

ESTTA Tracking number: **ESTTA475793**

Filing date: **06/01/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Virgin Enterprises Limited
Granted to Date of previous extension	06/02/2012
Address	The School House 50 Brook Green London, W67RR UNITED KINGDOM

Attorney information	SARAH E DALE NORVELL IP LLC 1776 ASH STREET NORTHFIELD, IL 60093 UNITED STATES OFFICEACTIONS@NORVELLIP.COM, SDALE@NORVELLIP.COM Phone:7737292247
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Applicant Information

Application No	85299486	Publication date	04/03/2012
Opposition Filing Date	06/01/2012	Opposition Period Ends	06/02/2012
Applicant	Michael Casey 2nd Floor Left Am Treptower Park 51 Berlin, Germany, 12435 GERMANY		

Goods/Services Affected by Opposition

<p>Class 009. All goods and services in the class are opposed, namely: Communication software for providing access to the Internet; Computer programs for searching remotely for content on computers and computer networks; Computer search engine software</p>
<p>Class 035. All goods and services in the class are opposed, namely: Advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels; Advertising on the Internet for others; Advertising via electronic media and specifically the internet; An interactive web site for users to review and rate internet content, people, companies, products and/or services utilizing a software application to award points whereby web site users are eligible to exchange points earned for promotional items consisting of coupons, rebates, discounts or special offerings on goods and/or service provided by web site sponsors; Business administration services for processing sales made on the Internet; Business services, namely, providing an online network for contractors to receive leads and bidding opportunities by means of an online marketplace for the purpose of developing business for energy related products and services; Promoting the goods and services of others by</p>

means of distributing advertising on the Internet; Providing a searchable on-line advertising website and guide featuring the goods and services of other vendors via the Internet

Class 036.

All goods and services in the class are opposed, namely: Investment banking services; On-line banking services

Class 038.

All goods and services in the class are opposed, namely: Communications by means of mobile phones; Mobile radio telephone services; Transmission of sound, video and information from web cams, video cameras or mobile phones, all featuring live or recorded materials

Class 042.

All goods and services in the class are opposed, namely: Computer services, namely, providing search engines for obtaining data on a global computer network; Consultation services in the field of search engine optimization; Development, maintenance and updating of a telecommunication network search engine; Providing a website featuring a media aggregator and search engine for internet content; Providing customized on-line web pages featuring user-defined information, which includes search engines and on-line web links to other web sites; Provision of Internet search engines; Technical consulting in the field of environmental engineering

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Applicant's lack of a bona fide intent to use the mark in connection with the goods and services shown in the application at the time of filing.

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1039574	Application Date	09/09/1974
Registration Date	05/18/1976	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1970/01/00 First Use In Commerce: 1970/01/00 SOUND RECORDS IN THE FORM OF DISCS AND TAPES AND CASSETTES FOR USE THEREWITH		

U.S. Registration No.	1413664	Application Date	11/29/1984
Registration Date	10/14/1986	Foreign Priority Date	NONE

Word Mark	VIRGIN
Design Mark	
Description of Mark	NONE
Goods/Services	Class 039. First use: First Use: 1984/06/22 First Use In Commerce: 1984/06/22 AIR TRAVEL SERVICES

U.S. Registration No.	1469618	Application Date	03/03/1986
Registration Date	12/22/1987	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: PRE-RECORDED AUDIO AND/OR VIDEO TAPES, CASSETTES AND CARTRIDGES; PRE-RECORDED AUDIO AND VIDEO DISCS, PHONOGRAPH RECORDS [; PHOTOGRAPHIC AND CINEMATOGRAPHIC FILMS]		

U.S. Registration No.	1517801	Application Date	03/03/1986
Registration Date	12/27/1988	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: [PRE-RECORDED AUDIO AND/OR VIDEO TAPES, CASSETTES AND CARTRIDGES;] PRE-RECORDED AUDIO AND VIDEO DISCS, PHONOGRAPH RECORDS; PHOTOGRAPHIC AND CINEMATOGRAPHIC FILMS		

U.S. Registration No.	1591952	Application Date	03/18/1988
Registration Date	04/17/1990	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 016. First use: PRINTED SHEET MUSIC; [HOLOGRAPHS; MOUNTED PHOTOGRAPHS; POSTERS,] FICTIONAL AND NON-FICTIONAL BOOKS, [GEOGRAPHY AND HISTORY BOOKS, TEACHING BOOKS, DRAWING BOOKS, PRINTING BOOKS, WRITING BOOKS, SCHOOL TEXT BOOKS, PAINTING BOOKS, NOTE BOOKS, REFERENCE BOOKS, GARDENING BOOKS, MAINTENANCE BOOKS, LANGUAGE BOOKS, ADDRESS BOOKS, TELEPHONE BOOKS, COOK BOOKS,] BIOGRAPHY AND AUTOBIOGRAPHY BOOKS, [COMIC BOOKS,] PERIODICALS, NAMELY, [PAMPHLETS, BROCHURES, NEWSLETTERS, JOURNALS,] PAPERBACK BOOKS [AND MAGAZINES,] ALL DEALING WITH MUSIC, FILMS AND ENTERTAINMENT; [DIARIES, PERSONAL ORGANIZERS, BOXES OF CARDBOARD, PAPER FACE TOWELS, FILTER PAPER, PAPER POCKET HANDKERCHIEFS, HYGENIC PAPER, PAPER BABIES' DIAPERS, BOXES OF PAPER,] PAPER FOR PACKAGING, PAPER CASES; WRITING INSTRUMENTS, NAMELY, PENS, PENCILS, BALL POINT PENS, [FOUNTAIN PENS, FELT TIP PENS, AND CRAYONS;] STATIONERY AND OFFICE SUPPLIES, NAMELY, WRITING AND NOTE PAPER, [ENVELOPES, GREETING CARDS, POSTCARDS, WRITING INK, UNGRADUATED RULERS, ERASERS, BLANK BOOKS, LEDGERS, CARDS, INDEX CARDS, ADHESIVE GLUES AND ADHESIVE TAPES FOR STATIONERY AND HOUSEHOLD PURPOSES, ADHESIVE TAPE DISPENSERS, LOOSE-LEAF BINDERS, BLOTTERS, BLOTTING PAPER, DESK ORGANIZER BOXES OR CONTAINERS FOR PENS, PENCILS AND PAPER CLIPS, CALENDARS, CARBON PAPER, CHARTS, DIAGRAMS, DOCUMENT FILES, DRAWING PADS, DRAWING PINS, ELASTIC BANDS FOR OFFICES, STATIONERY FOLDERS, GUMMED LABELS, PAPER KNIVES, PAPER WEIGHTS, PENCIL HOLDERS, PENCIL SHARPENERS, PENCIL SHARPENING MACHINES, ADDRESS STAMPS, POSTCARDS, SEALING WAX, SEALING WAXERS, SEALING STAMPS, SEALS, SIGNS OF PAPER OR CARDBOARD, STAPLES, STAPLING PRESSERS, STENCIL CASES, STENCIL PLATES, STENCILS, TAGS FOR INDEX CARDS, TRAYS FOR SORTING AND COUNTING; PAPER TABLEWARE, NAMELY, TABLE MATS, COASTERS, DECANTER MATS, DISH MATS, TABLE NAPKINS, AND TABLE CLOTHS;] PLAYING CARDS</p> <p>Class 025. First use: [ARTICLES OF UNDERCLOTHING, NAMELY, VESTS, UNDERPANTS, PANTS, BRASSIERES, CORSETS, CORSELETTES, PETTICOATS, CAMISOLES, KNICKERS, TEDDIES, FRENCH KNICKERS, TIGHTS, STOCKINGS, PANTY HOSE, GARTERS, SUSPENDERS BELTS, SLIPS, SOCKS, BODICES, BASQUES;] ARTICLES OF OUTER CLOTHING, NAMELY, [SUITS, DRESSES, SKIRTS,] SHIRTS, T-SHIRTS, SWEAT SHIRTS, [BLOUSES, TROUSERS, OVERALLS, LEATHER TROUSERS, JEANS, SLACKS,] JACKETS, [RAINCOATS, WAIST COATS, COATS, SWEATERS, CARDIGANS, PULLOVERS, SOCKS, LEG WARMERS,</p>

	LEGGINGS, DRESSING GOWNS, BATHROBES, JUMPERS, TIES, NECKWEAR,] HATS, CLOTHING CAPS, [GLOVES, MITTENS, SCARVES, APRONS,] CLOTHING BELTS [; SLEEPWEAR; FOOTWEAR; ARTICLES OF SPORTS CLOTHING, NAMELY, SHORTS, TRACK SUITS, SWIMWEAR, SWIMMING TRUNKS, WET SUITS, RAINWEAR, LEOTARDS]
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U.S. Registration No.	1597386	Application Date	03/18/1988
Registration Date	05/22/1990	Foreign Priority Date	NONE

Word Mark	VIRGIN
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 016. First use: [PRINTED SHEET MUSIC;] [HOLOGRAPHS;] [MOUNTED PHOTOGRAPHS; POSTERS,] FICTIONAL AND NON-FICTIONAL BOOKS, [GEOGRAPHY AND HISTORY BOOKS, TEACHING BOOKS, DRAWING BOOKS, PRINTING BOOKS, WRITING BOOKS, SCHOOL TEXT BOOKS, PAINTING BOOKS, NOTE BOOKS, REFERENCE BOOKS, GARDENING BOOKS, MAINTENANCE BOOKS, LANGUAGE BOOKS, ADDRESS BOOKS, TELEPHONE BOOKS, COOK BOOKS,] BIOGRAPHY AND AUTOBIOGRAPHY BOOKS, [COMIC BOOKS,] PERIODICALS, NAMELY, [PAMPHLETS, BROCHURES, NEWSLETTERS,] JOURNALS, PAPERBACK BOOKS [AND MAGAZINES,] ALL DEALING WITH MUSIC, FILMS AND ENTERTAINMENT; [DIARIES, PERSONAL ORGANIZERS, BOXES OF CARDBOARD, PAPER FACE TOWELS, FILTER PAPER, PAPER POCKET HANDKERCHIEFS, HYGIENIC PAPER, PAPER BABIES' DIAPERS, BOXES OF PAPER,] [PAPER FOR PACKAGING, PAPER CASES;] STATIONERY AND OFFICE SUPPLIES,[NAMELY, WRITING AND NOTE PAPER, ENVELOPES, GREETING CARDS, POSTCARDS, WRITING INK, BLANK BOOKS, LEDGERS, CARDS, INDEX CARDS, ADHESIVE GLUES AND ADHESIVE TAPES FOR STATIONERY AND HOUSEHOLD PURPOSES, BLOTTERS, BLOTING PAPER, CALENDARS, CARBON PAPER, CHARTS, DIAGRAMS, DOCUMENTS FILES, DRAWING PADS, STATIONERY FOLDERS, GUMMED LABELS, POSTCARDS, SIGNS OF PAPER OR CARDBOARD, TAGS FOR INDEX CARDS, PAPER TABLEWARE, NAMELY, TABLE MATS, COASTERS, DECANter MATS, DISH MATS, TABLE NAPKINS, AND TABLE CLOTHS,] PLAYING CARDS</p> <p>Class 025. First use: [ARTICLES OF UNDERCLOTHING, NAMELY, VESTS, UNDERPANTS, PANTS, BRASSIERES, CORSETS, CORSELETTES, PETTICOATS, CAMISOLES, KNICKERS, TEDDIES, FRENCH KNICKERS, TIGHTS, STOCKINGS, PANTY HOSE, GARTERS, SUSPENDERS] [BELTS,] [SLIPS, SOCKS, BODICES, BASQUES;] ARTICLES OF OUTER CLOTHING, NAMELY, [SUITS, DRESSES, SKIRTS,] SHIRTS, T-SHIRTS, SWEAT SHIRTS, [BLOUSES, TROUSERS, OVERALLS, LEATHER TROUSERS, JEANS, SLACKS,] JACKETS, [RAINCOATS, WAIST COATS, COATS, SWEATERS, CARDIGANS, PULLOVERS, SOCKS, LEG WARMERS, LEGGINGS, DRESSING GOWNS, BATHROBES, JUMPERS, TIES, NECKWEAR,] HATS, CLOTHING CAPS, [GLOVES, MITTENS, SCARVES, APRONS,] [CLOTHING BELTS;] [SLEEPWEAR; FOOTWEAR; ARTICLES OF SPORTS CLOTHING, NAMELY, SHORTS, TRACK SUITS, SWIMWEAR, SWIMMING TRUNKS, WET SUITS, RAINWEAR, LEOTARDS]</p>
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U.S. Registration No.	1851817	Application Date	05/01/1991
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Registration Date	08/30/1994	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark	VIRGIN		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1984/06/00 First Use In Commerce: 1984/06/00 [[direct mail advertising for others;] dissemination of advertising materials for other; preparing advertising, promotions, and public relations materials for others; [management of promotional and incentive plans and services for others;] business organization promotional consulting for others; demonstration of the goods and services of others and the promotion thereof; promoting and advertising the goods and services of others by [aircraft,] airships and air balloons; outdoor advertising such as by billboards; and distribution of advertising, promotional materials and sample materials of others]</p> <p>Class 039. First use: First Use: 1984/06/00 First Use In Commerce: 1984/06/00 transportation of goods and passengers by road, [rail,] air [and sea;] freight transportation services; [tourist agency services;] travel agency services; [arranging travel tours; and transportation reservation services]</p> <p>Class 042. First use: First Use: 1992/05/00 First Use In Commerce: 1992/05/00 [clubs, nightclubs;] bars; [hotels; resorts; hotel reservation services; hotel and resort management for others; carry-out restaurant and restaurant services; catering; computer programming for others; computer software design services for others; artwork and graphic design services for others;] and retail store services in the fields of [cosmetics and laundry preparations, metal hardware,] cameras, records, audio and video tapes, [audio and video recorders,] computers and electronic apparatus, [jewelry, clocks] and watches, [musical instruments, stationery,] sheet music, books and photography, handbags, purses, luggage and leather goods, clothing, [lace, embroidery, gifts and sewing materials, toys,] games, video game machines and video game cartridges, [processed foods, jellies and jams, coffee, tea, bakery items and candy, beer, ale, mineral and aerated waters and other non-alcoholic drinks, wines, spirits and liqueurs, and tobacco and smokers' articles]</p>		

U.S. Registration No.	1852776	Application Date	05/09/1991
Registration Date	09/06/1994	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 035. First use: First Use: 1984/06/00 First Use In Commerce: 1984/06/00 [direct mail advertising for others;] dissemination of advertising materials for others; preparing advertising, promotions, and public relations materials for others; [management of promotional and incentive plans and services for others;] business organization promotional consulting for others; demonstration of the goods and services of others and promotion thereof; promoting and advertising the goods and services of others by [aircraft,] airships and air balloons; outdoor advertising such as by billboards; and distribution of advertising, promotional materials and sample materials of others]</p> <p>Class 039. First use: First Use: 1984/06/00 First Use In Commerce: 1984/06/00 transportation of goods and passengers by road, [rail,] air [and sea;] freight transportation services; [tourist agency services; arranging travel tours; and, transportation reservation services]</p> <p>Class 042. First use: First Use: 1992/05/00 First Use In Commerce: 1992/05/00 [clubs, nightclubs;] bars; [hotels; resorts; hotel reservation services; hotel and resort management for others; carry-out restaurant and restaurant services; catering;] rental of food service equipment; namely, vending machines; [computer programming for others; computer software design services for others; artwork and graphic design services for others;] portrait and aerial photography; typesetting and printing services; and retail store services in the fields of [cosmetics and laundry preparations; metal hardware;] cameras, records, audio and video tapes, [audio and video recorders,] computers and electronic apparatus; [jewelry, clocks] and watches; [musical instruments; stationery,] sheet music, books and photography; handbags, purses, luggage and leather goods; clothing; [lace, embroidery, gifts and sewing materials; toys,] games, video game machines and video game cartridges; [processed foods, jellies and jams; coffee, tea, bakery items and candy; beer, ale, mineral and aerated waters and other nonalcoholic drinks; wines, spirits and liqueurs; and, tobacco and smokers articles]</p>

