

THIS DECISION IS
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Goodman

Mailed: December 5, 2005

Opposition No. **91125729**

VIRGIN ENTERPRISES LIMITED

v.

ENRIQUE RODRIGUEZ

Before Hairston, Holtzman and Walsh, Administrative
Trademark Judges.

By the Board:

Applicant has filed an application to register the mark VIRGINVISIONS for "computer screen savers recorded on various data storage media, sold as a unit with a mailer usable as a postcard" in International Class 9.¹ As grounds for opposition, opposer alleges that applicant's mark, when used in connection with the recited goods, so resembles opposer's previously used and registered VIRGIN marks as to be likely to cause confusion, or mistake, or to deceive. Opposer has also alleged dilution with its previously registered marks.

Opposer has pleaded ownership of fifteen VIRGIN marks in both standard character form and in stylized form as well

¹ Application Serial No. 76113129, filed August 22, 2000, claiming a date of first use in commerce of May 23, 2000.

as VIRGIN-formative marks. The pleaded registrations include the following: the mark VIRGIN, Registration No. 1469618² for "pre-recorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph recordspre-recorded audio and/or video tapes, cassettes and cartridges" in International Class 9

A handwritten logo for the brand 'Virgin'. The word 'Virgin' is written in a cursive, slanted font. A diagonal line crosses through the word from the top right to the bottom left.

and the mark , Registration No. 1517801³, for "pre-recorded audio and video discs, phonograph records; photographic and cinematographic films" in International Class 9.

Opposer also has pleaded ownership of applications

A handwritten logo for the brand 'Virgin'. The word 'Virgin' is written in a cursive, slanted font. A diagonal line crosses through the word from the top right to the bottom left.

including the following mark  for goods in Classes 9, 32 and 33. The Class 9 goods are as follows: "sound records of music in the form of discs and tapes and cassettes; pre-recorded audio or video tapes, cassettes and cartridges featuring music; pre-recorded audio and video

² Issued January 19, 1995. Section 8 and 15 accepted December 22, 1987.

³ Issued December 27, 1988. Section 8 and 15 accepted October 12, 1994.

discs, phonograph records featuring music; data processors and displays; graphical interface to aid the delivery of interactive products and services by cable or wireless transmission; parts for the aforesaid goods; computer game software; computer software for educational computer games, for calculators, for global computer network access and for music products; computer hardware" in International Class 9.⁴

In its answer, respondent denies the salient allegations in the notice of opposition and has asserted affirmative defenses.

This case now comes up on opposer's motion for summary judgment, filed, November 15, 2004, and applicant's cross-motion for summary judgment, filed February 10, 2005. The motions are fully briefed.

Preliminarily, we note that applicant has moved to strike opposer's declarations provided in support of its motion for summary judgment as being non-compliant with Fed. R. Civ. P. 56 and facially defective. In response, opposer argues that its declarations are entirely admissible because they comply with Trademark Rule 2.20 and 28 USC § 1746.

Applicant's motion to strike is denied. Trademark Rule 2.20 provides for the use of declarations in lieu of

⁴ Application Serial No. 74581589, filed October 3, 1994. Registration issued April 22, 2003 as Reg. No. 2709578. Claiming dates of first use in commerce of 1987 for the Class 9 goods.

affidavits. See also TMEP Section 804.01. Since opposer's declarations comply with Rule 2.20, the declarations are acceptable as are the exhibits introduced with the declarations.

We turn next to opposer's request that the Board not consider applicant's exhibits 2-6 and 11-13 which were submitted in support of applicant's cross-motion for summary judgment because the exhibits are either unauthenticated and/or inadmissible hearsay.

Opposer's request that the Board not consider applicant's exhibits on the ground of hearsay is denied because, upon reviewing the evidence, the Board can decide whether to discount the probative value of any hearsay evidence. Opposer's request that the Board not consider applicant's exhibits which are Internet printouts because they are unauthenticated and not accompanied by a declaration also is denied. The Internet printouts were referenced in and accompanied by Enrique Rodriguez's declaration; therefore, in view of the declaration, the printouts are authenticated. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1371 (TTAB 1998) (declaration stating that printouts were accessed on Internet by declarant sufficient for authentication).

We now turn to the cross motions for summary judgment.

In support of its motion for summary judgment, opposer argues that it has priority because it owns incontestable registrations of VIRGIN and VIRGIN-formative marks applied to a broad range of goods and services⁵, including various computer-related goods and services.

