

O-375-12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS 2526934 AND 2555879

BY

MICHAEL CASEY

TO REGISTER THE TRADE MARK:

CARBON VIRGIN

IN CLASSES 6, 7, 11, 16, 17, 19, 35, 36, 37, 41, 42, 44 AND 45

AND

THE CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS 100413 AND 101314

BY

VIRGIN ENTERPRISES LIMITED

1) On 21 September 2009 Mr Michael Casey applied to register the trade mark **Carbon Virgin** for services in classes 36, 42 and 44 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The application was published on 1 January 2010 with the following specification:

Class 36:

Brokerage of Greenhouse Gas Emissions Credits; Trading of Greenhouse Gas Offsets and Emission Credits; provision of charitable fundraising services in relation to Greenhouse Gas offsetting; Fund management in relation to Avoided Deforestation investment and the generation of Greenhouse Gas Offsets; Fund raising and fund management.

Class 42:

Provision of information, advice and consultancy in relation to Greenhouse Gas offsetting.

Class 44:

The planting of trees for Greenhouse Gas offsetting purposes, the preservation of trees, forests and landscapes for Greenhouse Gas offsetting purposes.

The application includes the following disclaimer:

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

On 16 August 2010 Mr Casey filed a further application to register the trade mark Carbon Virgin. This application was published on 17 September 2010 with the following specification:

Class 06:

Metal building materials; transportable buildings of metal; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes.

Class 07:

Machine tools; drills; drill nozzles; drill tips; drill parts; drill holders; blowers; parts and fittings for all the aforesaid.

Class 11:

Apparatus for lighting, heating, central heating systems, energy efficiency components, steam generating, cooking, refrigerating, freezing, clothes washing and drying, ventilating, dish washing and drying, water supply and sanitary purposes; parts and fittings for the aforesaid goods.

Class 16:

Books; booklets; journals; leaflets.

Class 17:

Insulating materials; materials for thermally insulating buildings; insulating materials for lofts and cavities; insulating materials consisting of mineral fibres; insulating materials consisting of or containing rock wool fibres; mastic; glass fibre rolls; rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastic in extended form for use in manufacture; packaging, stopping and insulating materials; flexible pipes, not of metal; parts and fittings for all the aforesaid goods.

Class 19:

Building materials (non-metallic); non-metallic rigid pipes for building; non-metallic transportable buildings.

Class 35:

Advertising services; advertising services relating to energy conservation; advertising services relating to installation of energy conservation measures and/or central heating systems; promotion of energy conservation and resource efficiency; distribution of promotional material; collection of data relating to energy consumption; collection of data in relation to energy conservation and resource efficiency, central heating schemes and/or the installation of energy efficient devices; business services; business management and administration; provision of commercial business information.

Class 36:

Administration of grants; fiscal assessments, real estate appraisals, real estate management, issuing tokens of value; provision of financial information, monetary affairs.

Class 37:

Building repair services; building installation services; arranging for refurbishment of buildings; installation of heating; installation of insulating materials; provision of consultancy and advisory services relating to building maintenance and installation of insulating materials; professional consultancy services regarding insulation of buildings, advice relating to heating, central heating systems energy efficiency components, steam generating, heating, drying, ventilating, water and sanitary purposes, washing machines, tumble dryers, dishwashers, refrigerators and cookers; parts and fittings for all the aforesaid goods.

Class 41:

Education, educating the individual by relaying the information to a caller re heating benefits; seminars; tuition; technical training, regarding insulation of buildings.

Class 42:

The commissioning of research into energy efficiency; the provision of information relating to energy efficiency; evaluation of energy efficiency of buildings; energy auditing; advisory services relating to energy efficiency; scientific and technological services in research and design relating to energy conservation and resource efficiency; scientific and technological service in research and design relating to administration of energy efficiency schemes; industrial analysis and research services relating to the aforesaid; research, analysis and consultancy services; research analysis and consultancy services relating to energy conservation; design and construction of installations for use in energy conservation; surveying services for all of the aforesaid; evaluation of energy efficiency of buildings; energy auditing; advisory services relating to energy efficiency.

Class 45:

The provision of advice relating to social security benefits.

The application includes the following disclaimer:

–No claim is being made for the words virgin or carbon alone. The trademark claim is being made for the words conjoined as a whole, namely Carbon Virgin.”

2) Virgin Enterprises Limited (VEL) has filed oppositions to the registration of both applications.

3) VEL relies upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

4) Section 5(2)(b) of the Act states:

—2) A trade mark shall not be registered if because -

.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 5(3) of the Act states:

—3) A trade mark which –

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

Section 5(4)(a) of the Act states:

—4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

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

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

—The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are

offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

5) A hearing took place on 7 September 2012. Mr Casey represented himself. VEL was represented by Mr Julius Stobbs of Ipulse.

6) VEL has relied upon a large number of earlier registrations and wide claims to reputation and goodwill. At the hearing, whilst not abandoning the claims made in the pleadings or any of the earlier registrations, Mr Stobbs honed the basis of the oppositions. In relation to the earlier registrations, Mr Stobbs relied upon three registrations which had not been pleaded: Community trade mark registration nos 1470186, 5190012 and 4396347. These registrations cannot be taken into account as they were not included in the pleaded case. Nothing turns upon this owing to other registrations upon which VEL relies which have the same specifications.

Evidence for VEL

7) VEL filed two witness statements by Mark James. There is a large amount of repetition in the witness statements. (Where two exhibits are identified with a solidus between them, eg MJ38/MJ40, this indicates that the same exhibit appears in each of the witness statements of Mr James but with a different exhibit number.) Parts of the witness statements deal with matters outside of the European Union and are, therefore, not pertinent to the proceedings. References are made to global sales, which do not assist in considering the position in the United Kingdom and/or the European Union. References are also made to undertakings that do not use the name Virgin eg The Music Channel. Mr James on a number of times directs the reader to visit websites; this is not evidence.

8) Mr James is the intellectual property manager for VEL.

9) VEL is a member of a group of companies known collectively as the Virgin group of companies (VG).

10) VG was established by Sir Richard Branson in the United Kingdom in 1970 when he started a business selling records of popular music by mail order under the name Virgin. In 1971 the first Virgin record shop was opened in London. In 1972 a Virgin recording studio was opened near Oxford. In 1973 the record label

Virgin Records was launched. In 1973 Virgin Records began music publishing in the United Kingdom. The first Virgin Megastore was opened in the United Kingdom in 1978, in this year the —Virgin Signature” was used for the first time (see paragraph 14). In 1983 Virgin Vision (later to become Virgin Communications) was formed to distribute films and videos and was distributing these products in the European Union by 1985. Virgin Games (computer games and software publisher) commenced operations in 1983 and subsequently became Virgin Interactive Entertainment. In 1983 VG’s pre-tax profit reached £2 million. In 1984 Virgin Atlantic Airways and Virgin Atlantic Cargo were launched. In 1985 Virgin Holidays, a tour operator specialising in long haul holidays, was formed. In 1985 VG won the Business Enterprise Award for company of the year. In 1987 VG acquired an interest in the United Kingdom distributorship of Sega computer games, which became Virgin Mastertronic when VG moved to full ownership. Virgin Interactive Entertainment was formed in 1987 by the merger of Virgin Games and Virgin Mastertronic. The Virgin Airship and Balloon Company was launched in the United Kingdom in 1987. In 1988 a book about Sir Richard Branson was published. Virgin Broadcasting was set up in 1988. In 1989 Virgin Hotels and Virgin Communications were formed, the latter to develop interests in television and radio. In 1989 Virgin Atlantic Airways announced pre-tax profits of £10 million.

