

THIS DECISION IS NOT
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Virgin Enterprises Limited
v.
Kay Guitar Company

Opposition No. 91154392
to application Serial No. 78070813
filed on June 25, 2001

James W. Dabney and Hayley W. Werner of Fried, Frank,
Harris, Shriver & Jacobson for Virgin Enterprises Limited.

Susan L. Ruzbasan, Esq. for Kay Guitar Company.

Before Quinn, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Kay Guitar Company to
register the mark shown below

The logo for Virgin Guitars features the word "VIRGIN" in a large, tall, serif font. The letter "V" is significantly larger than the other letters. Below "VIRGIN", the word "GUITARS" is written in a smaller, all-caps, sans-serif font.

Opposition No. 91154392

for "musical instruments, namely, guitars."¹ The word "guitars" is disclaimed apart from the mark.

Registration was opposed by Virgin Enterprises Limited on the ground that applicant's mark, if applied to applicant's goods, would so resemble opposer's previously used and registered VIRGIN marks for a wide variety of goods and services, including some related to the music and entertainment industries, as to be likely to cause confusion under Section 2(d) of the Trademark Act. In addition, opposer asserts that registration of applicant's mark is likely to dilute the distinctiveness of opposer's famous VIRGIN marks.

Applicant, in its answer, essentially denied the salient allegations in the notice of opposition.²

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by opposer; and applicant's responses to opposer's discovery requests, status and title copies of opposer's registrations and certified copies of opposer's applications, copies of official records in the nature of

¹ Application Serial No. 78070813, filed June 25, 2001, based on an allegation of a bona fide intention to use the mark in commerce.

² The answer is accompanied by copies of third-party registrations and other documents. Inasmuch as these exhibits were not identified and introduced in evidence at trial, they are not evidence on behalf of applicant. Trademark Rule 2.122(c); TBMP § 317 (2d ed. rev. 2004). Even if considered, however, this evidence would not change the result in this case.

Opposition No. 91154392

final orders in prior Board proceedings and in other litigation involving opposer's marks, and excerpts from printed publications, all made of record by way of opposer's notice of reliance. Applicant neither took testimony nor offered any other evidence. Only opposer filed a brief at final hearing. An oral hearing was not requested by either party.

Opposer and its related companies are engaged in a wide and diverse range of business activities under a variety of VIRGIN marks. Opposer's business, founded by Sir Richard Branson, started in the music industry as VIRGIN RECORDS, later branching out into goods and services such as commercial air transportation, telephone services, credit card services, retail store services featuring recorded music and music books, alcoholic beverages, and consumer electronic products. The evidence demonstrates that music has played a significant role in the advertising of opposer's myriad business ventures, including its VIRGIN MEGASTORE retail stores, VIRGIN MOBILE wireless phone goods and services, VIRGIN PULSE personal consumer electronic products, RADIO FREE VIRGIN Internet music services, and VIRGIN ATLANTIC airways (the self-proclaimed "rock and roll airline").

As discussed below, opposer has established its ownership of registrations of various VIRGIN marks for a

Opposition No. 91154392

variety of goods and services, as well as prior use of VIRGIN as a trade name. Opposer owns over thirty registrations for VIRGIN, both in typed form and in the stylized form shown below, as well as other VIRGIN-formative marks.



In its brief, opposer highlighted its VIRGIN (typed and stylized) registrations involving goods and services in the music industry as follows: "pre-recorded audio and/or video tapes, cassettes and cartridges; prerecorded audio and video discs; phonograph records; photographic and cinematographic films";³ "printed sheet music; fictional and non-fictional books, biography and autobiography books, periodicals, namely, paperback books and magazines, all dealing with music, films and entertainment";⁴ "retail store services in the fields of records, audio and video tapes, audio and

³ Registration No. 1469618, issued December 22, 1987, and Registration No. 1517801, issued December 27, 1988, respectively; affidavits under Sections 8 and 15 filed and acknowledged.

⁴ Registration No. 1591952, issued April 17, 1990, and Registration No. 1597386, issued May 22, 1990, respectively; both renewed.