With regard to likelihood of confusion, opposer maintains that the parties' marks are similar because "the distinctive portion" of applicant's mark is VIRGIN (VISIONS being descriptive) which is identical to opposer's VIRGIN marks in "sight, sound and meaning"; that applicant's goods are closely related to the goods identified in opposer's pleaded registrations and are substantially identical to goods distributed by opposer in the United States, namely, computer screen savers and postcards; that the parties' goods are targeted to the same consumers and through the same channels of trade; and that because opposer's VIRGIN marks are inherently distinctive, strong, and famous, confusion is likely.

As evidentiary support, opposer has submitted declarations and accompanying exhibits as well as status and title copies of pleaded registrations. Opposer's attorney,

⁵ Opposer has identified 33 VIRGIN or VIRGIN-formative marks in its motion for summary judgment and included status and title copies of the registrations for these marks. Some of the registrations are unpleaded. Therefore, those that have not been pleaded have been given no consideration. TBMP §528.07(a) (2d ed. rev. 2004).

Ms. Carrie Kingsley, avers that she viewed opposer's website www.virgin.net and downloaded a VIRGIN branded screensaver to a personal computer. Christopher Rossi, head of opposer's U.S Sales and Marketing avers that licensees of opposer have provided air travel, air freight, courier, cargo and related services under opposer's VIRGIN and VIRGIN ATLANTIC marks since 1984; that passengers of opposer's Virgin airline flights receive VIRGIN branded in-flight items such as headsets and may purchase duty-free VIRGIN VODKA, cosmetics, clothing, toys, airplanes, pens, cakes and other VIRGIN branded merchandise during the flight; and that Virgin Atlantic spends \$11 million each year to advertise and promote its VIRGIN ATLANTIC and VIRGIN branded services in the United States. Exhibits include photographs of VIRGIN branded items that are provided in-flight or are available for purchase through Virgin Atlantic's duty free retail catalog.

Mark James, Intellectual Property Manager for opposer, avers that since 1970 opposer and its predecessors have used the VIRGIN mark in association with diverse and numerous goods and services including computer media and accessory products, computer software, compact discs, computer games, audio and video discs, retail store services, travel related services and transportation and airline services; that opposer is the owner of thirty-three United States trademark

registrations and ten incontestable United States registrations for VIRGIN and VIRGIN-formative marks; that opposer licenses its VIRGIN mark for a wide variety of goods and services including computer media and accessory products, computer software, and retail store services featuring, among other things, computer games, audio discs and video discs; that the website www.virgin.com offers screensavers that prominently feature the VIRGIN mark that may be downloaded by Internet users in the United States; and that certain licensee's of opposer distribute screensavers bearing the VIRGIN mark and VIRGIN-branded video discs that are playable on personal computers. Exhibits include a copy of a webpage from www.virgin.com which offers screensavers available for download.

Robert Stohrer, Vice President of Brand and Communications for Virgin Mobile USA, LLC, avers that Virgin Mobile subscribers may download screensavers that users may access on their phones; that scenes of beaches are among the screensavers offered to Virgin Mobile subscribers; that Virgin Mobile phone and accessories are sold at more than 40,000 retail locations in the United States; and that Virgin Mobile advertises its VIRGIN and VIRGIN MOBILE goods and services on postcards and holiday cards that are distributed to the public and may later be used by the public as actual postcards or holiday cards. Exhibits to

Mr. Stohrer's declaration include: Web pages for Virgin Mobile phones which provide for downloadable screensavers including those of beaches and palm trees.

Marc Block, Director of Marketing for Virgin Entertainment Group, licensee of opposer, avers that Virgin and Virgin Megastores chains have operated in the United States since at least 1992; that the Virgin stores distribute a wide variety of goods including "computer software, CDs, DVDs, magazines, games, books and clothing and an array of VIRGIN branded goods"; and that the Virgin Megastore's packaging prominently displays the VIRGIN mark. Exhibits include copies of VIRGIN branded items for sale at Virgin Megastores.

Lori Levin-Hyams, Vice President of Corporate Affairs for parent company of opposer, avers that the VIRGIN brand has been the subject of many books; and that Virgin Group businesses have received national media coverage in the United States.