11) In 1991 Virgin Publishing (subsequently Virgin Books) was formed in the United Kingdom. In 1993 Virgin Euromagnetics launched a range of personal computers. In 1993 Virgin Radio was launched and Virgin Atlantic was voted Executive Travel’s airline of the year for the third year running. In 1994 the Virgin Trading Company was formed and launched Virgin Vodka in the United Kingdom. In 1994 the Virgin Cola Company was launched. In 1995 Virgin Direct was launched, VG acquired MGM cinemas and Virgin Cinemas was launched in the United Kingdom. In 1996 Euro Belgian Airlines was acquired and was renamed Virgin Express. In 1996 Virgin entered the Internet market with the launch of Virgin Net and Virgin Bride entered the wedding industry. In 1996 Virgin Rail Group Ltd was awarded the CrossCountry Trains Ltd passenger rail franchise. In 1997 Virgin Clothing and Virgin Cosmetics were launched. In 1998 Virgin Sun was launched to offer short haul holidays from the United Kingdom. In 1999 Virgin Mobile Telecoms Limited was established in the United Kingdom. In 1999 a network of health clubs, Virgin Active, was launched.

12) The following businesses were launched in the United Kingdom during 2000 and 2001: Virgin Cars, Virgin Wines, Virgin Student (a student community website and marketing agency), Virgin Energy (on-line retailer of gas and electricity), Virgin Money (financial services) and Virgin Travestore (travel agency services). In 2001 Virgin Bikes was launched. In 2002 Virgin Energy was re-branded as Virgin HomeEnergy under the larger umbrella of the Virgin Home brand. Under the Virgin Home brand the business Virgin HomePhone was launched. In 2002 Virgin Express became the largest carrier from Brussels to European destinations. Virgin Money launched a new credit card in 2002. In

2003 Virgin Cars opened its first retail outlet, in Salford. In 2004 Virgin Digital was launched as the digital platform of VG and Virgin.net launched a £17.99 broadband service. In 2004 Virgin Unite (a not for profit entrepreneurial foundation) was started as was Virgin Galactic; the latter to develop space ships and promote space tourism. In 2004 Virgin Money won 4 awards at the Your-Money Direct award. In 2006 Virgin Mobile launched in France and in the United Kingdom Virgin Mobile merged with NTL. In February 2007 Virgin Media was launched in the United Kingdom and in the same year Virgin Health Bank was announced and the Virgin 1 TV channel began broadcasting in the United Kingdom. In December 2009 the new formula 1 team Virgin Racing was launched in the United Kingdom as was Virgin Digital Help, a technical support service for United Kingdom consumers. In June 2010 Virgin Gaming, an international online gaming website was launched. In July 2010 the film and television production company Virgin Produced was launched.

13) Mr James refers to the number of trade mark applications that have been made by VEL and the number of registrations that it has. Applications and registrations are not representative of use and so, evidentially, of themselves are of no pertinence. Mr James states that there are no registrations of the word Virgin or trade marks comprising the word Virgin as a separate element in any third party trade mark in the United Kingdom except for various trade marks registered for olive oil products or registrations which are the subject of a specific agreement¹.

14) The “Virgin Signature” was first registered in the United Kingdom in 1979. The signature has changed slightly on two occasions. Reproduced below are the three versions of the signature:



¹ Since the writing of this statement Mr Casey has successfully registered the trade mark Carbon Virgin for advertising; electronic data storage; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing. The application had been the subject of opposition and an appeal to the High Court.

The signature appears in one of its three versions on the premises occupied by VG companies including Virgin Megastores, Virgin Atlantic Airline and Virgin Cosmetics.

15) VEL is responsible for licensing various Virgin trade marks in relation to a variety of goods and services to companies both within and without VG. VEL currently licenses Virgin trade marks to approximately 60 licensees. Mr James states that most of VEL's licensees are trading entities whose names begin with Virgin followed by a descriptor eg Virgin Media, Virgin Holidays, Virgin Mobile, Virgin Money, Virgin Radio and Virgin Trains.

16) The website virgin.com sets out the primary activities of VG. The number of hits for the website emanating from within the European Union are given. The vast majority emanate from the United Kingdom. There is no indication of unique visitor numbers, time spent on the website, the cause of the visit or any click-throughs. In the absence of such details the table of hits is of little value¹. VEL is the registered proprietor of over 4,500 domain names.

17) Virgin Atlantic was launched in 1984. It carries over 4 million passengers per year from the United Kingdom to destinations in the United States of America, Hong Kong, Japan, China, Australia, India, South Africa, Nigeria, Dubai, Cuba and the Caribbean. In the 12 months to the end of February 2009 Virgin Atlantic increased its profits from £34.8 million to £68.4 million while turnover rose from £2.38 billion to £2.58 billion. The Virgin name and signature have been used by Virgin Atlantic. They are used on the aircraft and in printed matter relating to the airline. Mr James states that some of the duty free products for sale on the aeroplanes are branded with Virgin trade marks. Various services are offered in Virgin Atlantic's Clubhouses at Heathrow and Gatwick airports, as well as airports abroad. Exhibited at MJ5/MJ8 is material relating to the airline. Exhibited at MJ6/MJ9 are copies of lists that detail the services that are available at the airline's lounges. Exhibited at MJ7/MJ10 is material relating to complimentary ground transfers for upper class passengers, which include chauffeur driven cars and Limobike bicycles. Exhibited at MJ8/MJ11 are copies of the in-flight shopping magazine of Virgin Atlantic, *Retail Therapy*. The first magazine was issued prior to 9 February 2006, the second has a copyright year of 2000, the third was issued prior to 30 April 2002, there is no indication of the date on the fourth magazine, the fifth magazine was issued prior to 31 January 2003, the sixth has a copyright date of 2004/2005, the seventh has a copyright date of 2003, the eighth has 2002 written by hand on the cover, it was issued prior to 31 January 2003, the ninth was issued prior to 31 May 2003, the tenth has 2004 written by hand upon the cover, the eleventh bears summer 1995 on the cover. Various goods using the Virgin or Virgin Atlantic brands are shown in the publications: toys, pens, cosmetics, sweatshirts, t-shirts, baseball caps, fleeces, watches, vodka, playing cards, lighters, clocks, passport holders, jewellery, bags, cases, games, maroquinerie, shirts, belts, phone cards. In relation to the two proof of use periods, only the first and sixth magazines are directly pertinent.

