

O-276-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2487177  
BY MICHAEL CASEY TO REGISTER THE TRADE MARK**

**CARBON VIRGIN**

**IN CLASS 35**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 98170  
BY VIRGIN ENTERPRISES LIMITED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF application No. 2487177  
by Michael Casey to register the trade mark  
CARBON VIRGIN in Class 35**

**and**

**IN THE MATTER OF Opposition thereto under No. 98170  
by Virgin Enterprises Limited**

### **BACKGROUND**

1) On 9 May 2008, Michael Casey, of Liegnitzer Strasse 13, Berlin, D-10999, Germany applied under the Trade Marks Act 1994 ("the Act") for registration of the trade mark CARBON VIRGIN in respect of the following services:

#### **Class 35**

*Advertising; electronic data storage; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing.*

2) The application included the following disclaimer:

"No claim is being made to either the words "carbon" or "virgin" when used on their own. The application is solely for their use together and as presented in the application."

3) The application was published on 1 August 2008 and on 29 October 2008, Virgin Enterprises Limited ("VEL") of The School House, 50 Brook Green, London, W6 7RR filed notice of opposition to the application. The grounds of opposition are in summary:

- a) The mark CARBON VIRGIN is identical to its registered mark VIRGIN, the subject of Community Trade Mark (CTM) 1471143 and is in respect of similar services as the earlier mark's Class 35 services. The application therefore falls foul of Section 5(2)(a) of the Act.
- b) The mark is similar to its earlier mark CTM 4262093 VIRGIN, CTM 6261473 VIRGIN GREEN FUND, and CTM 4262085 "VIRGIN signature" mark and in respect of similar services as the earlier marks' Class 35 services. The application therefore falls foul of Section 5(2)(b) of the Act.

- c) The mark is identical or similar to its earlier marks which have a reputation, namely CTM 1471143, CTM 6261473, CTM 611459 VIRGIN, CTM 3421633 VIRGIN, CTM 4262093 VIRGIN, CTM 1798560 VIRGIN, CTM 1746247 VIRGIN MOBILE and device, 2365570 VIRGIN MOBILE, 1369779 VIRGIN, CTM 5272273 VIRGIN, CTM 5189923 VIRGIN and CTM 611467 and CTM 4262085, both in respect of its “VIRGIN signature” mark. The application therefore falls foul of Section 5(3) of the Act.
- d) Its VIRGIN and “VIRGIN signature” signs are protected by virtue of the law of passing-off because they have been used since 1970 on a wide range of goods and services listed in Annex 1 to this decision. The application therefore falls foul of Section 5(4)(a) of the Act.

4) All the relevant details of the earlier marks detailed in sub-paragraphs 3 a) – c) above are provided in Annex 2.

5) Mr Casey subsequently filed a counterstatement denying VEL’s claims.

6) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 9 June 2010 when VEL was represented by Mr Julius Stobbs for Ipulse (IP) Limited and Mr Casey represented himself.

### **Opponent’s Evidence**

7) VEL provides copious amounts of evidence to illustrate the size and extent of its reputation identified by its various VIRGIN marks and Mr Casey, in his subsequent witness statement, conceded that VEL’s VIRGIN mark and its “VIRGIN signature” mark are “well known across a broad range of goods and services in the UK.” In light of this concession, it is not necessary for me to provide a detailed summary of VEL’s evidence. However, the following brief summary will provide an idea of the scope of VEL’s reputation, as I see it.

8) VEL is a member of a group of companies known collectively as the Virgin Group of Companies (“the Virgin Group”). The Virgin Group was founded in 1970 when the business sold music records. By 1973 its business had extended to include record company services, music publishing services and recording studio services. All these services were provided under the VIRGIN mark. The Virgin Group is now (June 2009) one of the UK’s largest private corporate groups that includes 200 companies, approximately 50,000 staff and operating in 29 countries.

9) The Virgin Group has traded under the name VIRGIN since it was founded and continues to do so and VEL is the registered proprietor of all of the VIRGIN marks used by the companies in the Virgin Group. VEL first registered the mark VIRGIN in 1973 and its “VIRGIN signature” mark in 1979.

10) There are 90 European or UK registrations and pending applications for VIRGIN or “VIRGIN signature” marks and there are no registrations in the UK held by a third party, that comprise or contain the word VIRGIN except in respect of olive oil products and two further registrations which are subject to specific agreements.

11) Mark James, VEL’s Intellectual Property Manager, states that VEL’s marks have been used in respect of a wide range of goods and services including radio broadcasting services, Internet services, television broadcasting services, night club services, cinema services, drinks, clothing, footwear, luggage, bags, wallets, passport and ticket holders, cosmetics, toiletries, health and beauty services, airline and travel services, bridal services, massage services, gyms and spas, records, CDs, tapes, videos, films, personal computers, computer software, books, computer games, holidays, hotel services, financial services, retail services, hot air balloon flights, telephones, toys, watches, telecommunication services and rail services.

12) Evidence is provided illustrating use of the relevant marks in respect of many of these claimed goods and services. In particular these include copies of selected publications, brochures and promotional material in which VEL’s marks appear. These show use of these marks in respect of the following:

- Virgin Megastores, retailing of music and DVDs (various publications including Heat magazine, dated May 2003), records (catalogue, June 1990) and retail of computer games (December 1993);
- Virgin Sun holidays (October 1999);
- Virgin Interactive entertainment (packaging bearing a publication date of 1996);
- Virgin credit card, cosmetics (in September 1997);
- cola drinks (various media reports dated 1995 – 99 and promotional events in 2000/2001);
- mobile phones and mobile phone services (Playstation magazine, September 2003);
- blank and pre-recorded cassettes (1991) and video tapes (The Grocer, 2006);
- TV and video production services (internal document from 1986) and broadcasting, film and video distribution services;
- Internet services (The Mail on Sunday, 14 September 1997);
- passenger air services (numerous, including The Sun newspaper, 19 April 1997),
- Virgin Atlantic flight catalogues showing branded watches, jigsaws, teddy bears, model planes and clocks;
- computer graphic design services (unidentified “profile” dated 1987);
- vodka (Media reports, 1997);
- computers (advert, unknown placement and undated);

- T-shirts, sweatshirts, shirts, belts, caps, leisurewear, backpacks, holdalls, wallets, spectacle cases, keyholders, card holders, pens and cameras (In-flight catalogue, 1994/5);

### **Applicant's Evidence**

13) Mr Casey, in his witness statement of 1 October 2009, identifies twenty seven earlier marks in the name of VEL, many of which are not relied upon in these proceedings and, based on his analysis of these twenty seven marks, he concedes that all of the services listed in his application are identical to VEL's services, with the exception of *auctioneering* and *trade fairs*.

14) Mr Casey explains that his business will be involved in investing in and preserving virgin tropical forests. He identifies the term "virgin forest" as being defined in the Compact Online Oxford Dictionary as "forest or woodland having a mature or overly mature ecosystem more or less uninfluenced by human activity". This is provided to support his argument that he has due cause to use his mark.

15) Mr Casey also provides dictionary references for the word VIRGIN and I will refer to these in more detail later.

16) Mr Casey's remaining comments are in the form of submissions. I will not detail these here, but I will refer to them as appropriate in my decision.

### **Preliminary and other issues**

#### VEL's request to amend its pleadings

17) During his submissions at the hearing, Mr Stobbs encouraged me to consider VEL's earlier mark CTM 1471143 in respect of its grounds based upon Section 5(2)(b), insofar as I deemed it not to be successful in respect of the grounds based upon Section 5(2)(a). I sought clarification of what Mr Stobbs was requesting and he confirmed that he was seeking leave to amend VEL's ground of opposition based upon Section 5(2)(b) to include this earlier mark. Further, he also requested that VEL's pleadings are amended so that earlier mark CTM 5189923, one of the earlier marks relied upon in its grounds based upon Section 5(3), is also added to its Section 5(2)(b) grounds.

18) No explanation was provided for the lateness of these requests. I permitted the pleadings to be amended as I am of the view that, whilst to do so introduced inconvenience and potential additional work for Mr Casey, this was such that it could be taken into account in any award of costs. I also took into account that any resultant delays would not be significant and I also consider the prospect of further proceedings against Mr Casey's mark if I denied the requests.

19) I also note that the earlier mark CTM 5189923 is not subject to the proof of use provisions but that CTM 1471143 is, by virtue of having a registration date more than five years before the publication date of Mr Casey's mark. Of potential significance to the substantive issues in these proceedings was Mr Stobbs' submission that *computer programming services* (covered by CTM 1471143) are similar to the *data processing* included in Mr Casey's application. Having reviewed the evidence provided by VEL, there is nothing to indicate that it has traded in such services during the relevant period. In light of Mr Casey's request, made in response to my decision to admit the amendments to the pleadings, to put VEL to proof of use, I agreed that if VEL's reliance upon these services became a determining factor in the proceedings, I would provide an opportunity for VEL to submit evidence on the point.

#### Mr Casey's further written submissions

20) Following the hearing, Mr Casey provided further submissions in writing. This is somewhat unusual and can be argued that it is a second attempt to be heard. Nevertheless, I have taken account that Mr Casey is unrepresented in these proceedings and also the guidance provided by Iain Purvis QC, sitting as the Appointed Person in BL O-115-10 *HYNOTIZER*, where he recognised that the "overriding objective" of "dealing with cases justly" (as stated in the Civil Procedure Rules) is to be served firstly by "ensuring that the parties are on an equal footing." On this occasion, I have concluded that the late submissions should be permitted into the proceedings. In this case, the rights and legitimate expectations of VEL are not diminished or prejudiced provided that it is given the opportunity to respond to these late submissions and as such, I gave VEL an opportunity to do so and to which it availed itself. All these submissions have been taken into account in my decision.