U.S. Registration No.	1863353	Application Date	05/19/1992
Registration Date	11/15/1994	Foreign Priority Date	NONE
Word Mark	VIRGIN MEGASTORE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1979/00/00 First Use In Commerce: 1992/12/04 retail department store services		

U.S. Registration No.	2151589	Application Date	01/25/1995
Registration Date	04/21/1998	Foreign Priority Date	NONE
Word Mark	VIRGIN VODKA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1986/01/24 First Use In Commerce: 1986/01/24 vodka		

U.S. Registration No.	2237092	Application Date	06/10/1996
Registration Date	04/06/1999	Foreign Priority Date	NONE
Word Mark	VIRGIN VACATIONS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1994/11/01 First Use In Commerce: 1994/11/01 ARRANGING THE TRANSPORT OF PASSENGERS BY AIR AND ROAD, ARRANGING AND CONDUCTING TRAVEL TOURS, TRAVEL AGENCY SERVICES, NAMELY, MAKING RESERVATIONS AND BOOKINGS FOR TRANSPORTATION, AND TRANSPORTATION RESERVATION SERVICES Class 042. First use: First Use: 1994/11/01 First Use In Commerce: 1994/11/01 RESORT HOTEL AND HOTEL RESERVATION; TRAVEL AGENCY SERVICES, NAMELY, MAKING RESERVATIONS AND BOOKINGS FOR TEMPORARY LODGING		

U.S. Registration No.	2586162	Application Date	10/03/1997
Registration Date	06/25/2002	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 articles of luggage, namely, suitcases; bags; namely, back packs, rucksacks, school bags, school satchels, travelling bags, sports bags, all purpose sports bags for campers and climbers, textile shopping bags; wallets; umbrellas and parasols		

U.S. Registration No.	2600080	Application Date	10/03/1994
Registration Date	07/30/2002	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 032. First use: First Use: 1994/10/09 First Use In Commerce: 1994/10/09 non-alcoholic beverages, namely, soft drinks

U.S. Registration No.	2625455	Application Date	12/17/1998
Registration Date	09/24/2002	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1997/12/00 First Use In Commerce: 1997/12/00 PROVIDING AN ON-LINE SHOPPING MALL VIA A GLOBAL COMPUTER NETWORK; PROVIDING BUSINESS INFORMATION VIA A GLOBAL COMPUTER NETWORK</p> <p>Class 038. First use: First Use: 1999/11/11 First Use In Commerce: 2000/03/21 COMPUTERIZED COMMUNICATION SERVICES, NAMELY, ELECTRONIC MAIL SERVICES, AND PROVIDING NETWORKS FOR THE PURPOSE OF TRANSMISSION AND RECEPTION OF ELECTRONIC MAIL, COMPUTER GENERATED MUSIC, NEWS AND OTHER DATA AND INFORMATION; AND BROADCASTING SERVICES BY RADIO AND OVER A GLOBAL COMPUTER NETWORK OF A WIDE VARIETY OF PROGRAMS, NAMELY, CURRENT EVENTS, ECONOMICS, POLITICS, SPORTS, ENTERTAINMENT, THE ARTS AND BUSINESS</p>		

U.S. Registration No.	2639079	Application Date	08/30/2001
Registration Date	10/22/2002	Foreign Priority Date	NONE
Word Mark	VIRGIN HOLIDAYS		
Design Mark	VIRGIN HOLIDAYS		
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1985/11/00 First Use In Commerce: 1985/11/00 TRANSPORTATION OF PASSENGERS AND GOODS BY ROAD, RAIL AND AIR; ARRANGING OF PACKAGE HOLIDAYS; ARRANGING AND ORGANIZING TOURS; ARRANGING VISITS TO PLACES OF INTEREST;		

	<p>TOURIST OFFICE SERVICES; TRAVEL AGENCY SERVICES, NAMELY, MAKING RESERVATIONS AND BOOKINGS FOR TRANSPORTATION; TRANSPORTATION RESERVATION SERVICES</p> <p>Class 043. First use: First Use: 1985/11/00 First Use In Commerce: 1985/11/00</p> <p>TRAVEL AGENCY SERVICES, NAMELY, MAKING RESERVATIONS AND BOOKINGS FOR TEMPORARY LODGING</p>		
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U.S. Registration No.	2643644	Application Date	09/08/1997
Registration Date	10/29/2002	Foreign Priority Date	NONE
Word Mark	VIRGIN VIE		
Design Mark			
Description of Mark	The mark consists of the designation MAQ!LIC with a stylized I.		
Goods/Services	<p>Class 003. First use: First Use: 1997/10/00 First Use In Commerce: 1998/00/00</p> <p>[Perfumes; eau-de-cologne;] non-medicated toilet preparations, namely, lotions and moisturizers; non-medicated preparations for the care of the skin, hands, scalp and body, namely, moisturizers, lotions, creams and gels; non-medicated skin cleansing preparations, namely, lotions, creams and gels; creams and lotions for the skin [; nail varnishes]</p>		

U.S. Registration No.	2689097	Application Date	08/10/2000
Registration Date	02/18/2003	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/11/11 First Use In Commerce: 2002/06/23</p> <p>MOBILE TELEPHONES; TELEPHONES; MODEMS; BATTERIES; BATTERY</p>		

	<p>CHARGERS; CIGARETTE LIGHTER ADAPTERS; DASHBOARD MOUNTS; [HAND-FREE] * HANDS-FREE * HEADSETS; CARRYING CASES; BELT CLIPS</p> <p>Class 038. First use: First Use: 1999/11/11 First Use In Commerce: 1999/11/18 TELECOMMUNICATIONS SERVICES, NAMELY, TRANSMISSION OF VOICE, DATA, IMAGES, AUDIO, VIDEO, AND INFORMATION VIA TELEPHONE OR THE INTERNET; PERSONAL COMMUNICATIONS SERVICES; PAGER SERVICES; ELECTRONIC MAIL SERVICES; TRANSMISSION OR BROADCAST OF NEWS AND INFORMATION FOR OTHERS VIA TELEPHONE, INCLUDING THE INTERNET</p>
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U.S. Registration No.	2689098	Application Date	08/10/2000
Registration Date	02/18/2003	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/11/11 First Use In Commerce: 2002/06/23 MOBILE TELEPHONES; TELEPHONES; MODEMS; BATTERIES; BATTERY CHARGERS; CIGARETTE LIGHTER ADAPTERS; DASHBOARD MOUNTS; HANDS-FREE HEADSETS; CARRYING CASES; BELT CLIPS</p> <p>Class 038. First use: First Use: 1999/11/11 First Use In Commerce: 1999/11/18 TELECOMMUNICATIONS SERVICES, NAMELY, TRANSMISSION OF VOICE, DATA, IMAGES, AUDIO, VIDEO, AND INFORMATION VIA TELEPHONE OR THE INTERNET; PERSONAL COMMUNICATIONS SERVICES; PAGER SERVICES; ELECTRONIC MAIL SERVICES; TRANSMISSION OR BROADCAST OF NEWS AND INFORMATION FOR OTHERS VIA TELEPHONE, INCLUDING THE INTERNET</p>		

U.S. Registration No.	2709578	Application Date	10/03/1994
Registration Date	04/22/2003	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 1980/00/00 First Use In Commerce: 1987/00/00 sound records of music in the form of discs [and tapes and cassettes; pre-recorded audio or video tapes, cassettes and cartridges featuring music;] pre-recorded audio and video discs, phonograph records featuring music; [data processors and displays;] graphical interface to aid the delivery of interactive products and services by cable or wireless transmission; parts for the aforesaid goods; computer game software; [computer software for educational computer games, for calculators, for global computer network access and for music products; computer hardware]</p> <p>Class 032. First use: First Use: 1994/11/04 First Use In Commerce: 1998/04/00 water, namely, mineral waters, aerated waters and flavored waters; non-alcoholic beverages, namely, fruit flavored drinks</p> <p>Class 033. First use: First Use: 1995/01/04 First Use In Commerce: 1995/01/04 spirits, namely vodka</p>

U.S. Registration No.	2717644	Application Date	09/09/1997
Registration Date	05/20/2003	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1994/10/09 First Use In Commerce: 1994/10/09 non-alcoholic beverages, namely, soft drinks		

U.S. Registration No.	2770775	Application Date	08/16/2001
Registration Date	10/07/2003	Foreign Priority Date	NONE
Word Mark	VIRGIN MOBILE		

Design Mark	VIRGIN MOBILE
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 1999/11/11 First Use In Commerce: 2002/07/24 MOBILE TELEPHONES, TELEPHONES AND MODEMS, AND ACCESSORIES THEREFOR, NAMELY, BATTERIES; BATTERY CHARGERS; CIGARETTE LIGHTER ADAPTERS; HANDS-FREE HEADSETS; CARRYING CASES AND BELT CLIPS</p> <p>Class 035. First use: First Use: 1999/11/11 First Use In Commerce: 2002/07/24 PROVIDING DIRECTORY INFORMATION VIA TELEPHONE</p> <p>Class 038. First use: First Use: 1999/11/11 First Use In Commerce: 2002/07/24 TELECOMMUNICATIONS SERVICES, NAMELY, TRANSMISSION OF VOICE, DATA, IMAGES, AUDIO, VIDEO, AND INFORMATION VIA TELEPHONE OR THE INTERNET; PERSONAL COMMUNICATIONS SERVICES; PAGER SERVICES; ELECTRONIC MAIL SERVICES; TRANSMISSION OR BROADCAST OF NEWS AND INFORMATION FOR OTHERS VIA TELEPHONE, INCLUDING THE INTERNET</p>

U.S. Registration No.	2770776	Application Date	08/16/2001
Registration Date	10/07/2003	Foreign Priority Date	NONE
Word Mark	VIRGIN MOBILE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/11/11 First Use In Commerce: 2002/07/24 MOBILE TELEPHONES, TELEPHONES AND MODEMS, AND ACCESSORIES THEREFOR, NAMELY, BATTERIES; BATTERY CHARGERS; CIGARETTE LIGHTER ADAPTERS; HANDS-FREE HEADSETS; CARRYING CASES AND BELT CLIPS</p> <p>Class 035. First use: First Use: 1999/11/11 First Use In Commerce: 2002/07/24 PROVIDING DIRECTORY INFORMATION VIA TELEPHONE</p> <p>Class 038. First use: First Use: 1999/11/11 First Use In Commerce: 2002/07/24</p>		

	TELECOMMUNICATIONS SERVICES, NAMELY, TRANSMISSION OF VOICE, DATA, IMAGES, AUDIO, VIDEO, AND INFORMATION VIA TELEPHONE OR THE INTERNET; PERSONAL COMMUNICATIONS SERVICES; PAGER SERVICES; ELECTRONIC MAIL SERVICES; TRANSMISSION OR BROADCAST OF NEWS AND INFORMATION FOR OTHERS VIA TELEPHONE, INCLUDING THE INTERNET
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U.S. Registration No.	2798130	Application Date	10/03/1994
Registration Date	12/23/2003	Foreign Priority Date	NONE

Word Mark	VIRGIN
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 016. First use: First Use: 2003/01/00 First Use In Commerce: 2003/01/00 playing cards, writing instruments, namely, pens, pencils and ball point pens</p> <p>Class 018. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 [Luggage]</p> <p>Class 025. First use: First Use: 1997/00/00 First Use In Commerce: 1997/00/00 Leisurewear, namely, fleece tops and shirts; articles of outer clothing, namely T-shirts, sweat shirts, jackets, hats, clothing caps</p> <p>Class 028. First use: First Use: 2003/01/00 First Use In Commerce: 2003/01/00 [sporting articles, namely, golf tees]</p> <p>Class 035. First use: First Use: 2003/01/00 First Use In Commerce: 2003/01/00 Preparing advertising, promotions, and public relations materials for others; demonstration of the goods of others and the promotion thereof; and distribution and dissemination of advertising, promotional materials and sample materials of others</p> <p>Class 038. First use: First Use: 1999/11/11 First Use In Commerce: 2002/07/24 Electronic transmission and display of information for business or domestic purposes from a computer stored data bank</p> <p>Class 042. First use: First Use: 1992/00/00 First Use In Commerce: 1992/00/00 Retail store services in the fields of records, audio and video tapes, computers and electronic apparatus and watches, books, luggage and leather goods, clothing, games, video game cartridges, and cafes</p>
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U.S. Registration No.	2808270	Application Date	03/05/2003
Registration Date	01/27/2004	Foreign Priority Date	NONE

Word Mark	VIRGIN ATLANTIC
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Design Mark	VIRGIN ATLANTIC
Description of Mark	NONE
Goods/Services	Class 039. First use: First Use: 1984/06/00 First Use In Commerce: 1984/06/00 TRANSPORTATION OF AND ARRANGING TRANSPORTATION OF GOODS AND PASSENGERS BY ROAD AND AIR; FREIGHT TRANSPORTATION SERVICES BY AIR; TRANSPORTATION OF HUMAN BEINGS BY MEANS OF LAND VEHICLES; CHAUFFEUR SERVICES; TRAVEL AGENCY SERVICES, NAMELY, MAKING RESERVATIONS AND BOOKINGS FOR TRANSPORTATION; ARRANGING AND/OR CONDUCTING TRAVEL TOURS; OPERATION OF AIRCRAFT FOR OTHERS

U.S. Registration No.	2870028	Application Date	08/16/2001
Registration Date	08/03/2004	Foreign Priority Date	NONE
Word Mark	VIRGIN XTRAS		
Design Mark	VIRGIN XTRAS		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2002/06/22 First Use In Commerce: 2002/06/22 Mobile telephones; computer software downloadable from the Internet for transmission, reception and storage of voice, data, images, e-mail and digital information Class 038. First use: First Use: 2002/06/22 First Use In Commerce: 2002/06/22 Telecommunications services, namely, transmission of voice, data, images, audio, video, and information via telephone or the internet; personal communications services; electronic mail services; transmission or broadcast of news and information for others via telephone, including the internet		

U.S. Registration No.	3009266	Application Date	04/25/2002
Registration Date	10/25/2005	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 044. First use: First Use: 1990/05/00 First Use In Commerce: 1990/05/00 Operation of leisure centers, namely, providing cosmetic and body care services

U.S. Registration No.	3100295	Application Date	01/07/2005
Registration Date	06/06/2006	Foreign Priority Date	NONE
Word Mark	VIRGIN XL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2004/09/28 First Use In Commerce: 2004/09/28 Mobile telephones; computer software downloadable from the Internet for transmission, reception and storage of voice, data, images, e-mail and digital information Class 038. First use: First Use: 2004/09/28 First Use In Commerce: 2004/09/28 Telecommunications services, namely, transmission of voice, data, images, audio, video, and information via telephone or the internet; personal communications services; electronic mail services; transmission or broadcast of news and information for others via telephone, including the internet		

