

O/1145/25

TRADE MARKS ACT 1994

**IN THE MATTER OF UK REGISTRATION NO. UK00003866751
IN THE NAME OF VIRTUAL ADMINISTRATION LIMITED
IN RESPECT OF THE FOLLOWING TRADE MARK:**

VIRTUAL ADMINISTRATION

IN CLASSES 41 AND 45

AND

**AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF
UNDER NO. 506929**

BY VIRTUAL ADMINISTRATION BRISTOL LIMITED

Background and pleadings

1. The UK trade mark UK00003866751 shown on the cover page of this decision stands registered in the name of Virtual Administration Limited (“the proprietor”). It was applied for on 11 January 2023 and completed its registration procedure on 20 October 2023. The relevant services for which it is registered are as follows:

Class 41: Proof reading of manuscripts

Class 45: Consultation in relation to data protection compliance;
Reviewing standards and practices to assure compliance
with laws and regulations

2. On 22 January 2024, Virtual Administration Bristol Limited (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of section 3(1)(c) of the Trade Marks Act 1994 (“the Act”) which are relevant in invalidation proceedings under section 47 of the Act. The application concerns all the services for which the mark stands registered.
3. The applicant claims that ‘virtual administration’ is a phrase which may (and does) serve, in trade, to describe the kind of work performed by virtual assistants or virtual administrators. The applicant claims that the registered proprietor sells virtual administration services, that is, services of virtual administrators or virtual assistants under the registered mark and that the services for which the mark is registered are the type which are typically provided by virtual assistants or virtual administrators. Consequently, the registered mark consists exclusively of a sign which may serve in trade to describe the kind of services provided under the registered mark.¹ Further the applicant submits that the registered trade mark had not acquired distinctive character as a result of the use that had been made of it by the day before the

¹ See the applicant’s notice of invalidation, paragraphs 8 to 12.

application was made for its registration.² It is for these reasons that the applicant contends that the mark was registered contrary to section 3(1)(c) of the Act.

4. The proprietor filed a defence and counterstatement denying that its registered mark consists exclusively of a sign which may serve in trade to describe the kind of services provided under the registered mark. Furthermore, the proprietor claims that the type of services that it offers are not those that would be commonly provided by virtual assistants or virtual administrators.
5. The applicant is represented by Robertson IP Limited; the proprietor represented itself.

Evidence and submissions

6. The applicant's evidence in chief comes from Antoinette Forbes, who is a director of the applicant's company. Her witness statement is dated 12 August 2024 and is accompanied by four exhibits, AF1-AF4. The exhibits contain articles and extracts from websites relating to the work of virtual assistants and virtual administrators. At the same time the applicant filed written submissions.
7. The proprietor's evidence comes from Tracey Clarke, who is a director of the proprietor's company. Her witness statement is dated 24 September 2024 and is accompanied by thirteen exhibits, VA1-VA13. These exhibits have been adduced to show use of the contested trade mark and to support submissions on the nature of the work carried out by virtual assistants and virtual administrators. At the same time the proprietor filed written submissions under a cover letter dated 25 September 2025 but received on 24 September 2024.
8. Neither side requested a hearing and only the applicant filed written submissions in lieu on 2 December 2024.

² Ibid, paragraph 13

Relevance of EU law

9. 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.

DECISION

Legislation

10. The relevant provisions of section 47 of the Act are as follows:

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection 1(c) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

11. The relevant parts of section 3(1) of the Act are as follows:

“The following shall not be registered –

[...]

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

[...]

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.”

12. The relevant date is the date of application, i.e. 11 January 2023.

Section 3(1)(c) case law

13. 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 L40, p. 1), see, by analogy, [2004] ECR I-1669, 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 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] E.C.R. I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] E.C.R. 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].”