In opposing the motion and in support of its cross motion, applicant maintains that opposer cannot rely on some of the registrations identified in its motion for summary judgment because the underlying applications were filed after applicant filed its application and/or belong to another party; that opposer lacks standing to challenge applicant's application because opposer has not established

any factual support for its reliance on the entities who are nonparties to the opposition who use VIRGIN marks on various goods and services; and that opposer also lacks standing because it no longer owns and has abandoned the rights to the name Virgin Vision and therefore it cannot challenge applicant's use of VIRGINVISIONS.⁶

With regard to the similarity of the marks, applicant argues that opposer's assertion that the marks are substantially identical is incorrect; that opposer has dissected applicant's mark rather than considering it as a whole; and that the marks are different in sound, meaning, appearance, and commercial impression due to the addition of the term VISIONS.

With regard to the similarity of the goods, applicant argues that there is no similarity between the parties' goods because opposer has no Class 9 goods which are similar or compete with screensaver postcards; that opposer has no evidence of use of its VIRGIN marks on postcards; and that the fact that opposer offers free downloadable screensavers advertising its VIRGIN mark or offers screensavers for mobile telephones is irrelevant and does not support a

⁶ Accompanying Mark James declaration was an exhibit from opposer's website describing opposer's past and present operations. One of the pages from the printout noted that Virgin Vision (later changed to Virgin Communications) was formed in 1983 to distribute films and video in the television broadcasting sector and that in 1989 Virgin Vision was sold to Management Company Entertainment Group in 1989.

finding of confusion since applicant's goods are purchased, not downloadable, and must be mailed.

With regard to the channels of trade, applicant argues that there are no similar trade channels for the parties' goods since applicant's goods are not sold through stores, affiliate websites and Target, Best Buy and Walmart.

With regard to fame, applicant argues that opposer's sales data of fame is irrelevant since there is no evidence that would support a finding of fame in the screensaver postcard market that would entitle opposer to assert sales, advertising or length of use figures. Applicant also argues that opposer's VIRGIN marks are not strong marks due to third party use of the VIRGIN mark on goods and services similar to opposer; that opposer's products are purchased by careful, sophisticated purchasers; and that there has been no actual confusion between the parties' marks.⁷

Applicant has submitted the following evidence in support of its position: Declarations of Kathleen Whisler, Maria van Heurck, Candela Sanchez and the declaration of Enrique Rodriguez, with accompanying exhibits. Kathleen Whisler, employee of Scenic Publishers and Distributors,

⁷ Applicant has also argued that opposer is estopped from asserting a challenge to the registration of VIRGINVISIONS due to the assignment of the VIRGIN VISIONS mark. However, this is an unpleaded affirmative defense that will be given no consideration. TBMP § 528.07(b).

avers that no client who purchased applicant's product has indicated they thought they were purchasing a product connected to opposer; that applicant's product is unique; and that the majority of applicant's goods have been sold in the United States Virgin Islands and the British Virgin Islands.

Maria van Heurck and Candela Sanchez, purchasers of applicant's goods, aver that when they purchased applicant's product they never thought that the product was connected to opposer and that friends and family who received the product never indicated that they thought the product was connected to opposer.

Applicant, Enrique Rodriguez, avers, among other things, that applicant's product is sold in tourist destinations that correspond with the images contained on the screensaver; that the product is not a downloadable screensaver but a postcard that contains a CD inside of it; that no one who has purchased applicant's products to date indicated that they considered the product to be connected with opposer's mark; and that none of applicant's products are sold in opposer's retail stores or on opposer's website.⁸

⁸ Applicant's declaration asks that the Board issue a cease and desist order against opposer to terminate its use of the domain name Virgin Vision. However, the Board is an administrative tribunal empowered only to determine the right to register or maintain a registration; it is not authorized to determine the

In reply on its motion and in response to applicant's cross-motion, opposer argues that it has priority and standing because opposer's licensee's use of VIRGIN marks inures to the benefit of opposer; that opposer's evidence of ownership of ten incontestable U.S. registrations consisting solely or primarily of the word VIRGIN is undisputed; that with regard to the du Pont factors, none of the evidence submitted by applicant raises a genuine issue as to the strength and fame of opposer's mark and therefore opposer's evidence of the strength and fame of its VIRGIN marks are undisputed⁹; that with regard to the similarity of the marks, applicant has offered no evidence about the dissimilarity of the marks to raise a genuine issue and opposer has established that the marks are confusingly similar; that with regard to similarity of the goods, applicant's assertion that the goods are different does not raise a genuine issue and opposer's evidence establishes that opposer's Class 9 entertainment, video and computer-related goods and/or Class 42 retail store services are

right to use. Moreover, the Board cannot enjoin a party from using a mark nor can it award monetary damages. See TBMP § 102.01. See generally *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990). (Board's function is to determine whether there is a right to secure or to maintain a registration).