U.S. Registration No.	3174388	Application Date	12/16/1999
Registration Date	11/21/2006	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	VIRGIN
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2004/10/31 First Use In Commerce: 2004/10/31 SOAPS; SHAMPOOS; NON-MEDICATED TOILET PREPARATIONS, NAMELY, SOAPS, SHAMPOOS, LOTIONS, AND MOISTURIZERS; ANTIPERSPIRANTS; DEODORANTS FOR USE ON THE PERSON; COSMETICS, NAMELY, FOUNDATION CREAMS AND LOTIONS; NON-MEDICATED PREPARATIONS FOR THE CARE OF THE SKIN, HANDS, SCALP AND BODY, NAMELY, MOISTURIZERS, LOTIONS, CREAMS, SOAPS, GELS; HAIR CARE PREPARATIONS, NAMELY, SHAMPOOS; NON-MEDICATED SKIN CLEANSING PREPARATIONS, NAMELY, CLEANSERS, LOTIONS, CREAMS, SOAPS; CREAMS AND LOTIONS FOR THE SKIN

U.S. Registration No.	3188282	Application Date	09/21/2004
Registration Date	12/19/2006	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark	VIRGIN		
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1995/01/04 First Use In Commerce: 1995/01/04 Alcoholic beverages, namely, vodka and wine		

U.S. Registration No.	3209714	Application Date	05/26/2005
Registration Date	02/13/2007	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Entertainment services, namely, providing online computer games

U.S. Registration No.	3209716	Application Date	05/31/2005
Registration Date	02/13/2007	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Entertainment services, namely, providing online computer games		

U.S. Registration No.	3230095	Application Date	04/25/2002
Registration Date	04/17/2007	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2000/01/01 First Use In Commerce: 2000/01/01 Organizing cultural activities and events; [operation of fitness centers;] operation of leisure centers, namely, providing library and Internet access facilities [; and providing health club services]

U.S. Registration No.	3245593	Application Date	09/21/2004
Registration Date	05/22/2007	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1995/01/04 First Use In Commerce: 1995/01/04 Alcoholic beverages, namely, vodka and wine		

U.S. Registration No.	3298420	Application Date	02/19/2002
Registration Date	09/25/2007	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	VIRGIN
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2006/03/00 First Use In Commerce: 2006/04/00 business incentive services, namely, offering plans to employers including motivational schemes, gift certificates and other rewards for employees, management of incentive programs, events and schemes for others Class 036. First use: First Use: 2006/08/00 First Use In Commerce: 2006/08/00 debit card services

U.S. Registration No.	3298421	Application Date	02/19/2002
Registration Date	09/25/2007	Foreign Priority Date	NONE

Word Mark	VIRGIN
Design Mark	

Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2006/03/00 First Use In Commerce: 2006/04/00 Business incentive services, namely, offering plans to employers including motivational schemes, gift certificates and other rewards for employees, management of incentive programs, events and schemes for others Class 036. First use: First Use: 2006/08/00 First Use In Commerce: 2006/08/00 debit card services

U.S. Registration No.	3398247	Application Date	07/24/2007
Registration Date	03/18/2008	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	<h1>VIRGIN</h1>		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2002/01/00 First Use In Commerce: 2002/01/00 banking services; loan services, namely, offering loans to others; credit card services; consumer financing; electronic funds transfer		

U.S. Registration No.	3398248	Application Date	07/24/2007
Registration Date	03/18/2008	Foreign Priority Date	NONE

Word Mark	VIRGIN
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Design Mark			
Description of Mark	The mark consists of the word "VIRGIN" in a stylized form.		
Goods/Services	Class 036. First use: First Use: 2002/01/00 First Use In Commerce: 2002/01/00 banking services; loan services, namely, offering loans to others; credit card services; consumer financing; electronic funds transfer		

U.S. Registration No.	3472228	Application Date	12/20/2004
Registration Date	07/22/2008	Foreign Priority Date	10/13/2004

Word Mark	VIRGIN UNITE
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 035. First use: Developing promotional campaigns for business; promoting public awareness of the need for businesses to have a positive impact on the communities and environment in which they operate and work together with the social sector to drive long term social change including making investments in emerging markets to accelerate positive social change through economic development; charitable services, namely, organizing and coordinating programs for the sick, people with health problems or issues, the homeless, drug users, those with disabilities, victims of abuse, those who are bereaved, children in need or at risk, those with sexual problems, and underprivileged communities, and organizing and conducting volunteer programs and community service projects; business management and administration services in connection with a charity</p> <p>Class 036. First use: Charitable fund raising; charitable financial services for those in need, namely, accepting and administering monetary charitable contributions; financial sponsorship of fund raising events and events designed to raise the profile of charitable and social issues</p> <p>Class 041. First use: Educational services, namely, conducting summits, conferences, lectures and seminars in the field of social change and charitable and social issues; training services in the field of social change and charitable and social issues; organizing community sporting and cultural events; educational services, namely, providing classes, lectures, seminars, workshops, and discussion groups in the fields of sickness, health problems, homelessness, drug use, disabilities, abuse, bereavement, children's needs, sexual problems, and poverty to young people, people with health problems or issues, the homeless, drug users, those with disabilities, victims of abuse, those who have been bereaved, children in need or at risk, those with sexual problems, and underprivileged communities; charitable services, namely, academic mentoring of children from underprivileged communities and young people</p>
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U.S. Registration No.	3427241	Application Date	04/25/2002
Registration Date	05/13/2008	Foreign Priority Date	NONE
Word Mark	VIRGIN		

Design Mark	VIRGIN
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2000/01/01 First Use In Commerce: 2000/01/01 Organizing sporting and cultural activities and events; operation of leisure centers, namely, providing library facilities Class 044. First use: First Use: 1990/05/31 First Use In Commerce: 1990/05/31 Operation of leisure centers, namely, providing cosmetic and body care services

U.S. Registration No.	3535624	Application Date	11/30/2005
Registration Date	11/18/2008	Foreign Priority Date	NONE

Word Mark	VIRGIN GALACTIC
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 039. First use: First Use: 2005/11/00 First Use In Commerce: 2005/11/00 Travel agency services, namely, making reservations and bookings for transportation, space travel agency services; namely, booking of transportation into space

U.S. Registration No.	3538900	Application Date	06/15/2006
Registration Date	11/25/2008	Foreign Priority Date	NONE

Word Mark	VIRGIN FESTIVAL
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Design Mark	VIRGIN FESTIVAL
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2006/09/23 First Use In Commerce: 2006/09/23 Arranging and conducting live musical performances and music festivals

U.S. Registration No.	3538901	Application Date	06/15/2006
Registration Date	11/25/2008	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2006/09/23 First Use In Commerce: 2006/09/23 Arranging and conducting live musical performances and music festivals		

U.S. Registration No.	3541731	Application Date	04/07/2004
Registration Date	12/02/2008	Foreign Priority Date	NONE
Word Mark	VIRGIN AMERICA		

Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 039. First use: First Use: 2007/08/08 First Use In Commerce: 2007/08/08 Air transportation; freight transportation services by means of air, ship, truck, and rail; airport passenger and baggage check-in services; airport services, namely, ticketing and boarding services; travel services, namely, booking seating arrangements for airline passengers; air transportation services featuring frequent flyer miles as a bonus program for frequent air travelers; providing flight arrival and departure information; and transportation reservation services</p> <p>Class 041. First use: First Use: 2007/08/08 First Use In Commerce: 2007/08/08 onboard in-flight entertainment services, namely, distributing movies, TV programs, and audio programs, and providing temporary use of video games, software and personal monitors for viewing the same</p>
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U.S. Registration No.	3543131	Application Date	04/18/2008
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Registration Date	12/09/2008	Foreign Priority Date	NONE
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Word Mark	VIRGIN COMICS
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 016. First use: First Use: 2006/07/00 First Use In Commerce: 2006/07/00 comic books</p> <p>Class 041. First use: First Use: 2006/07/00 First Use In Commerce: 2006/07/00 entertainment services, namely, providing a web site featuring comic strips, related film clips, photographs, drawings, art pictures, and other multimedia materials</p>
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U.S. Registration No.	3707308	Application Date	02/09/2007
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Registration Date	11/10/2009	Foreign Priority Date	NONE
Word Mark	VIRGIN VIE AT HOME		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: Perfumes, cosmetics, make up; hair care preparations; non-medicated skin care preparations, non-medicated sun care preparations; nail care products, namely, nail varnishes, nail varnish removers; nail care preparations; artificial nails and adhesives therefor; glues, adhesives, acrylic, and silk and linen wraps for the repair of artificial nails, nail polishes; powder compacts; lipsticks; lip gloss; nail varnish remover; cotton wool balls for use in removing and applying cosmetics; make-up powder and foundation; facial wipes impregnated with cosmetics; skin moisturisers; beauty creams; beauty gels; body care cosmetics, essential oils for personal use; antiperspirants; after shave lotions; eau de cologne; soaps; Make up removing preparations; non-medicated toiletries; eau de toilette; deodorants for personal care; hair lotions, hair creams, and hair conditioners; shampoos; beauty masks; skin cream, facial masks, cosmetic oils, face powder, and body scrubs; hand and body lotions; dentifrices; shaving preparations, dyes for hairs; bath preparations, namely, beads, crystals, foam, gels, oil and powder; scented body sprays; after-shave lotions; pre-electric shaving preparations</p> <p>Class 014. First use: Jewelry and imitation jewelry; precious metals and their alloys; bracelets of precious metal; fancy keyrings of precious metals; jewelry boxes of precious metal; key chains of precious metal; ornaments of precious metal; semi-precious and precious stones; watches, clocks, and structural parts therefor</p> <p>Class 035. First use: Retail shops featuring cosmetics and jewelry; computerized online retail ordering services featuring cosmetics and jewelry; shop at home services featuring cosmetics and jewelry; mail order catalog services featuring cosmetics and jewelry; business consultancy services; business advisory services; advertising services; advertising services provided over the internet; rental of advertising space on a website</p>		
U.S. Registration No.	3913150	Application Date	02/18/2005
Registration Date	02/01/2011	Foreign Priority Date	01/28/2005
Word Mark	VIRGIN		



Description of Mark	The mark consists of the stylized word "VIRGIN".
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Goods/Services	<p>Class 035. First use: Advertising services for others relating to real property; management of incentive and loyalty programs of others to promote healthy lifestyle choices; providing information and advice on advertising in the fields of health and fitness</p> <p>Class 036. First use: Health insurance underwriting; private health insurance underwriting; medical insurance underwriting; financial services in the field of health care, namely, administration and management of health savings plans and accounts; real estate brokerage services; brokerage for leasing of real estate property; real estate agencies; financial services in the field of real estate, namely, providing loans and mortgages; estate trust management services relating to transactions in real property; financing of real estate development; real estate management; real estate portfolio management; providing information and advice on the buying and selling of real estate</p> <p>Class 037. First use: Building construction; advisory services relating to development of real estate; advisory services relating to the renovation of real estate; commercial retail property development services; real estate development; providing information and advice on real estate development</p> <p>Class 044. First use: Medical evaluation services, namely, providing health assessments; advisory services relating to health; consultation relating to health care</p> <p>Class 045. First use: Personal lifestyle counseling and consultation</p>
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U.S. Registration No.	3913151	Application Date	02/18/2005
Registration Date	02/01/2011	Foreign Priority Date	01/28/2005
Word Mark	VIRGIN		

Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 035. First use: Advertising services for others relating to real property; management of incentive and loyalty programs of others to promote healthy lifestyle choices; providing information and advice on advertising in the fields of health and fitness</p> <p>Class 036. First use: Health insurance underwriting; private health insurance underwriting; medical insurance underwriting; financial services in the field of health care, namely, administration and management of health savings plans and accounts; real estate brokerage services; brokerage for leasing of real estate property; real estate agencies; financial services in the field of real estate, namely, providing loans and mortgages; estate trust management services relating to transactions in real property; financing of real estate development; real estate management; real estate portfolio management; providing information and advice on the buying and selling of real estate</p> <p>Class 037. First use: Building construction; advisory services relating to development of real estate; advisory services relating to the renovation of real estate; commercial retail property development services; real estate development; providing information and advice on real estate development</p> <p>Class 044. First use: Medical evaluation services, namely, providing health assessments; advisory services relating to health; consultation relating to health care</p> <p>Class 045. First use: Personal lifestyle counseling and consultation</p>
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U.S. Registration No.	4004271	Application Date	08/13/2009
Registration Date	08/02/2011	Foreign Priority Date	08/05/2009
Word Mark	VIRGIN MONEY EVERYONE'S BETTER OFF		

Design Mark	VIRGIN MONEY EVERYONE'S BETTER OFF
Description of Mark	NONE
Goods/Services	Class 036. First use: Insurance services, namely, brokerage, underwriting, administration, appraisals, and claims adjustment in the fields of life insurance, car insurance, home insurance, pet insurance, and travel insurance; financial affairs and monetary affairs, namely, financial information, management and analysis services; real estate affairs, namely, mortgage lending; banking services; financial clearing houses; credit card services; debit card services; mortgage banking; financial consultancy; provision of financial information; financial evaluation for insurance purposes; electronic funds transfer; financial services, namely, money lending; financial services, namely, investment management and investment of funds for others

U.S. Registration No.	4105375	Application Date	07/15/2011
Registration Date	02/28/2012	Foreign Priority Date	NONE
Word Mark	VIRGIN		
Design Mark			
Description of Mark	The mark consists of the word "VIRGIN" in a stylized form.		
Goods/Services	Class 041. First use: OPERATION OF FITNESS CENTERS; HEALTH CLUB SERVICES		

Related Proceedings	91194225
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Attachments	73031575#TMSN.gif (1 page)(bytes) 73585970#TMSN.gif (1 page)(bytes) 73717555#TMSN.gif (1 page)(bytes) 74162592#TMSN.gif (1 page)(bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/sed/
Name	SARAH E DALE
Date	06/01/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No. 85/299486

Filed: April 20, 2011

Mark: CARBON VIRGIN

Published in the *Official Gazette* (Trademarks) on: April 3, 2012

VIRGIN ENTERPRISES LIMITED,)	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
MICHAEL CASEY,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

VIRGIN ENTERPRISES LIMITED (“Opposer” or “Virgin”), a company organized under the laws of England and Wales acting through its Geneva branch, which is registered as Virgin Enterprises Limited, London, Geneva Branch, with its principal place of business at 13-15 Cours de Rive, 1204 Geneva, Switzerland, believes that it will be damaged by the registration of the mark CARBON VIRGIN shown in Application Serial No. 85/299486 (“Opposed Mark”), applied for by MICHAEL CASEY (“Applicant” or “Casey”), and Virgin hereby opposes registration on the basis of a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), a likelihood of dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and Applicant’s lack of a *bona fide* intent to use the mark in connection with the goods and services shown in the application at the time of filing.