14. More recently, Zacaroli J summarised the key question in *Puma SE v Nike Innovate C.V.*, [2021] EWHC 1438 (Ch)

“Ultimately, as Ms Himsworth QC submitted, the question is whether the mark applied for, when notionally and fairly used, is descriptive of the goods and services in question within the meaning of section 3(1)(c). A sign can be refused registration ‘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 [the characteristics in section 3(1)(c)]’: *Technopol* (above), at [50]. Moreover, a sign will be descriptive ‘if there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of one of the characteristics of the goods and services in question’: Case T-234/06 *Giampetro Torresan* (above) at [25].”³

15. I am further guided by the decision of the CJEU in *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, in which it stated that:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the

³ Paragraph 21.

goods or services concerned.

Average consumer

16. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice of the European Union (“CJEU”) held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade or amongst average consumers of the said goods or services, reasonably wellinformed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

17. The court had earlier addressed the significance of the trade’s perception of trade marks in more detail in *Björnekulla Fruktindustrier AB v Procordia Food AB*, Case C-371/02, where the court found that:

“24. In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it. 25. Accordingly, the relevant circles comprise principally consumers and end users. However, depending on the features of the product market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.”

18. Neither party has addressed who the average consumer of the services may be. However, given the services at issue, I consider that the average consumer will be either professionals or business users, in relation to the class 41 services, '*proof reading of manuscripts*', or business users in relation to the class 45 services, '*consultation in relation to data protection compliance*' and '*reviewing standards and practices to assure compliance with laws and regulations*'.

Distinctiveness of the contested mark

19. For a sign to be caught by the prohibition set out in section 3(1)(c), there must be a sufficiently direct and specific relationship between the sign and the goods or services for which it is registered, or sought to be registered, to enable the public concerned immediately to perceive, without further thought, a description of the goods or services in question or one of their characteristics: see *Metso Paper Automation Oy v OHIM - PAPERLAB*, Case T-19/04, paragraph 25.

20. I note from the file that prior to registration the mark at issue met an objection to registration from an examiner who believed the mark to fall foul of absolute grounds under sections 3(1)(b) and 3(1)(c). An ex parte hearing was held on 10 May 2023, the result of which was that the mark was not permitted registration for administration services in class 35 and auditing services in class 45. However, it was held that the remaining services were considered to be specialised services that could not be described as administrative services. Therefore, the objection was waived in relation to the services for which the mark now stands registered, and following an amendment to the applied for services the mark was registered as outlined at paragraph 1 of this decision. As the mark now stands registered as it was deemed to have some level of distinctive character in relation to the services, the onus is now on the applicant to show that the mark falls foul of section 3(1)(c).

21. I keep in mind that I am not bound by the decision of the ex-parte hearing officer, and indeed, I have the benefit of the evidence that has been provided by the

applicant that was not before the ex-parte hearing officer when that decision was reached. Therefore, in light of this evidence, I will form an independent assessment of whether the evidence provided in these proceedings shows that at the time of application the mark was either descriptive of the services applied for or could be used descriptively: see paragraph 38 of *Agencia Wydawnicza Technopol sp. z o.o. v OHIM*, quoted by Arnold J. (as he then was) in *Starbucks*, reproduced above.

22. Before I consider this evidence, I keep in mind how each of these words are defined within the Oxford English Dictionary as:

virtual (adjective): carried out, accessed, or stored by means of a computer, especially over a network: a virtual library/virtual learning.

administration (noun): the process or activity of running a business, organisation etc.

23. As such, when the words are used together, **virtual administration**, this will be understood as referring to administrative tasks that are carried out remotely.

24. Taking first, the class 41 services, '*proof reading of manuscripts*'. I observe that the proprietor has stated the following in the accompanying counterstatement letter on the subject of proof reading:

"We agree that proof reading can be a task carried out by virtual assistants and virtual administrators but is not absolutely common. The proof reading we carry out specifically for our clients includes complex medical reports and expert witness reports that go to the court. This is very different to proof reading a website or letter."