## **DECISION**

### **Earlier rights and genuine use**

21) In respect to the grounds based upon Sections 5(2)(a), 5(2)(b) and 5(3) of the Act, VEL relies on thirteen earlier marks. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"6.-(1) In this Act an "earlier trade mark" means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

22) Of potential relevance to these grounds of opposition are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

**“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

23) All of VEL’s earlier marks are registered and have filing dates that pre-dates the filing date of Mr Casey’s mark. Therefore, they all qualify as earlier marks as defined by Section 6 of the Act.

24) Seven of VEL’s thirteen earlier marks were registered within five years of the publication of Mr Casey’s mark, namely 1 August 2008. As such, these earlier marks are not subject to the proof of use provisions. The remaining six earlier marks have completed registration procedures that predate, by more than five years, the publication of Mr Casey’s mark and as such, fall foul of the proof of use provisions. However, Mr Casey has not put VEL to proof of use in relation to these marks (except in relation to his late request made in response to developments at the hearing and that I commented upon separately in paragraph 19). Therefore, in respect to the grounds of opposition based upon Sections 5(2) and 5(3) of the Act, I will consider VEL’s case based upon the full list of goods and services it relies upon for each of the thirteen marks as set out in its statement of grounds on the form TM7.

**Section 5(2)(a)**

25) Section 5(2)(a) reads:

“(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

...

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

26) The first issue I must consider is whether or not the marks are identical. In the European Court of Justice (“ECJ”) Case C-291/00 (*LJT Diffusion SA v Sadas Vertbaudet SA*) (“*Sadas*”), the Court said in relation to Art 5(1)(a):

“Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

27) *Sadas* is the lead authority on the question of whether marks are identical when it considered the issue within the context of proceedings to invalidate a registered mark (Article 5(1)(a) of First Council Directive 89/104/EEC to approximate the laws of the Member States relating to trademarks (recoded as Directive 2008/95/EC). The Court stated that the same interpretation given to Art 5(1)(a) also applies when considering whether marks are identical in opposition proceedings (Article 4(1)(a) of the Directive and equivalent to Section 5(1) of the UK Act). It follows that, in respect of Article 4(1)(b), insofar as marks are claimed to be identical, the same interpretation will apply here also. Article 4(1)(b) is the equivalent relevant provision to Section 5(2)(a) of the Act.

28) VEL relies upon the single earlier mark CTM 1471143 VIRGIN in respect to a wide range of goods and services. The application is for a mark consisting of the words CARBON VIRGIN. This differs from VEL’s mark by the addition of the word CARBON at the beginning of the mark. At the hearing, Mr Stobbs argued that the word CARBON is descriptive in respect to services relating to green or environmental issues. As such, Mr Stobbs claimed that the distinctive element of Mr Casey’s mark is the word VIRGIN and that this is identical to VEL’s mark. On the other hand, Mr Casey argued in his written submissions, that the word CARBON is not descriptive for the services in question even where such services are CO<sub>2</sub> neutral.

29) It is helpful at this stage to understand the meaning of the words CARBON and VIRGIN, the latter as pointed out by Mr Casey in his witness statement:



## carbon<sup>1</sup>

→ *n.*

1. the chemical element of atomic number 6, a non-metal which has two main forms (diamond and graphite), occurs in impure form in charcoal, soot, and coal, and is present in all organic compounds. (Symbol: C)
2. carbon dioxide or other gaseous carbon compounds released into the atmosphere, associated with climate change: [as (*modifier*) ] *fossil fuel consumption and carbon emissions continued to rise.*

## virgin<sup>2</sup>

→ *n.*

1. a person, typically a woman, who has never had sexual intercourse. • (*the Virgin*) the Virgin Mary.
2. a person who is naive or inexperienced in a particular context: *a political virgin.*
3. (*Entomology*) a female insect that produces eggs without being fertilized.

→ *adj.*

1. being or appropriate for a virgin.
2. not yet used, exploited, or processed: *acres of virgin forest.* • (of olive oil) obtained from the first pressing of olives. • (of wool) not yet, or only once, spun or woven. • (of metal) made from ore by smelting.

30) Taking account of these dictionary definitions, I cannot accept Mr Stobbs' contention that the dominant and distinctive element of Mr Casey's mark is the word VIRGIN. The term CARBON VIRGIN, whilst being somewhat impenetrable, suggests to the average consumer a person who is naïve or inexperienced on issues relating to carbon. Such a suggestion may lead the consumer to believe that it relates to something green or environmental in nature. It is also not inconceivable that CARBON VIRGIN may be perceived as describing a representation of the Virgin Mary made from a carbon material such as diamond or graphite. Whichever of these meanings is perceived, it is clear to me that the consumer will see the mark as a distinctive whole rather than the distinctive word VIRGIN preceded by the purely descriptive word CARBON. Certainly this will be the case in respect of the services covered by Mr Casey's application. In the absence of a direct descriptive message being conveyed by the word CARBON, the average consumer will not break down the mark into its constituent parts, but rather, he will recognise the mark as a whole.

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<sup>1</sup> "carbon *n.*" *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 16 June 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e8383>>

<sup>2</sup> "virgin *n.*" *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 16 June 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e63441>>

31) Applying the *Sadas* test, I believe the difference between the respective marks, being the addition of the word CARBON, as being a difference that will be noticed by an average consumer, even where that consumer rarely has the chance to make a direct comparison between the respective marks and must instead rely on an imperfect picture them kept in their minds. Further, for the reasons set out above, the consumer will perceive the mark as a whole and not dissect the mark into its component parts.

32) In summary, when considering the respective marks as a whole, I find that they are not identical and the ground based upon Section 5(2)(a) fails.

### **Section 5(2)(b)**

33) Section 5(2)(b) reads:

“(2) A trade mark shall not be registered if because –

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

34) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has

kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH (MEDION)*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

### ***Comparison of services***

35) In assessing the similarity of services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

36) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281). Finally, I also bear in mind that goods and services can be considered identical when those covered by an earlier mark are included in a wider term by a later mark (and vice versa); see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (MERIC)* Case T- 133/05.

37) Mr Casey provides information regarding the precise nature of the services he currently intends to provide, however, it is not necessary for me to detail this here because I must consider the notional list of services provided in his application.

38) In his witness statement, Mr Casey conceded that all of the services listed in his application are identical to VEL’s services, with the exception of *auctioneering* and *trade fairs*. Mr Casey arrived at this view after considering ALL of VEL’s earlier marks that cover Class 35 services, including many that are not relied upon by VEL in these proceedings. In fact, VEL relies upon only five of its earlier marks in respect to its grounds under Section 5(2)(b). When these five marks are considered, CTM 4262093 VIRGIN and CTM 4262085 “VIRGIN signature” mark, both cover *[a]dvertising services relating to real property*. Whilst it is not clear exactly what is intended by the term “real property”, it is nonetheless clear that VEL’s service is a subset of the wider *[a]dvertising* listed in Mr Casey’s application. I also note that VEL’s registration CTM 6261473 VIRGIN GREEN FUND includes *[a]dvertising* in its Class 35 specification and this obviously covers identical services.

39) In addition, VEL's services identified in the preceding paragraph also have at least some overlap with Mr Casey's *advertising services provided via the Internet* and, as such, the respective services must be considered as being identical.

40) Mr Casey's application also contains the term *production of television and radio advertisements*. As the technical service of television and radio production is proper to Class 41, this term must be understood as referring to the business services of developing and finalising ideas for advertisements. As such, Mr Casey's terms describe services that are part of the broader *advertising* covered by VEL's VIRGIN GREEN FUND registration and applying the guidance provided in *MERIC*, I conclude that these terms are identical. If I am wrong in reaching this conclusion, there will, nonetheless, be highly similar services.

41) The remaining terms covered by Mr Casey's application, namely *electronic data storage; [...] accountancy; auctioneering; trade fairs; opinion polling; data processing* are not replicated in the specifications of any of VEL's five earlier marks. Therefore, despite Mr Casey's concession, I will consider the level of similarity between these remaining services and those covered by the earlier marks relied upon by VEL.

42) Mr Stobbs argued that the retail services as covered by VEL's CTM 1471143 includes *auctioneering*, as listed in Mr Casey's application, and that *computer programming services* in Class 42 of the same CTM are very similar to Mr Casey's *data processing*. Considering the similarity with *auctioneering* first, such services are a specialist form of selling products where such products are sold to the highest bidder<sup>3</sup>. Such services are generally provided by specialist auctioneers and not by traditional retailers. Certainly, there is no evidence before me to suggest otherwise. Whilst there may be some competition between the respective services, the specialist nature of an auction service is such as to limit the actual instances of competition. Further, it will also result in the average consumer being less likely to expect a retailer to also provide auction services and *vice versa*. That said, the intended purpose of auctioneering is similar to that of retailing as they are both concerned with selling products. Taking all of this into account, Mr Casey's *auctioneering* shares a moderately low level of similarity with VEL's *retail services*.

43) In order to identify VEL's best case, it is also necessary to consider the similarity between the Class 35 terms *business administration* and *office functions* (as included by VEL's VIRGIN GREEN FUND mark) and Mr Casey's *data processing*. VEL's terms cover a wide range of services and to better understand the limits of this range it is helpful to refer to the Explanatory Note for

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<sup>3</sup> "auction n." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 16 June 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e3332>>

Class 35 that is provided in WIPO's International Classification of Goods and Services (Nice Classification), ninth edition. The relevant parts state:

“Class 35 includes mainly services rendered by persons or organizations principally with the object of:

- (1) help in the working or management of a commercial undertaking, or
- (2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise,

as well as [...]

