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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Virgin Enterprises Limited
v.
Albion Motors Ford Mercury, Inc.

Opposition Nos. 91153575, 91153612 & 91154161
to Application Serial Nos. 76256596, 7625149 & 76256597

James Dabney, Victoria J.B. Doyle, Carrie B. Kingsley and
Randy Eisensmith of Fried, Frank, Harris, Shriver & Jacobson
LLP for Virgin Enterprises Limited.

Daniel Van Dyke and Karl D. Ondersma of Van Dyke, Gardner,
Linn & Burkhardt, LLP for Albion Motors Ford Mercury, Inc.

Before Hairston, Drost and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

In these consolidated proceedings, Virgin Enterprises Limited (opposer) opposes three intent-to-use applications filed by Albion Motors Ford Mercury, Inc. (applicant) to register the marks VIRGIN VEHICLE, VIRGIN PURCHASE and VIRGIN SALE on the Principal Register in standard-character form. In all three applications applicant identifies its

services as "automobile and truck dealerships" in International Class 35. Also, in each of the respective applications applicant disclaims the words "VEHICLE," "PURCHASE" and "SALE."

The notices of opposition are identical in all respects other than in the references to the specific application at issue. As grounds for the oppositions opposer asserts both likelihood of confusion under § 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), and dilution under § 43(c) of the Act, 15 U.S.C. § 1125(c). In the notices of opposition opposer states, "Opposer, VEL, and its related companies (collectively, the "Virgin Group"), are now and for many years past have been engaged in the sale and distribution of a wide variety of goods and services under the world-famous VIRGIN mark." Notices of Opp. at ¶ 1. The notices state further that the goods and services offered under the VIRGIN mark include, among others, airline services, transportation services, travel-related services, cargo services, retail store services, alcoholic and nonalcoholic beverages, telecommunications products and services, clothing, luggage, compact discs, computer games, umbrellas, books, records, CDs, audio tapes and videotapes. Opposer relies on several registrations for its VIRGIN marks in these proceedings. *Id.* at ¶ 2. In its answers applicant has denied the essential allegations in the notices of opposition.

I. The Record

The record in these consolidated proceedings is enormous. The record includes the files of the three opposed applications and the pleadings in these proceedings. In addition, opposer filed trial testimony from nine witnesses, including eight officials connected with opposer and one official connected with applicant, along with hundreds of exhibits consisting of thousands of documents, as well as evidence in electronic form. Both opposer and applicant have filed notices of reliance, each relying on hundreds of documents.

Opposer and applicant have filed briefs.

II. Applicant's Objections

Before we address the merits, we must dispose of numerous evidentiary and procedural objections and motions. In its brief applicant lists twenty-eight separate objections related to opposer's main brief and opposer's evidence.

Opposer has also filed a motion requesting acceptance of its reply brief which was filed one day late. The reply brief was due on Friday, July 7, 2006. Opposer filed the reply brief electronically, and it was received in the USPTO on Saturday, July 8, 2006. Applicant opposes the motion for acceptance of opposer's late-filed reply brief.

Also, at the close of opposer's testimony period, applicant filed a motion to strike certain documents opposer submitted under its notice of reliance. In an action dated November 21, 2005 on that motion, the Board deferred action with respect to applicant's substantive objections and sustained certain objections as to the form of opposer's notice of reliance. In that action, the Board advised applicant that applicant must raise the substantive objections in applicant's trial brief. In accordance with the Board action, opposer has resubmitted the notice of reliance with corrections as to form. Accordingly, we will assume that applicant has raised all remaining substantive objections regarding the evidence, as directed, in applicant's brief. See *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007).

First we will address the objections and motion related to the consideration of opposer's briefs. In objection 11, applicant objects to our consideration of opposer's main brief on the ground that opposer failed to serve the brief on applicant in accordance with 37 C.F.R. § 2.119(d). Applicant's Brief at 37. More specifically, applicant asserts that opposer served its main brief on applicant by email, a means of service not provided for in the rules, though permitted if the parties agree to service by email. Applicant further asserts that applicant had not agreed to

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receipt of opposer's main brief by email. It is apparent that applicant did receive opposer's main brief on time. Applicant, in fact, responded to opposer's main brief. In view of the totality of the circumstances, we exercise our discretion to accept and consider opposer's main brief. We find that the email transmission in no way prejudiced applicant. In fact, it appears that applicant received the brief sooner than it would have if the brief had been mailed. Nonetheless, we urge parties to discuss and reach an agreement concerning these logistics to avoid unnecessary disputes over form.

Opposer has filed a motion requesting acceptance of its reply brief, which was apparently filed one day late. While applicant has objected to the acceptance of opposer's reply brief, it has not pointed to any prejudice to itself. Under the circumstances of this case, we grant opposer's motion to accept its reply brief although we add, the brief does not change the outcome of this case.

Next, in applicant's objection 1, applicant objects to "... any attempted reliance by VEL [opposer] to any registrations or applications or other purported marks that were not pleaded in VEL's Notice of Opposition." Applicant's Brief at 33. Applicant's objection is well taken, and accordingly we sustain the objection.

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Furthermore, applicant notes that opposer referred to eighteen registrations and three applications for VIRGIN marks in each of the notices of opposition, and that opposer provided status and title copies of only eighteen registrations under opposer's notice of reliance. With its notice of reliance opposer did provide status and title copies of numerous additional registrations which opposer failed to plead in the notices of opposition. Opposer made no attempt to amend its notice of opposition for this purpose. Accordingly, for the purposes of these proceedings, we have limited our consideration to the marks and goods and services covered by the eighteen registrations owned by opposer which opposer both pleaded in its notices of opposition, and as to which opposer filed status and title copies in its notice of reliance. We identify the particulars of those eighteen registrations below. We hasten to add that applicant has vastly underestimated the importance and scope of these eighteen registrations as we discuss below.

We note further that the marks in these eighteen registrations are the only VIRGIN marks which opposer has pleaded. Therefore, in accordance with applicant's objections, we also have limited our consideration in these proceedings to those marks identified in the eighteen registrations. This determination effectively disposes of

applicant's objections 2 and 3 related to evidence regarding the VIRGIN LIMO mark, one of the VIRGIN marks which opposer failed to plead.

Next in objections 4 and 5 applicant objects to certain of opposer's evidence related to its use of the VIRGIN marks with respect to limousine services. *Id.* at 35. We note that among the eighteen VIRGIN registrations before us are opposer's Reg. No. 1851817 for the mark VIRGIN in standard-character form and Reg. No. 1852776 for the VIRGIN mark in special form shown below. Each covers, among other services, "transportation of ... passengers by road..." Also, Reg. No. 2482726 for the mark VIRGIN ATLANTIC VACATIONS in standard-character form, which is also before us, covers, among other services, "transportation of ... passengers by road ... transportation of human beings by means of land vehicles ... chauffeur services." Therefore, opposer's registrations effectively cover use of the VIRGIN marks with respect to limousine services. Accordingly, we need not and do not rely on any other evidence, including the evidence applicant objects to here, for the purpose of opposer's use of the VIRGIN marks with respect to limousine services.

In objection 6, applicant objects to Opposer's Test. Exh. 13, a brochure promoting certain services under the VIRGIN ATLANTIC and VIRGIN marks for lack of foundation because Mr. Bershefsky, the authenticating witness,

indicated that he did not know whether the brochure had been distributed to the public. *Id.* at 36. We sustain the objection; we have not considered this brochure in reaching our decision here.