In support of its Opposition, Virgin states as follows:

BACKGROUND

Virgin is the owner of a portfolio of over 3,000 trademark applications and registrations incorporating the VIRGIN mark in over 150 countries worldwide. In the United States, Opposer owns 49 U.S. trademark registrations that include VIRGIN as the dominant element of the mark. These registrations cover an immense range of products and services, including but not limited to, entertainment, media, telecommunications, transportation, investments in renewable energy, other financial and charitable services, hospitality, and healthcare (VIRGIN and the VIRGIN-formative marks of record are hereafter referred to as the “VIRGIN Mark”).

The VIRGIN Mark, as used by Opposer and its licensees and affiliates (collectively, the “Virgin Group”), is one of the most highly recognized trademarks in the United States and throughout the world. Unlike many other famous brands that are limited to a particular industry, the reputation of the Virgin Group is not limited to any particular area or activity. The Virgin Group is a dynamic conglomerate of companies and business units that actively develop new products and services with an ever-growing range of branded goods and services, ranging from financial and environmental services to space travel, mobile phone services and wine. Substantial goodwill and national reputation has accrued to the VIRGIN Mark as a result of continuous sales and promotion of products and services bearing the VIRGIN Mark over many years. Additionally, the name and celebrity persona of Sir Richard Branson (“Sir Richard”), entrepreneur, adventurer and founder of the Virgin Group of companies, is tantamount with the VIRGIN mark, and Sir Richard is immediately known to the consuming public for his charitable, environmental and adventurous endeavors that are always conducted

in close association with the VIRGIN Mark. Sir Richard, in collaboration with Virgin Unite, founded the Carbon War Room.

COUNT I

1. Commencing at a time long prior to Applicant's filing date, the Virgin Group has operated numerous worldwide businesses under the trade name, trademark, and service mark VIRGIN. A description of the Virgin Group's operations appears at the Internet web site associated with the domain name www.virgin.com. In the year ending December 31, 2011, Virgin Group companies employed approximately 50,000 staff in thirty-four (34) countries and had global branded revenues of around U.S. \$21 billion.
2. Commencing at a time long prior to Applicant's filing date, Opposer has used the VIRGIN mark in association with a broad range of goods and services offered in United States commerce, including mobile phone and telecommunications products and services, philanthropic, environmental, financial and health-related services, airline and travel-related services, retail store services, wine, non-alcoholic beverages, restaurant and cafe services, clothing, toys, books, bags, records, CDs, videos, cosmetics, consumer electronics, and online information and entertainment services.
3. Virgin's licensee, Virgin Mobile USA, LLC ("Virgin Mobile" or "VMU"), has offered VIRGIN and VIRGIN MOBILE wireless telecommunications products and services in U.S. commerce continuously since June 2002. VMU currently provides VIRGIN and VIRGIN MOBILE wireless services to more than 5,000,000 subscribers located in more than 4,000 cities and communities located throughout the United States. A

description of VMU operations appears at the Internet web site associated with the domain name www.virginmobileusa.com. VMU also offers VIRGIN MOBILE FESTIVAL and VIRGIN MOBILE FREEFEST entertainment services in United States commerce. A description of VIRGIN MOBILE FESTIVAL entertainment services appear at the Internet web site associated with the domain name <http://www.virginmobilefestival.com>.

4. Virgin's licensee, Virgin Green Fund ("Virgin Green Fund" or "VGF"), founded in 2007, is a leading, independent private equity firm investing growth capital in the renewable energy and resource efficiency sectors in North America and Europe. A description of VGF operations appears at the website associated with the domain name www.virgingreenfund.com.
5. Virgin's licensee, Virgin Earth Challenge ("Virgin Earth Challenge" or "VEC"), launched by Sir Richard in 2007, is a prize of \$25 million dollars for whoever can demonstrate to the judges' satisfaction a commercially viable design, which results in the removal of anthropogenic, atmospheric greenhouse gases so as to contribute materially to the stability of the Earth's climate. A description of VEC operations appears at the website associated with the domain name www.virgin.com/subsites/virginearth/.
6. Virgin's licensee, Virgin Money Giving ("Virgin Money Giving" or "VMG"), created as a not-for-profit business by Virgin Money, is a website designed to help users raise money online for charities. A description of VMG operations appears at the website associated with the domain name www.virginmoneygiving.com.

7. Virgin's licensee, Virgin Unite ("Virgin Unite" or "VU"), founded in 2005, is the non-profit foundation of the Virgin Group. VU addresses social and environmental problems by helping the way businesses and the social sector work together. The Virgin Group covers all of VU's overheads meaning that 100% of donations received go direct to frontline charitable initiatives. A description of VU operations appears at the website associated with the domain name www.virginunite.com.
8. Virgin's licensee, Virgin Atlantic Airways Ltd. ("Virgin Atlantic" or "VAA"), has provided VIRGIN and VIRGIN ATLANTIC air travel, air freight, courier, cargo, and related services in U.S. commerce continuously since 1984. A description of VAA operations appears at the web site associated with the domain name www.virginatlantic.com. VAA operates a fleet of Boeing 747 and Airbus A300 and A340 aircraft providing daily departures to and from New York (JFK) and New Jersey (Newark), Boston, Chicago, Orlando, Miami, Las Vegas, Los Angeles, Phoenix, San Diego, San Francisco, Seattle and Washington, D.C. VAA provides entertainment, Internet, spa services and serves food and drinks to its passengers. VAA has offered various VIRGIN-branded goods. In addition, VAA has offered diverse merchandise including electronics, accessories, cosmetics, toys, jewelry, fragrances, liquor and watches.
9. Virgin's licensee, Virgin America Inc. ("Virgin America" or "VAI"), has provided VIRGIN-branded air travel and related services in U.S. commerce continuously since August 2007. A description of VAI operations appears at the web site associated with the domain name www.virginamerica.com. VAI operates commercial aircrafts providing daily departures to and from New York (JFK), Boston, Chicago, Dallas, Fort Lauderdale, Orlando, Palm Springs, Philadelphia, Portland, Washington D.C.,

Las Vegas, San Diego, Los Angeles, Orange County, San Francisco, and Seattle. VAI provides entertainment, Internet services, and serves food and drinks to its passengers. VAI has offered various VIRGIN-branded goods including, but not limited to, VIRGIN apparel, VIRGIN luggage, VIRGIN bags, VIRGIN cases for electronics, VIRGIN toys, VIRGIN water bottles, and VIRGIN pet products. In addition, VAI has offered diverse merchandise including electronics, accessories, gift cards, sports equipment, furniture, travel products, wine, jewelry, cookware, fragrances, and watches.

10. Virgin's licensee, Virgin Australia International ("Virgin Australia International" or "VAU"), has provided VIRGIN-branded air travel and related services in U.S. commerce continuously since February 2009. A description of VAU operations appears at the web site associated with the domain name www.virginaustralia.com. VAU operates commercial aircrafts providing departures to and from Aspen, Atlanta, Baltimore, Boston, Chicago, Cincinnati, Colorado Springs, Dallas, Denver, Detroit, Fort Lauderdale, Honolulu, Houston, Indianapolis, Kahului, Kauai, Kona, Las Vegas, Los Angeles, Memphis, Miami, Minneapolis, New Orleans, New York City, Orlando, Philadelphia, Phoenix, Portland, Salt Lake City, San Francisco, Seattle, Tampa, and Washington, D.C.
11. Virgin's licensee, Virgin Galactic ("Virgin Galactic" or "VG"), founded in 2005, is the world's first space line, which will own and operate its privately built spaceships, based on the remarkable, history-marking SpaceShipOne. A description of VG operations appears at the website associated with the domain name www.virgingalactic.com.

12. Virgin's licensee, Virgin Limited Edition ("Virgin Limited Edition" or "VLE"), is Sir Richard's collection of retreats and luxury portfolio of Virgin Hotels Group Limited. A description of VLE operations appears at the website associated with the domain name www.virginlimitededition.com.
13. Virgin's licensee, Virgin Vacations ("Virgin Vacations" or "VV"), established in 1994, provides tour operations in the U.S., Europe, Asia, South Pacific, South America and beyond. A description of VV operations appears at the website associated with the domain name www.virgin-vacations.com.
14. Virgin's licensee, Virgin Wines US ("Virgin Wines" or "VW"), sells handcrafted wines from all over the world. A description of VW operations appears at the website associated with the domain name www.virginwines.com.
15. Virgin's licensee, Virgin Books ("Virgin Books" or "VB"), has provided VIRGIN-branded books and guides in U.S. commerce continuously since at least as early as 2001. A description of VB operations appears at the web site associated with the domain name www.virginbooksusa.com.
16. Virgin's licensee, Virgin Healthmiles, Inc. ("Virgin Healthmiles" or "VHI"), has provided VIRGIN-branded health-related services in United States commerce continuously since 2005. A description of VHI operations appears at the web site associated with the domain name www.virginhealthmiles.com.
17. Virgin's licensee, Virgin Produced ("Virgin Produced" or "VP"), is a film and television development, packaging and production company announced in 2010 by the Virgin Group. A description of VP operations appears at the website associated with the domain name www.virginproduced.com.

18. Virgin's licensee, Virgin Gaming ("Virgin Gaming" or "VGM"), introduced in 2010, is a premier destination for competitive console gamers to meet and play against each other. A description of VGM operations appears at the website associated with the domain name www.virgingaming.com.
19. Virgin's licensee's affiliate, HDS Retail North America ("HDS Retail" or "HDS"), has provided VIRGIN-branded retail store services in the United States since 2002. VIRGIN retail stores distribute a broad range of goods including magazines, books, gifts, apparel, travel accessories, and phone cards. Among these goods are VIRGIN-branded goods including apparel. VIRGIN retail stores prominently feature the VIRGIN mark on store signage.
20. Virgin's licensee, Virgin Digital Publishing ("Virgin Digital Publishing" or "VDP"), launched the iPad only magazine, PROJECT. PROJECT Magazine is available at the website associated with the domain name www.projectmag.com.
21. Virgin's licensee, Virgin Digital Help US ("Virgin Digital Help" or "VDH"), offers technical assistance and repair services for computers and laptops, printers, cameras and other connected devices, smartphones and tablets, iPods and other mp3 players, as well as Internet, networking and Wi-Fi problems, email problems, and problems with setting up video game consoles and computer games. A description of VDH operations appears at the website associated with the domain name www.virgindigitalhelp.com.
22. Opposer is also the owner of numerous registrations of trademark and service marks that constitute or comprise the word VIRGIN, including the following:
 - 1) U.S. Reg. No. 1,039,574 for VIRGIN (stylized) for "sound records in the form of discs and tapes and cassettes for use therewith;"

- 2) U.S. Reg. No. 1,413,664 for VIRGIN for "air travel services;"
- 3) U.S. Reg. No.1,469,618 for VIRGIN for "pre-recorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records;"
- 4) U.S. Reg. No. 1,517,801 for VIRGIN (stylized) for "Pre-recorded audio and video discs, phonograph records; photographic and cinematographic films;"
- 5) U.S. Reg. No. 1,591,952 for VIRGIN (stylized) for "printed sheet music; fictional and non-fictional books, biography and autobiography books, periodicals, namely, paperback books all dealing with music, films and entertainment; paper for packaging, paper cases; writing instruments, namely, pens, pencils, ball point pens, stationery and office supplies, namely, writing and note paper, playing cards" and "articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps, clothing belts;"
- 6) U.S. Reg. No. 1,597,386 for VIRGIN for "fictional and non-fictional books, biography and autobiography books, periodicals, namely, journals, paperback books all dealing with music, films and entertainment; stationery and office supplies, playing cards" and "articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps;"
- 7) U.S. Reg. No. 1,851,817 for VIRGIN for "transportation of goods and passengers by road and air, freight transportation services; travel agency services" and "bars; retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus, and watches, sheet music, books and photography, handbags, purses, luggage and leather goods, clothing, games, video game machines and video game cartridges;"
- 8) U.S. Reg. No. 1,852,776 for VIRGIN (stylized) for "transportation of goods and passengers by road, air freight transportation services" and "bars; rental of food service equipment; namely, vending machines; portrait and aerial photography; typesetting and printing services; and retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus; and watches; sheet music, books and photography; handbags, purses, luggage and leather goods; clothing; games, video game machines and video game cartridges;"
- 9) U.S. Reg. No. 1,863,353 for VIRGIN MEGASTORE for "retail department store services;"
- 10)U.S. Reg. No. 2,151,589 for VIRGIN VODKA for "vodka;"
- 11)U.S. Reg. No. 2,237,092 for VIRGIN VACATIONS for "arranging the transport of passengers by air and road, arranging and conducting travel tours, travel agency services, namely, making reservations and bookings for transportation, and transportation reservation services" and "resort hotel and hotel reservation; travel agency services, namely, making reservations and bookings for temporary lodging;"
- 12)U.S. Reg. No. 2,586,162 for VIRGIN for "articles of luggage, namely, suitcases; bags; namely, back packs, rucksacks, school bags, school

- satchels, traveling bags, sports bags, all-purpose sports bags for campers and climbers, textile shopping bags; wallets; umbrellas and parasols;"
- 13) U.S. Reg. No. 2,600,080 for VIRGIN (stylized) for "non-alcoholic beverages, namely, soft drinks;"
 - 14) U.S. Reg. No. 2,625,455 for VIRGIN for "providing an on-line shopping mall via a global computer network; providing business information via a global computer network" and "computerized communication services, namely, electronic mail services, and providing networks for the purpose of transmission and reception of electronic mail, computer generated music, news and other data and information; and broadcasting services by radio and over a global computer network of a wide variety of programs, namely, current events, economics, politics, sports, entertainment, the arts and business;"
 - 15) U.S. Reg. No. 2,639,079 for VIRGIN HOLIDAYS for "transportation of passengers and goods by road, rail and air; arranging of package holidays; arranging and organizing tours; arranging visits to places of interest; tourist office services; travel agency services, namely, making reservations and bookings for transportation; transportation reservation services" and "travel agency services, namely, making reservations and bookings for temporary lodging;"
 - 16) U.S. Reg. No. 2,643,644 for VIRGIN VIE (stylized) for "non-medicated toilet preparations, namely, lotions and moisturizers; non-medicated preparations for the care of the skin, hands, scalp and body, namely, moisturizers, lotions, creams and gels; non-medicated skin cleansing preparations, namely, lotions, creams and gels; creams and lotions for the skin;"
 - 17) U.S. Reg. No. 2,689,097 for VIRGIN (stylized) for "mobile telephones; telephones; modems; batteries; battery chargers; cigarette lighter adapters; dashboard mounts; hands-free headsets; carrying cases; belt clips" and "telecommunications services, namely, transmission of voice, data, images, audio, video, and information via telephone or the internet; personal communications services; pager services; electronic mail services; transmission or broadcast of news and information for others via telephone, including the internet;"
 - 18) U.S. Reg. No. 2,689,098 for VIRGIN for "mobile telephones; telephones; modems; batteries; battery chargers; cigarette lighter adapters; dashboard mounts; hands-free headsets; carrying cases; belt clips" and "telecommunications services, namely, transmission of voice, data, images, audio, video, and information via telephone or the internet; personal communications services; pager services; electronic mail services; transmission or broadcast of news and information for others via telephone, including the internet;"
 - 19) U.S. Reg. No. 2,709,578 for VIRGIN (stylized) for "sound records of music in the form of discs pre-recorded audio and video discs, phonograph records featuring music; graphical interface to aid the delivery of interactive products and services by cable or wireless transmission; parts