*This Class includes, in particular:*

- [...]
- Services consisting of the registration, transcription, composition, compilation or systemization of written communications and registrations, and also the compilation of mathematical or statistical data;
- [...]

44) I am also mindful of the way that specifications, in particular in relation to services, should be interpreted. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd (THOMSON)*, at paragraph 31, Aldous LJ stated:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”

Although this was in the context of arriving at a fair specification consequent to an attack of revocation on the grounds of non-use, the principle that it is the public and circumstances of the relevant trade that is important when considering the scope of terms is relevant here. Further, guidance is provided in *TREAT* where Jacob J stated that “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”. Finally, I also bear in mind the following guidance in *Avnet Inc v Isoact Ltd (Avnet)* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

45) Taking account of the Explanatory Note and the above mentioned guidance, the broad terms *business administration* and *office functions* may well include

*data processing* as an office function that can include the compilation of mathematical or statistical data. Even if I am wrong, *data processing* is highly similar to *office functions* such word processing, book keeping and file management. As such, these services are identical or highly similar.

46) In light of the possible implications relating to genuine use, I will also consider the level of similarity, if any, between Mr Casey's *data processing* and VEL's *computer programming services*. The former is a non-technical business service where data is inputted and used for business purposes. Programming, on the other hand, is the technical service of writing new, or amending existing, computer programmes and requires technical knowledge, such as knowledge of the relevant computer code. Therefore, despite both services utilising computers, they are different in nature and intended purpose. As computer programming is a specialist service, it will be provided by a trader with the requisite specialist knowledge. Due to these differences, they are not in competition with each other. There may possibly be an element of complementarity, in the sense that one is indispensable or important to the other (*Boston Scientific Ltd v OHIM (Boston Scientific)*, Case T-325/06), where a computer may need to be programmed so that any data processed provides the required outputs. Taking all of this into account, I find that these services share only a low level of similarity. In light of my finding that VEL's *business administration* and *office functions* are identical to Mr Casey's *data processing*, it is clear that VEL is in no better position when relying upon its *computer programming services*. As such, I see no benefit in requiring that VEL provide proof of use in respect of these services as requested at the hearing by Mr Casey.

47) Next, I consider the similarity of *accountancy* with VEL's services. "Accounting" is defined as "the action of keeping financial accounts"<sup>4</sup>. Mr Stobbs argued that *accountancy* may be proper to Class 36 and not Class 35 and if so, it is identical to VEL's *financial affairs; monetary affairs* in Class 36 (and as covered by its VIRGIN GREEN FUND mark). If, on the other hand, *accountancy* is proper to Class 35, then it is covered by VEL's broad terms *business management* and *business administration*. "Accounting" is classified in Class 35 of the Nice Classification and is therefore not identical to any of VEL's Class 36 services. However, for completeness, I will consider the level of similarity between such services. Once again, it is helpful to consider WIPO's Explanatory Notes, this time in respect to Class 36:

"Class 36 includes mainly services rendered in financial and monetary affairs and services rendered in relation to insurance contracts of all kinds.

This Class includes, in particular:

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<sup>4</sup> "accounting n." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 16 June 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e295>>

- services relating to financial or monetary affairs comprise the following:
  1. services of all the banking establishments, or institutions connected with them such as exchange brokers or clearing services;
  2. services of credit institutions other than banks such as co-operative credit associations, individual financial companies, lenders, etc.;
  3. services of "investment trusts," of holding companies;
  4. services of brokers dealing in shares and property;
  5. services connected with monetary affairs vouched for by trustees;
  6. services rendered in connection with the issue of travellers' cheques and letters of credit;
- services of realty administrators of buildings, i.e., services of letting or valuation, or financing;
- services dealing with insurance such as services rendered by agents or brokers engaged in insurance, services rendered to insured, and insurance underwriting services."

48) When taking account of the Explanatory Notes for both Class 35 and Class 36 together with the dictionary definition of "accounting" and the guidance provided in *TREAT*, it is clear that VEL's Class 36 services have a different nature and purpose to Mr Casey's *accountancy*. The former are services provided by banks, credit companies and investment companies and relate to the management, lending and enhancement of their customers money. Accountancy, on the other hand, is the business service of providing a record of a company's financial transactions and tax liabilities. As a result, they are provided by different types of undertakings and utilised in different circumstances. Neither are they in competition with, or complementary to, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those services lies with the same undertaking (*Boston Scientific*). As such, any similarity that may exist by virtue of both services relating generally to money is offset to a greater degree by the numerous differences and I conclude that there is only a relatively low level of similarity.

49) I now turn to Mr Stobbs' fall back argument that *accountancy* is covered by VEL's broad terms *business management* and *business administration*. *Accounting* is defined as the keeping of financial accounts. Where such a service is provided in a business environment then it can be argued that this is a subset of wider business administration functions. Against such a supposition is that business administration services can be delivered by non-specialists but accountancy is a service provided by a specialist profession. Therefore, whilst there may be some overlap in terms of the nature of the services and their



intended purpose, their trade channels are likely to be different. As such, I conclude that there is a moderate level of similarity.

50) In respect of Mr Casey's *trade fairs*, Mr Stobbs argued that insofar as they are business related, they will be covered by VEL's terms *business management* and *business administration*. I do not share this view. Trade fairs are events where a specific business community gather and products are exhibited. The organising of such events is a distinct service provided to the business community. Whilst it may require elements of management and administration, these services will not be provided to others, but rather will be some of the in-house tasks required in organising an event. As such, the respective services are different in terms of nature and intended purpose. Further, organisers of trade fairs are likely to be different undertakings to those who provide management and administration services to businesses and therefore different trade channels are involved. Also, there is no obvious complementarity. Taking all of this into account, I conclude that, if there is any similarity, it is only very low.

51) Mr Casey's application also contains the term *opinion polling*. Here, Mr Stobbs contended that this is effectively a market research-type service and is therefore covered by VEL's *advertising*. Whilst there may be some relationship between the services, I do not agree that opinion poll services are covered by the term *advertising*. I have no reason to believe that these respective services would be provided by the same type of undertakings. One is for the promotion of goods and services, the other is a research-type service. Taking this into account, the services differ in nature, intended purpose and channels of trade. They are not complementary (in the sense expressed in *Boston Scientific*) or in competition with each other. Therefore, if there is any similarity, it is only very low.

52) Finally, I turn to consider the similarity, to VEL's services, of Mr Casey's remaining services, namely *electronic data storage*. Bearing in mind the guidance provided in *Avnet* and *TREAT*, it is not obvious to me that such services are covered by any of VEL's Class 35 terms. It could be said that its broad terms *business administration* and *office functions* cover similar services, but *electronic data storage* is not obviously a administrative or office function and no evidence has been presented to support such a contention. I therefore find that the respective services share only a low level of similarity, if any.

53) My findings can be summarised as follows:

| <b>Services of Mr Casey's application</b>  | <b>Similarity with VEL's services</b>   |
|--|---|
| <i>Advertising; [...]; advertising services provided via the Internet; production of television and radio advertisements</i> | Identical to <i>advertising</i> in CTM 6261473 VIRGIN GREEN FUND and <i>advertising services relating to real property</i> in both CTM 4262093 VIRGIN and CTM 4262085 Virgin signature mark   |
| <i>auctioneering</i>   | Moderately low level of similarity to <i>retail services</i> in CTM 1471143 VIRGIN  |
| <i>data processing</i>   | Identical or highly similar to <i>business administration</i> and <i>office functions</i> in CTM 6261473 VIRGIN GREEN FUND<br><br>Similarity on the low side to <i>computer programming services</i> in CTM 1471143 VIRGIN                              |
| <i>accountancy</i>   | Moderate level of similarity to <i>business management</i> and <i>business administration</i> in CTM 6261473 VIRGIN GREEN FUND<br><br>Relatively low level of similarity to <i>financial affairs; monetary affairs</i> in CTM 6261473 VIRGIN GREEN FUND |
| <i>trade fairs</i>   | If any, similarity is only very low in respect to <i>business management</i> and <i>business administration</i> in CTM 6261473 VIRGIN GREEN FUND  |
| <i>opinion polling</i>   | If any similarity, it is only very low in respect to <i>advertising</i> in CTM 6261473 VIRGIN GREEN FUND  |
| <i>electronic data storage</i>   | A low level of similarity, if any to <i>business administration</i> and <i>office functions</i> in CTM 6261473 VIRGIN GREEN FUND  |

### ***The average consumer***

54) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the services at issue.

55) I have found that Mr Casey's *advertising; advertising services provided via the Internet; production of television and radio advertisements* and *electronic data storage* are identical to services covered by some of VEL's earlier marks. It

follows that they will share the same average consumer and the nature of the purchasing act will be the same. These are generally business-to-business services, where the average consumer will have a higher level of knowledge than may be the case with services targeted at the general public. The cost of these services is likely to be high enough for the business to carefully consider the most appropriate provider. Therefore the purchasing act is reasonably well considered. Nothing has been put before me to indicate whether the purchasing act will rely predominantly on visual or aural considerations and I conclude that both aspects are of equal importance.


56) Mr Casey's remaining services are also business services that I would expect to be provided to other businesses. Therefore, similar considerations apply to the nature of the purchasing act. The average consumer will generally have a higher level of knowledge and the likely reasonably high cost of the services will result in a reasonably well considered purchasing act.

57) In addition to the above, of some relevance is VEL's *financial affairs; monetary affairs*. These terms cover a wide range of services with an accompanying range of average consumers and purchasing acts. At one end of the spectrum will be financial services such as the provision of credit card services to the general public and at the other end, investment services involving large amounts of money provided to large businesses. Nevertheless, even at the lower end of this spectrum, the purchasing act will be a well considered one as individuals will carefully consider the benefits and interest rates available before choosing a credit card from a particular undertaking.

