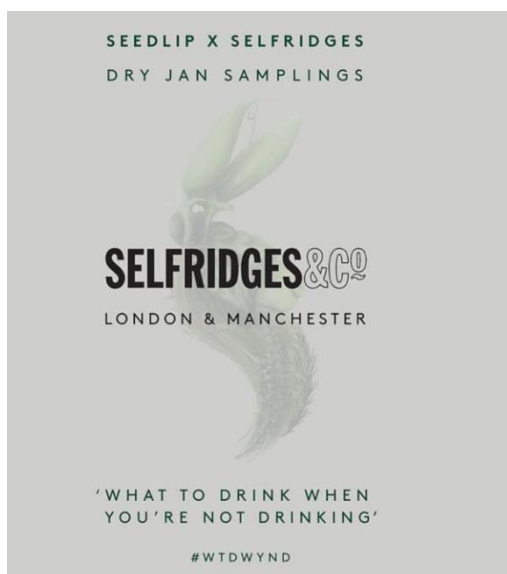
“38. Mr Stobbs made the point that whilst ‘freedom to use’ descriptive terms is the purpose of s3(1)(c), it is not the test for descriptiveness. I agree with this, and it is important to keep this distinction in mind. However, it seems to me that it may nonetheless be useful to ask, as a cross-check of a decision on a question of this kind, whether the result achieves the purpose of the section. If one can well imagine other traders in the same field wishing to use the term in

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<sup>25</sup> Such as ‘Harley Hospital’ and ‘Harley Dentist’. Case BL O/168/22.

a descriptive way, then this does tend to confirm that the term is indeed properly descriptive.”

61. Although not determinative, this approach supports my view on the basis of the way in which DRY JANUARY appears in social media posts amongst other non-distinctive and descriptive hashtags, and the other narrative use. For example, Seedlip’s Instagram page from 2016, nearly five years prior to the relevant date, referred to drinks as ‘DRY JAN SAMPLINGS’ at Selfridges stores in London and Manchester:



62. Although ‘JAN’ is not the full word JANUARY, it will immediately resonate as a shortened way of saying DRY JANUARY because some months of the year are commonly shortened (e.g. Feb, Aug, Sept, Oct, Nov and Dec).

63. I have referred above to the applicant’s claim to have coined the expression Dry January and that this, per se, does not mean that the mark has distinctiveness if it is an obvious description.<sup>26</sup> By the relevant date in question, the evidence shows that DRY JANUARY was in use by others in a non-distinctive and descriptive manner. Even if that were not so, the words were apt to describe the characteristics I have referred to above so that at the relevant date they may serve, in trade, to designate characteristics of the contested goods and services. There is a sufficiently direct and

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<sup>26</sup> See also *Wirex Ltd v Cryptocarbon Global Ltd & Ors* [2021] EWHC 617 (IPEC).

specific relationship between the mark and the contested goods and services of a non-trade origin kind. One trader, according to Mr Piper's evidence, was unaware that DRY JANUARY was a registered trade mark as late as 2023. Viewed in the context of the evidence and the findings I have made, that is not wholly surprising. They were using DRY JANUARY and DRY JAN, although Mr Piper does not say how they were being used.

#### **64. The ground of opposition under section 3(1)(c) of the Act succeeds.**

#### **Section 3(1)(d) of the Act**

65. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court ("GC") summarised the case law of the CJEU under the equivalent of s.3(1)(d) of the Act, as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

66. The enquiry under section 3(1)(d) is not whether the mark is descriptive of a characteristic of the services, although that could also apply to a mark which falls foul of section 3(1)(d). It is whether the mark was customary in the current language or was customary in the bona fide and established practice of the trade in the UK (i.e. where the trade means the contested goods and services) at the date of application. Proving this requires the filing of evidence of fact supporting the claim that it was customary for other traders to use DRY JANUARY/dry January at the relevant date, but not in a trade mark sense.<sup>27</sup> There is a relatively high evidential bar: in *Affinity Leasing Limited v Total Motion Limited*, Mr Daniel Alexander QC, sitting as the Appointed Person reviewed the authorities and concluded that the overall message was that section 3(1)(d) “requires specific evidence that it is specifically customary.”<sup>28</sup> Mr Alexander also observed at paragraph 12 of his decision that section 3(1)(c) “does not require the same degree of proof that the term has in [sic] been used in the specific descriptive way.”

67. I need to make the assessment taking into account the expectations of relevant average consumers in deciding whether at the date of the application the mark had

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<sup>27</sup> *Nude Brands Ltd v Stella McCartney Ltd*, [2009] EWHC 2154 Ch.