25. I acknowledge that the proprietor accepts that proof reading is a task that can be carried out by virtual assistants or virtual administrators but submits that this is not common. Nevertheless, even if proof reading services are not offered by

numerous virtual assistants, this of itself is not necessarily determinative. The courts have said that the number of competitors that might have an interest in using the sign is not relevant: see paragraph 39 of *Agencja Wydawnicza Technopol sp. z o.o. v OHIM*, Case C-51/10 P.

26. As can be seen above, the proprietor then goes on to argue that proof reading of complex medical reports or expert witness reports is different to proof reading of a website or letter, but it fails to explain why it believes this to be the case other than describing medical reports or expert reports as complex. However, a letter to the court may be just as complicated and have significant legal consequences and, there is nothing within the evidence to show that proof reading of medical manuscripts and expert witness statements require any additional skillset or expertise to those required for proof reading any other documents, such as, letters or business documents. Indeed, proof reading is focused on identifying errors of spelling, grammar and formatting issues within documents, it does not require any detailed knowledge of the subject matter at hand.

27. In addition to the proprietor's admission, its evidence also demonstrates that proof reading is a task that would be carried out by a Virtual PA. In a screenshot from the website of the Association of Virtual Assistants.⁴ This shows under the words '*Find a virtual assistant by skill*' that 'Editorial Proof Reading' is listed as a category in which users can find a Virtual Assistant. Below this on the same page when searching specifically for proof reading services a result for a virtual assistant company is generated who offer these services.

28. Moreover, there is evidence of leaflets that were placed by the proprietor in goodie bags at conferences.⁵ The leaflets refer to a list of services advertised as being offered by a Virtual P.A., it lists "*formatting, editing and proof reading reports*". Below the list it states: "*If you want help to show off your 'super efficiency' in business, let one of our Virtual PAs take care of your admin tasks*".

⁴ Exhibit VA13, page 37

⁵ Exhibit V9, page 24

This shows that proof reading is offered and advertised by the proprietor as an administrative task.

29. As I have identified above, I consider the relevant consumers of these services to be either professionals or business users. In my view given the evidence referred to above, along with the proprietor's admission that proof reading is a task that can be carried out by virtual assistants/administrators, it is likely that these consumers would consider proof reading services which identify spelling, grammatical and formatting errors, to fall under administrative tasks that would be conducted by Virtual Assistants or Virtual PA's. For these reasons, the words "virtual administration" are descriptive, as they will be understood as describing the type of services that would be provided by virtual assistants/administrators and the method in which the task is conducted, i.e. carried out remotely.

30. Turning to the class 45 services, '*consultation in relation to data protection compliance*' and '*reviewing standards and practices to assure compliance with laws and regulations*', for which the relevant consumers would be business users, as only businesses would require these services. In considering these services, I note the extracts from online company articles. One is entitled "*Hire a Compliance Virtual Assistant*",⁶ and the other is entitled "*What Is a Virtual Assistant and What Does One Do*".⁷ Both articles are undated; however, the accompanying witness statement refers to all the evidence exhibited as being downloaded on 9 August 2024 (which postdates the relevant period). However, the former references a study dated 2023, which would shine light on the period prior to the relevant date. As for the latter, it talks about the aftermath of Covid 19 which could indicate that it is referring to a time prior to the relevant date. In relation to the first article, Ms Forbes asserts within her witness statement that "*it is clear from the article that business support services related to compliance laws and regulations are among the services provided by virtual assistants provided by the Stealth Agents agency [a third party]*".⁸ As for the latter it is said,

⁶ Exhibit AF1

⁷ Exhibit AF2

⁸ Witness statement of Antoinette Forbes, paragraph 2

“Thus it is clear that ‘virtual administration’ is a term which can be and is used to describe the work of a virtual assistant.”⁹

31. In relation to the first point and the first article, I disagree that this shows that business support services would encompass compliance-based services such as those registered under the mark. The evidence shows that compliance virtual assistants, can assist businesses remotely with tasks such as policy development and documentation, regulatory research, audit preparation and support, risk assessment and management, compliance monitoring and reporting (which involves tracking compliance metrics, conducting regular reviews, and generating reports to provide insights into the organisation’s compliance status), document management (which involves management of all compliance related documents), and regulatory filings and submissions.¹⁰ This indicates that they are a more specialist type of virtual assistant to one that would typically perform business administration roles.