⁹ Opposer advises that nine of the ten third party users applicant has identified as using the mark VIRGIN are authorized licensees of opposer. Opposer also argues that applicant has not submitted evidence of the consuming public's awareness or extent of third-party uses rendering the probative value of the materials minimal.

closely related to applicant's goods and that opposer's licensees distribute substantially identical goods in the form of VIRGIN branded screensavers and VIRGIN branded postcards; that applicant's evidence of restricted channels of trade should not be considered since the channels of trade of applicant's VIRGINVISIONS application are unrestricted; and that the absence of actual confusion does not prevent entry of summary judgment in favor of opposer.

With its opposition to applicant's motion for summary judgment, opposer submitted the declaration of Mark James, Intellectual Property Manager for opposer, who avers that opposer uses its mark through a number of controlled licensees; and that between July 31, 1989 and July 31, 1992 entities named Virgin Vision Limited, Virgin Vision Inc., Management Company Entertainment Group, and MCEG Virgin Vision Limited were controlled licensees of opposer authorized to use the VIRGIN VISION mark in association with film and video distribution services.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). Each party, in regard to its own motion for summary judgment, bears the burden of showing the absence of any genuine issue of material fact, and that it is entitled to judgment as a

matter of law. See Fed. R. Civ. P. 56(c) and *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). In assessing each motion, the evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

We find the absence of a genuine issue of material fact as to opposer's standing and priority inasmuch as opposer has submitted status and title copies of its pleaded registrations. Applicant's arguments to the contrary notwithstanding, applicant has not counterclaimed to cancel any of the registrations relied upon by opposer; therefore, priority is not an issue as to any of the registered marks. See *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

In addition, the undisputed evidence of record clearly establishes opposer's use and/or licensed use of its VIRGIN (both standard character form and stylized) and VIRGIN-formative marks prior to the filing date of the involved application. Applicant's argument that opposer lacks a direct commercial interest because its licensees sell the goods and services under the VIRGIN marks and because these entities are not party-opposers is unavailing. A licensee's

use inures to the benefit of opposer. *Compuclean Marketing and Design v. Berkshire Products Inc.*, 1 USPQ2d 1323, 1325 (TTAB 1986) (owner and licensor of a mark establishes the commercial nexus for standing in a Board proceeding).

Turning to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion, which would include the similarity of the marks and the similarity of the goods.¹⁰

We turn first to the similarity of the marks. Opposer's VIRGIN (both standard character form and stylized) and VIRGIN-formative¹¹ marks are arbitrary and inherently distinctive. The parties' marks are similar in sound, appearance and commercial impression in that both parties' marks include the identical term VIRGIN.

We are not persuaded by applicant's argument that the marks are different by the addition of the word VISIONS to applicant's mark. Adding additional matter to a registered,

¹⁰ Our primary reviewing Court has held that only those du Pont factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered.

¹¹ With regard to opposer's VIRGIN-formative marks, those marks are dominated by the term VIRGIN since they generally include a descriptive term.

arbitrary mark does not mean that there is no likelihood of confusion. See *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) ("When one incorporates the entire arbitrary mark of another into a composite mark, inclusion in the composite mark of a significant, nonsuggestive element will not necessarily preclude a likelihood of confusion.")

Moreover, VIRGIN is a conspicuous part of both opposer's and applicant's marks as the first word. *Aluminum Air Seal Mfg. Co. v. Trim-Set Corp.*, 208 F.2d 374, 100 USPQ 52, 54 (CCPA 1953). ("Both petitioner's mark and respondent's mark have 'Trim' as the first word which would be spoken in calling for the goods and as the first part of the mark 'Trim' obviously forms a conspicuous part thereof and whether arbitrary, suggestive or descriptive cannot be ignored.") (quoting Examiner-in-Chief's decision with approval). See also *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("Although there are differences in appearance between the marks, there are also similarities between them in that both start with the term 'KID'").