In objection 7, applicant objects to the testimony from opposer's witness, Mr. Block, with regard to the number of "views" of bags used by Virgin Megastores, as speculative. *Id.* We sustain the objection. We will consider only the number of bags in our decision of the case.

In objection 8, applicant objects to "opposer's reliance on Board proceedings and court proceedings to establish the fame of its mark." *Id.* We sustain the objection to the extent that we will not adopt any findings of fact or conclusions of law reached in those proceedings. The parties, marks and evidence in those proceedings differ from those in the proceedings before us. We will consider the evidence of these proceedings for the limited purpose of evaluating the extent to which opposer has policed the VIRGIN marks, and for whatever bearing those policing efforts might have on the strength of opposer's VIRGIN marks.

In objection 9 applicant objects to "... any attempted reliance by VEL to (sic) the 'VIRGIN SALE' mark." *Id.* We susutain the objection; opposer did not plead the VIRGIN SALE mark.

In objection 10 applicant objects to opposer's reliance on Test. Exh. 212, the book *The World's Greatest Brands, an International Review by Interbrand* as hearsay. *Id.* at 37. We overrule the objection. Opposer's witness, Ms. Levin-Hyams, adequately authenticated the publication. Furthermore as to the hearsay issue, we regard this and similar publications both opposer and applicant have submitted as being submitted to show that the content of the publications appeared before the public, not for the truth of that content. To the extent applicant raises hearsay objections in any of its enumerated objections to any other similar publications opposer placed in evidence, we likewise overrule those objections.

With regard to applicant's objection 12 to opposer's submission of additional pages from the article in Exh. 141 to Opposer's Notice of Reliance, we sustain the objection. *Id.* at 38. We will not consider the additional pages to the exhibit which opposer provided only with its substitute notice of reliance.

In objection 13, applicant objects to Exhs. 147-150 to Opposer's Notice of Reliance. *Id.* We first note that opposer withdrew Exh. 147 when it filed its substitute notice of reliance. As to Exhs. 148 to 150, we sustain applicant's objection on the grounds that the printouts from certain web sites are not proper subject matter for a notice

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of reliance under 37 C.F.R. § 2.122 because they are copies from web sites and, as applicant alleges, there is no indication in the record that these materials are available to the public in printed form.

In objection 14 applicant objects to Exhs. 135, 139, 145, 146 and 151 to Opposer's Notice of Reliance. *Id.* With regard to Exhs. 135, 139 and 151 applicant asserts that the publications are not generally available to the public because the documents state that they are published in the United Kingdom, with no indication that they were distributed or otherwise available in the United States. We concur and sustain the objection with regard to this evidence. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 n.3 (TTAB 1986), *aff'd*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

With regard to Exhs. 145 and 146, applicant does not explain specifically why we should not regard these publications as generally available to the public. In fact, each of these documents bears a stamp indicating that the documents were obtained through the Burrelle's clipping service and an indication of the publication name, and the date and place of publication, indicating that both were published in the United States. We overrule the objection as to these exhibits.

In objection 15 applicant objects to opposer's Test. Exh. 1 for failure to authenticate and lack of foundation. *Id.* at 39. The exhibit is a printout from opposer's web site. We overrule the objection. The authenticating witness, Mr. Bershefsky, an official with Virgin Atlantic Airlines, one of the Vrigin Group companies, is competent to recognize and authenticate a printout from a Virgin Group web site, even though he did not print it out himself and even though he did not know precisely who did print it out.

In objection 16 applicant objects to Test. Exh. 3 "to the extent the document contains merely prospective budgeted advertising figures." *Id.* at 40. We sustain the objection.

In objection 17 applicant objects to Test. Exh. 4 because it is an advertisement which which ran in the United Kingdon only, and on other grounds. *Id.* We sustain the objection on the grounds that there is no evidence that the advertisement was run or seen in the United States.

In objection 18 applicant objects to Test. Exh. 5 arguing that opposer's authenticating witness, Mr. Bershefsky, testified that it was "not an advertisement." *Id.* In its argument applicant quotes the witness in misleading fashion. In cross examination, the witness explains quite clearly, "...this piece as we were describing was used to - used within specific companies or places we were going to alert the people in the company that the road

trip truck was outside the location." Bershefsky Test. at 121-122. The exhibit is clearly admissible as a promotional piece to show how opposer promoted its mark in relation to airline services, the focus of the "road trip" promotion. Accordingly, we overrule the objection.

In objection 19 applicant objects to opposer's Test. Exhs. 22-28 for failure to authenticate and lack of foundation. *Id.* The exhibits are copies of a promotional piece, duty-free catalogs and inflight magazines used in conjunction with opposer's airline services. Applicant argues that the exhibits should be excluded because the authenticating witness did not create them or retrieve them from the company archive personally. The witness, Mr. Bershefsky, as the brand marketing manager for Virgin Atlantic Airlines, is competent to recognize and authenticate these documents. We overrule the objection.

In objections 20 and 21, applicant objects to Test. Exhs. 214-217, 235 and 236 as hearsay, for failure to authenticate and/or for lack of foundation. *Id.* at 41. The exhibits are portions of various published books about Richard Branson, the principal owner of and moving force behind the Virgin Group of companies, or about the Virgin Group's brands. We overrule the objections. The books would qualify for submission under a notice of reliance under 37 C.F.R. § 2.122. It would be illogical to exclude

the same type of material when introduced by a witness - here Ms. Levin-Hyams, an official with the Virgin Group of companies. We will consider the material for whatever probative value it possesses.

In objection 22 applicant objects to Test. Exh. 239 because "VEL's identifying witness testified that she did not know where the exhibit came from." *Id.* In fact, the witness, again Ms. Levin-Hyams, testified that the article came from Bacon's clipping service. We overrule the objection.

In objections 23 and 24 applicant objects to Opposer's Test. Exhs. 240 and 241 which are CDs containing footage related to Virgin Group promotional activities. *Id.* Although Ms. Levin-Hyams testified that she was familiar with the content applicant objects because the witness did not personally witness the transfer of the material to CDs for submission in the case. We overrule the objection.

In objection 25 applicant objects to Opposer's Test. Exhs. 242 and 243, copies of articles regarding the Virgin Group from the *New York Times* because the authenticating witness, again Ms. Levin-Hyams, did not clip and copy the articles herself. *Id.* at 42. In fact, the witness testified that she had read the articles herself when they appeared and directed the copying of the articles; she thus went beyond what would be required to authenticate the

exhibits under the circumstances. We overrule the objection.

In objection 26 applicant objects to Test. Exhs. 244 and 245, copies of pages from the Fox TV website promoting "The Rebel Billionaire - Branson's Quest for the Best" again because Ms. Levin-Hyams, the authenticating witness, did not personally obtain the copies. *Id.* The witness testified that she had the pages in her own records and recognized them. We overrule the objection.

In objection 27 applicant objects to Test. Exh. 57 because opposer failed to provide a copy to applicant. The exhibit appears to be a media plan for August 2004 related to future advertising of the Virgin Megastores. Opposer did not respond to this objection in its reply brief. Accordingly, we sustain the objection.