32. The exhibit concludes:

“Hiring a Compliance Virtual Assistant is a strategic decision to bolster your organization’s adherence to regulations and operational standards. By delegating regulatory research, document management,¹¹ audits, and policy updates to a skilled virtual assistant, you ensure proactive compliance while focusing on core business initiatives. This approach not only enhances operational efficiency but also mitigates the risks and fosters a culture of compliance within your organization.

A Compliance Virtual Assistant brings specialized knowledge of regulatory frameworks and industry standards, ensuring thorough and accurate compliance management. Their expertise allows for timely responses to regulatory changes and proactive identifications of

⁹ Ibid, paragraph 3

¹⁰ Exhibit AF1, pages 2-5

¹¹ I note that this is in the context of compliance document management as opposed to general document management that may be considered to be administrative.

*compliance gaps, thereby safeguarding your organization's reputation and sustainability...*¹²

33. I note that the document is from a .com webpage domain and whilst that by itself is not determinative of the geographical location of the targeted article, I also observe that certain words are spelt in American English rather than British English and that the cost of the company's compliance virtual assistant found at the end of the exhibit is provided in dollars rather than in sterling. As a result, it is clear the company article that has been provided is one based in America and shows use of the services offered within an American market rather than within the UK market. Nevertheless, I do not discount this evidence as it is possible that it may shed light on emerging trends that have the capacity to migrate to the UK market.

34. I turn to the second article which focuses on virtual assistants, rather than compliance virtual assistants. This is from investopedia.com and contains American English spellings alongside a reference to the amount that Virtual assistants can charge in dollars. As with the first article, this would suggest that the information provided relates to an American market rather than the UK market. However, as I have premised above, this may still be able to shed light on future use within the UK. I note from this evidence that the duties of a virtual assistant (rather than a compliance virtual assistant) are discussed as set out below:

*"The specific duties of a virtual assistant vary according to the needs of the client and the terms of the contract. Some virtual assistants handle clerical and bookkeeping tasks, while others may post regular updates to social media or write articles for a blog. A well-rounded virtual assistant may also handle travel arrangements, appointment scheduling, data entry, and online file storage."*¹³

¹² Exhibit AF1, pages 14-15

¹³ Exhibit AF2, page 2

35. Although I agree with the applicant that '*virtual administration*' is a term which can be, and is, used to describe the work of a virtual assistant. I do not accept that it has clearly been made out through the evidence that the services for which the mark is registered are services that would typically be understood by the average consumer as being performed by a virtual assistant or virtual administrator. Rather the evidence shows that virtual assistants are responsible for administrative services rather than compliance-based services such as '*consultation in relation to data protection compliance*', or '*reviewing standards and practices to assure compliance with laws and regulations*'.
36. As for the remaining evidence, printouts are provided from two separate professional websites, each which appear to be from providers within the UK.¹⁴ It is stated within the applicant's narrative evidence that these are examples of the use of the phrase '*virtual administration*' in relation to the work of a virtual assistant.¹⁵ I accept that the evidence shows the phrase is used in relation to the services of virtual assistants that are offering administration support to businesses in various fields, but in my view, it does not show that the phrase virtual administration is used in relation to any compliance-based services. Indeed, exhibit AF4 specifically relates to administrative support dedicated to financial advisers rather than compliance-based services.
37. Further, in the proprietor's evidence, there is a screenshot from the website of the Association of Virtual Assistants.¹⁶ This shows the words 'Find a virtual assistant' with a list of various skills below. Although I appreciate it may not be an exhaustive list, I note that compliance is not listed. Further, when the word '*compliance*' as a skill criteria is searched for, it brings back no results.¹⁷
38. Having considered the evidence, it shows that the proprietor's class 45 services are not conducted by virtual assistants or virtual administrators but compliance virtual assistants which appear to be compliance specialists. These compliance specialists appear to offer services to businesses that are beyond

¹⁴ Exhibits AF3 and AF4.