The former shows use in relation to toys, pens, passport holders, a cross and cosmetics. The latter shows use in relation to vodka, toys and pens.

18) Exhibited at MJ9/MJ12 are pictures and details of amenity kits that are given to passengers on flights.

19) Exhibited at MJ10/MJ13 are copies of the in-flight magazine *seatback*. Exhibited at MJ11 to the witness statement of 7 September 2011 are extracts from the website virgin-atlantic.com.

20) Mr James states that in October 2004 it was announced that VG had entered into an agreement to license the technology to develop the world's first privately funded spaceships to carry commercial passengers on space flights. On 7 December 2009 Virgin Galactic announced the launch of Space Ship Two, a space vessel designed to take passengers into space. Mr James states that deposits have been taken from hundreds of potential passengers. Exhibited at MJ12 to the witness statement of 7 September 2011 is press coverage relating to this undertaking; all of which emanates from 2004.

21) In April 1996 VG acquired 90% of EBA Express, a European low cost airline, it was renamed Virgin Express. Virgin Express flew to Belgium, Denmark, France, Germany, Greece, Italy, Portugal and Spain. In 2004 it carried 2 million passengers and generated revenues of €180 million. In 2004 Virgin Express was sold to a non Virgin company and continued to operate under the Virgin Express name until it was re-branded as Brussels Airlines in March 2007.

22) Virgin Holidays was formed in 1985 and began to offer package holidays in conjunction with Virgin Atlantic. Virgin Holidays now provides travel services to destinations in North America, Asia, Africa, South America, the Indian Ocean and the Caribbean. In its first year of operation Virgin Holidays carried just over 14,000 passengers and now carries 400,000 inclusive tour passengers each year. Mr James states that Virgin Holidays is now the United Kingdom's market leader tour operator for trips to the United States of America. Turnover in the financial year 2006/2007 was in excess of £430 million and grew to over £500 million in 2008/2009. Exhibited at MJ13/MJ15 is material relating to Virgin Holidays. The material at MJ13 is downloaded from the Virgin Holidays website on 6 September 2011. The material exhibited at MJ15 includes pages downloaded from the Internet on 27 May 2007 in relation to Virgin Vacations (a United States undertaking), copies of brochures for 1999, 2000 and 2001 for Virgin Sun (for destinations in the Mediterranean and the Canaries) and a copy of a brochure for Virgin Holidays' weddings for 2005.

23) Mr James refers to Virgin Holiday Cruises being an addition to the Virgin Holidays business.

24) Virgin Limited Edition is a portfolio of luxury resorts. The worldwide revenue for Virgin Limited Edition was £23.5 million and £28.5 million in 2007 and 2008 respectively. Over 380,000 customers visited the resorts in 2008.

25) In 1996 VG established Virgin Trains. VG operates a domestic rail franchise, which runs trains under the Virgin name from London Euston to Glasgow via Birmingham and Manchester. Virgin Trains carries nearly 35 million passengers a year. Turnover for the year 2006/2007 was over £500 million and exceeded £600 million the following year. Material relating to Virgin Trains is exhibited at MJ14/MJ16.

26) Mr James states that Virgin Limobike is a motorcycle taxi service operating in London to transport celebrities and business people around London and to and from airports. He states that it has been operating for about 10 years. Exhibit MJ15 to the witness statement of 7 September 2011 contains material relating to the service.

27) Virgin Balloon Flights was launched in the United Kingdom in 1987. All passengers are flown in VIRGIN branded balloons which form the largest fleet of passenger carrying balloons in the United Kingdom (no actual number of balloons is given). The business has been —~~transferred~~” to a business outside of VG but it continues to use the Virgin name under licence from VEL. Exhibited at MJ16/MJ17 are copies of promotional material for the business from 2003 to 2005. The exhibit also includes material relating to Sir Richard Branson’s attempt to circumnavigate the world in a balloon. VG has licensed a third party to use the Virgin name on commercial balloon flights in the Benelux; no further details have been adduced re this business.

28) In 1999 VG entered into a joint venture agreement with the telecommunications network operator T-Mobile to provide mobile telecommunications services under the name Virgin Mobile in the United Kingdom. As Virgin Mobile does not own its own network and relies upon T-Mobile’s infrastructure, the former is referred to as a Mobile Virtual Network Operator (MVNO). Mr James states that Virgin Mobile UK was the first successful MVNO to be launched. The company had a turnover of £228 million in 2002 and had over 3 million customers. In July 2004 Virgin Mobile UK was listed on the London Stock Exchange with an —~~enterprise~~ value” of £811 million. In July 2006 NTL, the United Kingdom’s largest cable operator, acquired Virgin Mobile UK. NTL had previously acquired Virgin Net, an Internet service provider in the United Kingdom, which had been launched by VG in 1996. Virgin Net was renamed Virgin Broadband. NTL offers combined mobile, fixed line telephony, broadband Internet and television services under the Virgin trade marks and is licensed to use these trade marks by VEL. The name of the combined entity is Virgin Media, which commenced trading on 8 February 2007. In 2008 Virgin Media had over 15.5 million subscribers and, Mr James states, a turnover of £4,016 million. There are currently 4 million subscribers to Virgin Mobile UK.

29) In April 2006 Virgin Mobile France was launched in partnership with Carphone Warehouse; it uses France Telecom's Orange network. As of 2008 there were 130,000 subscribers. The turnover for the Virgin Mobile business is as follows:

	2007 US\$ million	2008 US\$ million	2009 US\$ million
France	210	278	377
United Kingdom	849	810	817

Exhibited at MJ18/MJ20 is material relating to Virgin Mobile. Where there are indications of date on the material, they all relate to periods prior to 2005.

30) Virgin 1 was the first Virgin branded television channel. It was launched on 1 October 2007 and was available on Freeview, Virgin Media and digital satellite to customers in the United Kingdom. It was re-branded as Channel One on 3 September 2010 following the sale of Virgin Media Television. Channel One ceased broadcasting on all platforms on 1 February 2011.

31) In April 1993 the Virgin 1215 radio station was launched in the United Kingdom by VG. It was the second independent nationwide radio station and the first national independent pop/contemporary music station in the United Kingdom. It was listened to by over 2 million people each week. Virgin Radio was sold to the Ginger Media Group in 1998, VG retaining a 20% stake. In 2000 it was sold to the Scottish Media Group. Virgin Radio continued to use Virgin trade marks under licence from VEL until it was rebranded Absolute Radio in September 2008. Virgin Radio was also broadcast via the Internet. In 2003 Virgin Radio was voted best online station at the Interactive Music Awards and won the same award in 2004 at the Digital Music Awards. In February 2005 it won the Best Media Owner Award and the Webby Award for radio in May 2006 (exhibits MJ19/MJ21 relate) Mr James states that it was the most listened to on-line radio station in the world. Material relating to the radio station is exhibited at MJ20/MJ22, the material, where bearing a year, emanates from the 1990s. Virgin Radio Italy and Virgin Radio France were launched in 2007 and 2008 respectively.