In objection 28 applicant objects to Test. Exhs. 1 through 248, which includes all such exhibits, for failure to make the exhibits available prior to the testimonial depositions and for failure to supplement answers to certain related interrogatories propounded by applicant. We overrule the objections.

Opposer was under no obligation to make exhibits presented through testimony available to applicant in advance of the testimonial depositions. Applicant elected to take part in the depositions by telephone. Applicant

could have attended the depositions and viewed the exhibits at that time. Furthermore, it appears most of the exhibits were made available to applicant prior to or at the time of the depositions, as evidenced by the extensive cross examination applicant conducted with regard to specific exhibits. There is no evidence that opposer intentionally withheld documents. In fact, it appears that opposer tried to accommodate applicant when problems arose - problems which are inevitable when so many documents are involved.

Furhermore, we will not entertain a global objection of this sort based on failure to meet discovery obligations without particulars as to the exhibits and other cirucmstances, including evidence as to responses and documents which were, in fact, provided during discovery. Cf. *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d at 1106. See also *CareFirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005).

Finally, we note that opposer has referred to certain uses of its VIRGIN marks outside the United States in its notices of opposition and in its arugments. Furthermore, certain of opposer's evidence either relates to use outside the United States or comingles use within and outside the United States. Although applicant has not specifically objected to these claims or opposer's evidence on this ground, we note here that we have not considered any use by

opposer of its marks outside the United States nor any evidence relating to such use in reaching our decision here.

III. Standing

Opposer has shown that it has used the VIRGIN marks in the United States and that it is the owner of numerous U.S. registrations for those marks. Accordingly, opposer has established standing. *See generally Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

IV. Priority

For purposes of the likelihood-of-confusion claim, priority is not at issue in these proceedings. Opposer has made of record valid and subsisting registrations for various VIRGIN marks which it owns. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

V. Findings of Fact

At the outset we note that both opposer and applicant have submitted certain information regarding their businesses, principally specific financial information, under claims of confidentiality. Both parties' claims are appropriately narrow and within reason, and therefore we will respect those claims. Consequently, we are somewhat constrained in our discussion of specific information regarding the activities of both parties.

A. Opposer

Opposer is the owner of various marks consisting in whole or in part of the word VIRGIN which it uses through a number of related companies. The related companies include the Virgin Group of companies, referenced above, which are substantially owned and controlled by Richard Branson, and certain licensees not owned by Mr. Branson. James Test. at 6. The scope of the businesses which the Virgin Group operates is expansive to say the least; there are in excess of 200 businesses. Test. Exh. 95.

More importantly for our purposes, as noted above, opposer is the current owner of eighteen valid and subsisting registrations for the VIRGIN marks which are in evidence in these proceedings. Those registrations include the following:

Reg. No. 1413664 for the mark VIRGIN in standard-character form for air travel services, in International Class 39;

Reg. No. 1469618 for the mark VIRGIN in standard-character form for pre-recorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records, in International Class 9;

Reg. No. 1597386 for the mark VIRGIN in standard-character form for printed sheet music; mounted photographs; posters, fictional and non-fictional books, biography and autobiography books, periodicals, namely, journals, paperback books all dealing with music, films and entertainment; paper for packaging, paper cases; stationery and office supplies, playing cards, in International Class 16, and belts, articles of outer clothing, namely, shirts, t-shirts, sweat

shirts, jackets, hats, clothing caps, clothing belts, in International Class 25;

Reg. No. 1851817 for the mark VIRGIN in standard-character form for transportation of goods and passengers by road, air freight transportation services; travel agency services, in International Class 39; and bars; and retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus, and watches, sheet music, books and photography, handbags, purses, luggage and leather goods, clothing, games, video game machines and video game cartridges, in International Class 42;

Reg. No. 2586162 for the mark VIRGIN in standard-character form for articles of luggage, namely, suitcases; bags; namely, back packs, rucksacks, school bags, school satchels, travelling bags, sports bags, all purpose sports bags for campers and climbers, textile shopping bags; wallets; umbrellas and parasols, in International Class 18;

Reg. No. 2625455 for the mark VIRGIN in standard-character form for providing an on-line shopping mall via a global computer network; providing business information via a global computer network, in International Class 35, and computerized communication services, namely, electronic mail services, and providing networks for the purpose of transmission and reception of electronic mail, computer generated music, news and other data and information; and broadcasting services by radio and over a global computer network of a wide variety of programs, namely, current events, economics, politics, sports, entertainment, the arts and business, in International Class 38;

Reg. No. 1517801 for the mark shown below for pre-recorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records; photographic and cinematographic films, in International Class 9;



Reg. No. 1591952 for the mark shown below for printed sheet music; fictional and non-fictional books, biography and autobiography books, periodicals, namely, paperback books all dealing with music, films and entertainment; paper for packaging, paper cases; writing instruments, namely, pens, pencils, ball point pens, stationery and office supplies, namely, writing and note paper, playing cards, in International Class 16, and articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps, clothing belts, in International Class 25;

A handwritten logo for 'Virgin' in a cursive, slanted font. The word is written in black ink and is crossed out by a single diagonal line from the bottom left to the top right.

Reg. No. 1852776 for the mark shown below for transportation of goods and passengers by road, air freight transportation services, in International Class 39; and bars; rental of food service equipment; namely, vending machines; portrait and aerial photography; typesetting and printing services; and retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus; and watches; sheet music, books and photography; handbags, purses, luggage and leather goods; clothing; games, video game machines and video game cartridges, in International Class 42;

A handwritten logo for 'Virgin' in a cursive, slanted font. The word is written in black ink and is crossed out by a single diagonal line from the bottom left to the top right.

Reg. No. 2600080 for the mark shown below for non-alcoholic beverages, namely, soft drinks, in International Class 32, and stating "The drawing of the trademark is lined for the color red.";



Reg. No. 2482726 for the mark VIRGIN ATLANTIC VACATIONS in standard-character form for transportation of and arranging transportation of goods and passengers by road, rail, air and sea; transportation of human beings by means of land vehicles; automobile and motorcycle rental services; chauffeur services; tourist agency services; travel agency services, namely, making reservations and bookings for transportation; arranging and/or conducting travel tours; and arranging visits to places of interest, in International Class 39, and making hotel reservations for others; arranging, organizing and providing facilities for exhibitions and conferences; and providing beauty salons and hairdressing, massage, manicure and pedicure services, in International Class 42, with "VACATIONS" disclaimed;

Reg. No. 2488605 for the mark VIRGIN CARGO WINGS in standard-character form for freight airline services; arranging of transportation of goods by air; packaging and storage of goods, in International Class 39, with "CARGO" disclaimed;

Reg. No. 2536973 for the mark shown below for charitable fundraising, in International Class 36, with "HEALTHCARE FOUNDATION" disclaimed;



Reg. No. 1863353 for the mark VIRGIN MEGASTORE in standard-character form for retail department store services, in International Class 42, with "MEGASTORE" disclaimed;

Reg. No. 2237092 for the mark VIRGIN VACATIONS in standard-character form for arranging the transport of passengers by air and road, arranging and conducting travel tours, travel agency services, namely, making reservations and bookings for transportation, and transportation reservation services, in International Class 39; and resort hotel and hotel reservation; travel agency services, namely, making reservations and bookings for temporary lodging, in International Class 42;

Reg. No. 2151589 for the mark VIRGIN VODKA in standard-character form for vodka, in International Class 33, with "VODKA" disclaimed;

Reg. No. 2507654 for the mark shown below for non-alcoholic beverages, namely, soft drinks, and syrups and preparations for making soft drinks, in International Class 32, and spirits, in International Class 33, with "TRADING COMPANY" disclaimed;



and

Reg. No. 2639079 for the mark VIRGIN HOLIDAYS in standard-character form for transportation of passengers and goods by road, rail and air; arranging of package holidays; arranging and organizing tours; arranging visits to places of interest; tourist office services; travel agency services, namely, making reservations and bookings for transportation; transportation reservation services, in International Class 39 and travel agency services, namely, making reservations and bookings for temporary lodging, in International Class 43, with "HOLIDAYS" disclaimed.