- for the aforesaid goods; computer game software; water, namely, mineral waters, aerated waters and flavored waters; non-alcoholic beverages, namely, fruit flavored drinks" and "spirits, namely vodka;"
- 20) U.S. Reg. No. 2,717,644 for VIRGIN for "non-alcoholic beverages, namely, soft drinks;"
- 21) U.S. Reg. No. 2,770,775 for VIRGIN MOBILE for "mobile telephones, telephones and modems, and accessories therefor, namely, batteries; battery chargers; cigarette lighter adapters; hands-free headsets; carrying cases and belt clips; providing directory information via telephone" and "telecommunications services, namely, transmission of voice, data, images, audio, video, and information via telephone or the internet; personal communications services; pager services; electronic mail services; transmission or broadcast of news and information for others via telephone, including the internet;"
- 22) U.S. Reg. No. 2,770,776 for VIRGIN MOBILE (stylized) for "mobile telephones, telephones and modems, and accessories therefor, namely, batteries; battery chargers; cigarette lighter adapters; hands-free headsets; carrying cases and belt clips; providing directory information via telephone" and "telecommunications services, namely, transmission of voice, data, images, audio, video, and information via telephone or the internet; personal communications services; pager services; electronic mail services; transmission or broadcast of news and information for others via telephone, including the internet;"
- 23) U.S. Reg. No. 2,798,130 for VIRGIN (stylized) for "playing cards, writing instruments, namely, pens, pencils and ball point pens"; "leisurewear, namely, fleece tops and shirts; articles of outer clothing, namely T-shirts, sweat shirts, jackets, hats, clothing caps; preparing advertising, promotions, and public relations materials for others; demonstration of the goods of others and the promotion thereof; and distribution and dissemination of advertising, promotional materials and sample materials of others; electronic transmission and display of information for business or domestic purposes from a computer stored data bank and retail store services in the fields of records, audio and video tapes, computers and electronic apparatus and watches, books, luggage and leather goods, clothing, games, video game cartridges, and cafes;"
- 24) U.S. Reg. No. 2,808,270 for VIRGIN ATLANTIC for "transportation of and arranging transportation of goods and passengers by road and air; freight transportation services by air; transportation of human beings by means of land vehicles; chauffeur services; travel agency services, namely, making reservations and bookings for transportation; arranging and/or conducting travel tours; operation of aircraft for others;"
- 25) U.S. Reg. No. 2,870,028 for VIRGIN XTRAS for "mobile telephones; computer software downloadable from the Internet for transmission, reception and storage of voice, data, images, e-mail and digital information" and "telecommunications services, namely, transmission of voice data, images, audio, video, and information via telephone or the

- internet; personal communications services; electronic mail services; transmission or broadcast of news and information for others via telephone, including internet;”
- 26)U.S. Reg. No. 3,009,266 for VIRGIN (stylized) for “operation of leisure centers, namely, providing cosmetic and body care services;”
 - 27)U.S. Reg. No. 3,100,295 for VIRGIN XL for "mobile telephones; computer software downloadable from the Internet for transmission, reception and storage of voice, data, images, e-mail and digital information" and "telecommunications services, namely, transmission of voice, data, images, audio, video, and information via telephone or the internet; personal communications services; electronic mail services; transmission or broadcast of news and information for others via telephone, including the internet;”
 - 28)U.S. Reg. No. 3,174,388 for VIRGIN for "soaps; shampoos; non-medicated toilet preparations, namely, soaps, shampoos, lotions, and moisturizers; antiperspirants; deodorants for use on the person; cosmetics, namely, foundation creams and lotions; non-medicated preparations for the care of the skin, hands, scalp and body, namely, moisturizers, lotions, creams, soaps, gels; hair care preparations, namely, shampoos; non-medicated skin cleansing preparations, namely, cleansers, lotions, creams, soaps; creams and lotions for the skin;”
 - 29)U.S. Reg. No. 3,188,282 for VIRGIN for "alcoholic beverages, namely, vodka and wine;”
 - 30)U.S. Reg. No. 3,209,714 for VIRGIN (stylized) for "entertainment services, namely, providing online computer games;”
 - 31)U.S. Reg. No. 3,209,716 for VIRGIN for "entertainment services, namely, providing online computer games;”
 - 32)U.S. Reg. No. 3,230,095 for VIRGIN (stylized) for "organizing cultural activities and events; operation of leisure centers, namely, providing library and Internet access facilities;”
 - 33)U.S. Reg. No. 3,245,593 for VIRGIN (stylized) for "alcoholic beverages, namely, vodka and wine;”
 - 34)U.S. Reg. No. 3,298,420 for VIRGIN for "business incentive services, namely, offering plans to employers including motivational schemes, gift - certificates and other rewards for employees, management of incentive programs, events and schemes for others" and "debit card services;”
 - 35)U.S. Reg. No. 3,298,421 for VIRGIN (stylized) for "business incentive services, namely, offering plans to employers including motivational schemes, gift certificates and other rewards for employees, management of incentive programs, events and schemes for others" and "debit card services;”
 - 36)U.S. Reg. No. 3,398,247 for VIRGIN for "banking services; loan services, namely, offering loans to others; credit card services; consumer financing; electronic funds transfer;”

- 37)U.S. Reg. No. 3,398,248 for VIRGIN (stylized) for "banking services; loan services, namely, offering loans to others; credit card services; consumer financing; electronic funds transfer;"
- 38)U.S. Reg. No. 3,472,228 for VIRGIN UNITE for "developing promotional campaigns for business; promoting public awareness of the need for businesses to have a positive impact on the communities and environment in which they operate and work together with the social sector to drive long term social change including making investments in emerging markets to accelerate positive social change through economic development; charitable services, namely, organizing and coordinating programs for the sick, people with health problems or issues, the homeless, drug users, those with disabilities, victims of abuse, those who are bereaved, children in need or at risk, those with sexual problems, and underprivileged communities, and organizing and conducting volunteer programs and community service projects; business management and administration services in connection with a charity; charitable fund raising; charitable financial services for those in need, namely, accepting and administering monetary charitable contributions; financial sponsorship of fund raising events and events designed to raise the profile of charitable and social issues; and educational services, namely, conducting summits, conferences, lectures and seminars in the field of social change and charitable and social issues; training services in the field of social change and charitable and social issues; organizing community sporting and cultural events; educational services, namely, providing classes, lectures, seminars, workshops, and discussion groups in the fields of sickness, health problems, homelessness, drug use, disabilities, abuse, bereavement, children's needs, sexual problems, and poverty to young people, people with health problems or issues, the homeless, drug users, those with disabilities, victims of abuse, those who have been bereaved, children in need or at risk, those with sexual problems, and underprivileged communities; charitable services, namely, academic mentoring of children from underprivileged communities and young people;"
- 39)U.S. Reg. No. 3,427,241 for VIRGIN for "organizing sporting and cultural activities and events; operation of leisure centers, namely, providing library facilities" and "operation of leisure centers, namely, providing cosmetic and body care services;"
- 40)U.S. Reg. No. 3,535,624 for VIRGIN GALACTIC (stylized) for "travel agency services, namely, making reservations and bookings for transportation, space travel agency services; namely, booking of transportation into space;"
- 41)U.S. Reg. No. 3,538,900 for VIRGIN FESTIVAL for "arranging and conducting live musical performances and music festivals;"
- 42)U.S. Reg. No. 3,538,901 for VIRGIN (stylized) for "arranging and conducting live musical performances and music festivals;"

- 43)U.S. Reg. No. 3,541,731 for VIRGIN AMERICA for "air transportation; freight transportation services by means of air, ship, truck, and rail; airport passenger and baggage check-in services; airport services, namely, ticketing and boarding services; travel services, namely, booking seating arrangements for airline passengers; air transportation services featuring frequent flyer miles as a bonus program for frequent air travelers; providing flight arrival and departure information; and transportation reservation services" and "onboard in-flight entertainment services, namely, distributing movies, TV programs, and audio programs, and providing temporary use of video games, software and personal monitors for viewing the same;"
- 44)U.S. Reg. No. 3,543,131 for VIRGIN COMICS for "comic books" and "entertainment services, namely, providing a web site featuring comic strips, related film clips, photographs, drawings, art pictures and other multimedia materials;"
- 45)U.S. Reg. No. 3,707,308 for VIRGIN VIE AT HOME for "Perfumes, cosmetics, make up; hair care preparations; non-medicated skin care preparations, non-medicated sun care preparations; nail care products, namely, nail varnishes, nail varnish removers; nail care preparations; artificial nails and adhesives therefore; glues, adhesives, acrylic, and silk and linen wraps for the repair of artificial nails, nail polishes; powder compacts; lipsticks; lip gloss; nail varnish remover; cotton wool balls for use in removing and applying cosmetics; make-up powder and foundation; facial wipes impregnated with cosmetics; skin moisturizers; beauty creams; beauty gels; body care cosmetics, essential oils for personal use; antiperspirants; after shave lotions; eau de cologne; soaps; Make up removing preparations; non-medicated toiletries; eau de toilette; deodorants for personal care; hair lotions, hair creams, and hair conditioners; shampoos; beauty masks; skin cream, facial masks, cosmetic oils, face powder, and body scrubs; hand and body lotions; dentifrices; shaving preparations, dyes for hairs; bath preparations, namely, beads, crystals, foam, gels, oil and powder; scented body sprays; after-shave lotions; pre-electric shaving preparations; jewelry and imitation jewelry; precious metals and their alloys; bracelets of precious metal; fancy key rings of precious metals; jewelry boxes of precious metal; key chains of precious metal; ornaments of precious metal; semi-precious and precious stones; watches, clocks, and structural parts therefore; and retail shops featuring cosmetics and jewelry; computerized online retail ordering services featuring cosmetics and jewelry; shop at home services featuring cosmetics and jewelry; mail order catalog services featuring cosmetics and jewelry; business consultancy services; business advisory services; advertising services; advertising services provided over the internet; rental of advertising space on a website;"
- 46)U.S. Reg. No. 3,913,150 for VIRGIN (stylized) for "advertising services for others relating to real property; management of incentive and loyalty programs of others to promote healthy lifestyle choices; providing

information and advice on advertising in the fields of health and fitness; health insurance underwriting; private health insurance underwriting; medical insurance underwriting; financial services in the field of health care, namely, administration and management of health savings plans and accounts; real estate brokerage services; brokerage for leasing of real estate property; real estate agencies; financial services in the field of real estate, namely, providing loans and mortgages; estate trust management services relating to transactions in real property; financing of real estate development; real estate management; real estate portfolio management; providing information and advice on the buying and selling of real estate; building construction; advisory services relating to development of real estate; advisory services relating to the renovation of real estate; commercial retail property development services; real estate development; providing information and advice on real estate development; medical evaluation services, namely, providing health assessments; advisory services relating to health; consultation relating to health care; and, personal lifestyle counseling and consultation;”

47) U.S. Reg. No. 3,913,151 for VIRGIN for “advertising services for others relating to real property; management of incentive and loyalty programs of others to promote healthy lifestyle choices; providing information and advice on advertising in the fields of health and fitness;” “health insurance underwriting; private health insurance underwriting; medical insurance underwriting; financial services in the field of health care, namely, administration and management of health savings plans and accounts; real estate brokerage services; brokerage for leasing of real estate property; real estate agencies; financial services in the field of real estate, namely, providing loans and mortgages; estate trust management services relating to transactions in real property; financing of real estate development; real estate management; real estate portfolio management; providing information and advice on the buying and selling of real estate; building construction; advisory services relating to development of real estate; advisory services relating to the renovation of real estate; commercial retail property development services; real estate development; providing information and advice on real estate development; medical evaluation services, namely, providing health assessments; advisory services relating to health; consultation relating to health care; and, personal lifestyle counseling and consultation;”

48) U.S. Reg. No. 4,004,271 for VIRGIN MONEY EVERYONE’S BETTER OFF for “insurance services, namely, brokerage, underwriting, administration, appraisals, and claims adjustment in the fields of life insurance, car insurance, home insurance, pet insurance, and travel insurance; financial affairs and monetary affairs, namely, financial information, management and analysis services; real estate affairs, namely, mortgage lending; banking services; financial clearing houses; credit card services; debit card services; mortgage banking; financial consultancy; provision of financial information; financial evaluation for

- insurance purposes; electronic funds transfer; financial services, namely, money lending; financial services, namely, investment management and investment of funds for others;”
- 49)U.S. Reg. No. 4,105,375 for VIRGIN (stylized) for "operation of fitness centers; health club services;”
- 50)U.S. Application Serial No. 77/946459 for VIRGIN for “advisory and consultancy services related to resource efficiency, energy usage management and energy efficiency; creation, management and administration of investment funds, venture capital funds and private equity funds, fund investment services, including fund investment services and fund investment management services in the renewable energy, resource efficiency, energy efficiency, clean technology and alternative energy sectors; environmental brokerage services; brokerage of carbon credits and carbon trading services; advisory and consultancy services in relation to the aforesaid and in relation to the evaluation, consummation, administration and management of investments in businesses operating in the renewable energy, resource efficiency, energy efficiency, clean technology and alternative energy sectors; and, advisory and consultancy services relating to the design and development of renewable energy sources and related to energy measurement to improve energy efficiency;”
- 51)U.S. Application Serial No. 85/613140 for VIRGIN MONEY for “billing services; accounting services” and “credit and loan services; financing and loan services; electronic loan origination services; electronic funds transfer services via the Internet to enable individuals to engage in lending and borrowing transactions with other individuals; arranging of loans; providing student loan information; student loan services;”
- 52)U.S. Application Serial No. 85/288394 for VIRGIN for “operation of fitness centers; providing health club services;”
- 53)U.S. Application Serial No. 85/136217 for VIRGIN (stylized) for “Aircraft, airplanes, space vehicles namely, aeronautical vehicles, aeronautical vehicles, aeronautical vehicles and parts therefor; books featuring space travel and exploration, pictures, prints, cards bearing universal greetings, postcards, magazines featuring adventure travel and space exploration, writing instruments, stickers, calendars, decals, decorative tops for writing instruments, photo and scrapbook albums, event programs, posters, guide books featuring outer space travel and amenities, maps, newsletters in the field of space travel news and events, photographs, paper, note pads, folders and stationery; clothing, namely, suits, stockings, under garments, shirts, t-shirts, pants, skirts, dresses, jackets, coats, blazers, sweaters, scarves, hats, headwear, bathrobes, shorts, socks, belts, gloves, jeans, neckwear, swimwear, beachwear, footwear, visors, sleep masks, cloth bibs, nightwear, outerwear, namely, parkas, wind vests, and coats, wraps and wristbands; playing cards, toy models of airplanes, spaceships, and rockets, board and card games, toys, namely, stuffed toy animals and space vehicles, sports balls, dolls and doll accessories, and puzzles; air transportation, freight transportation by air and space vehicles, passenger

transportation by space vehicle, air and ground transportation, airport services, travel agency services, namely, making reservations and bookings for transportation, space vehicle transportation services, namely, launching of space vehicles, space travel agency services, namely, booking of transportation into space, and transportation of passengers into space;”

54)U.S. Application Serial No. 77/876194 for VIRGIN for “hotel services; restaurant services; bar services; hotel accommodation services;”

55)U.S. Application Serial No. 77/876197 for VIRGIN (stylized) for “hotel services; restaurant services; bar services; hotel accommodation services;”