¹⁵ Witness statement of Antionette Forbes, paragraphs 4 and 5.

¹⁶ Exhibit VA13, page 37

¹⁷ See Ibid, page 38.

administrative services provided by virtual administrators. In my view, the relevant consumer of these services will be business users who in my view would have an elevated knowledge of the differences between business administration duties and business compliance duties and the skills that are required to conduct these. There is nothing to indicate that business users would hire virtual administrators or virtual assistants expecting them to be capable of providing the more specialised compliance services that would require legal and/or regulatory understanding or knowledge as discussed within the evidence. I do not consider business users would believe these specialist compliance-based services to typically fall within the scope of services that would generally be described as '*administrative services*'.

39. I acknowledge that it is not necessary for the term to be in current use and that a reasonable apprehension that it might be used in the future as a description of the services or a description of the characteristics of the services concerned is sufficient.¹⁸ Therefore, I will now consider whether it is reasonably foreseeable that the words "*virtual administration*" could become descriptive for the class 45 services in future.

40. The proprietor claims to have been using the phrase '*virtual administration*' as a sole trader since 2006.¹⁹ However, it would appear to be a term that has gathered traction amongst business users following the emergence of more interactive online working and working from home which will no doubt have increased since the Covid 19 pandemic. That said, as I have discussed above, the term '*virtual administration*' is typically used for administrative tasks undertaken remotely, such as, for example, billing and invoices, book keeping, payroll processing, scheduling and data entry, whereas the class 45 services are more specialised services that require additional knowledge, skills and expertise to perform. For those reasons it is unlikely that virtual administration will ever be considered by relative consumers i.e. business users, as referring to compliance services, particularly as they will have an awareness of the

¹⁸ *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] E.T.M.R. 57, Case C-363/99, paragraph 56.

¹⁹ Witness statement of Tracey Clarke, paragraph 1.

difference skill sets required for administration compared to regulatory compliance. It seems highly unlikely that they would choose a virtual assistant or virtual administrator to carry out the class 45 services.

Acquired distinctiveness

41. The applicant objects to acquired distinctiveness being relied upon by the proprietor on the basis that notwithstanding the applicant raising the matter of acquired distinctive character in their statement of grounds, the proprietor failed to plead acquired distinctiveness in its statement of defence. Although the applicant acknowledges that the proprietor did claim acquired distinctive character within its submissions filed during the evidence rounds, the applicant submits that this claim has been made too late to be considered by the Tribunal. It is asserted that if the proprietor intended to rely on acquired distinctiveness in defence of the registered trade mark, it should have been claimed in the statement of defence.²⁰

42. The position that should be taken by the Tribunal in these circumstances where pleadings have not been denied by a party was discussed at length by Mr Phillip Johnson, sitting as the Appointed Person in *Skyclub*, BL O/044/21. At paragraphs 24 and 25 of this decision, Mr Johnson states:

“24. The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a “blank” defence would lead to the whole of the Claimant’s case being admitted.

²⁰ Applicant’s written submissions, at page 2 under the heading “acquired distinctiveness”.

25. The procedure before neither the registrar nor the Appointed Person is governed by the CPR, but there is a Tribunal Practice Notice (TPN 4/2000) which deals with pleadings and provides a similar rule to the CPR:

19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.

20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counterstatement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided.”