Applicant has, perhaps, overlooked the forest for the trees in presenting its case. The scope and importance of

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these eighteen registrations cannot be underestimated. The registrations, shown above, cover a significant number of variations on the VIRGIN marks. More importantly, the registrations for marks which consist of either VIRGIN alone in standard-character form or of VIRGIN alone in stylized script cover a vast variety of goods and services. They identify services ranging from transportation and travel, to bar services, to communications services, to online sales and retail store services for a wide variety of goods. The goods identified in the registrations range from audio and video recordings in varied forms, to clothing, to luggage, to publications, to stationary and office supplies, to alcoholic and nonalcoholic beverages.

As we stated above, among the eighteen VIRGIN registrations before us are opposer's Reg. No. 1851817 for the mark VIRGIN in standard-character form and Reg. No. 1852776 for the VIRGIN mark in special script. Each covers, among other services, "transportation of ... passengers by road..." Also, Reg. No. 2482726 for the mark VIRGIN ATLANTIC VACATIONS in standard-character form, which is also before us, covers, among other services, "transportation of ... passengers by road ... transportation of human beings by means of land vehicles ... automobile and motorcycle rental services; chauffeur services."

The registrations for variations on the VIRGIN mark identify still more goods and services. Mr. Branson, the Virgin Group and the VIRGIN brands have been the subject of numerous books and features. See, e.g., Opposer's Test. Exh. 212-217. Mr. Branson has appeared on numerous telecasts in the United States, including on CNN, NBC and Fox where he has promoted the VIRGIN marks. Levin-Hyams Test. at 26-35. Thus, Mr. Branson's notoriety has attracted significant attention for himself, for the companies he owns and controls and for the VIRGIN marks.

In the United States, one of the principal services opposer offers under the VIRGIN mark is airline services. Opposer has offered this service since 1984. The service has operated between the United Kingdom and certain U.S. cities, including Boston, Las Vegas, Los Angeles, Miami, Newark, New York, Orlando, San Francisco and Washington, D.C. Bershefsky Test. at 9-10. Opposer offers many "extras" with its airline service, most notably limousine service to and from airports for departure and on arrival, including at airports opposer serves in the United States. Bershefsky Test. at 27-28. The "extras" have also included an amenities kit, a catalog and magazines featuring the VIRGIN marks. James Test. at 22.

While opposer is not one of the largest air carriers operating in the United States, the service it has provided

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is significant in terms of both length of service, revenue and numbers of passengers carried. *Id.* at 10 *et seq.*

Opposer has conducted significant advertising related to its airline service in media including print, radio and television. *Id.* at 13. For example, opposer has run ads in major U.S. newspapers and magazines, including, *The New York Times*, *The Wall Street Journal*, *The Washington Post*, *The Boston Herald*, *The San Francisco Chronicle*, *The Los Angeles Times*, *Newsweek*, *Forbes*, *Fortune*, *The Economist*, and *Business Week*. *Id.* at 16-17.

The Virgin Group has also sold significant numbers of musical recordings under the VIRGIN mark in the United States since the early 1990s. James Testimony at 85. The Virgin Group has operated retail stores under the VIRGIN and VIRGIN MEGASTORE marks in as many as twenty major U.S. cities since 1992 (Test. Exh. 185); the Virgin Group also sells VIRGIN MEGASTORES' products online. The stores carry musical recordings, DVDs, clothing, books and magazines, games and other products. Many of the stores are located in prime, high visibility locations, such as, Times Square and Union Square in New York City, Michigan Ave. in Chicago, Mass. Ave. and Newbury St. in Boston, Market St. in San Francisco and Sunset Blvd. in Los Angeles. Block Test. at 19. The signage at these locations, as illustrated in Test.

Exh. 189 showing the Time Square location, is highly visible.

Opposer has experienced substantial sales at its retail and online stores. Opposer has placed a substantial amount of advertising with regard to its stores in local and national print media, and on television and radio in the cities where the stores operate. *Id.* at 12. Over 31,000,000 people visited the stores in 2003. *Id.* at 19. The stores use/distribute approximately 8,000,000 shopping bags per year using the VIRGIN and VIRGIN MEGASTORE marks. *Id.* at 31. See Test. Exhs. 89 and 208. Opposer logs between 30,000 to 50,000 hits at its VIRGIN MEGASTORE web site each month. Opposer hosts approximately 300 in-store events per year at its stores. Block Test. at 51.

Opposer also provides a wide variety of communications services under the VIRGIN and VIRGIN MOBILE marks. Reg. No. 2625455, noted above, for the mark VIRGIN in standard-character form, among other services, covers "computerized communication services, namely, electronic mail services, and providing networks for the purpose of transmission and reception of electronic mail, computer generated music, news and other data and information; and broadcasting services by radio and over a global computer network of a wide variety of programs, namely, current events, economics, politics, sports, entertainment, the arts and business." Although the

registration arguably does not cover cellular telephone service, Virgin Mobile renders the services referenced here, along with its cellular telephone service. Stohrer Test. at 13 and 67.

The rights conferred by the registration date from the filing date of December 17, 1998. Virgin Mobile began actively marketing its communication services in July 2002. *Id.* at 86.

Opposer uses both the VIRGIN and VIRGIN MOBILE marks consistently in the rendering of these communications services. Although, the VIRGIN MOBILE mark is not among the marks pleaded here, the VIRGIN MOBILE mark is consistently used/displayed in a manner where VIRGIN creates a distinct commercial impression apart from the generic MOBILE element which is consistently displayed less prominently and separate from VIRGIN as shown here:



VIRGIN appears in the familiar script form shown above. See, e.g., Opposer Test. Exhs. 135-165 and 178. Thus, opposer has used the VIRGIN mark covered by its registration in conjunction with the communications services identified in the registration.

Opposer's use of the VIRGIN mark in conjunction with communications services has been extensive. Opposer has promoted the VIRGIN mark for its communications services primarily to the youth market over a wide geographic area. *Id.* at 11. Opposer offers its communications services through 12,000 outlets, including its own Virgin Megastores and major retailers, such as, Best Buy and Target. Opposer has expended significant sums in advertising and promoting its VIRGIN mark in connection with its communications services. *Id.* at 6. Opposer has advertised in virtually all forms of print and electronic media, in major magazines, through radio and over national television, including MTV, BET, and Comedy Central, and on stations on the ABC, CBS, NBC and Fox networks. *Id.* at 54. Opposer has also conducted extensive promotions in relation to its communications services.

As a consequence of these efforts opposer has, in a relatively short period of time, secured significant recognition of its VIRGIN mark in connection with communications services. *Stohrer Test.* at 83.