58) Finally, at the hearing, VEL also relied upon its *computer programming services*. As with its services discussed above, these are business-to-business services and are somewhat specialist in nature, relying upon professional experts to deliver the services and where the costs of the services are likely to reflect this. The purchasing act is therefore reasonably well considered.

### ***Comparison of marks***

59) VEL relies upon five earlier marks. For ease of reference, these five earlier marks, together with Mr Casey's mark, are reproduced below:

| VEL's marks   | Mr Casey's mark      |
|---|----------------------|
| CTM 1471143 &<br>CTM 4262093<br>CTM 5189923<br><b>VIRGIN</b><br><br>CTM 6261473<br><b>VIRGIN GREEN FUND</b><br><br>CTM 4262085<br><br> | <b>CARBON VIRGIN</b> |

60) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23).

61) Firstly, I will consider the extent of similarity between Mr Casey's mark and VEL's VIRGIN marks. From a visual perspective, there is a clear similarity in that the second word in Mr Casey's mark is the same as the single word in VEL's mark. An obvious difference is the addition of the word CARBON that appears as the first of the two words in Mr Casey's mark. Taking these factors into account, I conclude that the respective marks share a reasonable level of visual similarity.

62) In respect to the aural aspects of the two marks, Mr Casey's mark consists of two words totalling four syllables, namely car-bon-vir-gin as opposed to VEL's mark which consists of the two syllables vir-gin. There is an element of similarity by virtue of the shared word VIRGIN, but also a difference in length and sound because of the additional word CARBON. Taking these similarities and differences into account, I find that the respective marks share a reasonable level of aural similarity.

63) Turning to the consideration of conceptual similarity, the word VIRGIN alone will be seen as designating its primary meaning, namely a person, typically a woman, who has never had sexual intercourse. Without the addition of a qualifying word that leads the consumer to see an alternative meaning (as exemplified by the term "political virgin" referred to in the dictionary extract at paragraph 29 above), it is this risqué meaning that dominates.

64) Mr Casey's mark, on the other hand, is qualified by the addition of the word CARBON. He contends that the mark "speaks to customers seeking 100% carbon neutral services" and contends that VEL's arguments that the word CARBON has a subordinated role does "not hold water". I believe there is some

force to this argument. The combination of the words CARBON and VIRGIN leads the consumer to perceive the word VIRGIN differently to where it appears alone or at the start of a term. It is seen as meaning “a person who is naive or inexperienced in a particular context” (see dictionary reference detailed earlier) with the “particular context” being identified by the word CARBON. That said, the concept of a “carbon virgin” is somewhat opaque, where the word CARBON is allusive and not purely descriptive, as Mr Stobbs contends. The word CARBON is associated with global warming but when combined with the word VIRGIN, the totality has no more than an allusion to a person inexperienced in environmental matters. Alternatively, Mr Casey identified that it is possible that his mark will be perceived as describing a representation of the Virgin Mary made from a carbon material such as diamond or graphite. When used in respect of the relevant services, this meaning is much less likely to be identified in the minds of the consumer. Here, although the word CARBON may be perceived as descriptive, this is only because the word VIRGIN would be perceived as a reference to the Virgin Mary.

65) Mr Stobbs submitted that in Mr Casey’s mark the word VIRGIN will have an independent and distinctive role within the mark. He also contended that as the word CARBON is descriptive in relation to the subject of global warming then, in the mark CARBON VIRGIN, it functions purely as a description of services offered by VIRGIN. In support of this, he referred to the Registry decision BL O-372-99 DIGITAL EDGE. Here the Hearing Officer found that, when comparing the marks DIGITAL EDGE and EDGE, the addition of the word DIGITAL in the first mark was insufficient to remove the likelihood of confusion because the mark DIGITAL EDGE would be perceived as merely indicating digital products identified by the mark EDGE. This is not on all-fours with the current case as VEL’s services cannot be described as “carbon” in the way that there were goods sold under the mark EDGE could be “digital”. I am particularly mindful of the guidance from *MEDION* that a mark to mark comparison must be made by examining each of the marks in question as a whole and, from *Sabel BV v Puma AG*, that the consumer normally perceives a mark as a whole and does not proceed to analyse its various details. This point is also made by Mr Casey in his written submissions. With the *MEDION* guidance in mind, the different meaning associated with the word VIRGIN in each of the marks results in the marks having a subtly distinct conceptual identity. In Mr Casey’s mark the overall impression is conveyed by a combination of both components so that the conceptual identity is that as identified in the preceding paragraph.

66) Taking account of all these points, and despite the marks sharing a common element, namely the word VIRGIN, the word takes on a subtly different meaning in each mark resulting in different concepts being created in the minds of the average consumer. As such, there is no conceptual similarity.

67) To summarise, I have found that the respective marks share a reasonable level of visual and aural similarity but that there is no conceptual similarity. These

factors combine so that the respective marks share a moderate level of similarity overall.

68) Similar considerations exist in respect of the aural and conceptual comparison between Mr Casey's mark and VEL's "VIRGIN signature" mark. Visual considerations differ in that VEL's mark is a stylised version of its mark with the word VIRGIN appearing in the style of a hand written signature. The impact of this stylisation is to introduce an additional point of difference between the respective marks that results in a moderate level of visual similarity. Taking these points into account VEL's "VIRGIN signature" mark shares a a low to moderate level of similarity with Mr Casey's mark.

69) Finally, I turn to consider the similarity between VEL's VIRGIN GREEN FUND and Mr Casey's mark. From a visual perspective, VEL's mark consists of three words and Mr Casey's mark consists of two. This is a point of difference, as is the fact that the words GREEN FUND that appear in VEL's mark are not present in Mr Casey's mark, but the word CARBON is. The word VIRGIN appears as the first element in VEL's mark but the second and last element of Mr Casey's mark. Taking all of this into account, I conclude that the respective marks share a low level of visual similarity.

70) In respect of aural similarity, both marks contain the word VIRGIN that is pronounced the same way in both marks. However, this is the extent of similarity as the word VIRGIN appears in different positions within the respective marks and with additional words that differ in each mark. This all combines to result in only a low level of aural similarity.

71) As I have identified above, the conceptual identity of Mr Casey's mark is that of an allusion to a person inexperienced in environmental matters. VEL's mark includes the words GREEN FUND that describe a financial resource or large stock<sup>5</sup> that is managed in a way that supports protection of the environment<sup>6</sup>. In light of this descriptive function, the word VIRGIN is the dominant and distinctive element when the mark is considered as a whole, and without further qualification, it will retain its risqué meaning in the minds of the consumer. As such the whole has two, apparently unlinked conceptual elements that have no sensible meaning when combined. Taking all of this into account, I conclude that there is no conceptual similarity, or at best, a very low level of conceptual similarity.

72) In summary, VEL's VIRGIN GREEN FUND mark and Mr Casey's mark share a low level of visual and aural similarity and no, or at best, a very low level of

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<sup>5</sup> "fund n." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 22 June 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e22236>>

<sup>6</sup> "green adj." *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 22 June 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e24152>>

conceptual similarity. These factors combine so that the respective marks share a low level of similarity overall.

***Distinctive character of the earlier trade mark***

73) I have to consider whether VEL's marks have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. They all consist of, or contain, the word VIRGIN. In VEL's marks, this has a clear and slightly risqué meaning in English, as already identified earlier, but in respect of the relevant goods and services the word has no connection. Taking this into account and in particular the risqué and memorable meaning of the word VIRGIN, the marks enjoy a high degree of inherent distinctive character.

74) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

75) It has been accepted by Mr Casey that VEL enjoys a reputation in respect of a broad range of goods and services. Whilst the evidence supports a claim to a reputation in respect of numerous services including retailing and credit card services, there is nothing to illustrate that this reputation extends to advertising

services, business administration, office functions or computer programming services. As such, I conclude that the already high degree of distinctiveness of VEL's marks is enhanced further through use in respect of many services, including retailing and credit card services, but not in respect of the other relevant services.

### ***Likelihood of confusion***

76) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

77) VEL's best case resides in its word only mark CTM 4262093 VIRGIN that includes some advertising services that are identical to Mr Casey's advertising services. Therefore, in the first instance, I will consider the likelihood of confusion between this mark and Mr Casey's mark. I have concluded that VEL's mark enjoys a high level of distinctive character and that the purchasing act in respect of the relevant respective services is reasonably well considered. I have also concluded that these marks share a reasonable level of visual and aural similarity but that, at best, they only share a very low level of conceptual similarity. This results from the different impression created by Mr Casey's mark in the minds of the consumer because the word VIRGIN takes on a different meaning as a result of it being used with the word CARBON. This different concept is sufficient to differentiate the marks in the minds of the consumer, even taking account of imperfect recollection. Certainly, there is no likelihood of direct confusion where one mark is mistaken for the other because I have rejected VEL's argument that CARBON serves in a totally descriptive way and that, as a result, the dominant and distinctive element of Mr Casey's mark is the word VIRGIN. Further, in light of the lack of conceptual similarity, neither will there be any indirect confusion where the consumer assumes that the services provided under each mark originate from the same or linked undertaking. In summary, I find that there is no likelihood of confusion in respect of these marks.

78) VEL's case is no stronger in respect of its VIRGIN GREEN FUND mark. Here, the high point of its case is in respect of its *business administration* and *office functions* that I have found to be identical to Mr Casey's *electronic data storage*. However, similar considerations exist regarding how the respective marks will be perceived in the minds of the relevant consumer and, as a result, there will be no likelihood of confusion.