32) Virgin Records was created by Sir Richard Branson in the United Kingdom in 1972. The first release on the label was Mike Oldfield's *Tubular Bells*, in 1973, which went on to become the largest selling album in the United Kingdom in the 1970s. The Sex Pistols and Genesis were also signed to the label. Virgin Records was sold to Thorn EMI Plc in June 1992 for US\$1 billion and continues to use the Virgin marks under licence from VEL.

33) In the 1970s the Virgin Records shop in Oxford Street, London, developed and experimented with various entertainment superstore features. VG launched the Virgin Megastore concept in 1979. The stores sold tapes, records, CDs, mini discs, DVDs, videos, computer games software, t-shirts and jumpers. In 2003-

2004 the Virgin Megastore business in the United Kingdom was in the region of £550 million. In the United Kingdom the stores were rebranded as Zavvi in December 2007, following a management buy-out. Prior to the rebranding there were 120 Virgin Megastores in the United Kingdom. There are currently 30 Virgin Megastores in France.

34) The V Festival has been a music festival in the United Kingdom since 1996. Virgin Media sponsors the festival. 155,000 and 180,000 attended the festival in 2007 and 2008 respectively. Exhibited at MJ21/MJ23 is material relating to the festival. There are references to Virgin Mobile in the material.

35) In March 1995 VG launched Virgin Direct in the United Kingdom to sell financial services by telephone. In February 2002 Virgin Direct was renamed Virgin Money. Mr James states that it provides banking, insurance, credit cards, mortgages, share dealing, personal loans, pensions, savings and investments. Mortgages were provided under the name Virgin One Account, which business was sold to the joint venture partner in 2001. Virgin Money has approximately 2.7 million customers of whom 2.4 million are credit card holders, 200,000 have investment products or savings and 100,000 have an insurance product. The annual turnover of Virgin Money was £77 million and £98 million in 2007 and 2008 respectively. Exhibits MJ22/MJ24 include a history of Virgin Money from 1995 to 2008. There is reference to the Virgin Climate Change Fund, launched in February 2008 which “invests in companies who are driving outstanding growth and who are environmental leaders in their field”.

36) Virgin Money Giving was created as a not-for-profit business by Virgin Money. Mr James states that it is a “not-for-profit sponsorship website which will improve the way donations and Gift Aid is collected, ensuring more money goes to charities”. Virgin Money Giving was the official fundraising website for the 2010/2011 Virgin London Marathon.

37) Virgin Active, a fitness and health club business, was launched in the United Kingdom by VG in 1999. As of 2009 Virgin Active had 71 clubs in the United Kingdom, 17 in Italy, 7 in Spain and 1 in Portugal. Mr James states that Virgin Active clubs provide spas, gyms, physiotherapy, restaurants, libraries, Internet access, swimming pools, crèches, child care facilities, yoga, spinning, kickboxing and health and beauty parlours. They also have café-bars. The clubs have Body IQ wellness centres which provide members with information on their individual vital health statistics. Material relating to the clubs is exhibited at MJ23/MJ25. At pages 1807 and 1808 of MJ25 details of the café bars are given. These are run under the name Crunch Café Bar and are run by Leiths Catering.

38) Mr James states that a range of clothing is sold under the Virgin trade marks. He states that the range includes vests, t-shirts, sleeveless tops, swimsuits and trousers. He states the range is available online through TLC Sport. Mr James states that a range of accessories and clothing, under the Virgin trade marks, is

sold by Virgin Active in Italy. Exhibits MJ24/MJ26 show pages from 2004 from the website of TLC Sport, where articles of Virgin Active clothing can be seen.

39) Mr James refers to the London Marathon and VG's sponsorship. He does not state when the sponsorship began.

40) VG was the principal sponsor of the Brawn GP Formula One team in 2009. In 2010 VG joined forces with Manor Grand Prix and the team's name was changed to Virgin Racing. In 2011 the team changed its name to Marussia Virgin Racing.

41) In the early 1980s VG moved into computer games and software publishing with the formation of Virgin Games and Virgin Mastertronic Limited. In 1992 VG acquired a 100% share holding in Euro-Magnetic Products Limited, which is engaged in the personal computer business. It subsequently traded as Virgin Euromagnetics. In 1997 Virgin Communications Limited, a member of VG, sold Virgin Mastertronic Limited, its European computer games distributor, to Sega but retained the publishing division and began to expand Virgin Games Limited, which published and marketed computer games. Virgin Games Limited subsequently changed its name to Virgin Interactive Entertainment Limited, a majority stake of which was sold in July 1994. The company has changed its name. In June 2004 Virgin Games was launched, allowing customers in the United Kingdom to play a selection of skill based games, as well as casino games, poker and bingo, online. Material relating to Virgin Games is exhibited at MJ25/MJ27.

42) Virgin Gaming was introduced in June 2010 through a partnership with WorldGaming.com. Mr James states that Virgin Gaming is a betting platform for competitive console gamers.

43) In 2009 VG launched a new IT support service called Virgin Digital Help.

44) Virgin Publishing was formed in 1991. Mr James states that it publishes fact, fiction, guides on films and music and travel guides. Virgin Publishing changed its name to Virgin Books in 2001. In each of the financial years 2002/2003 and 2003/2004 the turnover was around £9 million and in the financial years 2005/2006 and 2006/2007 the turnover was around £8 million and £7 million respectively. There is no indication as to how much of this turnover relates to the United Kingdom or the European Union. Material relating to Virgin Books/Publishing is exhibited at MJ26/MJ28. (Page 1026 of MJ28 shows distributors outside of the United Kingdom and the European Union.)

45) Virgin Comics and Virgin Animation were set up in Bangalore. In September 1998 Virgin Comics was bought by Liquid Comics and rebranded.

46) Virgin Drinks was launched as the Virgin Cola Company Limited in 1994, selling Virgin branded cola in the United Kingdom. Virgin Cola was launched in France in March 1996, Belgium in 1998, Italy in 1999 and Sweden in 2001. Mr James states Virgin Drinks currently sells products in the United Kingdom. In 1994 VG produced and distributed Virgin Vodka in the United Kingdom. It was sold in European supermarkets and was available on Virgin Atlantic flights from and returning to the United Kingdom. Virgin Ooze was used under licence from VEL for alcoholic drinks in Sweden until June 2011. In 2004 VG and Glenmorangie launched a new vodka under the Virgin brand with the sub-brand Fallen. Material exhibited at MJ28/MJ30 includes use outside of the European Union. Use within the European Union is shown for Virgin Ooze, described as —Bubbles & Red Berry Flavoured Alcohol Beverage”, cola, Virgin Colours, lemonade, ice tea, VJuice, mixers and vodka. Further material relating to beverages is exhibited at MJ29/MJ31. At page 1264 of MJ31 a picture of a bottle of Fallen is shown; no reference to Virgin can be seen upon the bottle.

