

BL O/0518/26

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER UK00004248251
BY THE VIRTUAL ADVISORY BOARD LTD
TO REGISTER THE FOLLOWING MARK IN CLASSES 35 AND 41:**

VIRTUAL ADVISORY BOARD

Background

1. On 12 August 2025, THE VIRTUAL ADVISORY BOARD LTD ('the applicant') applied to register the mark shown above, for the following services:

Class 35: Career advisory services (other than education and training advice); Career information and advisory services (other than educational and training advice); Business networking; Business networking services; Online business networking services.

Class 41: Organisation of educational events; Arranging of educational events; Conducting of educational events; Ticket reservation and booking services for education, entertainment and sports activities and events; Organising of education conferences; Organising of education seminars; Education and training; Training and education services; Education and training services; Adult education services; Career advisory services (education or training advice).

2. On 19 August 2025, the Intellectual Property Office ('IPO') issued an examination report in response to the application. The examination report contained objections under Sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') against all services in Classes 35 and 41.
3. The Section 3(1)(c) objection was raised on the basis the mark consists exclusively of a sign which may serve in trade to designate the intended purpose of the services e.g., organisation of educational events, business networking and career advisory services that provide educational events and advice for board members virtually.
4. In line with standard IPO procedure, the applicant was allowed a period of two months to respond.
5. On 16 September 2025, SPRINTLAW (UK) LTD ("the representative"), acting on behalf of the applicant responded stating that they disagreed with the examination report and provided submissions to say that the mark "*goes beyond describing a generic "advisory board" or network service.*"
6. In response, on 23 September 2025, the examiner issued a letter which confirmed that they had not been persuaded by the representative's submissions and that a further two month period had been allowed for the representative to

respond.

7. No further response was received to the previous correspondence and on 01 December 2025, the examiner confirmed that the objections taken under Section 3(1)(b) and (c) remained and as such the application was being refused under Section 37(4) of the Act.
8. On 12 December 2025, following formal refusal, the applicant responded, (as opposed to their representative), filing the Form TM5, being a request for a written statement of reasons for the Registrar's decision to refuse the application. As the applicant had a named attorney however, the Office required that the Form TM5 be regularised by submission through the attorney not the applicant and the fresh Form TM5 was filed on 23 December 2025. Nothing hinges on this discrepancy however and I will make no further mention of it.
9. On 07 January 2026, the IPO issued correspondence to the representative clarifying the basis of the objection raised under section 3(1)(c) of the Act. Namely, the mark consists, exclusively of a sign which may serve to designate, the type, kind, or subject matter of the services, or the nature of the body providing those services, e.g. a board that provides advice virtually in relation to, for example, career, business, or educational matters.
10. In addition, a separate and contingent objection was raised under section 3(1)(b) of the Act because the mark would simply trigger perceptions in the relevant consumer which are neutral in terms of functioning as a trade mark. As a consequence I will deal in my decision below with both 3(1)(b) and (c) as comprising independent objections.
11. A period of two months for the submission of observations in response was permitted. However, if no response were received in that period the IPO would proceed and issue a statement of reasons in respect of the objection.
12. Having received no response, I now set out my reasons below.

The Law - Sections 3(1)(b) and (c)

13. Section 3(1) of the Act reads as follows:

3(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of 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) ...

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

Relevance of EU Law

14. 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 some decisions of the EU courts which predate the UK's withdrawal from the EU.

The relevant legal principles – Section 3(1)(c)

15. The case law under section 3(1)(c) of the Act was summarised by Arnold J (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc.* [2012] EWHC 3074 (Ch). These are the most relevant points:

- a. The general interest underlying section 3(1)(c) 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.*
- b. With a view to ensuring that that objective of free use is fully met, 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.*
- c. 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. It is, furthermore, irrelevant whether there are other, more issue for designating the same characteristics of the goods or services referred to in the application for registration.*
- d. The situations specifically covered by section 3(1)(c) of the Act 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 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.

- e. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in section 3(1)(c) of the Act 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. A sign can be refused registration on the basis of section 3(1)(c) 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.*
- f. In addition, a sign is caught by the exclusion from registration in section 3(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned.*

16. I have also taken into account the impact on third parties of granting the holder a monopoly in the sign. In this regard, in *Linde A.G. v Rado Uhren A.G.* (Case C-53/01), the Court provided the following guidance:

73. According to the Court's case-law "Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, Windsurfing Chiemsee, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3) any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

Application of the legal principles

- 17. From the aforementioned case law, it is clear I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating characteristics of the services being provided. In order to do this, I must assess who I consider the relevant consumer to be and if they may have any particular characteristics in terms for example of levels of attention in the purchasing process.
- 18. The application is filed in Classes 35 and 41 in respect of a range of services, including career advisory services, business networking, and the organisation, arrangement and conduct of educational events. Accordingly, the relevant consumer is comprised of both professionals and members of the general public.