79) In respect of VEL's "VIRGIN signature" mark where the level of similarity between the respective marks is slightly less, it follows that its case in respect of this mark is no better and I find that there is no likelihood of confusion.



80) In summary, taking all factors into account, I find that there is no likelihood of confusion between any of VEL's marks and Mr Casey's mark and the grounds of opposition based upon Section 5(2)(b) of the Act are dismissed in their entirety.

#### **Section 5(4)(a)**

81) I will consider the ground under Section 5(4) (a) first. That section reads as follows:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) .....

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

82) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponent's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent; and

(3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

83) The relevant date for determining the opponent's claim, in the absence of any competing earlier claim on the part of the applicant, will be the filing date of the application in suit, that is to say 9 May 2008. The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104, codified version Directive 2008/95/EC, on which the UK Act is based). It has been accepted by Mr Casey that VEL's VIRGIN mark and its “VIRGIN signature” mark are “well known across a broad range of goods and services in the UK”. This is indeed supported by VEL's evidence that illustrates that it is recognised

by its marks in numerous fields such as retail services, airline services, credit card services and rail services to list but a few. However, even accepting this, I do not see how there is misrepresentation any more than there may be likelihood of confusion under Section 5(2)(b). VEL relies upon two signs, that whilst offering its best case, are also relied upon in its opposition based upon Section 5(2)(b). Further, whilst it claims a reputation in respect of a wide range of goods and services, the evidence does not demonstrate that it has a reputation in respect of any relevant services that have not already been taken into account when considering the grounds based upon Section 5(2). I recognise that goodwill in the business itself may, in certain circumstances, be enough to support a claim of passing-off but in this case, taking all factors into account, and in particular how the consumer will perceive the respective marks, VEL is in no better position than it is in respect of its grounds under Section 5(2)(b). In light of this, I cannot see that VEL can be successful in respect to its grounds based upon Section 5(4)(a) and this ground is therefore rejected.

### **Section 5(3)**

84) I turn to consider the ground of opposition under Section 5(3) of the Act which reads as follows:

“5.-(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

85) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA* (CHEVY) [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited* (TYPHOON) [2000] FSR 767, *Daimler Chrysler v Alavi* (MERC) [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* (VISA) [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines* (LOADED) O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7, *Davidoff & Cie SA v Gofkid Ltd* (DAVIDOFF) [2003] ETMR 42, *Intel Corporation Inc. v CPM United Kingdom Ltd* (INTEL) [2009] RPC 15, *L'Oreal v Bellure* [2010] RPC 1 and *Whirlpool Corp v Kenwood Limited* [2010] RPC 2.

86) The applicable legal principles arising from these cases are as follows:

- a) 'Reputation' for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the ECJ's judgment in *CHEVY*).
- b) Under this provision the similarity between the marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier mark and the later mark or sign (*Adidas Salomon v Fitnessworld*, paragraphs 29-30).
- c) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case (*INTEL*).
- d) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link between the conflicting marks, within the meaning of *Adidas-Salomon and Adidas Benelux*. (*INTEL*)
- e) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the ECJ in *CHEVY*, paragraph 30).
- f) Whether use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case (*INTEL*).
- g) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous mark or an attempt to trade upon its reputation (*Spa Monopole v OHIM*).
- h) The use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique; a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark; proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*INTEL*).

i) Taking unfair advantage of the distinctive character or repute of a mark relates not to detriment caused to the earlier mark but to the advantage taken by the third party. Such an advantage may be unfair even where the use is not detrimental to the distinctive character or to the repute of the mark (*L'Oreal v Bellure*). It is not sufficient to show that an advantage has been obtained, there must be an added factor of some kind for that advantage to be categorised as unfair (*Whirlpool Corp v Kenwood Limited*).

### **Reputation**

87) As I have already said, Mr Casey has accepted that VEL's VIRGIN mark and its "VIRGIN signature" mark are "well known across a broad range of goods and services in the UK". VEL's evidence confirms this. There may be issues regarding the precise extent of this reputation, but for reasons that will become obvious, I have no need to consider this point further.

### **The Link**

88) Having established the existence of a broad reputation, I need to go on to consider the existence of the necessary link. I am mindful of the comments of the ECJ in *INTEL* that it is sufficient for the later trade mark to bring the earlier trade mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The ECJ also set out the factors to take into account when considering if the necessary link exists:

"41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;

– the existence of the likelihood of confusion on the part of the public.”

89) I have already concluded that there is only a moderate level of similarity between VEL’s best case mark, VIRGIN, and Mr Casey’s mark and that VEL’s earlier marks all enjoy a high level of distinctive character, but that there is no likelihood of confusion.

90) The evidence illustrates a wide range of goods and services for which VEL has a reputation in the UK and, in particular, in respect to the retail of music, holiday services and airline services. Mr Stobbs argued that because of this broad reputation, where a mark incorporating the word VIRGIN is used in respect of the services claimed in Mr Casey’s application, the consumer would assume a link to VEL. I do accept that, in light of VEL’s broad reputation identified by its various VIRGIN marks, some marks incorporating the word VIRGIN may lead the consumer to believe there is a link with VEL. However, I do not accept that this in the case with Mr Casey’s mark. The lack of conceptual similarity and the different impressions created in the minds of the consumer, when confronted with the respective marks, will result in the consumer not making the necessary link.

91) As I have found that the necessary link has not been established, I do not need to go on to consider the issue of unfair advantage or detriment. Neither do I need to consider Mr Casey’s defence that use of the word VIRGIN in his mark is with due cause.

92) In summary, VEL’s grounds based upon Section 5(3) of the Act are dismissed

## **COSTS**

93) The opposition having failed, Mr Casey is entitled to a contribution towards his costs. I take account of the fact that I allowed VEL to amend its pleadings at the hearing, but this did not result in any additional work on the part of Mr Casey and the fact that Mr Casey filed further written submissions after the hearing that I permitted into the proceedings and necessitated further detailed submissions to be made on behalf of VEL. Mr Casey has not been legally represented in these proceedings and it is the Registrar’s practice to award costs to litigants in person at half the rate that he awards them where a party has had legal representation.

94) I award costs on the following basis:

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| Considering Notice of Opposition and preparing statement | £200         |
| Preparing and filing evidence & considering evidence     | £600         |
| Preparing for, and attending hearing                     | £200         |
| <b>TOTAL</b>   | <b>£1000</b> |

95) I order Virgin Enterprises Limited to pay Michael Casey the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 03 day of August 2010**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**

## **Annex 1**

### **GOODS AND SERVICES THAT VEL RELIES UPON IN RESPECT OF ITS SECTION 5(4)(a) GROUNDS**

Preparations for the hair, scalp, skin and nails; soaps, anti-perspirants; essential oils; non-medicated toilet preparations, toilet articles included in class 3; cosmetics; depilatory preparations; dentifrices; fragrances, perfumes, incense; deodorants; pot pourri; room fragrances; fragranced articles for fragrancing rooms; cotton wool; sun-tanning preparations, bronzing preparations for the skin; toiletries.

Candles; christmas tree candles; industrial oils and greases; lubricants; fuels and illuminants; wicks for lighting.

Common metals and their alloys; ironmongery, small items of metal hardware; key rings; coat hangers; storage boxes; storage box stacks; wine racks made of metal.

Hand tools and implements (hand operated); cutlery; razors; can openers; cheese slicers (non- electric); pizza cutters; garden tools; scissors; egg slicers (non-electric); sugar tongs; tin openers (non-electric); vegetable choppers; vegetable shredders; vegetable slicers; manicure sets; pedicure sets; tweezers; curling tongs; eyelash curlers; hair straighteners; crimping irons.

Precious metals and their alloys and goods in precious metal or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; vases of precious metal; clocks; napkin rings of precious metal; tealight holders of precious metal; candlesticks of precious metal; candelabra of precious metal; toothbrush holders; tissue boxes; toilet roll holders; soap dispensers; key rings; jewellery boxes; perfume bottles; place mats; coffee services of precious metal; containers (household) of precious metal; cruet stands of precious metal for oil and vinegar, cruets of precious metal; cups of precious metal; dishes of precious metal; figurines (statuettes) of precious metal; gold and silverware (other than cutlery, forks and spoons); jugs of precious metal; napkin holders of precious metal; nutcrackers of precious metal; salad bowls; salt cellars and salt shakers of precious metal; tea caddies, tea infusers, tea services, tea strainers and teapots all of precious metal; towel holders of precious metal; trays of precious metal for household purposes; trinkets; works of art of precious metal.

Apparatus and instruments, all for recording, reproduction and/or transmitting sound/or video information; sound and/or video recordings; sound and/or video recording media; video games; CD ROM; virtual reality systems; telephonic apparatus and instruments; mobile telephones; scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments;

apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; apparatus and instruments, all for recording and reproducing sound and video; radio and television apparatus and instruments both for reception and transmission, aerials; sound and/or video recordings; in the form of cassettes, records discs, tapes or wires; magnetic tapes for bearing sound or video recordings; cassettes, discs, tapes and cartridges; video discs; compact discs; video accessories; cinematographic films; photographic slide transparencies; calculators; video games; electronic games, electronic amusement apparatus, computers, computer software; magnetic tapes for recording computer programmes or data; electronically, magnetically and optically recorded data for computers; computer games; racks adapted to hold records or to hold tapes; cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods, all included in class 9; parts and fittings for all the aforesaid goods; publications in electronic format (downloadable).