43. Therefore, I accept that despite the applicant explicitly claiming within its pleadings that the mark had not acquired distinctiveness, the proprietor failed to defend this point within its defence and counterstatement which should be taken as an admission of the point. Nevertheless, I also acknowledge that as acquired distinctiveness was raised within the evidence rounds, the applicant had the opportunity to consider this point and provide submissions on the matter. Therefore, given that I have submissions from both parties on the matter I note from *Skyclub*, that it would have been open to me to invite the proprietor to amend its pleadings, even at this late stage in proceedings:

“29. The Hearing Officer has the power to request clarifications from a party to proceedings under r 62(1)(a) of the Trade Marks Rules 2008. He also could have invited Mr Engelman to apply to amend his pleadings to put in issue the similarity of goods and services, confusion and so on [...]”

44. Whilst I acknowledge this available course of action, I do not consider it to be appropriate in this case. For reasons that will become apparent, I have concluded that to request the proprietor to amend its defence at this late stage

of the proceedings would only increase costs to the parties and delay proceedings further without actually benefiting the proprietor's position.

45. Even where a mark inherently offends against Section 3(1)(c), it shall not be refused registration if it has acquired distinctiveness through the use that has been made of it before the date of application, i.e. 22 January 2024.

46. The relevant case law was summarised by Arnold J (as he then was) in *Frank Industries Pty Ltd v Nike Retail BV* [2018] EWHC 1893 (Ch):

“68. Acquired distinctive character. The following propositions are settled by the case law of the CJEU.

69. First, for a trade mark to possess distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings.

70. Secondly, the distinctive character of a trade mark must be assessed by reference to (i) the goods or services in respect of which registration has been applied for and (ii) the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.

71. Thirdly, the criteria for assessment of distinctive character are the same for all categories of trade marks, but nevertheless the perception of the relevant public is not the same for all categories of trade marks and it may therefore be more difficult to establish distinctive character in relation to some categories (such as shapes, colours, personal names, advertising slogans and surface treatments) than others.

72. Fourthly, in assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of

the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character.

73. Fifthly, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression "use of the mark as a trade mark" refers solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product as originating from a given undertaking.

74. Sixthly, a trade mark may acquire a distinctive character in consequence of the use of that mark as part of, or in conjunction with, another trade mark (which may itself be a registered trade mark).

75. Seventhly, it is not possible to state in general terms, for example by referring to predetermined percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has acquired a distinctive character through use. Nor can the results of a consumer survey be the only decisive criterion to support the conclusion that a distinctive character has been acquired through use.

76. Eighthly, the trade mark applicant or proprietor must prove that the relevant class of persons perceive the goods or services designated

exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company. It is not sufficient for the applicant or proprietor to show that a significant proportion of the relevant class of persons recognise and associate the mark with the applicant or proprietor's goods.”

47. Should acquired distinctiveness be considered the applicant argues that:

“[...] the evidence is insufficient to show acquired distinctiveness. The Mark in question is wholly and directly descriptive of the types of services sold under it, and lacks any inherent distinctive character whatsoever. This sets the bar extremely high for a successful demonstration of acquired distinctive character. In our submission, the evidence of use and of marketing expenditure are not enough to demonstrate distinctive character, [...]”.

The applicant goes on to cite *British Sugar* [1996] R.P.C. 281 at 302, which states as follows:

“I have already described the evidence of use to support the original registration. It was really no more than evidence of use. Now, it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that ‘use equals distinctiveness’. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word ‘Soap’ as a purported trade mark for soap the word would not be distinctive of his goods”.

The applicant continues to argue that:

“The analogy with soap applies [as] well in this case, because the Mark in question is nothing more than the phrase ‘virtual administration’, used in association with the sale of virtual administration services. Furthermore, it seems that the examples of use of the Mark provided in the Registered Proprietor’s evidence shows it is accompanied by their

distinctive logo, comprising grey text, a large bold red triangle, and a portion of a smaller orange triangle arranged to suggest that it is behind the red triangle. In our submissions, this is the Mark which consumers are likely to take as distinguishing the Registered Proprietor's services from those of other undertakings, and not the plain descriptive words 'virtual administration' on their own.