19. In so far as the Class 35 services are concerned, these are primarily directed at business users and individuals seeking career or commercial advancement. Such consumers are likely to exhibit a higher than average level of attention, given the strategic and professional nature of the services in question.
20. By contrast, the services in Class 41, including the organisation, arranging, and conducting of educational events, are directed at a broader public, encompassing both individual consumers and organisations seeking educational or training services.
21. Having established the relevant consumer, I must assess how they would perceive the words 'VIRTUAL ADVISORY BOARD' in relation to the services claimed in normal and fair use. The following definitions for each constituent word are provided in the Collins English Dictionary:

Advisory - Giving advice; empowered to make recommendations.

Virtual - existing as a computer-generated version that resembles that thing in reality.

Board – a group of people who officially administer a company, trust, etc, or any other committee or council.

22. I am required to determine, on the basis of notional and fair use in trade, whether the sign applied for would be perceived by the relevant average consumer as designating a characteristic of the services claimed. The dictionary definitions set out above demonstrate that the individual components of the sign consist of ordinary English words which are in common usage and readily understood by the UK public. Furthermore, the combination of the words 'VIRTUAL ADVISORY BOARD' together is grammatically correct and conveys a clear and intelligible message.
23. In correspondence the representative submitted that the mark goes beyond describing a generic "*advisory board*" and to the contrary identifies a specific programme with "*defined features*." I respectfully disagree with this submission and the assessment in the *prima facie* under section 3(1)(c) must proceed on the basis of the sign as applied for, considered in the context of notional and fair use across the full range of the claimed services. The precise nature of the applicant's business model or that it is regarded by the applicant as a proprietary programme will not serve to displace the established legal tests set out above, including the clear public interest which underlies the strict provisions.
24. The expression 'VIRTUAL ADVISORY BOARD' is composed exclusively of ordinary, descriptive terms, as defined above, which, when combined, retain their natural and immediately clear meaning. In the context of services in Classes 35 and 41, including career advisory services, business guidance, training, and educational provision, the sign will be readily understood by the average consumer as indicating a format or method of delivery, namely, a board which provides advice virtually, i.e. via an online medium. Such an understanding arises

directly and without the need for any interpretative effort.

25. Accordingly, the sign describes a characteristic of the services, in that it informs the consumer that the services may be delivered through, or relate to, a virtual advisory board. This is apt to encompass, for example, career guidance delivered by panels of experts convened online, or educational programmes involving advisory groups participating virtually.
26. For these reasons, I am not persuaded that the sign departs from its descriptive meaning so as to function as a badge of origin. Instead, it designates, or at least may serve in trade to designate e.g., the type (including subject matter), nature, or delivery format of the services in question, and is therefore objectionable under section 3(1)(c).
27. In light of my finding that the mark 'VIRTUAL ADVISORY BOARD' is excluded from registration under section 3(1)(c) of the Act for the reasons set out above, the matter is determinative on that basis. However, in the event that this conclusion is found to be incorrect, I proceed to consider, in the alternative, a separate and independent objection under section 3(1)(b) of the Act.

The relevant legal principles – Section 3(1)(b)

28. In relation to Section 3(1)(b) it was held in *Postkantoor* case C-363/99 that:

86. In particular, a word mark which is descriptive of characteristics of the goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may nonetheless be devoid of any distinctive character in relation to goods or service for reasons other than the fact that it may be descriptive.

29. I approach this ground of objection on the basis of the following main guiding principles derived from ECJ cases noted below:
- an objection under Section 3(1)(b) operates independently of objections under section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68).
 - for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47).
 - a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86).

30. Furthermore, Ms Anna Carboni sitting as the Appointed Person in *COMBI/STEAM*, BL O-363-09, summarised the case law in respect of this part of the Act when, at paragraph 7, she stated the following:

It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: Procter & Gamble Ltd’s Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86].

31. It is therefore necessary to assess whether the sign is nevertheless devoid of any distinctive character for the purposes of section 3(1)(b) of the Act in relation to the services applied for, notwithstanding that it may not fall within the scope of section 3(1)(c) as designating a characteristic of those services. In my view, even if the mark does not exclusively describe such a characteristic, it remains incapable of fulfilling the essential function of a trade mark, namely, to guarantee the origin of the services. As I have indicated above, the mark comprises of ordinary, commonly understood words which, when encountered in combination by the average consumer, would convey a readily intelligible but non-distinctive meaning, and would not be perceived as an indication of commercial origin.
32. I have found that the sign applied for would not be perceived by the relevant public as a trade mark without prior use sufficient to educate them that it functions as an indication of trade origin. For the sake of clarity, no plea of acquired distinctiveness has been made by the applicant and so I have only the case in the *prima facie* to consider. Accordingly, I conclude that the mark is devoid of any distinctive character and is therefore excluded from *prima facie* acceptance pursuant to section 3(1)(b) of the Act.

Conclusion

33. In this decision, I have carefully considered all the submissions made during the proceedings and, having done so, concluded that for the reasons set out above, the application is refused in respect of the services applied for because it fails to qualify for registration under Section 3(1)(b) and (c) of the Act.

Dated this 19th day of June 2026

**Jon Hayward
For the Registrar
Comptroller-General**