47) In June 2000 the Virgin Wines website was launched in the United Kingdom. The site now has 100,000 active customers. In 2005 Virgin Wines was sold to Laithwaites and continues to use Virgin trade marks under licence from VEL. The turnover for Virgin Wines from 2001 to 2006 was:

	£ millions
12 months to December 2001	8.3
12 months to December 2002	12.1
15 months to June 2004	13.9
15 months (sic) to June 2005	19.0
12 months to June 2006	15.1

48) Virgin Bride, later trading as Virgin Brides, was set up in 1996. It had a store in the United Kingdom. Mr James states that Virgin trade marks were used by Virgin Brides in relation to bridal wear and bridal services. In 2002 the turnover was £2.47 million. In 1998 turnover was £700,000. It ceased trading in September 2008. Material relating to Virgin Brides is exhibited at MJ30/MJ32. The undertaking had one store in London and one store in Manchester. At page 1430 of MJ32, a company history states that in May 2003 Virgin Brides decided to continue solely with offering wedding dresses, bridesmaid dresses and wedding accessories.

49) A range of Virgin branded clothing was launched by the Virgin Clothing Company in 1998. Mr James states that the range included men’s wear, women’s wear, footwear and accessories and was distributed through independent retailers and department stores such as Selfridges in London. In June 2002 a range of clothing under the trade mark Virgin Ware was developed. The range included loungewear, nightwear, underwear, swimwear, t-shirts, jerseys, jeans and trousers. Exhibited at MJ31/MJ33 are pages from virginware.it. The clothing shown is for the autumn winter 2002 collection and is

all for women; contact addresses in Italy and France are given. The pages are in English. Mr James states that clothing could also be ordered online, by telephone or through Figleaves.com. Exhibited at MJ32/MJ34 are undated pages from figleaves.com which show bikinis and underwear for women and a t-shirt for men. Virgin Ware clothing is no longer available in the United Kingdom. Turnover in the United Kingdom was £1.2 million, £1.6 million and £4.8 million in 2002, 2003 and 2004 respectively.

50) VG operated a business called Virgin Cosmetics which provided goods and services under the trade mark Virgin Vie and Virgin Vie at Home. Mr James states that Virgin Cosmetics provided cosmetic products and beauty products through nearly 10,000 “consultants” and 16 stores in the United Kingdom. Exhibited at MJ33/MJ35 are undated pages from virgincosmetics.com. From the pages it appears that the “consultants” are persons who host Virgin Vie parties at which Virgin Vie products are sold. Exhibited at MJ34/MJ36 are copies of catalogues for summer 2005 and Christmas 1999. These show use of the names The Virgin Cosmetics Company and Virgin Vie. The business was subject to a management buyout and now trades as Vie at Home. Virgin Jewellery was a range of jewellery which was provided in conjunction with the goods of Virgin Cosmetics. It was launched in 2005 and was sold in the United Kingdom and the Republic of Ireland. Exhibited at MJ35/MJ37 are copies of a catalogue and pages from Virgin Cosmetics’ website. The catalogue is for summer 2005 and is entitled *The Virgin Jewellery Company a division of The Virgin Cosmetics Company*.

51) Virgin Cinemas traded until 1999 when it was sold to UCHG; at that time there were 20 cinemas trading under Virgin trade marks.

52) Mr James states that Virgin Unite is a not-for-profit “entrepreneurial foundation” of VG which was created in September 2004. Matter relating to Virgin Unite is exhibited at MJ37/MJ39. At page 1940 of MJ39 the following appears:

—So who are we?

We are a group of passionate people driven by the belief that we have made a role to play in tackling some of the tougher social challenges by uniting people and Virgin’s global resources and of course having a bit of fun in the process too.”

At page 1934:

—Virgin Unite is the independent charitable arm of Virgin uniting all the global resources of the Virgin Group to drive entrepreneurial approaches to social and environmental issues. We partner with amazing frontline

organisations to come up with solutions that will last for the long run in order to give people a voice and a choice in life.”

Where dates can be identified in the exhibits, they are from July 2007.

Mr James states that Virgin Unite is involved in campaigns to raise awareness of diseases such as HIV and Aids and to provide support for people with such diseases. He states that the Bhubezi Community Healthcare Centre in rural South Africa has been established as a one stop healthcare clinic providing basic health care services on a sliding scale fee basis. He states that on average it —supp~~or~~ts” 110 patients daily. Mr James does not explain the exact relationship with Virgin Unite. Virgin Unite provided tents for children to play in, children’s clothes and basic necessities, such as rolls of plastic sheeting, for the victims of an earthquake in Pakistan on 8 October 2005. Virgin Unite is also involved in raising awareness of fistula. The Virgin Unite —amb~~as~~sador” Natalie Imbruglia addressed the Economic and Social Council of the United Nations on this topic on 6 July 2011.

53) Virgin Fuels has invested in bio-fuels. Material relating to Virgin Fuels is exhibited at MJ38/MJ40. At page 1969 of MJ40 a screen print from virgin-fuels.net states:

—Vg~~in~~ Fuels has been established to invest up to \$400 million in companies in the renewable energy and resource efficiency sectors in the US and Europe. Virgin Fuels is a sector focused, multi-stage investment firm investing primarily in expansion/growth capital opportunities with an allocation to venture capital. Diversification is a cornerstone of our strategy, investing across stage, geography and technology in our core sectors.

Virgin Fuels is uniquely positioned to access attractive investment opportunities, and help portfolio companies maximise value.”

54) A copy of *Thomson Venture Capital Journal* of June 2007 identifies Virgin Fuels as having invested in three biofuel start-ups. Included in the magazine is the following comment on biofuels:

—~~the~~ Earth Policy Institute recently said ethanol production will consume more than twice as much corn in the next two years as previously thought. With global demand for farm products expected to double over the next 40 years, critics say America’s farmland is best used – from both a social and economic standpoint – to grow food for the world’s population.

And a recent academic study concluded that the manufacture of corn-based ethanol – with its attendant fertilizers, tractors and harvesters – actually produces more greenhouse gases than petroleum.”

55) Virgin Fuels changed its name to Virgin Green Fund. In an article from *The Jewish Chronicle Online* dated 29 April 2009, the following appears:

—~~6~~illed the Virgin Green Fund, it has raised in excess of \$200 million – including a \$100 million injection from Sir Richard – to invest in renewable energy technology and energy efficiency sectors

—It was a good call”, says Mr Weiss, the fund’s managing partner.
—SiRichard saw that rising fossil fuel prices could potentially hurt his business dramatically. So he wanted to mitigate the risk. He had the timing spot on.””