56)U.S. Application Serial No. 77/915463 for VIRGIN GALACTIC for “aircraft, airplanes, space vehicles, and structural parts therefor; watches; books in the field of space travel, aircraft, airplanes, space vehicles, and parts therefor; pictures; prints; trading cards, collectable trading cards; postcards; magazines in the field of space travel, aircraft, airplanes, space vehicles, and parts therefor; writing instruments; stickers; calendars; decals; decorative tops for writing instruments; event programs; posters; maps; newsletters in the field of space travel, aircraft, airplanes, space vehicles, and parts therefor; photographs; paper; note pads; folders; and stationery; all-purpose sports bags; all-purpose carrying bags; clothing, namely, suits, flight suits, stockings, undergarments, shirts, t-shirts, sweatshirts, pants, sweat pants, track suits, skirts, dresses, jackets, coats, blazers, sweaters, scarves, hats, headwear, bathrobes, shorts, socks, belts, gloves, jeans, neckwear, swimwear, beachwear, footwear, sleep masks, cloth bibs, nightwear, wraps, and wristbands; playing cards; toy models of aircraft, airplanes, space vehicles, and parts therefor; card games and board games; toys, namely, action figures; dolls and doll accessories; puzzles; and, air transportation; freight transportation by air; transportation of passengers by air; airport services; launching of space vehicles for others; transportation of passengers and freight through space; space travel agency services, namely, booking of transportation into space;”

57)U.S. Application Serial No. 85/136215 for VIRGIN GALACTIC (stylized) for “Aircraft, airplanes, space vehicles namely, aeronautical vehicles, aeronautical vehicles, aeronautical vehicles and parts therefor; books featuring space travel and exploration, pictures, prints, cards bearing universal greetings, postcards, magazines featuring adventure travel and space exploration, writing instruments, stickers, calendars, decals, decorative tops for writing instruments, photo and scrapbook albums, event programs, posters, guide books featuring outer space travel and amenities, maps, newsletters in the field of space travel news and events, photographs, paper, note pads, folders and stationery; clothing, namely, suits, stockings, under garments, shirts, t-shirts, pants, skirts, dresses, jackets, coats, blazers, sweaters, scarves, hats, headwear, bathrobes, shorts, socks, belts, gloves, jeans, neckwear, swimwear, beachwear,

footwear, visors, sleep masks, cloth bibs, nightwear, outerwear, namely, parkas, wind vests, and coats, wraps and wristbands; playing cards, toy models of airplanes, spaceships, and rockets, board and card games, toys, namely, stuffed toy animals and space vehicles, sports balls, dolls and doll accessories, and puzzles; air transportation, freight transportation by air and space vehicles, passenger transportation by space vehicle, air and ground transportation, airport services, travel agency services, namely, making reservations and bookings for transportation, space vehicle transportation services, namely, launching of space vehicles, space travel agency services, namely, booking of transportation into space, and transportation of passengers into space;”

58)U.S. Application Serial No. 77/274906 for VIRGIN MOTORS for “aircraft engines; anti-pollution devices for motors and engines; automotive engine blocks; diesel engines for machines; diesel engines not for land vehicles; engine parts, namely, electronic fuel injection modules; engines and motors for the generation of electricity; engines for aerostation purposes; engines not for land vehicles; gasoline engines not for land vehicles; industrial engines; jet engines; pneumatic controls for machines, motors and engines” and “automobile engines; diesel engines for land vehicles; engines for land vehicles; internal combustion engines for land vehicles; motorcycle engines;”

59)U.S. Application Serial No. 77/644656 for VIRGIN for “bottled water;”

60)U.S. Application Serial No. 85/455406 for VIRGIN for “Provision of exercise facilities; organization, operation and supervision of incentivized fitness programs and information advisory services relating to aforesaid services; Operation of leisure centers, namely, providing cosmetic and body care 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 services; reflexology services; medical services, namely, chiropody services; health assessments and health care risk assessments, namely, providing a heart-rate based overview of their own metabolism in order to assist in reaching weight loss, sports performance, health, fitness, and wellness related goals; health spa services in the nature of providing steam room facilities; organization, operation and supervision of incentivized health programs and information advisory services relating to all aforesaid services; and, Lifestyle counseling and consultancy;” and

61)U.S. Application Serial No. 85/476874 for VIRGIN ACTIVE for “Providing Internet access; Providing facilities for and organizing sporting and cultural activities and events; Operation of leisure centers, namely, providing library services; Providing health club services.”

23.As established above, Virgin’s licensees typically use the VIRGIN-formative in combination with a generic or descriptive term in conjunction with “VIRGIN” to

denote the goods or services offered by (or the aspirations of) the particular business unit or licensee. Examples of this include Virgin Mobile, Virgin Green Fund, Virgin Earth Challenge, Virgin Money Giving, Virgin Unite, Virgin Atlantic, Virgin America, Virgin Galactic, Virgin Limited Edition, Virgin Vacations, Virgin Wines, Virgin Books, Virgin Healthmiles, Virgin Produced, Virgin Digital Publishing, Virgin Gaming and Virgin Digital Help.

24. As a result, Virgin has established a VIRGIN family of at least seventeen (17) marks comprised of Opposer's famous VIRGIN-formative paired with a suitable generic or descriptive term (the "VIRGIN Family of Marks").

25. The members of Virgin's VIRGIN Family of Marks have been so extensively used and advertised together that the VIRGIN family "surname" is recognized by consumers as an identifying trademark or service mark in and of itself when it appears in a composite.

26. By reason of more than thirty (30) years of continuous and substantially exclusive use, as well as the Virgin Group's expenditure of tens of millions of dollars in advertising and promotion, Opposer's VIRGIN Mark and its VIRGIN Family of Marks were well known and famous prior to Applicant's filing date of April 20, 2011, and symbolized extensive goodwill identifying Virgin Group companies and their founder, Sir Richard Branson. As a result, in July 2003, the Court of Appeals for the Second Circuit held that VIRGIN was a "famous, arbitrary, and distinctive mark." *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 146 (2d Cir.2003) (attached hereto as Annex A).

27. On April 20, 2011, long after Opposer commenced use of VIRGIN in association with diverse businesses, goods, and services in United States commerce, Applicant filed U.S. Application Serial No. 85/299486 (based on an intent to use) seeking registration of CARBON VIRGIN as a purported trademark for the following goods and services:

- a) "Communication software for providing access to the Internet; Computer programs for searching remotely for content on computers and computer networks; Computer search engine software," in International Class 9;
- b) "Advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels; Advertising on the Internet for others; Advertising via electronic media and specifically the internet; An interactive web site for users to review and rate internet content, people, companies, products and/or services utilizing a software application to award points whereby web site users are eligible to exchange points earned for promotional items consisting of coupons, rebates, discounts or special offerings on goods and/or service provided by web site sponsors; Business administration services for processing sales made on the Internet; Business services, namely, providing an online network for contractors to receive leads and bidding opportunities by means of an online marketplace for the purpose of developing business for energy related products and services; Promoting the goods and services of others by means of distributing advertising on the Internet; Providing a searchable on-line advertising website and guide featuring the goods and services of other vendors via the Internet," in International Class 35;
- c) "Investment banking services; On-line banking services," in International Class 36;
- d) "Communications by means of mobile phones; Mobile radio telephone services; Transmission of sound, video and information from web cams, video cameras or mobile phones, all featuring live or recorded materials," in International Class 38; and
- e) "Computer services, namely, providing search engines for obtaining data on a global computer network; Consultation services in the field of search engine optimization; Development, maintenance and updating of a telecommunication network search engine; Providing a website featuring a

media aggregator and search engine for internet content; Providing customized on-line web pages featuring user-defined information, which includes search engines and on-line web links to other web sites; Provision of Internet search engines; Technical consulting in the field of environmental engineering,” in International Class 42.

28. The designation CARBON VIRGIN so resembles Virgin's prior VIRGIN Mark, as well as Virgin's VIRGIN Family of Marks, as to be likely, when used in connection with Applicant's goods and services identified the application, to cause confusion, to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer or as to the origin, sponsorship, or approval of Applicant's services by Opposer.

29. Opposer believes that it would be damaged by the registration sought herein by Applicant because such registration would support and assist Applicant in the confusing and misleading use of Applicant's designation sought to be registered, and would give color of exclusive statutory rights in Applicant in violation and derogation of the prior superior rights of Opposer.

30. Accordingly, Applicant's application to register the Opposed Mark must be refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), as amended.

COUNT II

31. Paragraphs 1 through 30, above, are realleged and incorporated by reference as if set forth in full.

32. Applicant's intended use of CARBON VIRGIN is likely to dilute the distinctive quality of Virgin's famous VIRGIN marks under Section 43(c) of the federal Trademark Act, 15 U.S.C. § 1125(c).

33. Opposer believes that it would be damaged by the registration sought herein by Applicant because such registration would support and assist Applicant in diluting the distinctiveness of Opposer's VIRGIN Mark and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior superior rights of Opposer.

34. Accordingly, Applicant's application to register the Opposed Mark must be refused registration under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), as amended.

COUNT III

35. Paragraphs 1 through 34, above, are realleged and incorporated by reference as if set forth in full.

36. Applicant filed Application Serial No. 85/299486 to register the Opposed Mark on the basis of Applicant's alleged *bona fide* intent to use the mark in connection with the goods and services set forth in the application, pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), as amended.

37. The goods and services set forth in Application Serial No. 85/299486 at the time of Applicant's filing, as set forth hereinabove, have remained the same since the date of filing, up to and including the present date.

38. As of the date of filing on April 20, 2011, Applicant had no *bona fide* intent to use the CARBON VIRGIN mark in connection with the goods and services listed in Application Serial No. 85/299486, and as a result, Application Serial No. 85/299486 is void *ab initio*.

39. Accordingly, Applicant's application to register the Opposed Mark must be refused registration under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), as amended.

PRAYER FOR RELIEF

WHEREFORE, Opposer prays that the mark shown by the above-identified application be refused registration, and that this Notice of Opposition be sustained in favor of Opposer.

Respectfully submitted,

VIRGIN ENTERPRISES LIMITED



Dated: June 1, 2012

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition has been served upon Michael Casey via first class mail, postage prepaid, addressed to:

MICHAEL CASEY
AM TREPTOWER PARK 51
2ND FLOOR LEFT
12435 BERLIN
GERMANY



Dated: June 1, 2012

By: _____

ANNEX A

335 F.3d 141, 67 U.S.P.Q.2d 1420
(Cite as: 335 F.3d 141)



United States Court of Appeals,
Second Circuit.
VIRGIN ENTERPRISES LTD., Plaintiff-Appellant,
v.
Tahir NAWAB, Nathan Erlich, Simon Blitz, Daniel
Gazal, Gerald Wren, Bob Wroblewski, Corporation
Solutions, LLC, Cel-Net Communication, Inc., the
Cellular Network Communication Group, Inc., d/b/a
CNCG, SD Telecommunications Inc., Virgin Wire-
less, Inc., Iwaycity, and Virginwireless.com, De-
fendants-Appellees.

Docket No. 02-7491.
Argued: Aug. 5, 2002.
Decided: July 11, 2003.

Holder of “VIRGIN” trademark brought applica-
tion for preliminary injunction against defendants
using mark “VIRGIN WIRELESS” in connection
with retail sale of wireless telephones. The United
States District Court for the Eastern District of New
York, [Charles P. Sifton](#), J., denied relief, and trade-
mark holder appealed. The Court of Appeals, [Leval](#),
Circuit Judge, held that trademark holder was likely to
prevail on merits of claim.

Reversed and remanded

West Headnotes

[\[1\] Injunction 212](#) [138.1](#)

[212](#) Injunction

[212IV](#) Preliminary and Interlocutory Injunctions
[212IV\(A\)](#) Grounds and Proceedings to Procure
[212IV\(A\)2](#) Grounds and Objections
[212k138.1](#) k. In General. [Most Cited](#)

[Cases](#)

To obtain preliminary injunction, party must
demonstrate probability of irreparable harm in ab-
sence of injunctive relief, and either likelihood that it
will succeed on merits of its claim, or serious question
going to merits and balance of hardships tipping de-
cidedly in its favor.

[\[2\] Federal Courts 170B](#) [815](#)

[170B](#) Federal Courts

[170BVIII](#) Courts of Appeals

[170BVIII\(K\)](#) Scope, Standards, and Extent

[170BVIII\(K\)4](#) Discretion of Lower Court

[170Bk814](#) Injunction

[170Bk815](#) k. Preliminary Injunction;
Temporary Restraining Order. [Most Cited Cases](#)

District court's denial of preliminary injunction is
reviewed for abuse of discretion.

[\[3\] Trademarks 382T](#) [1704\(9\)](#)

[382T](#) Trademarks

[382TIX](#) Actions and Proceedings

[382TIX\(F\)](#) Injunctions

[382Tk1701](#) Preliminary or Temporary In-
junctions

[382Tk1704](#) Grounds and Subjects of
Relief

[382Tk1704\(9\)](#) k. Similarity; Likeli-
hood of Confusion. [Most Cited Cases](#)
(Formerly 382k620 Trade Regulation)

On motion for preliminary injunction in trade-
mark infringement action, where mark merits protec-
tion, showing that significant number of consumers
are likely to be confused about source of goods iden-
tified by allegedly infringing mark is generally suffi-
cient to demonstrate both irreparable harm and like-
lihood of success on merits.

[\[4\] Trademarks 382T](#) [1421](#)

[382T](#) Trademarks

[382TVIII](#) Violations of Rights

[382TVIII\(A\)](#) In General

[382Tk1418](#) Practices or Conduct Prohibited
in General; Elements

[382Tk1421](#) k. Infringement. [Most Cited](#)
[Cases](#)
(Formerly 382k332 Trade Regulation)

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(Cite as: 335 F.3d 141)

Test for trademark infringement, regardless of whether mark is registered is whether: (1) mark is entitled to protection, and (2) defendant's use of mark is likely to cause consumer confusion as to origin or sponsorship of defendant's goods. Lanham Trade-Mark Act, §§ 32(1), 43(a), [15 U.S.C.A. §§ 1114\(1\), 1125\(a\)](#).

[\[5\] Trademarks 382T](#) [1704\(8\)](#)

[382T](#) Trademarks

[382TIX](#) Actions and Proceedings

[382TIX\(F\)](#) Injunctions

[382Tk1701](#) Preliminary or Temporary Injunctions
[382Tk1704](#) Grounds and Subjects of Relief

[382Tk1704\(8\)](#) k. Ownership; Marks Protected. [Most Cited Cases](#)
(Formerly 382k620 Trade Regulation)

Trademarks [382T](#) [1704\(9\)](#)

[382T](#) Trademarks

[382TIX](#) Actions and Proceedings

[382TIX\(F\)](#) Injunctions

[382Tk1701](#) Preliminary or Temporary Injunctions
[382Tk1704](#) Grounds and Subjects of Relief

[382Tk1704\(9\)](#) k. Similarity; Likelihood of Confusion. [Most Cited Cases](#)
(Formerly 382k620 Trade Regulation)

Holder of “VIRGIN” mark for retail stores selling computers and electronic devices was likely to succeed on merits of infringement claim against operator of retail stores selling wireless telephones under “VIRGIN WIRELESS” mark, for purpose of obtaining preliminary injunction; holder's mark was arbitrary and famous, differences in marks' typefaces and colors did not outweigh similarities, holder sold similar goods and had plans to bridge gap, and there was evidence of actual confusion. Lanham Trade-Mark Act, § 32(1), [15 U.S.C.A. § 1114\(1\)](#).