Stationery; printed matter, periodicals; books, magazines, publications, posters; comic books, activity books, colouring books, note books, address books, trading cards, stickers, decalcomanias; trading card milk bottle caps; bookmarks; artists' materials; writing or drawing implements; calendars, posters, organisers (non-electronic); instructional and teaching materials; office requisites; erasers, sharpeners; rulers; rub down transfers; stationery portfolios; photo albums; albums; wrapping paper, gift wrap, gift tags, gift boxes; greeting cards; paper party goods; paper party decorations; wrapping and packaging materials; cork boards; chalk boards; memorandum boards; stamp albums; manuals; scrap books; playing cards; photographs; paper or cardboard models; adhesives for office or domestic use; sticky tape; paper; paint brushes; paperweights; pencil sets; pencil or pen boxes; organisers; paper napkins; postcards; modelling materials; sheet music.

Clothing, headwear, footwear, headgear

Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); articles for cleaning purposes; glassware, porcelain and earthenware not included in other classes; vases (not of precious metal); bowls and pot-pourri bowls; storage boxes for household use; storage box stacks for household use; ornaments made of ceramics, china, crystal, earthenware, glass or porcelain, table centre pieces made of glass; model figures (ornaments) made of earthenware, glass, porcelain or terracotta; crockery including dinner plates, side plates, soup bowls, teacups, saucers, teapots, sugar bowls, jugs and coffee mugs; napkin rings (not of precious metal); coasters; table dressing plates; glasses including stemmed glasses and water glasses; tealight holders; candlesticks (not of precious metal); toothbrush holders; beakers; soap dishes; tissue boxes; ceramic storage



containers; toilet roll holders; toilet brushes; soap dispensers; coffee cup gift sets; baskets; bins; perfume bottles; unbreakable glasses; wine glass holders; glasses sets; busts of china, terracotta or glass; butter dishes; chopsticks; cocktail stirrers; coffee filters (non-electric); coffee grinders (hand operated); coffee percolators (non-electric); coffee services (not of precious metal); coffee pots (non-electric) not of precious metal; cooking pots and cooking pot sets; coolers (ice pails); corkscrews; cosmetic utensils; cruet stands for oil and vinegar (not of precious metal); cruets (not of precious metal); crystal (glassware); egg cups; decanters; cutting boards for the kitchen; flasks (not of precious metal); flower pots; glassware (painted); ice buckets; ice cube moulds; ironing boards and ironing board covers; insect traps; jugs (not of precious metal); kettles (non-electric); liqueur sets; mills for domestic purposes (hand operated); nailbrushes; paper plates; perfume burners; perfume sprayers and perfume vaporisers; picnic baskets; piggy banks (not of metal); pitchers (not of metal); salad bowls (not of precious metal); salt cellars and salt shakers (not of precious metal); spice sets; tableware; tankards (not of precious metal); tea caddies, tea infusers, tea services and tea strainers (not of precious metal); thermally insulated containers for food; trays for domestic purposes (not of precious metal); trivets (table utensils); watering cans; works of art of porcelain, terracotta or glass; plastic jugs.

Textiles and textile goods, not included in other classes; bed and table covers; duvets; duvet covers; fitted sheets; pillow cases; flat sheets; throws; cushion covers; voile panels; rugs (travelling); napkins of textiles; placemats (not of paper); table runners; towels; shower curtains; picnic blankets; bed linen; hooded towels; bedspreads; blankets (bed); furniture coverings of textile; (curtains of textile) or plastic; eiderdowns; face towels of textile; mattress covers; mosquito nets; net curtains; quilts, wall hangings of textile.

Carpets, rugs, mats and matting, linoleum and other materials for existing floors; wall hangings (non textile); bath mats; wallpaper.

Toys, games and playthings; electronic games and video games; amusement apparatus; gymnastic and sporting articles; decorations for Christmas trees; parts and fittings for all the aforesaid.

Wines; sparkling wines; alcoholic beverages; liqueurs, cider; spirits; cocktails.

Retail services; retail services in relating to music products including CDs, records, tapes, discs and video, sound or image recordings, retail services in relation to magazines, books and other printed matter; retail services in relation to clothing, footwear, headgear, toys, games, clocks, watches, precious goods, pop memorabilia, PCs, printers, stationery, computer games, food, drinks, furniture, fragrances, toiletries, cosmetics, bags, electrical goods, wall hangings, floor coverings. Advertising; business management; business administration; office functions

Insurance; financial affairs; monetary affairs; real estate affairs; creation, management and administration of investment funds, fund investment (services). Real estate services; agency services for the leasing of real estate property; agency services for the selling on commission of real property; financial services relating to real estate property and buildings; estate management services relating to transactions in real property; financing of property development; management of property; property portfolio management; information and advisory services relating to all the aforesaid services.

Building construction; advisory services relating to development of property; advisory services relating to the renovation of property; commercial retail property development services; property development.

Telecommunication services; broadcasting services; transmission of messages amongst remote users via telephone, on-line, cable or satellite systems; communication via computer terminals; Internet communication services.

Arranging transportation of goods or persons by road, rail, air and sea; transportation of goods and of persons by road, rail, air and sea; freight services; ground transport services; car and motorcycle hire; chauffeur services; arranging of travel; tourist offices; travel agencies; tour operating; reservation services; operation of aircraft, airships and air balloons; travel information services.

Storage, distribution and transportation of energy and fuels.

Energy production; treatment of materials.

Catering services for the provision of food and drink; club, hotels; hotel reservation, restaurant, public house, café and cafeteria services; organising and providing facilities for conferences and exhibitions; photography services; Turkish baths, beauty salons; non-business consultancy in the field of body care; manicure services; pedicure services; aromatherapy services; reflexology services; chiropody services; provision of exercise and steam rooms; computer programming services; scientific and industrial research, legal services, medical, hygienic and beauty care, veterinary and agricultural services; provision of temporary accommodation; consultancy services; security services; dress rental; fashion information; printing services; junk clearance; rental and hire services; flower arranging services; landscape gardening; graphic arts design; pet grooming; retirement homes; horoscope casting; investigations; midwifery services; pharmacy advice; meteorological information; weather reports; psychological services; news reporter services; plastic surgery; vocational guidance services; sanatoriums; computer software design; tree surgery; wreath making; underwater exploration services; opticians services; dentistry services; physiotherapy services; quality control services; butler services; escort agency services; genealogical research services; chaperone services; funeral services; cremation services; dress design; hospital services; convalescent services; child

care or nanny services; hair implantation; detective services; intellectual property services; consultancy in the field of environmental protection; fire-fighting services; chiropratics; homeopathy services; marriage bureau services; engineering services; architecture services; blood bank services; vermin extermination; translation services.

Educational services; educational services in relation to films or other artistic productions; provision of educational or training material in relation to films or other artistic productions; arranging for seminars for educational purposes; showing of educational films; provision of entertainment; provision of cinema facilities; motion picture production, live performances, theatrical productions, stage, screen and television entertainment services; audio programming; organising and conducting stage shows, theatre productions, contests, dances and parties; casino services; provision of recreational and sporting facilities; recording studio services for sound, films, videos and television; film distribution and production; publishing; concert and nightclub entertainment services; entertainer services; sporting and cultural activities; operation of leisure/fitness centres and health club services; entertainment services, amusement parks; rental of sports equipment; organisation of sporting events and competitions; publication of books; entertainment or educational club services; library services; camp services; arranging and conducting of conferences; club and resort entertainment and recreation services.

Provision of food and drink; club, restaurant, public house, café, cafeteria and bar services; catering; accommodation services; hotel and hotel reservation services; day nurseries; camp services.

Medical services; beauty salons; turkish bath services; hairdressing, manicure and pedicure services; consultancy in the field of beauty, body and skincare, make up and dress; massage; physical therapy; sun tanning salons; provision of sauna facilities; aromatherapy; reflexology; chiropody; provision of exercise and steam facilities.

Health assessments and health care risk assessments; advisory services relating to health; consultancy relating to health care; lifestyle counselling and consultancy; organisation, operation and supervision of incentivised health and fitness programmes and information advisory services relating to all aforesaid services.

Personal and social services rendered by others to meet the needs of individuals; clothing rental; security services for the protection of property and individuals; investigation services.

## Annex 2

### RELEVANT DETAILS OF VEL'S EARLIER MARKS

| Application Number and relevant dates   | Mark          | Relevant list of goods and/or services  |
|---|---------------|---|
| <p>CTM 1471143</p> <p>Filing date:<br/>21/01/2000</p> <p>Date of Registration:<br/>30/01/2003</p> | <p>VIRGIN</p> | <p><b>Class 16:</b> Stationery; printed matter, periodicals, books, magazines, publications, posters, comic books, activity books, colouring books, note books, address books, trading cards, stickers, decalcomanias; trading cards in the form of milk bottle caps; bookmarks; artists' materials; writing or drawing implements; calendars; posters, organisers (non-electronic); instructional and teaching materials; office requisites; erasers, sharpeners; rulers; rub down transfers; stationery portfolios; photo albums; albums; wrapping paper, gift wrap, gift tags, gift boxes; greeting cards; paper party goods; paper party decorations; wrapping and packaging materials; cork boards; chalk boards; memorandum boards; stamp albums; manuals; scrap books; playing cards; photographs; paper or cardboard models; adhesives for office or domestic use; sticky tape; paper; paint brushes; paperweights; pencil sets; pencil or pen boxes; organisers; paper napkins; postcards; modelling materials; sheet music.</p> <p><b>Class 25:</b> Clothing, headwear, footwear, headgear.</p> <p><b>Class 35:</b> Retail services; retail services in relating to music products including CDs, records, tapes, discs and video, sound or image recordings, retail services in relation to magazines, books and other printed matter; retail services in relation to clothing, footwear, headgear, toys, games, clocks, watches, precious goods, pop memorabilia, PCs, printers, stationery, computer games, food, drinks, furniture, fragrances, toiletries, cosmetics, bags, electrical goods, wall hangings, floor coverings.</p> <p><b>Class 42:</b> Catering services for the provision of food and drink; club, hotels; hotel reservation, restaurant, public house, café and cafeteria services; organising and providing facilities for conferences and exhibitions; photography services; Turkish baths, beauty salons; non-business consultancy in the field of body care; manicure services; pedicure services; aromatherapy services; reflexology services; chiropody services; provision of exercise and</p> |