Thus, we have given greater weight to the word VIRGIN in applicant's mark, because it is often the first part of a mark that is most likely to be impressed upon the mind of a purchaser and remembered, and we find that would be the case

here. This is particularly true when considering the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. That is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Spoon's Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1749 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

Accordingly, in considering the marks in their entirety, we find that there is no genuine issue of material fact that applicant's VIRGINVISIONS mark is similar to opposer's VIRGIN (both standard character form and stylized) and VIRGIN-formative marks in sound, appearance and meaning, and that the parties' marks create similar overall commercial impressions. Therefore, this factor favors opposer.

We turn next to the similarity or dissimilarity of opposer's and applicant's goods.

Applicant has argued that there is no similarity between the parties' Class 9 goods. However, we find that there is no genuine issue of material fact that opposer provides similar and/or related Class 9 goods.

Opposer's Class 9 registrations for VIRGIN (both standard character form or stylized) include the goods "pre recorded audio and video discs." This wording is broad

enough to encompass computer screensavers provided on various storage media. At the very least, opposer's prerecorded audio and video discs are closely related to applicant's computer screensavers provided on various storage media. Therefore, we find that opposer's Class 9 goods encompass or are at the very least related to applicant's computer screen savers.

Accordingly, we find that there is no genuine issue that the parties' goods are otherwise closely related items. Thus, this du Pont factor weighs in favor of opposer.

With respect to the channels of trade, we note that neither opposer's Class 9 registrations nor the involved application contains any restrictions as to trade channels. Therefore, applicant's assertions that "there are no similar trade channels" because applicant's product is not sold at "Mega-stores", "affiliate websites and Target, Best-Buy and Walmart," are not well taken. We must presume that applicant's goods are marketed in all the normal channels of trade for the identified goods and to all the classes of purchasers targeted by opposer. *See Kangol Ltd. v. Kangaroo U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992). Therefore, we find that this factor also weighs in opposer's favor.

We also find that there is no genuine issue that opposer's mark is a strong mark in the marketplace. The

fame or strength of a mark is determined by a variety of factors, including the length of time the mark has been in use, the volume of sales under the mark and the extent of advertising or promotion of the goods with which the mark is used. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Therefore, applicant's argument that opposer cannot assert its sales, advertising or length of use figures regarding other goods and services under the VIRGIN (both standard character form and stylized) and VIRGIN-formative marks is unavailing since use of a mark on a wide variety of products is reflective of and emphasizes the mark's strength. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 936 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Opposer has used its VIRGIN marks continuously and without interruption since 1970 in connection with a wide variety of goods and services. Opposer and its licensees promote VIRGIN branded goods and services in television advertisements, radio advertisements, on the Internet, in magazines and periodicals, in direct mailings, on billboards and through its retail partners. (Declarations of Rossi, Block, and Stohrer). The annual advertising budgets for its licensees providing VIRGIN branded goods and services run to millions of dollars including \$3,000,000 (retail), \$11,000,000 (airline), \$35,000,000 (wireless). (Declarations

of Block, Rossi and Stohrer). Sales of its licensed Virgin goods and/or services include \$235,000,000 in U.S. sales in 2003 for Virgin branded retail stores and \$285,000,000 in U.S. revenue from Virgin Atlantic Airways flights from May 2003 through February 2004. (Declarations of Block and Rossi). Thus, the record shows that opposer's promotional efforts have resulted in widespread awareness and recognition of opposer's VIRGIN marks. Similarly, opposer's aggressive trademark enforcement activities reinforce the strength of opposer's VIRGIN marks.

Therefore, we find that there is no genuine issue that opposer's VIRGIN (both standard character form and stylized) and VIRGIN-formative marks are well-known, strong marks and are entitled to a broad scope of protection.

With regard to the sophistication of the purchasers, we find that, applicant's arguments notwithstanding, there is no genuine issue that opposer's goods and services, as well as applicant's goods, would be purchased by ordinary consumers, and there is no evidence that the normal purchasers of the parties' goods and services are especially sophisticated or careful in making their purchasing decisions.

We have considered all of applicant's arguments to the contrary (including arguments not specifically addressed in this opinion), but are not persuaded.

Accordingly, we find no genuine issue of material fact regarding opposer's standing, priority, or likelihood of confusion between the parties' marks.

In view thereof, opposer's motion for summary judgment is granted, the opposition is sustained, and registration to applicant is refused.¹²

¹² Having determined that opposer is entitled to prevail on the ground of likelihood of confusion, we need not reach the issue of dilution.