What is most impressive about opposer's advertising and promotional activities in general is the effectiveness of its public relations activities in addition to the placement of paid advertising. This applies to its airline services, its retail services and its communications services.

The promotions take many forms. For example, opposer conducted a "Virgin Across America" road show to promote its airline services. In this promotion opposer outfitted a tractor trailer to replicate the interior of its aircraft. The tour visited numerous locations across the United States and generated substantial publicity in the process. See, e.g., Test. Exh. 5, Bershefsky Test. 122-123.

As we indicated, opposer conducts approximately 300 in-store events at its retail stores per year. These events include appearances by celebrities, such as recording artist Ricky Martin. See Opposer's Test. Exh. 191, *Newsday* article dated May 22, 2003.

The events also include promotions, such as one conducted in nine U.S. cities in conjunction with VOLVO, which featured the introduction of a new VOLVO model. The cars were displayed inside and outside the stores, and test drives were offered. The event featured a sweepstakes where the winner was flown from the United States to London and then Sweden where the winner selected a VOLVO automobile which was then shipped to the winner in the United States. Egelhoff Test. at 29. Another similar program was conducted in the stores with BMW in 2003. *Id.* at 50. The BMW promotion was conducted at all U.S. stores, and again, BMW automobiles were given to certain individuals. *Id.* at 51.

Opposer also ran the "Virgin College MegaTour" promotional program wherein its goods and services were promoted along with the goods of other companies, including auto companies, at numerous college campuses in the United States. *Id.* at 51. There was extensive media coverage of the college tour. Test. Exh. 54.

The impact of these promotions is evident. The record includes copies of several hundred articles featuring the Virgin Group and its VIRGIN branded goods and services. The publications where the articles appeared run the full gamut, from national to local, from magazines to newspapers, from general interest to special interest. They include local newspapers, among others, in Columbus (OH), Las Vegas, St. Petersburg, Spokane, Austin, Reading (PA), and Grand Rapids, as well as, *The Wall Street Journal*, *The Boston Globe*, *The New York Times*, *The Salt Lake Tribune*, *Newsday*, *The Washington Post*, and *The Arkansas Democrat Gazette*, and major magazines, such as *Forbes*, *Women's Wear Daily*, *Black Enterprise*, *Consumer Electronics*, *Daily Variety*, *Rolling Stone*, *The National Enquirer*, *People*, *Harper's*, *Business Week*, and many others. See Test. Exhs. 30, 218-234 and 191-193. The subject matter of the articles ranges from Mr. Branson, the performance of the Virgin Group businesses, the Virgin Group products and services and primarily opposer's promotional activities and events. In virtually all

instances the VIRGIN marks are referenced. A *Wall St. Journal* article of May 14, 2004 even discusses the opposer's environmental programs. Test. Exh. 191.

In sum, the record establishes that opposer's extensive and varied advertising and promotional activities have resulted in a widespread awareness of the VIRGIN marks.

Furthermore, opposer has provided an impressive record of its policing activities to enforce its rights in the VIRGIN marks. See Opposer's Notice of Rel. Exhs. 50-122.

B. Applicant

Applicant is a family-owned Ford and Mercury auto and truck dealership in Albion, Michigan where applicant sells and services new and used vehicles from one location. Vann Test. at 9, 15-16. William Ward Vann is part owner and principal manager of the business. *Id.* at 15-16.

Applicant also sells vehicles through its dealership online. *Id.* at 35. In addition, applicant offers vehicle rentals in conjunction with its dealership in association with ENTERPRISE car rental. *Id.* at 9.

Applicant offers a program whereby customers may custom order a vehicle either at the dealership or online. Applicant uses the VIRGIN SALE, VIRGIN VEHICLE and VIRGIN PURCHASE marks in conjunction with this program. Applicant states, "The business strategy behind custom ordered new vehicles in conjunction with the marks is based on the

perceived strong association that a consumer will make with the marks to custom ordered vehicles, the manufacturing element of the word 'virgin,' and 'the newness, purity, first-time element of the custom-ordered vehicle,"

Applicant's Brief quoting from Vann Test. 54 and 64.

Applicant maintains an Internet site and uses its VIRGIN marks on that site. *Id.* at 17; App. Test. Exh. 6.

Applicant states the following on its web site with regard to each of its VIRGIN marks:

Virgin Vehicles™ - Any vehicle of transportation custom ordered and custom manufactured for the first end user; not previously available to others; Virgin Ford.

Virgin Purchase™ - To acquire something by custom order and custom manufactured first, genuine and pure by sacrifice (money), to acquire a **Virgin Vehicle™**.

Virgin Sale™ - Selling or being sold that is custom ordered and custom manufactured for and by the first end user; genuine and pure, selling a **Virgin Vehicle™**.

App. Test. Exh. 6.

Applicant has used its VIRGIN marks since 2002. Vann Test. at 25. Ford Motor Company has asked applicant not to use the term "VIRGIN" in conjunction with its FORD mark. Vann Test. at 44. Applicant generally advertises locally. *Id.* at 15-16.

VI. Discussion

A. Likelihood of Confusion

We first address opposer's claim of likelihood of confusion. The opinion in *In re E. I. du Pont de Nemours &*

Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), sets forth the factors to be considered in determining likelihood of confusion. We must determine the issue of likelihood of confusion in each case based on the evidence of record relating to the factors. *In re Majestic Distilling Co.*, 315 F.3d 1301, 65 USPQ2d 1201, 1203-04 (Fed. Cir. 2003). Accordingly, we will discuss each of the factors as to which opposer or applicant have presented evidence or arguments.

1. Fame

We begin our discussion with the *du Pont* factor related to the fame of opposer's mark because fame of the prior mark, if it exists, plays a dominant role in likelihood of confusion cases. *Recot, Inc. v. M. C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000).

In determining fame in this case we focus our attention on the VIRGIN mark itself, that is, VIRGIN alone in standard-character form and VIRGIN in stylized script, as shown above. We conclude that VIRGIN has achieved significant fame in the fields of airline services, in the retail store and online sale of recorded music and related products and in the field of communications. In reaching these conclusions we have relied primarily on opposer's evidence with regard to (1) the length of time it has provided the relevant services under the VIRGIN mark, (2) the sales and advertising activities related to those

services, and most importantly (3) the evidence opposer provided of the public recognition of the VIRGIN mark as used in conjunction with these services. The principal evidence of the public recognition of the mark is the evidence of the media attention opposer generated with regard to the VIRGIN mark as used in connection with these services as a result of opposer's advertising and promotional efforts. This evidence is impressive both in quality and quantity.

Applicant argues that the VIRGIN mark is not famous. Applicant questions both the quality and quantity of the evidence opposer presented to show fame. In particular, applicant asserts that opposer failed to show fame within a particular product or service category and that opposer failed to establish through its evidence that opposer is a leader in any of the fields in which it uses its mark. Applicant also asserts that opposer's evidence of fame should be rejected because it relates to a period after the filing of the applications and after the filing of these proceedings. Applicant's Brief at 19.