Opposition No. 91154392

video recorders, computers and electronic apparatus, [and] sheet music";⁵ "retail department store services";⁶ "sound records of music in the form of discs and tapes and cassettes; pre-recorded audio and video tapes, cassettes and cartridges featuring music; pre-recorded audio and video discs, phonograph records featuring music; [and] computer software for music products";⁷ 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."⁸ In our determination of likelihood of confusion, we will focus our attention, as opposer has, on these marks and goods and services sold thereunder.

In view of opposer's ownership of these valid and subsisting registrations, priority is not an issue in this proceeding. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue.

⁵ Registration No. 1851817, issued August 30, 1994, and Registration No. 1852776, issued September 6, 1994, respectively; both renewed.

⁶ Registration No. 1863353, issued November 15, 1994; renewed.

⁷ Registration No. 2709578, issued April 22, 2003.

⁸ Registration No. 2625455, issued September 24, 2002.

Opposition No. 91154392

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These, and other du Pont factors deemed pertinent in the proceeding now before us, are discussed below.

Opposer's VIRGIN mark and applicant's mark are virtually identical, differing only in the inclusion of the generic term "GUITARS" in applicant's mark.⁹ Applicant has adopted the entirety of opposer's arbitrary mark VIRGIN, and merely added the generic term to it; the addition of the

⁹ In the notice of opposition, opposer referred to its "family" of VIRGIN marks. As contemplated in case law, a family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks, or the mere fact of registration of many marks with a common "surname," does not of itself establish the existence of a family. J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); Polaroid Corp. v. Richard Mfg. Co., 341 F.2d 150, 144 USPQ 419 (CCPA 1965); and American Standard, Inc. v. Scott & Fetzer Co., 200 USPQ 457 (TTAB 1978). In the past the Board has stated, in pertinent part, that a proponent of a family of marks must prove that all or many of the marks in the alleged family were used and promoted together in such a way as to create public perception of the family "surname" as an indication of source. Champion International Corp. v. Plexowood, Inc., 191 USPQ 160 (TTAB 1976). In the present case, we find that opposer's evidence falls short of demonstrating that it owns a family of marks. To this end, in analyzing likelihood of confusion, we have compared applicant's mark with each of opposer's marks.

term "GUITARS" is clearly insufficient to avoid a finding of likelihood of confusion with opposer's VIRGIN marks. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); and *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). As to appearance, the stylization of applicant's mark does not distinguish it from any of opposer's VIRGIN marks (including opposer's stylized marks) in any meaningful way.¹⁰

We also find that applicant's mark is similar to each of opposer's logo marks. Opposer's marks are, in each instance, dominated by the inherently distinctive term VIRGIN which, as indicated above, is identical in sound, appearance and meaning to the dominant portion of applicant's mark. Although we have considered the marks in their entireties, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In opposer's logo

¹⁰ Opposer's registrations of VIRGIN in typed form afford opposer a scope of protection that encompasses the same stylized manner of display of the word VIRGIN in applicant's mark. See *Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [registration of word mark in typed drawing form means that rights in the word mark "are not limited to the mark depicted in any special form"].

Opposition No. 91154392

marks, we have given less weight to the descriptive and/or design portions thereof; for the same reason, we have given less weight to the "GUITAR" portion (which is generic and disclaimed) of applicant's mark. We find that these features do not eliminate the likelihood of confusion in consumers' perceptions of opposer's marks and applicant's mark.

Each of opposer's marks is similar in sound, appearance and meaning to applicant's mark. In sum, the parties' marks engender similar overall commercial impressions. The similarity between the marks weighs in opposer's favor.

With respect to the goods and/or services, it is well established that the goods and/or services of the parties need not be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone &*

Opposition No. 91154392

Telephone Corp., 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source of the goods and/or services. In re Rexel Inc., 223 USPQ 830 (TTAB 1984).