[\[6\] Trademarks 382T](#) [1033](#)

[382T](#) Trademarks

[382TII](#) Marks Protected

[382Tk1033](#) k. Levels or Categories of Distinctiveness in General; Strength of Marks in General. [Most Cited Cases](#)

(Formerly 382k331 Trade Regulation)

Trademark law accords broad, muscular protection to marks that are arbitrary or fanciful in relation to products on which they are used, and lesser protection, or no protection at all, to marks consisting of words that identify or describe goods or their attributes.

Trademarks [382T](#) [1800](#)

[382T](#) Trademarks

[382TXI](#) Trademarks and Trade Names Adjudicated

[382Tk1800](#) k. Alphabetical Listing. [Most Cited Cases](#)
(Formerly 382k736 Trade Regulation)

VIRGIN.

*[142 James W. Dabney](#) ([Catherine M. Clayton](#), [Melissa A. Antonecchia](#), on the brief), Pennie & Edmonds LLP, New York, NY, for Appellant.

[Kevin J. Harrington](#) ([John C. Mascari](#), on the brief), Harrington, Ocko & Monk, LLP, White Plains, NY, for Appellees.

Before: [LEVAL](#), [CALABRESI](#), and [POOLER](#), Circuit Judges.

[LEVAL](#), Circuit Judge.

Plaintiff Virgin Enterprises Limited (“VEL” or “plaintiff”) appeals from the denial of its motion for a preliminary injunction. This suit, brought under § 32 of the Lanham Act, [15 U.S.C. § 1114\(1\)](#), alleges that defendants infringed plaintiff's rights in the registered mark VIRGIN by operating retail stores selling wireless telephones and related accessories and services under the trade name VIRGIN WIRELESS. The United States District Court for the Eastern District of New York (Sifton, *J.*) denied plaintiff's motion for a preliminary injunction, based upon its finding that plaintiff's registration did not cover the retail sale of wireless telephones and related products, and that plaintiff failed to show a likelihood of consumer confusion.

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 (Cite as: 335 F.3d 141)

We find that the plaintiff is likely to succeed on the merits and was entitled to a preliminary injunction. We therefore reverse *143 and remand with instructions to enter a preliminary injunction.^{FN1}

FN1. Immediately following oral argument, we issued a summary order, opinion to follow, directing the district court to enter a preliminary injunction.

BACKGROUND

Plaintiff VEL, a corporation with its principal place of business in London, owns U.S. Registration No. 1,851,817 (“the 817 Registration”), filed on May 5, 1991, and registered on August 30, 1994, for the VIRGIN mark as applied to “*retail store services* in the fields of ... computers and *electronic apparatus*” (emphasis added). Plaintiff filed an affidavit of continuing use, pursuant to [15 U.S.C. § 1058\(a\)](#), on April 27, 2000, which averred that plaintiff had used the mark in connection with retail store services selling computers and electronic apparatus. Plaintiff also owns U.S. Registration No. 1,852,776 (“the 776 Registration”), filed on May 9, 1991, and registered on September 6, 1994, for a stylized version of the VIRGIN mark for use in connection with “retail store services in the fields of ... computers and electronic apparatus,” and U.S. Registration No. 1,863,353 (“the 353 Registration”), filed on May 19, 1992, and registered on November 15, 1994, for the VIRGIN MEGASTORE mark. It is undisputed that these three registrations have become incontestable pursuant to [15 U.S.C. § 1065](#).

VEL, either directly or through corporate affiliates, operates various businesses worldwide under the trade name VIRGIN, including an airline, large-scale record stores called Virgin Megastores, and an internet information service. Plaintiff or its affiliates also market a variety of goods branded with the VIRGIN name, including music recordings, computer games, books, and luggage. Three of plaintiff’s megastores are located in the New York area. According to an affidavit submitted to the district court in support of plaintiff’s application for preliminary injunction, Virgin Megastores sell a variety of electronic apparatus, including video game systems, portable CD players, disposable cameras, and DVD players. These stores advertise in a variety of media, including radio.

Defendants Simon Blitz and Daniel Gazal are the

sole shareholders of defendants Cel-Net Communications, Inc. (“Cel-Net”); The Cellular Network Communications, Inc., doing business as CNCG (“CNCG”); and SD Telecommunications, Inc. (“SD Telecom”). Blitz and Gazal formed Cel-Net in 1993 to sell retail wireless telephones and services in the New York area. Later, they formed CNCG to sell wireless phones and services on the wholesale level. CNCG now sells wireless phones and services to more than 400 independent wireless retailers. In 1998, Cel-Net received permission from New York State regulators to resell telephone services within the state.

Around 1999, Andrew Kastein, a vice-president of CNCG, began to develop a Cel-Net brand of wireless telecommunications products. In early 1999, Cel-Net entered into negotiations with the Sprint PCS network to provide telecommunications services for resale by Cel-Net. In August 1999, Cel-Net retained the law firm Pennie & Edmonds to determine the availability of possible service marks for Cel-Net. Pennie & Edmonds associate Elizabeth Langston researched for Kastein a list of possible service marks; among the marks Cel-Net asked to have researched was VIRGIN. Defendants claim that Langston told Cel-Net officer Simon Corney that VIRGIN was available for use in the telecommunications field. Plaintiff disputed this, offering an affidavit from Langston that she informed defendants that she *144 would not search the VIRGIN mark because her firm represented plaintiff.^{FN2}

FN2. Because of Pennie & Edmonds’s involvement in searching marks for defendants, and because of the factual dispute about whether plaintiff’s counsel searched the VIRGIN mark for defendants, defendants sought in the district court to have Pennie & Edmonds disqualified from representing plaintiff. The district court denied this motion on March 13, 2002.

According to defendants, in December 1999, Cel-Net retained Corporate Solutions, LLC and its principals Nathan Erlich and Tahir Nawab as joint venture partners to help raise capital to launch Cel-Net’s wireless telephone service. On December 2, 1999, Erlich and Nawab filed four intent-to-use applications with the U.S. Patent and Trademark Office (“PTO”) to register the marks VIRGIN WIRELESS, VIRGIN MOBILE, VIRGIN COMMUNICATIONS,

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and VIRGIN NET in the field of telecommunications services, class 38. On December 24, 1999, Corporate Solutions incorporated defendant Virgin Wireless, Inc. ("VWI") and licensed to VWI the right to use the marks VIRGIN WIRELESS and VIRGIN MOBILE. Meanwhile, one of plaintiff's affiliates had begun to offer wireless telecommunication services bearing the VIRGIN mark in the United Kingdom. A press release dated November 19, 1999, found on plaintiff's website, stated that its Virgin Mobile wireless services were operable in the United States.

On June 23, 2000, defendant Blitz signed a lease under the name Virgin Wireless for a kiosk location in South Shore Mall in Long Island from which to re-sell AT & T wireless services, telephones, and accessories under the retail name Virgin Wireless. Defendants Cel-Net and VWI later expanded their telecommunications re-sale operations to include two retail stores and four additional retail kiosks in malls in the New York area and in Pennsylvania. All of these stores have been run by VWI under the trade name VIRGIN WIRELESS. VWI also has leases and bank accounts in its name, and has shown evidence of actual retail transactions and newspaper advertisements.

In August 2000, plaintiff licensed Virgin Mobile USA, LLC, to use the VIRGIN mark for wireless telecommunications services in the United States. On August 10, 2000, plaintiff filed an intent-to-use application with the PTO for use of the VIRGIN mark in the United States on telecommunications services and mobile telephones. On October 11, 2001, the PTO suspended this mark's registration in international class 9, which covers wireless telephones, and class 38, which covers telecommunications services, because the VIRGIN mark was already reserved by a prior filing, presumably defendants'. On August 16, 2001, plaintiff filed another intent-to-use application for the mark VIRGIN MOBILE to brand telecommunications services. The PTO issued a non-final action letter for both of plaintiff's pending new registrations on October 31, 2001, which stated that defendant Corporation Solutions' pending applications for similar marks in the same class could give rise to "a likelihood of confusion." The PTO suspended action on plaintiff's application pending the processing of Corporation Solutions' applications.

In October 2001, plaintiff issued a press release announcing that it was offering wireless telecommu-

nications services and mobile telephones in the United States.

Plaintiff became aware of Corporation Solutions' application for registration of the VIRGIN WIRELESS and VIRGIN MOBILE marks by May 2000. In October 2001 and December 2001, defendant *145 VWI filed suits against plaintiff in the federal district courts in Arizona and Delaware, alleging that plaintiff was using VWI's mark. Plaintiff maintains (and the district court found) that it learned in January 2002 that VWI and Cel-Net were operating kiosks under the VIRGIN WIRELESS name and two days later filed the present suit seeking to enjoin defendants from selling mobile phones in VIRGIN-branded retail stores.

On May 2, 2002, the district court considered plaintiff's application for a preliminary injunction. It found that no essential facts were in dispute, and therefore no evidentiary hearing was required. It was uncontested (and the district court accordingly found) that plaintiff sold "electronic apparatus" in its stores, including "various video game systems, portable cassette tape, compact disc, mp3, and mini disc players, portable radios, and disposable cameras," but not including telephones or telephone service, and that the only products the defendants sold in their stores were wireless telephones, telephone accessories, and wireless telephone services.

Noting that a party seeking a preliminary injunction must show the probability of irreparable harm in the absence of relief, and either (1) likelihood of success on the merits or (2) serious questions going to the merits and a balance of hardships tipping decidedly in its favor, the court found that plaintiff had failed to satisfy either standard. Arguing against plaintiff's likelihood of success, the court noted that plaintiff's registrations did not claim use of the VIRGIN mark "in telecommunications services or in the associated retail sale of wireless telephones and accessories." While plaintiff's 817 and 776 Registrations covered the retail sale of "computers and electronic apparatus," they did not extend to telecommunications services and wireless phones.

The court noted that the defendants were the first to use the VIRGIN mark in telecommunications, and the first to attempt to register VIRGIN for telecommunications and retail telephone sales. The court also

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observed that the dissimilarity in appearance of plaintiff's and defendants' logos and the differences between plaintiff's huge Virgin Megastores and defendants' small retail outlets in malls diminished likelihood of consumer confusion. Finally, because the defendants had expended substantial resources in pursuing their trademark applications and in establishing their retail presence, the court found that plaintiff could not demonstrate that the balance of hardships tipped in its favor.

The court denied the application for preliminary injunction. The crux of the court's decision lay in the facts that plaintiff's prior use and registration of the VIRGIN mark in connection with the sale of consumer electronic equipment did not include the sale of telephones or telephone services, and that defendants were the first to register and use VIRGIN for telephones and wireless telephone service. This appeal followed.

DISCUSSION

I.

[1][2] As the court below correctly noted, in order to obtain a preliminary injunction, a party must demonstrate probability of irreparable harm in the absence of injunctive relief, and either a likelihood that it will succeed on the merits of its claim, or a serious question going to the merits and a balance of hardships tipping decidedly in its favor. See *Jackson Dairy, Inc. v. H.P. Hood & Sons, Inc.*, 596 F.2d 70, 72 (2d Cir.1979) (*per curiam*); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1038 (2d Cir.1992). We review *146 the court's denial of a preliminary injunction for abuse of discretion. *Bristol-Myers*, 973 F.2d at 1038.

[3] In an action for trademark infringement, where a mark merits protection, a showing that a significant number of consumers are likely to be confused about the source of the goods identified by the allegedly infringing mark is generally sufficient to demonstrate both irreparable harm and a likelihood of success on the merits. *Bristol-Myers*, 973 F.2d at 1038; *W. Publ'g Co. v. Rose Art Indus., Inc.*, 910 F.2d 57, 59 (2d Cir.1990). Thus, our inquiry must be whether the district court correctly determined that the plaintiff was not entitled to protection from use of its mark by others in the sale of wireless telephones and related services, and that there was no likelihood that, in the absence of a preliminary injunction, a signifi-

cant number of consumers would be confused about the sponsorship of defendants' retail stores. For the reasons discussed below, we find that the mark is entitled to protection, and there is a significant likelihood of confusion. We reverse and remand.

II.

[4] A claim of trademark infringement, whether brought under 15 U.S.C. § 1114(1) (for infringement of a registered mark) or 15 U.S.C. § 1125(a) (for infringement of rights in a mark acquired by use), is analyzed under the familiar two-prong test described in *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072 (2d Cir.1993). See *Time, Inc. v. Petersen Publ'g Co. L.L.C.*, 173 F.3d 113, 117 (2d Cir.1999) (noting that *Gruner* test is applicable to claims brought under § 1114(1) and § 1125(a)). The test looks first to whether the plaintiff's mark is entitled to protection, and second to whether defendant's use of the mark is likely to cause consumers confusion as to the origin or sponsorship of the defendant's goods. *Gruner*, 991 F.2d at 1074. Examining the question as the test dictates, we have no doubt that plaintiff was entitled to a preliminary injunction.

[5] We believe the district court accorded plaintiff too narrow a scope of protection for its famous, arbitrary, and distinctive mark. There could be no dispute that plaintiff prevailed as to the first prong of the test-prior use and ownership. For years, plaintiff had used the VIRGIN mark on huge, famous stores selling, in addition to music recordings, a variety of consumer electronic equipment. At the time the defendants began using VIRGIN, plaintiff owned rights in the mark. The focus of inquiry thus turns to the second prong of the test-whether defendants' use of VIRGIN as a mark for stores selling wireless telephone services and phones was likely to cause confusion. There can be little doubt that such confusion was likely.

The landmark case of *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir.1961) (Friendly, J.), outlined a series of nonexclusive factors likely to be pertinent in addressing the issue of likelihood of confusion, which are routinely followed in such cases. See, e.g., *Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 743-46 (2d Cir.1998); *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 391-99 (2d Cir.1995); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 256-60 (2d Cir.1987).

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Six of the *Polaroid* factors relate directly to the likelihood of consumer confusion. These are the strength of the plaintiff's mark; the similarity of defendants' mark to plaintiffs'; the proximity of the products sold under defendants' mark to those sold under plaintiffs'; where the products are different, the likelihood that plaintiff will *147 bridge the gap by selling the products being sold by defendants; the existence of actual confusion among consumers; and the sophistication of consumers. Of these six, all but the last (which was found by the district court to be neutral) strongly favor the plaintiff. The remaining two *Polaroid* factors, defendants' good or bad faith and the quality of defendants' products, are more pertinent to issues other than likelihood of confusion, such as harm to plaintiff's reputation and choice of remedy. We conclude that the *Polaroid* factors powerfully support plaintiff's position.

Strength of the mark. The strength of a trademark encompasses two different concepts, both of which relate significantly to likelihood of consumer confusion. The first and most important is inherent strength, also called "inherent distinctiveness." This inquiry distinguishes between, on the one hand, inherently distinctive marks—marks that are arbitrary or fanciful in relation to the products (or services) on which they are used—and, on the other hand, marks that are generic, descriptive or suggestive as to those goods. The former are the strong marks. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir.1976). The second sense of the concept of strength of a mark is "acquired distinctiveness," *i.e.*, fame, or the extent to which prominent use of the mark in commerce has resulted in a high degree of consumer recognition. See *TCPIP Holding Co. v. Haar Communications Inc.*, 244 F.3d 88, 100 (2d Cir.2001) (describing these two concepts of strength); *Streetwise Maps*, 159 F.3d at 743.