As Jacob J has said:

"Mere evidence of use of a highly descriptive or laudatory word will not suffice without more, to prove that it is distinctive of one particular trader – is taken by the public as a badge of origin. This is all the more so when the use has been accompanied by what is undoubtedly a distinctive and well-recognised trade mark." (Ibid. at 286)".

48. I bear these submissions in mind.

49. Tracey Clarke, (for the proprietor) states that she is *"one of the directors of Virtual Administration Limited, which I have held since 2012. Before this I was a sole trader of Virtual Administration, as from 2006."*²¹

50. She continues to say:

"My Company has been using its trademark since 1 November 2023, on the Company website, LinkedIn and Twitter to promote the services detailed below – see attached exhibits VA1 to VA10.

- proof-reading of initial assessment reports, expert witness reports, documents that go to the Court in relation to a personal injury claim supported by a brain injury case manager.*
- reviewing standards and practices to assure compliancy with Laws and Regulations - by offering clients support with registration application to the Care Quality Commission (CQC) providing bespoke policies & procedures, creating business plans and business continuity plans as*

²¹ Witness statement of Tracey Clarke, paragraph 1

part of the governance and regulation, in getting ready for CQC inspection.

- *Consultancy in relation to data protection compliance – providing GDPR update webinars and reviewing privacy policies on clients’ consent forms, terms & conditions, employment contracts and data sharing agreements.”²²*

51. However, I note contrary to the narrative evidence that the exhibits referenced do not show the proprietor’s website, or Twitter evidence. There is just one exhibit, Exhibit V9 referenced below that shows LinkedIn evidence. Rather, the evidence mainly refers to Webinars, leaflets and brochures advertising the proprietor’s services at those events that I will discuss below.

52. I will focus first on “*proof reading of manuscripts*” services in class 41.

53. Turnover figures are provided for the services under the proprietor’s trademark. This information is taken from a screenshot of the company accounts which is replicated below:²³

Profit and Loss

Virtual Administration Limited
For the period 1 November 2023 to 22 September 2024

1 Nov 2023-22 Sept 2024

Turnover	
Business Continuity Plans	1,615.00
Canada Sales	4,336.95
CQC Plans	9,689.27
Sales	129,728.07
Tender Work	3,767.50
Webinars Evenbrite	11,033.20
Total Turnover	160,169.99

54. Below this Ms Clarke confirms that “*As an estimate the proof reading service would likely be around 5% of the sales, equal to around £6,486.40.*”²⁴ However, I accept that some of these sales will fall outside of the relevant period.

²² Ibid, paragraph 2

²³ Ibid, paragraph 8


²⁴ Ibid

55. With regards to marketing and advertising, it is stated:

“Marketing and advertising spend was £3,709.20 over the period of 1 November 2023 to 22 September 2024. Exhibit VA12 (pages 31 – 35) shows the screen shots from Xero with the breakdown of spending on the different marketing activities.”²⁵

I note that the dates for marketing and advertising spending includes some spending outside of the relevant period i.e. figures from 22 January 2024 – 22 September 2024.

56. Having viewed the documents at Exhibit V12, these relate to 3 invoices for the

proprietor’s services under the mark:  and what is described within the exhibit as a “Log sheet of tasks below showing the proof-reading tasks carried out on 25 and 30 July 2024”.

57. Taking first the invoice evidence, proof reading is not a service expressly referred to within any of the invoices. One invoice refers to services described as ‘*admin tasks*’²⁶ which may refer to proof reading services given the way that proof reading has been marketed as referred to below, however this is not clear, and in any event, the invoice is dated 5 August 2024, which is after the relevant period.

58. As for the log sheet, first and foremost this is also outside the relevant period therefore I will not take account of this evidence for the purpose of acquired distinctiveness. Although I note that proof reading tasks are described and referred under the heading ‘task’ as ‘admin’.