56) The exhibit also includes an article with the title —~~6~~w green is Richard Branson?” The article refers to a speech that Sir Richard Branson made in September 2006:

—We’re very pleased today to be making a commitment to invest 100 per cent of all future proceeds of the Virgin Group from our transportation businesses into tackling global warming.....” The applause interrupted him....”for an estimated value of \$3 billion over the next 10 years”

...But perhaps they mistakenly assumed that Virgin’s —~~6~~roceeds” meant their transportation business’s —~~6~~profits”. In fact, Branson meant the share dividends Virgin received from these operations. These are proportional to Virgin’s stake in its transport businesses, and rely on the directors choosing to use profits in that way. In the three years since the pledge, the Virgin Group has received —~~6~~proceeds” of around £110 million. Why so low? Out of Virgin’s six main transportation businesses, only two are making any money.....

....The Virgin Green Fund has made investments worth \$150 million in renewable energies such as water, solar and wind. —~~6~~\$,000 inquiries we looked at 250, thought about 100 and invested in nine,” Weiss says. The fund has two investments in solar power. California-based Solyndra makes photovoltaic panels for rooftops, and Odersun, a German company, specialises in building —~~6~~integrated photovoltaics”. —

57) Mr James states that the Virgin Earth Challenge is a prize of \$25 million for whomsoever 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. The prize was announced on 9 February 2007. 900 entries have been received but there has been no winner. Material relating to the prize is exhibited at MJ39/MJ41 and MJ40/MJ42.

58) Virgin Energy was launched to provide energy in the United Kingdom for domestic use. It no longer trades. Pages downloaded from the Internet on 21 November 2001 relating to it are exhibited at MJ41/MJ43.

59) Sir Richard Branson is a member of the Carbon War Room. Mr James states that —[t]he Carbon War Room harnesses the power of entrepreneurs to implement market-driven solutions to climate change. It is premised on the basis that the world needs entrepreneurial leadership to create a post-carbon economy”. Mr James states that Virgin Unite works closely with the Carbon War Room; Jean Oelwang, CEO of Virgin Unite, is on the executive board. Mr James states that —[o]ne is hard pushed to find reference to the Carbon War Room without reference to the Virgin Group of Companies”. Exhibited at MJ43 to the witness statement of 7 September 2011 is a copy of the first issue of Carbon War Room’s publication CCW from May 2011, so after all material dates. Exhibited at MJ42 to the witness statement of 7 September 2011 are media references relating to the Carbon War Room. They come from environmentalleader.com, msnbc.msn.com, carbon-based-ghg.blogspot.com, director.co.uk and nytimes.com. Exhibited at MJ44/MJ46 is material downloaded from carbonwarroom.com on 4 January and 19 August 2011; so after all material dates.

59) Mr James states that VG has made a commitment to invest 100% of all future proceeds from VEL’s transportation interests into tackling global warming. He states that this is estimated to be US\$3 billion. The article —How green is Richard Branson?” exhibited at MJ38/MJ40 by VEL shows that a far smaller sum may be invested. Press articles are exhibited at MJ44/MJ45:

- msnbc.msn.com from 21 September 2006 on Sir Richard Branson pledging —to commit all profits from his transportation business over 10 years to combat global warming – profits that he estimated would reach \$3 billion”.
- CNNMoney.com from 2 October 2006 on a —Virgin superfuel that will let us jet around the world guilt-free”.
- Guardian Unlimited of 11 September 2006 headed —Virgin pumps £214m into green’ fuel initiatives.
- CNNMoney.com from 30 January 2006 on Sir Richard Branson’s interest in ethanol
- Environmentalleader.com of 2 July 2008 advising that Sir Richard Branson intends to turn —Msquito Island in the British Virgin Islands into the most environmentally-friendly resort in the world”.

60) Exhibit MJ46 to the witness statement of 7 September 2011 emanates from after all material dates. The material exhibited at MJ47 to the witness statement of 7 September 2011 all emanates from after the material dates.

61) Exhibit MJ45 to the witness statement of 4 January 2011 has Google® searches for carbon virgin, without Boolean operators. The searches were

conducted on 1 June 2009. In the absence of Boolean operators, hits are produced wherever the pages interrogated by the search engine have virgin and carbon in them. In a number of the hits there are reference to carbon offsetting and Virgin Atlantic. There is also a hit for the Carbon War Room. There are hits in relation to a telegraph.co.uk article entitled —[a]born again carbon Virgin”. The article is also exhibited. It emanates from 23 February 2007. The article begins:

—Here are two ways of looking at the announcement last week that Sir Richard Branson has bought a second British Virgin Island to turn into a holiday resort. It heralds either a state-of-the-art demonstration of how tourism can adapt and survive in a time of climate change – Sir Richard’s version – or the despoliation of a near pristine hump or scrub and rock in the middle of the Caribbean.”

Pages 2058 – 2061 were downloaded from the Virgin Atlantic website and relate to the opportunity of passengers to offset the carbon footprint of their flight by going to myclimate’s website where they can make a donation.

62) Exhibited at MJ47/MJ48 is a copy of *Virgin Group’s Corporate Responsibility and Sustainable Development Report 2010*.

63) In June 1966 VG began operating its own website at virgin.com. As well as providing general corporate information on VG it has links to specific web pages for most of the companies of VG and provides information on products and services provided by VG. Numbers of visitors to the website are given but not unique visitors nor time spent on the website, nor the term that led to the website nor click-throughs (see above re this matter).

64) Turnover for the United Kingdom was:

2003	£2,400 million
2004	£2,800 million
2005	£3,100 million
2006	£3,400 million
2007	£3,405 million

The above figures do not include the turnover of —associated” companies or VEL’s licensees outside of VG. Therefore, the sales of goods and services under the Virgin trade marks are higher.

65) Exhibits MJ49/MJ50 consist of examples of articles in the print media re goods and services provided by reference to Virgin trade marks. Parts of the exhibits relate to the exploits of Sir Richard Branson and also his comments about the demise of the Concorde. Sir Richard Branson is identified with Virgin in the articles. The articles all relate to transport.

66) Estimated United Kingdom expenditure on advertising and promotion by VG is:

	£ thousands
2001	74,777
2002	14,042
2003	18,534
2004	31,947
2005	85,016
2006	89,618
2007	42,470

The above figures relate to VG companies and do not include the expenditure of licensees of VEL outside of VG.

67) Exhibited at MJ51/MJ55 is a copy of an NOP market research report from August 1994. Owing to period of time between this report and the dates of the applications for registration, this report does not have any great pertinence to the proceedings. Exhibit MJ52 to the witness statement of 4 January 2011 consists of various press cuttings relating to Sir Richard Branson and Virgin. The most recent clipping that can be identified by date emanates from 29 September 2004, page 2110. The majority of the clippings, where identifiable by date, emanate from prior to 2000.

68) Biographies and an autobiography of Sir Richard Branson were published in 1988, 1994 and 1998.