The record is replete with examples of the close connection between music and opposer's goods and services. Opposer's retail store services under the VIRGIN MEGASTORE mark involve the sale of pre-recorded audio discs and tapes. The openings of these stores are marked by extensive publicity, including appearances by major recording artists in the music industry. In addition, opposer's stores sponsor live in-store performances by artists whose records are being sold in the stores. These performances frequently involve giveaways, including autographed guitars from the bands. According to Andrea Moreno, one of opposer's field marketing managers, opposer's stores attract a clientele of guitar players by offering a section in the stores dedicated to guitar books, including instructional books, history books, and sheet music, as well as guitar magazines. In connection with opposer's assertion that opposer is "constantly reinventing itself," opposer points out that due to a successful launch at its VIRGIN MEGASTORE store in London, opposer is considering offering in the future musical instruments and lessons at its United States stores.

Opposition No. 91154392

Opposer also offers, under the mark RADIO FREE VIRGIN, music streaming services on the Internet. Further, opposer sells a line of consumer electronic products, including CD players, MP3 players and AM/FM tuners under the mark VIRGIN PULSE. Opposer has published a series of books known as VIRGIN ENCYCLOPEDIA which details the history of popular music. Opposer's air transportation services under the mark VIRGIN ATLANTIC feature an in-flight entertainment system, and airport lounges for its passengers feature sound-proof sitting rooms with state-of-the-art music systems. Opposer's wireless telephone services are offered under the mark VIRGIN MOBILE, and users are able to download musical content from MTV and VH1 to their phones.

Opposer's goods and services, as well as applicant's guitars, would be purchased by the same classes of purchasers, namely, ordinary consumers. These consumers include guitar players and musicians, and there is no evidence that the normal purchasers of the parties' goods and services are especially sophisticated or careful in making their purchasing decisions.

Our analysis of likelihood of confusion in the present case is influenced by our finding that opposer's VIRGIN mark is a strong mark that is entitled to a relatively broad

Opposition No. 91154392

latitude of protection.¹¹ VIRGIN is an arbitrary term as used in connection with opposer's goods and services. The record establishes that opposer uses VIRGIN essentially as a house mark on a wide range of goods and services. The record is devoid of evidence of any use by third parties of VIRGIN marks on or in connection with the goods and services involved in this case or, indeed, in connection with any goods or services at all. The record also shows, from the many law suits brought by opposer, that opposer diligently polices its rights in its VIRGIN marks.¹² Most significantly, we find that opposer's VIRGIN marks are especially strong in connection with music-related goods and services. The evidence of record establishes that the VIRGIN record label is a well known label, with a roster of

¹¹ On this record, however, we cannot conclude that opposer's VIRGIN marks are famous. Although opposer submitted several excerpts from printed publications and decisions rendered by federal courts in other litigation, this evidence is insufficient to prove "fame" herein. Critical direct evidence is lacking, such as volume of sales under the marks, and the amount of opposer's advertising expenditures. See *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1409 (TTAB 1998). In this connection, we note that more than one court has characterized opposer's VIRGIN mark as a famous mark. However, the courts' findings and conclusions in the context of opposer's lawsuits against third parties are not evidence in this case of the facts said to underlie such findings and conclusions, nor are they entitled to any legally preclusive effect as against applicant, who was not a party to that litigation. We hasten to add, however, that our findings of fact are not inconsistent with the decision in *Virgin Enterprises Ltd. V. Nawab*, 335 F.3d 141, 67 USPQ2d 1420 (2d Cir. 2003).

¹² Opposer has received favorable judgments in no fewer than twenty-five inter partes proceedings before the Board against marks incorporating the term "VIRGIN." In addition, opposer has been successful in over thirty civil actions brought in federal district courts.

Opposition No. 91154392

famous artists (such as The Rolling Stones, David Bowie and Lenny Kravitz), and that opposer's retail music stores, along with opposer's other business ventures, have enjoyed substantial success.

We conclude that purchasers familiar with opposer's variety of goods and services related to the music industry sold under its strong VIRGIN marks would be likely to believe, upon encountering applicant's VIRGIN GUITARS (stylized) mark for guitars, that the goods and/or services originated with or were somehow associated with or sponsored by the same entity.

Lastly, to the extent that there may be any doubt on our finding of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior user. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

In view of our finding of likelihood of confusion, we need not reach the merits of opposer's dilution claim under Section 43(a) of the Trademark Act.

Decision: The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.