<sup>28</sup> Case BL O/522/20, at [22].

become “customary in the current language or in the bona fide and established practices of the trade”. Although where intermediaries influence decisions to purchase goods or services their views should also be taken into account, in the present case the average consumer for the contested services is largely the general public over 18, and it is their views which are likely to be of decisive importance.<sup>29</sup>

68. In *Stash Ltd v Samurai Sportswear Ltd*, Professor Annand, sitting as the Appointed Person, stated that it was sufficient if a mark offended either limb of s.3(1)(d).<sup>30</sup> That is to say, that (at the relevant date) the mark had become customary (a) “in the current language”, or b) “in the bona fide and established practices of the trade”. The words ‘of the trade’ should not be construed as applying to both limbs. Basing herself on the Oxford English Reference Dictionary, 1995, Professor Annand took “customary” (in the language) to mean “usual; in accordance with custom”.

69. There is no such evidence in relation to the contested goods in class 30, *water* in class 32, and the contested services in classes 35 and 43. The ground fails in relation to these goods and services. However, I find on the evidence that DRY JANUARY had become both customary in the current language, and also customary in the bona fide and established practice of trade, in relation to non-alcoholic drinks in class 32. The Seedlip use and all the hashtag use of Lucky Saint and Athletic Brewing, several years prior to the relevant date, supports a finding that the contested mark offends both limbs of section 3(1)(d). I find that the section 3(1)(d) ground of opposition is made out in relation to non-alcoholic drinks, but if I am wrong that the evidence does not meet the high bar, the mark is nevertheless objectionable under section 3(1)(b) and (c) for all the contested goods and services, as found earlier in this decision.

### **Acquired distinctiveness**

70. The applicant has filed evidence about the use it has made of DRY JANUARY. The proviso to section 3(1) of the Act provides that marks which are *prima facie*

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<sup>29</sup> CJEU, Case C-371/02 *Björnekulla Fruktindustrier AB v Procordia Food AB*, paragraphs 24 and 25.

<sup>30</sup> BL O/281/04.

objectionable under sections 3(1)(b), (c) and (d) shall be accepted “if, before the date of application for registration, [the mark] has in fact acquired a distinctive character as a result of the use made of it.” The CJEU provided guidance in *Windsurfing Chiemsee* as to the correct approach with regard to the assessment of the acquisition of distinctive character through use.<sup>31</sup> The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

71. I begin by reminding myself that the relevant date is 29 October 2020 and that the applicant must prove that the mark had acquired distinctive character prior to that date.<sup>32</sup> It is explicit in paragraph 54 of *Windsurfing Chiemsee* that the assessment as to whether the mark has acquired distinctive character must be made in relation to the goods and services for which registration is sought. At paragraph 9 of Mr Piper’s witness statement dated 23 March 2023, he states:

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<sup>31</sup> Joined cases C-108 & C-109/97.

<sup>32</sup> See *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV*, CJEU, Joined cases C-217 and 218/13 and *Dualit Ltd's Trade Mark* [1999] RPC 890.

“... the DRY JANUARY trade mark is used in relation to the campaign specifically directed to support those abstaining from alcohol for the month of January”.

72. The applicant has not provided any evidence of its use in relation to the contested goods and services such that it would have educated the average consumer to see DRY JANUARY as indicating the goods and services of one undertaking and distinguishing them from those of other undertakings at the relevant date. The use is also invariably with the cup device and/or with the applicant’s name which are the distinctive elements in use. For words which are lacking in distinctiveness and are descriptive, mere use does not prove distinctiveness. It must be use in a distinctive sense and it must be in relation to the goods and services for which the application has been made and, in the present proceedings, those which are contested. **The claim to distinctiveness acquired through use fails.**

### **Section 3(6) of the Act**

73. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

74. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“67. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]”.

75. It is necessary to ascertain what the applicant for the trade mark knew at the relevant date which is the date of application (29 October 2020): *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

76. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). It is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*.

77. The caselaw shows that the initial evidential burden falls upon the opponent: it must present evidence from which a rebuttable presumption of lack of good faith can be drawn. If the opponent does that, then the burden shifts to the applicant to rebut the allegation.

78. I remind myself that the opponent claims that:

“The Applicant neither produces, provides or sells non-alcoholic, low alcoholic beverages or beverages per se. Seeking registration for the contested goods and services prevents legitimate producers and sellers selling such products and providing the same during January and other times in the year. Registration should be refused to prevent an unfair monopoly arising and offending against section 3(6).”

79. The facts do not point towards bad faith; at any rate, they point as much to good faith as to bad, which is not enough for the opponent to succeed under this ground.