69) VG sponsored the London Marathon in 2010, 2011 and 2012. The 2010 marathon took place on 25 April, and so after the date of the filing of 2526934.

70) Mr James states that VEL acts whenever a third party seeks to register a trade mark —comprising” Virgin. He states that it successfully opposed the registration of the trade marks Virgin Bathroom Concept and Virgin Oil in the Community and the United Kingdom respectively. Copies of the decisions are exhibited at MJ44 to the witness statement of 4 January 2011.

71) Mr James gives details of survey results in relation to the Virgin brand. Certain of the surveys do not relate to the European Union, or it is not clear that they do, and certain relate to an individual rather than a brand eg number 1 choice for London mayor.

72) Exhibited at MJ53 to the witness statement of 7 September 2011 is material relating to the Superbrands surveys. Virgin Atlantic, Virgin Media and Virgin Mobile attained Superbrand status in 2009. On page 3 the Virgin brand values are described in the following terms:

—Virgin has an appealing youthful personality and since its inception has endeavoured to adhere to its brand values. Fun, Value for Money, Quality, Innovation, Competitive Challenge and Brilliant Customer Service. These brand values focus on putting Virgin customers' needs first, constantly challenging the status quo by putting innovation at the heart of its philosophy and always encouraging staff to think the impossible with resulting benefits for its customers.”

The nature of the writing of pages 2 and 3 and the presence of virgin.com at the end, suggest that VG is responsible for the description. Listings are made for business to consumer brands and business to business brands. It is not clear from the pages exhibited which pages relate to which category. Pages 4 and 7 show Virgin Atlantic appearing at fourth and eleventh positions in 2010. Pages 5 and 6 show Virgin Atlantic appearing at fourteenth and seventeenth positions. In the expert council listings for 2010 and 2011, Virgin Atlantic appears forty-fifth and twenty-fourth respectively. In 2010/2011 Virgin Atlantic was the category winner for “travel- general” in the CoolBrands survey.

73) Exhibited at MJ56 to the witness statement of 7 September 2011 are the results of the categorisation by the Reputation Institute of the undertakings with the best reputations in the United Kingdom. VG appears at fourteenth position.

74) Details of awards given to Virgin Active, Virgin Mobile, Virgin Atlantic, Virgin Trains, Virgin Media, Virgin Holidays, Virgin Net and V Festival between 2000 and 2007 are given.

Witness statement of Julius Stobbs

75) Mr Stobbs is the trade mark attorney handling the oppositions for VEL.

76) On 26 May 2011 Mr Stobbs instructed Ipsos Mori to carry out a survey. The particular survey carried out is called by Ipsos Mori a Capibus Omnibus survey. The Capibus questionnaire is collected by the interviewers via modem and is downloaded onto their laptop computer. There were 1,957 respondents.

77) The first question that the respondent was asked was “if you saw this would it bring anything to mind?” Mr Stobbs states that the respondents were shown a card with the words Carbon Virgin on it. A copy of the card is not exhibited. The second question asked was “if you were to see the phrase Carbon Virgin used as a trade mark in relation to fund raising and fund management services, would it make you think of anything?” Mr Stobbs states that when asking the question the respondent was shown a card with the words upon it. The third question asked was “if you were to see the phrase Carbon Virgin, used as a trade mark, in relation to fund raising and fund management services, who would you think is responsible for providing them?” Again the words were shown on a card. In relation to the first question Mr Stobbs states that 23% gave an answer of Virgin,

Virgin Group of companies or Sir Richard Branson. In response to the second question, Mr Stobbs, states that 21% responded Virgin, Virgin Group of companies or Sir Richard Branson. In relation to the third question, Mr Stobbs, states that 46% answered Virgin, Virgin Group of companies or Sir Richard Branson.

78) No physical questionnaires were used and so, naturally, they have not been adduced into the proceedings.

Witness statement of Mark Gilmour

79) Mr Gilmour is the brand development and Asia Pacific brand head of VEL.

80) Most of what Mr Gilmour writes has been covered by the evidence of Mr James. He refers to the Virgin Green Fund, Virgin Unite, the Carbon War Room, Virgin Earth Challenge. He also refers to the Elders' Initiative. He states that the last mentioned is an independent group of eminent global leaders working together for peace and human rights.

Evidence of Michael Casey

Witness statement of Michael Casey

81) Parts of Mr Casey's statement are submission rather than evidence of fact. Cognisance is taken of these elements but they are not recorded here as they are not evidence of fact.

82) Mr Casey has a Community trade mark registration for Carbon Virgin, no 6901623. This is registered for:

advertising; business management; business administration; office functions;

telecommunications;

trade marks (professional advisory services relating to licensing of -); advisory services relating to intellectual property licensing; designs (registered, licensing of -); trade marks (licensing of -).

83) Mr Casey refers to the history of his application for the United Kingdom trade mark Carbon Virgin under no 2487177. No trade marks of VEL were notified when the trade mark was examined. The application was subject to opposition by VEL; which opposition was unsuccessful before the Intellectual Property Office and on appeal before the High Court. The trade mark is now registered for:

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

84) Mr Casey states that VEL has trained its customers to see the Virgin signature trade mark with another distinctive element. He exhibits what he describes as a brief from VEL to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) at exhibit J:

—Furthermore, the public at large have become accustomed to the Opponent's use of their VIRGIN brand alongside other elements, and in particular in relation to the services applied for in the present application. The public are used to seeing VIRGIN used in conjunction with another element, and would not question that the services derive from the Opponent.”

85) Exhibit L shows use, inter alia, of Virgin Euromagnetics, Virgin Brides, Virgin.net, Virgin.com, Virgin mobile, Virgin games, Virgin Vacations, Virgin Sun, Virgin Unite, Virgin Fuels, Virgin Active, Virgin money, Virgin Hotels, Virgin Atlantic, Virgin Balloon Flights, Virgin Books, Virgin Galactic, Virgin green fund, Virgin Holiday Cruises, Virgin Holidays, Virgin media, Virgin money giving, Virgin Radio, Virgin trains and Virgin Wines. In these brands the Virgin signature is clearly a separate element to the word(s) that are used in conjunction with it.

86) Mr Casey states that the Virgin signature is highly distinctive when presented in isolation.

87) Mr Casey states that when VG markets its products to the public there is frequent emphasis on light sexuality and comic vulgarity. He refers to material exhibited at pages 1, 14 and 15 of L1 and the advertisements on the DVD which is part of exhibit L. Most of the advertisements use females to the fore.

88) Mr Casey states that:

—It should be borne in mind that the simple word marks in Virgin Enterprises ownership are not used in the market place for advertising or promotion.”

89) Mr Casey gives definitions for the words carbon and virgin; he does not indicate the source of the definitions. Carbon is defined as the chemical element and as meaning —carbon dioxide or other gaseous carbon compounds released into the atmosphere associated with climate change”. Virgin is defined as a person who has not had sexual intercourse, a person who is naïve or inexperienced in a particular context, a female insect that produces eggs without being fertilised, being a virgin, not yet used, exploited or processed, pure from

the first pressing of olives, (of wool) not yet, or only once, spun or woven, (of metal) made from ore by smelting.