[6] Considering first *inherent distinctiveness*, the law accords broad, muscular protection to marks that are arbitrary or fanciful in relation to the products on which they are used, and lesser protection, or no protection at all, to marks consisting of words that identify or describe the goods or their attributes. The reasons for the distinction arise from two aspects of market efficiency. The paramount objective of the trademark law is to avoid confusion in the marketplace. The purpose for which the trademark law accords merchants the exclusive right to the use of a

name or symbol in their area or commerce is *identification*, so that the merchants can establish goodwill for their goods based on past satisfactory performance, and the consuming public can rely on a mark as a guarantee that the goods or services so marked come from the merchant who has been found to be satisfactory in the past. See *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1510 (2d Cir.1997) (quoting *Restatement (Third) of Unfair Competition § 21* comment *i* (1995)); *Power Test Petroleum Distribs., Inc. v. Calcu Gas, Inc.*, 754 F.2d 91, 97 (2d Cir.1985); *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1131 (2d Cir.1979). At the same time, efficiency and the public interest require that every merchant trading in a class of goods be permitted to refer to the goods by their name, and to make claims about their quality. Thus, a merchant who sells pencils under the trademark *Pencil* or *Clear Mark*, for example, and seeks to exclude other sellers of pencils from using those words in their trade, is seeking an advantage the trademark law does not intend to offer. To grant such exclusivity would deprive the consuming public of the useful market information it receives where every seller of pencils is free to call them pencils. *Abercrombie*, 537 F.2d at 9; *CES Publ'g Corp. v. St. Regis Publ'ns, Inc.*, 531 F.2d 11, 13 (2d Cir.1975). The trademark right does not protect the exclusive right to an advertising message—only the exclusive right to an identifier, to protect against confusion in the marketplace. Thus, as a matter of policy, the trademark law accords broader protection *148 to marks that serve exclusively as identifiers and lesser protection where a grant of exclusiveness would tend to diminish the access of others to the full range of discourse relating to their goods. See *TCPIP*, 244 F.3d at 100; *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 215 (2d Cir.1999); *Otokoyama Co. Ltd. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 270 (2d Cir.1999).

The second aspect of efficiency that justifies according broader protection to marks that are inherently distinctive relates directly to the likelihood of confusion. If a mark is arbitrary or fanciful, and makes no reference to the nature of the goods it designates, consumers who see the mark on different objects offered in the marketplace will be likely to assume, because of the arbitrariness of the choice of mark, that they all come from the same source. For example, if consumers become familiar with a toothpaste sold under an unusual, arbitrary brand name, such as *ZzaaqQ*, and later see that same inherently distinctive brand name appearing on a different product, they are

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likely to assume, notwithstanding the product difference, that the second product comes from the same producer as the first. The more unusual, arbitrary, and fanciful a trade name, the more unlikely it is that two independent entities would have chosen it. In contrast, every seller of foods has an interest in calling its product “delicious.” Consumers who see the word *delicious* used on two or more different food products are less likely to draw the inference that they must all come from the same producer. *Cf. Streetwise Maps*, 159 F.3d at 744 (noting that several map producers use “street” in product names; thus plaintiff’s mark using “street” was not particularly distinctive); *W. Publ’g*, 910 F.2d at 61 (noting numerous registrations of marks using word “golden”). In short, the more distinctive the mark, the greater the likelihood that the public, seeing it used a second time, will assume that the second use comes from the same source as the first. The goal of avoiding consumer confusion thus dictates that the inherently distinctive, arbitrary, or fanciful marks, i.e., strong marks, receive broader protection than weak marks, those that are descriptive or suggestive of the products on which they are used. *See Abercrombie*, 537 F.2d at 9-11; *TCPIP*, 244 F.3d at 100-01.

The second sense of trademark strength, fame, or “acquired distinctiveness,” also bears on consumer confusion. *See TCPIP*, 244 F.3d at 100-01; *Streetwise Maps*, 159 F.3d at 744. If a mark has been long, prominently and notoriously used in commerce, there is a high likelihood that consumers will recognize it from its prior use. Widespread consumer recognition of a mark previously used in commerce increases the likelihood that consumers will assume it identifies the previously familiar user, and therefore increases the likelihood of consumer confusion if the new user is in fact not related to the first. *See Nabisco*, 191 F.3d at 216-17. A mark’s fame also gives unscrupulous traders an incentive to seek to create consumer confusion by associating themselves in consumers’ minds with a famous mark. The added likelihood of consumer confusion resulting from a second user’s use of a famous mark gives reason for according such a famous mark a broader scope of protection, at least when it is also inherently distinctive. *See McGregor*, 599 F.2d at 1132 (noting that secondary meaning may further enlarge the scope of protection accorded to inherently distinctive marks).

Plaintiff’s VIRGIN mark undoubtedly scored high

on both concepts of strength. In relation to the sale of consumer electronic equipment, the VIRGIN mark is inherently distinctive, in that it is arbitrary *149 and fanciful; the word “virgin” has no intrinsic relationship whatsoever to selling such equipment. Because there is no intrinsic reason for a merchant to use the word “virgin” in the sale of consumer electronic equipment, a consumer seeing VIRGIN used in two different stores selling such equipment will likely assume that the stores are related.

Plaintiff’s VIRGIN mark was also famous. The mark had been employed with world-wide recognition as the mark of an airline and as the mark for megastores selling music recordings and consumer electronic equipment. The fame of the mark increased the likelihood that consumers seeing defendants’ shops selling telephones under the mark VIRGIN would assume incorrectly that defendants’ shops were a part of plaintiff’s organization. *See Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 873 (2d Cir.1986).

There can be no doubt that plaintiff’s VIRGIN mark, as used on consumer electronic equipment, is a strong mark, as the district court found. It is entitled as such to a broad scope of protection, precisely because the use of the mark by others in connection with stores selling reasonably closely related merchandise would inevitably have a high likelihood of causing consumer confusion.

Similarity of marks. When the secondary user’s mark is not identical but merely similar to the plaintiff’s mark, it is important to assess the degree of similarity between them in assessing the likelihood that consumers will be confused. *See McGregor*, 599 F.2d at 1133. Plaintiff’s and defendants’ marks were not merely similar; they were identical to the extent that both consisted of the same word, “virgin.”

The district court believed this factor did not favor plaintiff because it found some differences in appearance. Defendants’ logo used a different typeface and different colors from plaintiff’s. While those are indeed differences, they are quite minor in relation to the fact that the name being used as a trademark was the same in each case.

Advertisement and consumer experience of a mark do not necessarily transmit all of the mark’s

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features. Plaintiff, for example, advertised its Virgin Megastores on the radio. A consumer who heard those advertisements and then saw the defendants' installation using the name VIRGIN would have no way of knowing that the two trademarks looked different. See [Sports Auth., Inc. v. Prime Hospitality Corp.](#), 89 F.3d 955, 962 (2d Cir.1996). A consumer who had visited one of plaintiff's Virgin Megastores and remembered the name would not necessarily remember the typeface and color of plaintiff's mark. The reputation of a mark also spreads by word of mouth among consumers. One consumer who hears from others about their experience with Virgin stores and then encounters defendants' Virgin store will have no way knowing of the differences in typeface. See [Hills Bros. Coffee, Inc. v. Hills Supermarkets, Inc.](#), 428 F.2d 379, 381 (2d Cir.1970) (*per curiam*).

In view of the fact that defendants used the same name as plaintiff, we conclude the defendants' mark was sufficiently similar to plaintiff's to increase the likelihood of confusion. This factor favored the plaintiff as a matter of law. We conclude that the district court erred in concluding otherwise on the basis of comparatively trivial and often irrelevant differences.

Proximity of the products and likelihood of bridging the gap. The next factor is the proximity of the products being sold by plaintiff and defendant under identical (or similar) marks. See [Arrow FASTER](#), 59 F.3d at 396. This factor has an obvious *150 bearing on the likelihood of confusion. When the two users of a mark are operating in completely different areas of commerce, consumers are less likely to assume that their similarly branded products come from the same source. In contrast, the closer the secondary user's goods are to those the consumer has seen marketed under the prior user's brand, the more likely that the consumer will mistakenly assume a common source. See [Cadbury Beverages, Inc. v. Cott Corp.](#), 73 F.3d 474, 480-81 (2d Cir.1996).

While plaintiff had not sold telephones or telephone service prior to defendant's registration evincing intent to sell those items, plaintiff had sold quite similar items of consumer electronic equipment. These included computer video game systems, portable cassette-tape players, compact disc players, MP3 players, mini-disc players, and disposable cameras. Like telephones, many of these are small consumer

electronic gadgets making use of computerized audio communication. They are sold in the same channels of commerce. Consumers would have a high expectation of finding telephones, portable CD players, and computerized video game systems in the same stores. We think the proximity in commerce of telephones to CD players substantially advanced the risk that consumer confusion would occur when both were sold by different merchants under the same trade name, VIRGIN.

Our classic *Polaroid* test further protects a trademark owner by examining the likelihood that, even if the plaintiff's products were not so close to the defendants' when the defendant began to market them, there was already a likelihood that plaintiff would in the reasonably near future begin selling those products. See [Cadbury Beverages](#), 73 F.3d at 482. VEL's claim of proximity was further strengthened in this regard because, as the district court expressly found, "plans had been formulated [for VEL] to enter [the market for telecommunications products and services] shortly in the future." VEL had already begun marketing telephone service in England which would operate in the United States, and, as the district court found, had made plans to sell telephones and wireless telephone service under the VIRGIN name from its retail stores.

The district court, nonetheless, found in favor of the defendants with respect to the proximity of products and services. We would ordinarily give considerable deference to a factual finding on this issue. Here, however, we cannot do so because it appears the district court applied the wrong test. The court did not assess the *proximity* of defendants' VIRGIN-branded retail stores selling telephone products to plaintiff's VIRGIN-branded retail stores selling other consumer electronic products. It simply concluded that, because defendants were selling exclusively telephone products and services, and plaintiff's electronic products did not include telephones or related services, the defendants must prevail as to the proximity factor.

This represents a considerable misunderstanding of the *Polaroid* test. The famous list of factors of likely pertinence in assessing likelihood of confusion in *Polaroid* was specially designed for a case like this one, in which the secondary user is not in direct competition with the prior user, but is selling a somewhat different product or service. In *Polaroid*,

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the plaintiff sold optical and camera equipment, while the defendant sold electronic apparatus. The test the court discussed was expressly addressed to the problem “how far a valid trademark shall be protected with respect to goods *other than those to which its owner has applied it.*” [287 F.2d at 495](#) (emphasis added); *see also Arrow Fastener*, 59 F.3d at 396 (noting that products *151 need not actually compete with each other). The very fact that the test includes the “proximity” between the defendant’s products and the plaintiff’s and the likelihood that the plaintiff will “bridge the gap” makes clear that the trademark owner does not lose, as the district court concluded, merely because it has not previously sold the precise good or service sold by the secondary user.

In our view, had the district court employed the proper test of proximity, it could not have failed to find a high degree of proximity as between plaintiff VEL’s prior sales of consumer electronic audio equipment and defendants’ subsequent sales of telephones and telephone services, which proximity would certainly contribute to likelihood of consumer confusion. And plaintiff was all the more entitled to a finding in its favor in respect of these matters by virtue of the fact, which the district court *did* find, that at the time defendants began using the VIRGIN mark in the retail sale of telephones and telephone services, plaintiff already had plans to bridge the gap by expanding its sales of consumer electronic equipment to include sales of those very goods and services in the near future. Consumer confusion was more than likely; it was virtually inevitable.

Actual confusion. It is self-evident that the existence of actual consumer confusion indicates a likelihood of consumer confusion. [Nabisco](#), 191 F.3d at 228. We have therefore deemed evidence of actual confusion “particularly relevant” to the inquiry. [Streetwise Maps](#), 159 F.3d at 745.

Plaintiff submitted to the district court an affidavit of a former employee of defendant Cel-Net, who worked at a mall kiosk branded as Virgin Wireless, which stated that individuals used to ask him if the kiosk was affiliated with plaintiff’s VIRGIN stores. The district court correctly concluded that this evidence weighed in plaintiff’s favor.

Sophistication of consumers. The degree of sophistication of consumers can have an important

bearing on likelihood of confusion. Where the purchasers of a products are highly trained professionals, they know the market and are less likely than untrained consumers to be misled or confused by the similarity of different marks. The district court recognized that “[r]etail customers, such as the ones catered to by both the defendants and [plaintiff], are not expected to exercise the same degree of care as professional buyers, who are expected to have greater powers of discrimination.” On the other hand, it observed that purchasers of cellular telephones and the service plans were likely to give greater care than self-service customers in a supermarket. Noting that neither side had submitted evidence on the sophistication of consumers, the court made no finding favoring either side. We agree that the sophistication factor is neutral in this case.

Bad faith and the quality of the defendants’ services or products. Two factors remain of the conventional *Polaroid* test: the existence of bad faith on the part of the secondary user and the quality of the secondary user’s products or services. [Polaroid](#), 287 F.2d at 495. Neither factor is of high relevance to the issue of likelihood of confusion. A finding that a party acted in bad faith can affect the court’s choice of remedy or can tip the balance where questions are close. It does not bear directly on whether consumers are likely to be confused. *See TCPIP*, 244 F.3d at 102. The district court noted some evidence of bad faith on the defendants’ part, but because the evidence on the issue was scant and equivocal, the court concluded that such a finding “at this stage [would be] *152 speculative.” The court therefore found that this factor favored neither party.

The issue of the quality of the secondary user’s product goes more to the harm that confusion can cause the plaintiff’s mark and reputation than to the likelihood of confusion. *See Arrow Fastener*, 59 F.3d at 398 (noting that first user’s reputation may be harmed if secondary user’s goods are of poor quality). In any event, the district court found this factor to be “neutral” with respect to likelihood of confusion.

* * * * *

In summary we conclude that of the six *Polaroid* factors that pertain directly to the likelihood of consumer confusion, all but one favor the plaintiff, and that one-sophistication of consumers-is neutral. The

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plaintiff is strongly favored by the strength of its mark, both inherent and acquired; the similarity of the marks; the proximity of the products and services; the likelihood that plaintiff would bridge the gap; and the existence of actual confusion. None of the factors favors the defendant. The remaining factors were found to be neutral. Although we do not suggest that likelihood of confusion may be properly determined simply by the number of factors in one party's favor, the overall assessment in this case in our view admits only of a finding in plaintiff's favor that defendants' sale of telephones and telephone-related services under the VIRGIN mark was likely to cause substantial consumer confusion.

One issue remains. Defendants argue that plaintiff should be barred by laches from seeking injunctive relief. They contend that because of plaintiff's delay after learning of the defendants' applications to register the VIRGIN marks, they expended considerable sums and developed goodwill in their use of the VIRGIN marks before plaintiff brought suit. Because the district court ruled in the defendants' favor it made no express finding on the issue of laches. But the district court explicitly found that plaintiff first learned of defendants' use of the name VIRGIN in commerce only two days before plaintiff instituted this suit. Given that finding, plaintiff could not be chargeable with laches.

We conclude that, as a matter of law, plaintiff demonstrated irreparable harm and likelihood of success on the merits and was entitled to a preliminary injunction.

CONCLUSION

REVERSED and REMANDED.

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