As to the quantity of evidence, in its argument applicant sets the bar very high. In so doing applicant fails to recognize the important difference between the standard for establishing fame for likelihood-of-confusion purposes as opposed to establishing fame for dilution

purposes. As the Court of Appeals for the Federal Circuit has stated, "Fame for likelihood of confusion purposes and fame for dilution purposes, however, are distinct concepts. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (T.T.A.B. 2001). While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame 'varies along a spectrum from very strong to very weak.' *In re Coors Brewing Co.* 343 F.3d 1340, 1341 [68 USPQ2d 1059] (Fed. Cir. 2003)." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

We have concluded that opposer has established significant fame here for purposes of our consideration of likelihood of confusion. We need not and do not consider here whether or not opposer has established the high degree of fame required as an element of a dilution claim. *Cf. NASDAQ Stock Market Inc. v. Antarctica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003); *Toro Co. v. ToroHead Inc.*, 61 USPQ 1164, 1173 (TTAB 2001).

As to the quality of opposer's evidence, here also applicant assumes a standard which is overly rigid. Applicant dismisses sales and advertising information as being insufficient and implies that opposer must show that it is an industry leader in the field in which it claims fame.

The evidence of fame in this case, when viewed in its totality, is more than sufficient to establish the fame of the VIRGIN mark in the field of airline services, communications and in the retail store and online sale of recorded music and related products. In fact, the type of evidence of record in this case parallels the evidence of fame in the *Palm Bay* case. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1695. Here we have evidence of use of the VIRGIN mark over a significant period of time, significant sales and significant advertising and promotional expenditures and activities. As we noted, the evidence of public recognition of the VIRGIN mark in the media, large and small, local and national, print and electronic, general interest and special interest, is critical to our finding of fame.

Contrary to applicant's contentions, we find none of the weaknesses in the evidence here the Board noted in the *Blue Man Productions* case. *Cf. Blue Man Productions Inc. v. Tarrmann*, 75 USPQ2d 1811, 1819 (TTAB 2005). We note, in particular, that virtually all of the many hundreds of articles are, in fact, about opposer and its services. The mentions of opposer and the VIRGIN marks are not merely passing references.

We also reject applicant's implication that opposer must establish itself as an industry leader in relevant

fields to show fame. We find no support in the cases for such an inflexible approach. Such an arbitrary rule would unduly limit the consideration of legitimate evidence of fame.

We likewise reject applicant's argument regarding the fields of use. In fact, we have considered fame in relation to specific goods and services, and we have limited our conclusion with regard to fame appropriately in that regard, that is, to the fields of airline services, communications and to the retail store and online sale of recorded music and related products.

Finally, we reject applicant's contention that we should not consider opposer's evidence of fame which relates to a period after the filing of its applications or after the filing of these proceedings. We find no support for this proposition. Again, there is an important distinction between likelihood of confusion and dilution in this regard. The Trademark Act requires that a party asserting dilution in an opposition proceeding must establish that its mark had become famous prior to the filing date of an intent-to-use application. *Toro Co. v. ToroHead Inc.*, 61 USPQ at 1174. In contrast the Trademark Act provides no such limitation in the presentation of evidence of distinctiveness. For example, Trademark Act § 2(f) simply provides that a prima facie claim of distinctiveness assert use "... for the five

years before the date on which the claim of distinctiveness is made." 15 U.S.C. 1052(f). Also, the Board generally accepts and considers evidence related to likelihood of confusion and similar issues for the period up to the time of trial. We see no reason to treat evidence of fame differently. Accordingly, we have considered opposer's evidence of fame without regard to whether it relates to a time period before or after the filing of the applications at issue here or these proceedings.

Accordingly, we conclude that opposer's VIRGIN mark has achieved significant fame in the fields of airline services, communications services and in the retail store and online sale of recorded music and related products.

The degree of fame shown here entitles opposer to a significantly broader scope of protection than would otherwise apply for its VIRGIN marks. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). This factor favors opposer.

2. The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692.

As a preliminary matter we must address opposer's claim that it has a family of VIRGIN marks. The Federal Circuit characterizes a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but also the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

The Board has specified the following requirements to establish a family of marks: "... it must be shown by competent evidence 'first, that prior to the entry into the field of the opponent's mark, the marks containing the claimed "family" feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the "family" feature; and second, that the "family" feature is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark).' *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983)." *Marion*

Laboratories v. Biochemical/Diagnostics, 6 USPQ2d 1215, 1218 (TTAB 1988).

Although opposer refers to its family of marks in the notices of opposition, opposer does not identify which marks are members of that family in the notices. Notices of Opp.

¶¶ 19 and 22. *Cf. Marion Laboratories v.*

Biochemical/Diagnostics, 6 USPQ2d at 1216-17. Likewise, in its briefs opposer fails to identify the marks it considers within the family. Nor does opposer address the "family-of-marks" issue in general directly in its brief. Accordingly, in determining whether the VIRGIN marks constitute a family of marks, we have considered all of the marks identified in the eighteen registrations noted above as potential members of the family. Furthermore, we have considered whether "a substantial number of them were used and promoted together."

Id. In this enormous record, we have identified a few examples of instances where a number of the VIRGIN marks appeared together. For example, in Test. Exh. 56, taken from one of opposer's web sites, we noted uses of the VIRGIN mark along with VIRGIN ATLANTIC, and VIRGIN VACATIONS, as well as a number of unpleaded variations of the VIRGIN marks, such as, VIRGIN MOBILE, and READIOFREEVIRGIN.

However, we have not found sufficient evidence of the type of use and promotion of the potential marks in the family to conclude that there is a family of VIRGIN marks.

Accordingly, for purposes of our comparison of the marks in this case, we will not consider the VIRGIN marks as a family of marks. Therefore, we must compare each of opposer's VIRGIN marks at issue in this proceeding with the marks in the opposed applications.

We begin that analysis by noting that, while we must consider the marks in their entirety, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, "... in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

With regard to opposer's marks, we first note the registrations which opposer has pleaded and made of record, shown above, which cover either VIRGIN alone in standard-character form or VIRGIN alone in stylized script, that is, ten of the eighteen registrations which are properly of record. As we noted above, these registrations, considered alone, cover a wide variety of goods and services, most

notably, all of the services in connection with which we have concluded the VIRGIN mark has become famous.

Secondly, we consider those registrations for standard-character marks which consist of only the word VIRGIN and disclaimed wording which is either descriptive or generic, that is, VIRGIN MEGASTORES, VIRGIN VACATIONS, VIRGIN VODKA and VIRGIN HOLIDAYS. These four registrations add marginally to the scope of the goods and services covered by the ten registrations noted above. In fact, the ten registrations noted cover substantially all of the significant goods and services covered by the eighteen registrations.

Accordingly, for purposes of our consideration of opposer's marks, we have considered only the marks in the ten registrations noted above, those which consist of VIRGIN without any other wording or separate design element. We conclude that the word VIRGIN is either the only or the dominant element in each of these marks. The design element, that is, the script and underlining in the special-form marks, in no way detracts from the dominance of VIRGIN in these marks. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

Likewise, in analyzing applicant's marks, VIRGIN VEHICLE, VIRGIN PURCHASE and VIRGIN SALE, we conclude that the dominant element in each of these marks is also VIRGIN.

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Here also, the only additional element in each case is a disclaimed term which is either descriptive or generic, VEHICLE, PURCHASE and SALE, respectively. Therefore, we conclude that the additional elements in each of these marks in no way detracts from the dominance of VIRGIN in each of applicant's marks.