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|   |                                  | <p>steam rooms; computer programming services; scientific and industrial research, legal services, medical, hygienic and beauty care, veterinary and agricultural services; provision of temporary accommodation; consultancy services; security services; dress rental; fashion information; printing services; junk clearance; rental and hire services; flower arranging services; landscape gardening; graphic arts design; pet grooming; retirement homes; horoscope casting; investigations; midwifery services; pharmacy advice; meteorological information; weather reports; psychological services; news reporter services; plastic surgery; vocational guidance services; sanatoriums; computer software design; tree surgery; wreath making; underwater exploration services; opticians services; dentistry services; physiotherapy services; quality control services; butler services; escort agency services; genealogical research services; chaperone services; funeral services; cremation services; dress design; hospital services; convalescent services; child care or nanny services; hair implantation; detective services; intellectual property services; consultancy in the field of environmental protection; fire-fighting services; chiropratics: homeopathy services; marriage bureau services; engineering services; architecture services; blood bank services; vermin extermination; translation services.</p> |
| <p>CTM 6261473</p> <p>Filing date:<br/>06/09/2007</p> <p>Date if Registration:<br/>13/06/2008</p> | <p>VIRGIN<br/>GREEN<br/>FUND</p> | <p><b>Class 16:</b> Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; books relating to general subject matter; greeting cards; postcards; writing instruments, pens, pencils, ball point pens.</p> <p><b>Class 35:</b> Advertising; business management; business administration; office functions.</p> <p><b>Class 36:</b> Insurance; financial affairs; monetary affairs; real estate affairs; creation, management and administration of investment funds, fund investment (services).</p>   |
| <p>CTM 611459</p> <p>Filing date:<br/>25/09/1997</p>  | <p>VIRGIN</p>                    | <p><b>Class 38:</b> Telecommunication services; broadcasting services; transmission of messages amongst remote users via telephone, on-line, cable or satellite systems; communication via computer terminals; Internet communication</p>   |

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| Date of Registration:<br>26/01/1999  |        | services.   |
| CTM 3421633<br><br>Filing date:<br>21/10/2003<br>Date of Registration:<br>22/04/2005 | VIRGIN | <p><b>Class 28:</b> Toys, games and playthings; electronic games and video games; amusement apparatus; gymnastic and sporting articles; decorations for Christmas trees; parts and fittings for all the aforesaid.</p> <p><b>Class 33:</b> Wines; sparkling wines; alcoholic beverages; liqueurs, cider; spirits; cocktails.</p> <p><b>Class 41:</b> Educational services; educational services in relation to films or other artistic productions; provision of educational or training material in relation to films or other artistic productions; arranging for seminars for educational purposes; showing of educational films; provision of entertainment; provision of cinema facilities; motion picture production, live performances, theatrical productions, stage, screen and television entertainment services; audio programming; organising and conducting stage shows, theatre productions, contests, dances and parties; casino services; provision of recreational and sporting facilities; recording studio services for sound, films, videos and television; film distribution and production; publishing; concert and nightclub entertainment services; entertainer services; sporting and cultural activities; operation of leisure/fitness centres and health club services; entertainment services, amusement parks; rental of sports equipment; organisation of sporting events and competitions; publication of books; entertainment or educational club services; library services; camp services; arranging and conducting of conferences; club and resort entertainment and recreation services.</p> <p><b>Class 43:</b> Provision of food and drink; club, restaurant, public house, café, cafeteria and bar services; catering; accommodation services; hotel and hotel reservation services; day nurseries; camp services.</p> <p><b>Class 44:</b> Medical services; beauty salons; turkish bath services; hairdressing, manicure and pedicure services; consultancy in the field of beauty, body and skincare, make up and dress; massage; physical therapy; sun tanning salons; provision of sauna facilities; aromatherapy; reflexology; chiropody; provision of exercise and steam facilities.</p> <p><b>Class 45:</b> Personal and social services rendered</p> |

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|  |        | by others to meet the needs of individuals; clothing rental; security services for the protection of property and individuals; investigation services.   |
| CTM 4262093<br><br>Filing date:<br>29/01/2005<br>Date of Registration:<br>17/03/2006 | VIRGIN | <p><b>Class 35:</b> Advertising services relating to real property; management of incentive and loyalty programmes and other promotional schemes including those that reward healthy lifestyle choices with bonuses and benefits; information and advisory services relating to all the aforesaid services.</p> <p><b>Class 36:</b> Health insurance services including bonus and reward payments made as part of the insurance service; private health insurance; medical insurance; provision of finance for health care; savings schemes relating to health and health care; savings schemes relating to health insurance; issuing of tokens of value in relation to incentive schemes; incentivised health and fitness programmes; real estate services; agency services for the leasing of real estate property; agency services for the selling on commission of real property; financial services relating to real estate property and buildings; estate management services relating to transactions in real property; financing of property development; management of property; property portfolio management; information and advisory services relating to all the aforesaid services.</p> <p><b>Class 37:</b> Building construction; advisory services relating to development of property; advisory services relating to the renovation of property; commercial retail property development services; property development.</p> <p><b>Class 44:</b> Health assessments and health care risk assessments; advisory services relating to health; consultancy relating to health care; lifestyle counselling and consultancy; organisation, operation and supervision of incentivised health and fitness programmes and information advisory services relating to all aforesaid services.</p> |
| CTM 1798560<br><br>Filing date:<br>08/08/2000<br>Date of Registration:<br>05/06/2002 | VIRGIN | <p><b>Class 03:</b> Preparations for the hair, scalp, skin and nails; soaps, anti-perspirants; essential oils; non-medicated toilet preparations, toilet articles included in class 3; cosmetics; depilatory preparations; dentifrices; fragrances, perfumes, incense; deodorants; pot pourri; room fragrances; fragranced articles for fragrancing rooms; cotton wool; sun-tanning preparations, bronzing preparations for the skin; toiletries.</p> <p><b>Class 09:</b> Apparatus and instruments, all for</p>   |

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|  |   | <p>recording, reproduction and/or transmitting sound/or video information; sound and/or video recordings; sound and/or video recording media; video games; CD ROM; virtual reality systems; telephonic apparatus and instruments; mobile telephones; scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; apparatus and instruments, all for recording and reproducing sound and video; radio and television apparatus and instruments both for reception and transmission, aerials; sound and/or video recordings; in the form of cassettes, records discs, tapes or wires; magnetic tapes for bearing sound or video recordings; cassettes, discs, tapes and cartridges; video discs; compact discs; video accessories; cinematographic films; photographic slide transparencies; calculators; video games; electronic games, electronic amusement apparatus, computers, computer software; magnetic tapes for recording computer programmes or data; electronically, magnetically and optically recorded data for computers; computer games; racks adapted to hold records or to hold tapes; cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods, all included in class 9; parts and fittings for all the aforesaid goods; downloadable information in an electronic form; publications in electronic format (downloadable).</p> <p><b>Class 39:</b> Arranging transportation of goods or persons by road, rail, air and sea; transportation of goods and of persons by road, rail, air and sea; freight services; ground transport services; car and motorcycle hire; chauffeur services; arranging of travel; tourist offices; travel agencies; tour operating; reservation services; operation of aircraft, airships and air balloons; travel information services.</p> |
| <p>CTM 1746247</p> <p>Filing date:<br/>13/09/2000</p> <p>Date of Registration:</p> |  | <p><b>Class 09:</b> Apparatus and instruments, all for recording, reproduction and/or transmitting sound/or video information; sound and/or video recordings; sound and/or video recording media; video games; CD ROM; virtual reality systems; telephonic apparatus and instruments; mobile</p>  |





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| 04/03/2002 |  | <p>telephones; scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; apparatus and instruments, all for recording and reproducing sound and video; radio and television apparatus and instruments both for reception and transmission, aerials; sound and/or video recordings; in the form of cassettes, records discs, tapes or wires; magnetic tapes for bearing sound or video recordings; cassettes, discs, tapes and cartridges; video discs; compact discs; video accessories; cinematographic films; photographic slide transparencies; calculators; video games; electronic games, electronic amusement apparatus, computers, computer software; magnetic tapes for recording computer programmes or data; electronically, magnetically and optically recorded data for computers; computer games; racks adapted to hold records or to hold tapes; cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods, all included in class 9; parts and fittings for all the aforesaid goods; electronic publications (downloadable) provided online from databases or via the Internet.</p> <p><b>Class 16:</b> Stationery; printed matter, periodicals; books, magazines, publications, posters; comic books, activity books, colouring books, note books, address books, trading cards, stickers, decalcomanias; trading card milk bottle caps; bookmarks; artists' materials; writing or drawing implements; calendars, posters, organisers (non-electronic); instructional and teaching materials; office requisites; erasers, sharpeners; rulers; rub down transfers; stationery portfolios; photo albums; albums; wrapping paper, gift wrap, gift tags, gift boxes; greeting cards; paper party goods; paper party decorations; wrapping and packaging materials; cork boards; chalk boards; memorandum boards; stamp albums; manuals; scrap books; playing cards; photographs; paper or cardboard models; adhesives for office or domestic use; sticky tape; paper; paint brushes; paperweights; pencil sets; pencil or pen boxes; organisers; paper napkins; postcards; modelling</p> |
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|   |                          | <p>materials, catalogues.</p> <p><b>Class 38:</b> Telecommunication services; broadcasting services; providing user access to a global computer network; providing telecommunications connections to a global computer network; telecommunications of information (including web pages), electronic mail services; telecommunication gateway services; providing user access to the Internet.</p>   |
| <p>2365570</p> <p>Filing date:<br/>11/06/2004</p> <p>Date of Registration:<br/>04/02/2005</p> | <p>VIRGIN<br/>MOBILE</p> | <p><b>Class 09:</b> Sound and/or video recording media; radio or television apparatus or instruments; video games; CD ROM; virtual reality systems; telephonic apparatus and instruments; mobile telephones; telecommunications apparatus and instruments; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus or instruments for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; radio and television apparatus and instruments both for reception and transmission, aerials; sound and/or video recordings; cassettes, cartridges, records discs, tapes or wires bearing sound or video recordings; video discs; compact discs; video accessories; cinematographic films; photographic slide transparencies; calculators; video games; electronic games, electronic amusement apparatus; computers, computer software; computer hardware; computer firmware; magnetic tapes for recording computer programmes or data; electronically, magnetically and optically recorded data for computers; computer games; racks adapted to hold records or to hold tapes; cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods; parts and fittings for all the aforesaid goods; electronic publications (downloadable) provided online from databases or via the Internet; apparatus and instruments for conducting, controlling, regulating, switching, transforming or accumulating electricity; battery chargers, batteries; cabling for connecting electronic and electric goods; electric and electronic mobile phone accessories; all included in Class 09.</p> <p><b>Class 38:</b> Telecommunications services; transmission of voice, data, images, audio,</p> |