The applicant already uses DRY JANUARY for its campaign, and has done since 2013. As stated by Mr Fink, the opponent worked with the applicant (or its predecessor) in the past and entered into a sponsorship agreement from 1 December 2018 to 30 November 2019. The opponent's non-alcoholic beer was promoted during the campaign under the applicant's DRY JANUARY trade mark in 2019. Mr Piper has explained that it is common for charities to expand their core charitable activities into areas such as merchandising and licensing to increase fund-raising.<sup>33</sup> Exhibit RP27 comprises some of the applicant's current merchandise for sale via its online shop, including wristbands, badges and printed matter. The applicant considers it coined the mark and it therefore is entitled to protect it in relation to the contested goods and services, which it claims are merchandise and will be the subject of licensing (which it already does) to raise funds for the charity. It seems to me that the application was the action of a charity already using the name for years, in relation to the area in which it wished to expand. That the mark is objectionable under other absolute grounds, thereby dealing with the monopoly point, does not mean that it was applied for in bad faith. Filing the application was not behaviour which falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. The burden is upon the opponent to prove bad faith, not for the applicant to prove good faith, although I consider that the applicant has done so. **The section 3(6) ground fails.**

### **Section 5(4)(a) of the Act**

80. The opponent pleads section 5(4)(a) of the Act in the alternative. Its primary position is that the absolute ground of opposition succeeds under section 3(1). As I have found that the grounds of opposition under sections 3(1)(b) and (c) succeed in full, I will deal with this ground briefly, in the event that I am wrong.

81. Section 5(4)(a) states:

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<sup>33</sup> Examples of such third-party activities are shown at Exhibit RP26 in relation to the British Heart Foundation, Cancer Research UK and Crisis.

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

82. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

83. The three elements which the applicant must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “a substantial number” of the Claimants' customers or potential customers are deceived, but

it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

84. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

85. The *prima facie* relevant date is the date of the application for the contested mark: 29 October 2020. The opponent must show that it had sufficient goodwill at this date to bring the claim. There could also be a second, earlier, relevant date given the applicant’s evidence about the use of its mark.<sup>34</sup> I will return to this issue only if it is necessary to do so.

86. In *Smart Planet Technologies, Inc. v Rajinda Sharm*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. Mr Mitcheson concluded at paragraph 30 that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that

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<sup>34</sup> *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander QC, sitting as the Appointed Person.

there would be substantial damage on the basis of the misrepresentation relied upon.”

87. A feature of that case was the size of the market for disposable cups which, like the present case for the opposed goods and services, is large. It was also a major consideration that there was an element of descriptiveness in the sign relied upon, Recup. Commensurately stronger evidence would be required to demonstrate significant or substantial goodwill. Mr Mitcheson said, after finding the evidence in that case did not establish sufficient goodwill for the passing off claim, that:

“41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A’s goods.”

88. No doubt this is why the opponent has pleaded the ground in the alternative because its primary position is that DRY JANUARY for the opposed goods and services is devoid of any distinctive character, descriptive and generic. However, the tests are not entirely the same, as Jacob LJ said, in *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd*:<sup>35</sup>

“This is the language of distinctiveness for trade mark registration, not that for testing whether a goodwill has been established.”

89. Bearing in mind the *Recup* case and *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, the opponent faces an uphill struggle in succeeding under this ground. I have already found that use as hashtags on Instagram, amongst other non-distinctive and descriptive tags, will not be seen as distinctive of one undertaking’s trade. None of the opponent’s

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<sup>35</sup> [2006] EWCA 244 (Civ).

use is distinctive of the goods and services upon which it relies for this ground. There are no turnover figures in relation to the use it claims to have made of #DRYJANUARY as a sign distinctive of its business.

90. The evidence does not take the opponent over the line from trivial to small, but protectable, goodwill; in fact, there is no goodwill at all. It is therefore unnecessary to consider the position at any earlier date. **The section 5(4)(a) ground fails.**

### **Overall outcome**

91. The opposition succeeds in full.

### **Costs**

92. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale of costs published in Tribunal Practice Notice 2/2016. The breakdown is as follows:

Official fee for filing the opposition	£200
Preparing and filing the notice of opposition and considering the counterstatement	£250
Filing evidence and considering the applicant's evidence	£1000
Filing written submissions in lieu of a hearing	£400
<b>Total</b>	<b>£1850</b>

93. I order Alcohol Research UK to pay to Big Drop Brewing Company Limited the sum of **£1850**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 20<sup>th</sup> day of February 2024**

**Judi Pike  
For the Registrar,  
the Comptroller-General**