Furthermore, as to the marks of both opposer and applicant before us here, we note that in each of the marks VIRGIN is the first word. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("... [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

The only significant arguments applicant raises with regard to the similarity or dissimilarity of the parties' marks are (1) that the marks, when viewed in their entirety, differ, and (2) that VIRGIN is a weak, suggestive term.

It is apparent from our discussion here that we reject applicant's argument regarding the comparison of the marks in their entirety. We have considered the marks in their entirety and conclude that VIRGIN is the dominant element in the marks of both parties.

Turning to applicant's argument regarding the strength of VIRGIN, we will address applicant's argument and evidence on that point below under the appropriate factor.

Finally, we have concluded that each of opposer's VIRGIN marks in the ten registrations noted here is similar to each of applicant's marks. In reaching these conclusions we have considered the marks, in every instance, in their entireties. This factor favors opposer.

3. The Number and Nature of Similar Marks in Use on Similar Goods.

Applicant argues that opposer's VIRGIN marks are weak as a result of third-party uses of "virgin." At the outset we note our conclusion above that opposer's VIRGIN mark has achieved significant fame, a conclusion which necessarily requires the further conclusion that opposer's mark is strong and not weak.

Applicant introduced evidence in support of its position, specifically: records of active and dead third-party registrations, not owned by opposer, for marks which include "VIRGIN"; records of live and dead approved, pending applications fitting the same description; records of Board proceedings brought by opposer against marks which include "VIRGIN"; copies of certain responses by opposer to applicant's discovery; certain exhibits from opposer's testimony deposition of Mr. Vann; and examples of various

uses of "virgin" in publications. Applicant introduced all of this evidence by notice of reliance. We have reviewed all of the evidence carefully and conclude that it fails to establish that opposer's VIRGIN mark is weak.

First we note that third-party registrations are entitled to little weight on the question of likelihood of confusion. See, e.g., *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Such registrations are not evidence that the marks are in use or that the public is familiar with them. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). As the Federal Circuit has stated, "[t]he probative value of third-party trademarks depends entirely upon their usage." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1693. As to the dead registrations, such registrations ordinarily have no evidentiary weight. See *Mattel, Inc. v. Funline Merchandise Co., Inc.*, 81 USPQ2d 1372 (TTAB 2006). Likewise, records of pending applications, regardless of status, lack probative value for our purposes here.

Furthermore, the active registrations applicant submitted provide no support for its position. First, the majority of the registrations involve marks which simply have no relevance to the issues in these proceedings. The majority of the active registrations, all but five of the

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forty-two provided, involve marks which either (1) include VIRGIN or EXTRA VIRGIN used generically as applied to olive oil or similar goods, or (2) marks which include VIRGIN ISLANDS used in its geographical sense.

The remaining five registrations are: VIRGIN SPRINGS for bottled water (Applicant's Not. of Rel. Exh. 3); VIRGIN BOURBON for whiskey (Exh. 5); K PORT NATURAL SPRING WATER EXTRA VIRGIN and design with "EXTRA VIRGIN" disclaimed for natural spring water (Exh. 18); VIRGIN HAIR & AFRO on the Supplemental Register with "VIRGIN HAIR" disclaimed for hair styling preparations and skin moisturizers (Exh. 33); and REBORN VIRGIN for books (Exh. 34). Even if we were to presume that these marks were in use, and we do not, the use would be insufficient to establish that opposer's VIRGIN marks are weak.

The records of the proceedings brought by opposer with regard to third-party VIRGIN marks, in fact, provide evidence of opposer's policing efforts and, on balance, support the conclusion that opposer's VIRGIN mark is a strong mark.

As to the publications, the only exhibits which have any relevance with regard to the strength or weakness of opposer's mark are: a *Chicago Tribune* article referencing the EXTRA VIRGIN restaurant opening eight weeks earlier in Chicago (Exh. 205); an article from the *Washington Times*

referencing the opening of another EXTRA VIRGIN restaurant in Virginia (Exh. 106); and an item from the *Las Vegas Review Journal* referencing a contract involving "the Virgin River hotel-casinos in Mesquite" (Exh. 207). (Ex. 218 refers to the Virgin mountains and the Virgin River Gorge in Arizona which may be related.)

The remainder of the publications include uses of "virgin" in its descriptive or generic sense, not as a mark or even part of a mark -- for example, "virgin snow" (Exh. 220), "virgin aluminum" (Exh. 255), "virgin iron ore" (Exh. 256) and "virgin forest" (Exh. 269). Applicant also includes a dictionary definition of "virgin" (Exh. 201). Furthermore, applicant includes exhibits related to its own use from the Vann deposition to support its general argument that opposer's VIRGIN marks are weak, arguing that its own uses are suggestive.

We find none of applicant's evidence intended to show that opposer's VIRGIN mark is weak persuasive. The fact that "virgin" has a dictionary meaning and is used in its dictionary sense in no way precludes a party, such as opposer, from adopting it as a mark and developing a strong or famous mark. *Chicago Bears Football Club Inc. v. 12th Man/Tennessee LLC*, 83 USPQ2d 1073, 1081-82 (TTAB 2007). Applicant's evidence shows either use of "virgin" in its dictionary sense, and a few isolated potential uses of

"virgin" in marks. There is no evidence of any significant use by third parties of VIRGIN marks. Furthermore, we have no evidence that applicant's own use of VIRGIN in the marks at issue here, whether suggestive or not, has in any way detracted from the strength of opposer's VIRGIN marks. Accordingly, we conclude that opposer's VIRGIN mark is a strong mark possessing a significant degree of fame. This factor favors opposer.

4. The Goods and Services and Channels of Trade

The goods and services of opposer and applicant need not be identical to find likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods or services originate from the same source. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). *See also On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods and services we must consider the goods and services as identified in the application and registrations. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must

be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

Applicant argues that its "automobile and truck dealerships" are far removed from any of the goods and services offered by opposer under its VIRGIN marks. Applicant states, "In response to discovery requests, VEL [opposer] acknowledged that it does not have a retail facility for selling vehicles in the United States, that it has never sold vehicles in the United States, and that it possesses no documents evidencing plans to utilize any mark with the term VIRGIN in association with the retail sale of automobiles and trucks in the United States. (App. NOR EXS. 198-200)." Applicant's Brief at 9. Applicant also points out that certain Virgin Group officials indicated in testimony that they had no knowledge of any Virgin Group plans to sell vehicles in the United States. *Id.* at 10-11. Applicant also asserts that opposer failed to provide any

evidence that opposer's goods and services are related to applicant's services.

On the other hand, opposer states, "The services specified in the opposed applications, "automobile and truck dealerships," are closely related to automobile transportation, retail store, and online shopping services recited in Opposer's registrations and actually provided by the Virgin Group companies as described above." Opposer's Brief at 27. Opposer also points to its BMW and Volvo promotions as evidence that the goods and services of the parties are related.

We conclude that the goods and services identified in opposer's eighteen registrations are related to the automobile and truck dealership services identified in the applications at issue in view of the wide variety of goods and services identified in opposer's registrations and the fame of the VIRGIN mark. We might reach a different conclusion if we looked at each of opposer's goods and services in isolation in relation to applicant's services. However, the circumstances surrounding the marketing of opposer's goods and services when viewed as a whole, that is, considering the wide variety in opposer's goods and services, and the fame of opposer's mark, lead us to conclude that relevant purchasers would perceive that the goods and services of the parties are related.