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|  |        | video, and information via telephone or the Internet; personal communications services; pager services; electronic mail services; broadcasting services; transmission or broadcast of news and information for others via telephone, television, radio, satellite or the Internet.  |
| 1369779<br><br>Filing date:<br>12/01/1989<br>Date of Registration:<br>20/03/1992     | VIRGIN | <b>Class 09:</b> Magnetic tapes for or bearing sound or video recordings, cassettes and cartridges all for use therewith; video discs; compact discs; sound records in the form of discs, tapes or wires; cinematographic and photographic films all prepared for exhibitions; photographic slide transparencies; calculators, video games, electronic games, amusement apparatus and parts and fittings therefor; computers, computer software; magnetic tapes for recording computer programmes or data; electrically, magnetically and optically recorded data for computers; computer games and parts and fittings therefor; racks adapted to hold records or to hold tapes; cases, bags, holdalls, carriers and containers all adapted for carrying or for storing any of the aforesaid goods; all included in Class 9.  |
| CTM 5272273<br><br>Filing date:<br>23/08/2006<br>Date of Registration:<br>03/07/2007 | VIRGIN | <b>Class 04:</b> Candles; christmas tree candles.<br><br><b>Class 06:</b> Common metals and their alloys; ironmongery, small items of metal hardware; key rings; coat hangers; storage boxes; storage box stacks; wine racks made of metal.<br><br><b>Class 08:</b> Hand tools and implements (hand operated); cutlery; razors; can openers; cheese slicers (non- electric); pizza cutters; garden tools; scissors; egg slicers (non-electric); sugar tongs; tin openers (non-electric); vegetable choppers; vegetable shredders; vegetable slicers; manicure sets; pedicure sets; tweezers; curling tongs; eyelash curlers; hair straighteners; crimping irons.<br><br><b>Class 14:</b> Precious metals and their alloys and goods in precious metal or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; vases of precious metal; clocks; napkin rings of precious metal; tealight holders of precious metal; candlesticks of precious metal; candelabra of precious metal; toothbrush holders; tissue boxes; toilet roll holders; soap dispensers; key rings; jewellery boxes; perfume bottles; place mats; coffee services of precious metal; containers (household) of precious metal; cruet stands of precious metal for oil and vinegar, cruets of precious metal; cups of precious metal; dishes of precious metal; figurines (statuettes) of precious metal; gold and |

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|  | <p>silverware (other than cutlery, forks and spoons); jugs of precious metal; napkin holders of precious metal; nutcrackers of precious metal; salad bowls; salt cellars and salt shakers of precious metal; tea caddies, tea infusers, tea services, tea strainers and teapots all of precious metal; towel holders of precious metal; trays of precious metal for household purposes; trinkets; works of art of precious metal.</p> <p><b>Class 21:</b> Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); articles for cleaning purposes; glassware, porcelain and earthenware not included in other classes; vases (not of precious metal); bowls and pot-pourri bowls; storage boxes for household use; storage box stacks for household use; ornaments made of ceramics, china, crystal, earthenware, glass or porcelain, table centre pieces made of glass; model figures (ornaments) made of earthenware, glass, porcelain or terracotta; crockery including dinner plates, side plates, soup bowls, teacups, saucers, teapots, sugar bowls, jugs and coffee mugs; napkin rings (not of precious metal); coasters; table dressing plates; glasses including stemmed glasses and water glasses; tealight holders; candlesticks (not of precious metal); toothbrush holders; beakers; soap dishes; tissue boxes; ceramic storage containers; toilet roll holders; toilet brushes; soap dispensers; coffee cup gift sets; baskets; bins; perfume bottles; unbreakable glasses; wine glass holders; glasses sets; busts of china, terracotta or glass; butter dishes; chopsticks; cocktail stirrers; coffee filters (non-electric); coffee grinders (hand operated); coffee percolators (non-electric); coffee services (not of precious metal); coffee pots (non-electric) not of precious metal; cooking pots and cooking pot sets; coolers (ice pails); corkscrews; cosmetic utensils; cruet stands for oil and vinegar (not of precious metal); cruets (not of precious metal); crystal (glassware); egg cups; decanters; cutting boards for the kitchen; flasks (not of precious metal); flower pots; glassware (painted); ice buckets; ice cube moulds; ironing boards and ironing board covers; insect traps; jugs (not of precious metal); kettles (non-electric); liqueur sets; mills for domestic purposes (hand operated); nailbrushes; paper plates; perfume burners; perfume sprayers and perfume vaporisers; picnic baskets; piggy banks (not of metal); pitchers (not of metal); salad bowls (not of precious metal); salt cellars and salt shakers (not of precious metal); spice sets;</p> |
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|   |   | <p>tableware; tankards (not of precious metal); tea caddies, tea infusers, tea services and tea strainers (not of precious metal); thermally insulated containers for food; trays for domestic purposes (not of precious metal); trivets (table utensils); watering cans; works of art of porcelain, terracotta or glass; plastic jugs.</p> <p><b>Class 24:</b> Textiles and textile goods, not included in other classes; bed and table covers; duvets; duvet covers; fitted sheets; pillow cases; flat sheets; throws; cushion covers; voile panels; rugs (travelling); napkins of textiles; placemats (not of paper); table runners; towels; shower curtains; picnic blankets; bed linen; hooded towels; bedspreads; blankets (bed); furniture coverings of textile; (curtains of textile) or plastic; eiderdowns; face towels of textile; mattress covers; mosquito nets; net curtains; quilts, wall hangings of textile.</p> <p><b>Class 27:</b> Carpets, rugs, mats and matting, linoleum and other materials for existing floors; wall hangings (non textile); bath mats; wallpaper.</p> |
| <p>CTM 5189923</p> <p>Filing date:<br/>10/07/2006</p> <p>Date of Registration:<br/>02/05/2007</p> | VIRGIN  | <p><b>Class 04:</b> Industrial oils and greases; lubricants; fuels and illuminants; candles and wicks for lighting.</p> <p><b>Class 39:</b> Storage, distribution and transportation of energy and fuels.</p> <p><b>Class 40:</b> Energy production; treatment of materials.</p> <p><b>Class 41:</b> Education; providing of training; entertainment; sporting and cultural activities; gaming services; provision of access to online computer games; betting and gambling services; entertainment services; providing online computer games; provision of online games for remote users or remote competitors; downloadable electronic games provided via the Internet.</p>   |
| <p>CTM 611467</p> <p>Filing date:<br/>25/09/1997</p> <p>Date of Registration:<br/>26/01/1999</p>  |  | <p><b>Class 38:</b> Telecommunication services; broadcasting services; transmission of messages amongst remote users via telephone, on-line, cable or satellite systems; communication via computer terminals; Internet communication services.</p>   |
| <p>CTM 4262085</p> <p>Filing date:<br/>28/01/2005</p>   |  | <p><b>Class 35:</b> Advertising services relating to real property; management of incentive and loyalty programmes and other promotional schemes including those that reward healthy lifestyle choices with bonuses and benefits; information</p>   |

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| <p>Date of Registration:<br/>17/03/2006</p> |  | <p>and advisory services relating to all the aforesaid services.</p> <p><b>Class 36:</b> Health insurance services including bonus and reward payments made as part of the insurance service; private health insurance; medical insurance; provision of finance for health care; savings schemes relating to health and health care; savings schemes relating to health insurance; issuing of tokens of value in relation to incentive schemes; incentivised health and fitness programmes; real estate services; agency services for the leasing of real estate property; agency services for the selling on commission of real property; financial services relating to real estate property and buildings; estate management services relating to transactions in real property; financing of property development; management of property; property portfolio management; information and advisory services relating to all the aforesaid services.</p> <p><b>Class 37:</b> Building construction; advisory services relating to development of property; advisory services relating to the renovation of property; commercial retail property development services; property development.</p> <p><b>Class 44:</b> Health assessments and health care risk assessments; advisory services relating to health; consultancy relating to health care; lifestyle counselling and consultancy; organisation, operation and supervision of incentivised health and fitness programmes, information and advisory services relating to all aforesaid services.</p> |
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