59. In relation to promotional material, I can see that the proprietor has placed an advert in a third-party booklet for the Case Management Society UK (CMSUK) event on 15 May 2024 in London, which states:

²⁵ Ibid, paragraph 7

²⁶ Exhibit V12, page 33

“Whether your case management company is in its infancy or firmly established, you’ll feel the benefits of a Virtual PA providing proof reading, minute taking at MDT meetings, and Qunote email filing.”²⁷

However, this is evidence of advertising that took place after the relevant date for acquired distinctiveness, which is the date of application for invalidity, i.e. 22 January 2024. Therefore, I cannot take this into consideration for acquired distinctiveness.

60. Further there is a LinkedIn post from Tracey Clarke who is described as the director at Virtual Administration Ltd. Contrary to the narrative evidence, it does not show the trade mark but the proprietor’s company name. The post is advertising its proof reading services (amongst others) conducted by Virtual PA’s. It states:

“We love proof reading your initial assessment reports and expert witness reports. We know how important it is, in making sure they read well and are easy to understand, are grammatically correct, with no spelling mistakes, bullet points lined up with proper headers. Let us make you sound professional”²⁸

The post is reproduced below:

²⁷ Exhibit VA5, page 13

²⁸ Exhibit V10, page 26



Although it is unclear how many people have viewed this post, I note that the linked in profile shows that there are 515 followers for Tracey Clarke who is described as the director at Virtual Administration Ltd. In my view, the LinkedIn evidence does not show that the proprietor is attempting to educate the public to view the contested mark as an indication of trade origin, but instead is promoting the personnel and company name. Regardless, the post refers to '4mo' which I understand to be a reference that the post was created 4 months ago. I take this to be 4 months from the date that the evidence was provided which was 24 September 2024, therefore it follows that the post was created in roughly May 2024 which postdates the relevant date and cannot be considered for acquired distinctiveness.

61. In relation to the leaflet evidence that has been placed into goodie bags at conferences, that I have referred to above at paragraph 28. It is observed from the exhibit evidence that these leaflets were distributed at events that ran for 18 months from 2017, and the evidence refers to a deadline for ensuring compliance of 25 May 2018. Therefore, I accept that this evidence shows proof

reading was a task advertised by Virtual Administration prior to the relevant date for acquired distinctiveness under the mark:



62. Taking all the evidence of use of the mark in relation to the class 41 services, “*proof reading of manuscripts*”, I have limited evidence of use of the mark in relation to these services within the relevant period. I do not have particularly large turnover figures, nor do I have any invoices specifically relating to these services that would show the scale and extent of use in the UK within the relevant period. The narrative evidence states that the proprietor’s trade mark is used on the company website, LinkedIn and Twitter within the relevant period. However, the only evidence provided to support this is that of a LinkedIn post discussed above that shows the trademark by the company name, which casts doubt on whether the trademark is present on its website and in particular its other social media platforms, such as Twitter. I have no evidence of promotional activity prior to the relevant date other than leaflets that was distributed within goodie bags at events that ran for 18 months from 2017 and were attended by 1000 attendees. However, I do not have any evidence of exposure of the mark in relation to proof reading services beyond this 18-month period and prior to the relevant date. In absence of any further evidence to show how the mark has been exposed to the public, I would not have been prepared to make a finding that the contested mark has acquired distinctiveness through use for the class 41 services.

63. A finding of acquired distinctiveness would not change the outcome of my decision in relation to the class 45 services.

CONCLUSION

64. The invalidation applicant has partially succeeded under section 3(1)(c). Therefore, '*proof reading of manuscripts*' in class 41 will be removed from registered mark no. UK00003866751. However, the invalidation has failed in relation to the class 45 services, 'consultation in relation to data protection compliance' and 'reviewing standards and practices to assure compliance with laws and regulations', and therefore, the contested mark will remain registered for these services.

COSTS

65. As both parties have enjoyed a roughly equal measure of success, no costs are awarded.

Dated this 9th day of December 2025

**Sarah Wallace
For the Registrar**