Below, we discuss further the impact of opposer's use of its VIRGIN marks on the wide variety of goods and services identified in the registrations under eighth *du Pont* factor.

Although opposer did present evidence of its use of the VIRGIN mark in the United Kingdom in conjunction with the sale of automobiles, that use is not relevant for purposes of these proceedings and we have not considered that use in reaching our conclusion here. We reject opposer's argument that those activities somehow extend into the United States. We note that none of the registrations which are of record here cover those services, nor did opposer otherwise plead use of its mark on such services in the United States.

We also agree with applicant that the mere fact that one can navigate from opposer's sites to sites which do offer cars for sale establishes the necessary relationship in the minds of consumers between opposer's goods and services and applicant's automobile and truck dealerships and we have not relied on that evidence in reaching our conclusion here. The relationship here is too attenuated; taken to its logical limit, the argument would support a relationship between virtually any goods or services which are offered online.

Likewise, we agree with applicant that opposer's limited sales of vehicles used by Virgin Limo fails to

establish that the goods and services of the parties are related. Again, opposer did not plead that it used its VIRGIN mark in the sale of automobiles, nor is this service covered by opposer's registrations which are before us in these proceedings. Furthermore, the sales of cars here is merely incidental to the rendering of the limousine service. The cars were merely purchased for use in conducting the business and disposed of when they were no longer suitable for such use.

On the other hand, applicant attaches undue probative value to the statements by opposer's witnesses that they had no knowledge of any plans by opposer to sell automobiles or trucks under the VIRGIN mark in the United States. This testimony is not probative of the perception of relevant purchasers. In fact, the record includes a *Wall Street Journal* article discussing opposer's innovative methods for selling automobiles of varied manufacturers under the VIRGIN mark in the United Kingdom. The article discusses both opposer's interest in the doing the same in the United States and obstacles in bringing that business to the United States. This article shows that at least some people in the United States may be aware of opposer's use of the VIRGIN mark in relation to automobile sales and the possibility it might do so in the United States. We hasten to add that it is the wide variety of opposer's goods and services and the

fame of its mark which leads us to conclude that the goods and services of the parties are related, and not this specific evidence.

Accordingly, we conclude that the goods and services of the parties are related. This factor favors opposer.

Turning to the channels of trade, here also we must look to the goods and services identified in the registrations and applications of the parties to determine whether there are related. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

Based on the same analysis we conducted with regard to the parties' goods and services, we conclude that the channels of trade are related. Applicant's goods and services, as identified, for the most part would be sold or rendered to the general public. Applicant's services, as identified, would also be rendered to the general public. Again, the wide variety of opposer's goods and services likewise travel in varied trade channels. Under the circumstances potential customers are likely to perceive that the trade channels could extend to applicant's trade channels. Accordingly, we also conclude that the parties' trade channels are related. This factor favors opposer.

5. The Variety of Goods on Which a Mark is Used

The *du Pont* case directs us to consider evidence regarding the variety of goods [or service] with which the mark is used under the eighth *du Pont* factor. As already discussed, in this case we have significant evidence on this factor. As we noted above, the eighteen registrations on which opposer relies identify a wide variety of goods and services covering a diverse collection of goods and services. *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1662 (TTAB 2002). The registrations which cover the VIRGIN mark by itself either in standard form or script identify services ranging from transportation and travel, to bar services, to communications services, to online sales and retail store services for a wide variety of goods. The goods identified in these registrations range from audio and video recordings in varied forms, to clothing, to luggage, to publications, to stationary and office supplies, to alcoholic and nonalcoholic beverages. On the basis of these registrations we conclude that opposer's goods and services include a wide variety and that this factor favors opposer.

We also note the significance of this factor in our overall analysis - if consumers have been exposed to use of a mark, especially a famous mark, on a wide variety of goods and services from one party they are more likely to believe

that the use of the mark has been extended by the same party to additional goods or services.

6. Actual Confusion

Applicant argues that there has been no actual confusion, presumably to support its position that there is no likelihood of confusion. Applicant's Brief at 28. It is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990).

In this case, Mr. Vann, who is an owner of applicant and the only witness connected with applicant, states that applicant used its VIRGIN marks since 2002; he is noncommittal as to any earlier use. Vann Test. at 25. Applicant operates from a single location in Albion, Michigan and generally advertises locally. *Id.* at 15-16. Applicant maintains an Internet site and uses its VIRGIN marks on that site. *Id.* at 17; Test. Exh. 34. Mr. Vann indicated that so far as he knew applicant did not maintain records regarding the numbers of visitors to applicant's web site. *Id.* at 24. The applications at issue here are intent-to-use applications; the record shows use of the marks in a limited area for a limited period of time. We have no evidence regarding the impact of the use of the

marks on the Internet. Accordingly, on this record, we must conclude that the opportunity for confusion is minimal.

Under the circumstances, the absence of actual confusion is of little or no probative value with regard to the likelihood of confusion. The Federal Circuit has stated, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight (citation omitted) . . ." *Majestic*, 65 USPQ2d at 1205. See also *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

Accordingly, we conclude that the actual-confusion factor is neutral in this case.

7. Purchaser Sophistication

Applicant states, "Further, the Board will recognize that automobiles and trucks are expensive goods and consumers and potential consumers of Albion Motors' services are, thus, elevated to the standard of 'discriminating purchasers.'" (Citations omitted.) Applicant's Brief at 24. Opposer disagrees and notes, among other things, the potential for initial interest confusion. Opposer's Reply Brief at 15.

We agree with applicant's point that potential purchasers of automobiles and trucks are likely to exercise a higher degree of care than purchasers of less expensive

items. However, those purchasers would include the general public; the class of purchasers is not restricted to persons possessing special knowledge or expertise. Even sophisticated purchasers are not immune from trademark confusion. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

On this record, on balance we conclude that applicant's customers are not less likely to be confused as a result of the higher level of care associated with vehicle purchases. Accordingly, we conclude that the evidence in this application bearing on the sophistication of the potential purchasers fails to indicate a diminished likelihood of confusion. This factor is neutral.

8. Bad Faith

Opposer has suggested, at least indirectly, that applicant adopted its VIRGIN marks in bad faith. Applicant disputes this implication. We must look to the record to see whether opposer has established bad faith. *See Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1899; *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d at 1820. Although Mr. Vann was somewhat evasive in responding to questions regarding applicant's intent in adopting the marks, we conclude that there is no evidence here of bad faith.

Therefore, we have not considered bad faith as a factor in this case.

9. Conclusion

We have considered all evidence properly of record in these proceedings bearing on the factors set forth in *du Pont* and conclude that there is a likelihood of confusion between opposer's VIRGIN marks when used in connection with the goods and services identified in the registrations relied upon here and applicant's VIRGIN VEHICLE, VIRGIN PURCHASE and VIRGIN SALE marks for automobile and truck dealerships. We conclude so principally based on the similarity of the marks of the parties, the fame of opposer's mark and the variety of goods and services with which opposer's mark is used. We note finally that we have given full consideration to all competent evidence and all arguments raised in this case whether or not we have discussed them specifically.

B. Dilution

Opposer also asserts dilution as a ground for opposition. In view of our decision to sustain the oppositions on the ground of likelihood of confusion, it is not necessary for us to consider opposer's dilution claim.

Decision: The opposition is sustained on the ground of likelihood of confusion and registration is refused in each of the three applications in these proceedings.