90) Mr Casey states he devised the trade mark Carbon Virgin in 2007/2008 and first registered it in 2008 when trying to develop a trade mark to help market certificates which protect virgin rainforests from being felled under the United Nations REDD programme. Mr Casey states that at that time he approached the World Land Trust in relation to this. He exhibits a letter dated 30 September 2009 from the World Land Trust at F.

91) Mr Casey states that he conducted a survey in the United Kingdom with TNS from 11 – 13 October 2011 and that TNS repeated the survey from 25 – 27 October 2011. The surveys were conducted by online self-completion forms. There were 1,272 respondents to the first survey. The second survey was completed by 1306 adults.

92) The questionnaire is in this form:

- Statements about the decline of species, followed by questions about the statements.
- Statements about the increase of carbon dioxide levels on the planet, followed by questions about the statements.
- Statement about the amount spent on the protection of nature, followed by a question about the statement.
- Question about whether respondent would object to paying a charge for the protection of nature.
- Question: —“Do you understand, or think you know what Carbon Virgin is?”
- —“All who think they know what Carbon Virgin is Please briefly describe what Carbon Virgin is, or you believe it could be? Please be as specific as possible.”

The respondent is then asked to read several web pages which explain the purpose of Carbon Virgin. Included in the reading material is the following:

—“Carbon Virgin is neither charity nor NGO but a business owned and operated by Birdsong working in partnership with the World Land Trust.”

The respondent is asked:

—~~having~~ read the screen shots of the website on the previous page, please detail what comes to mind when you see the term Carbon Virgin, or say the term Carbon Virgin to yourself.”

The respondent is then asked: —Which organisation or group of organisations is responsible for the Carbon Virgin Initiative?” The respondent is given the choice of: Carbon Virgin, The World Land Trust, The Birdsong Trust, Carbon Virgin together with The World Land Trust and The Birdsong Trust, Microsoft and Yahoo, Apple, IBM, The National Trust, The Royal Society for the Protection of Birds, Virgin Group Companies (Richard Branson), Don’t know. Other than for —do’t know” the options rotated, so no one option was at the top of the list. In the first survey 24% chose Carbon Virgin, 19% Carbon Virgin together with the World Land Trust and the Birdsong Trust, 8% chose the World Land Trust, 3% the Birdsong Trust and 4% Virgin Group Companies (Richard Branson). In the second survey the figures were 24%, 19%, 10%, 4% and 4% respectively.

93) The respondent is asked: —Do you like the Carbon Virgin brand for Nature concept?”

94) TNS gives an analysis of the results. Copies of the completed questionnaires are not given. A CD-ROM giving verbatim comments from the respondents is exhibited.

95) Page 10 of exhibit G gives details of the online omnibus surveys that TNS conducts. TNS states:

—~~one~~ of the main uses for OnlineBus has been PR professionals for collecting credible and authoritative survey results for press release activity.....
...Invitations to complete the questionnaire are emailed out to a sample of GB online panellists who have agreed to participate in market research.”

96) Mr Casey states that the videos and advertisements at exhibit L make it abundantly clear that VG relies heavily on the risky (sic) sexual element in the word Virgin to market its goods and services.

97) Mr Casey states that in 2011 there was absolutely no information on virgin.com or in VG’s sustainability report as to how the pledge to invest \$US3 billion is developing in terms of actual money invested in relation to that promised. Mr Casey states that the Virgin Earth Challenge prize has not been given. He refers to exhibit M which is an article from FT.com dated 9 February 2007 re the prize.

98) Mr Casey states that although VG has received media attention for its environmental promises there is little or no information on the scale of the implementation and whether the announcements have met with commensurate action. Mr Casey states that 2010 was the first year that VG produced a sustainability report; this, he states, has been a standard reporting document for many years for most large corporations. He states that 2011 was the first year that Virgin Atlantic participated in the Carbon Disclosure Project. Mr Casey states that the project is based in the United Kingdom and has been in operation since 2003 and that over 3,000 global corporations participated in 2010.

Surveys

99) VEL adduced evidence from Adam Ivor Cargill Phillips in relation to the surveys furnished. The witness statement of Mr Phillips is reproduced below:

I, Adam Ivor Cargill Phillips, of Bampers, Grayswood Road, Haslemere Surrey, say as follows:

1. I am Managing Director of my own market research consultancy firm, Real Research, Chair of the Financial Services Consumer Panel, a statutory body which advises the Financial Services Authority on regulation and Chairman of the ESOMAR (World Association of Professional Researchers) Professional Standards and Legal Affairs Committees. I am also a Fellow of the Market Research Society, a past Chairman of the Market research Society, a member of the Executive Editorial Board of the International Journal of Market Research, a member of the ISO Technical Committee which develops international standards for market research and a member of the British Polling Council's sub-committee on disclosure.
2. I refer to my curriculum vitae marked as Exhibit AP1, which sets out details of my qualifications and experience.
3. I have read the Witness Statements of Mr Michael Casey and of Mr Julius Stobbs. I will comment on the surveys described in these statements and the conclusions which have been drawn by the witnesses.
4. A general observation is that the all the survey evidence provided has been collected by omnibus survey. This method is not usually regarded as providing reliable survey data for legal purposes. The reason for this is that an omnibus survey is one where the research company combines questions from a number of different clients in order to reduce the cost each client. For many purposes the data is regarded as adequate. However, a problem with this method is that, unless the survey questions are the first ones in the questionnaire, it is impossible to know whether questions asked for other clients before the ones being used as evidence have introduced a bias into answers. I will return to this issue when discussing my conclusions from the results.
5. It is also important to note that I have had to work from the tables of analysis provided by both parties and have not been able to examine the questionnaires or commission extra analysis. The relevance of this latter issue will become apparent when trying to establish the number of individual answers which relate to the same general topic, for example answers such as "carbon reduction" and "global warming" which relate to the general heading of "the environment, Carbon or CO2" or "the Virgin Group" and "Richard Branson". In some case these can be added together because they were said by different people, but in others they should not be added together because they were part of an answer given by the same person. Where net codes have been provided in the tables this has been helpful. Where

they have not been provided, I have done my best to estimate the effect of this and made clear where I have done so.

6. I will first consider the surveys provided by Mr Casey. Both surveys were online omnibus surveys among adults in Great Britain conducted by TNS. The first survey, with a sample size of 1272, was carried out between 11 and 13 October 2011 and the second, with a sample size of 1306, between 25 and 27 October TNS is a reputable market research firm and I have no reason to doubt that the surveys were executed in a professional manner. Both sample sizes are adequate for the purpose and because the questionnaires were the same they can be added together. However, the online method of fieldwork, which is cheaper and quicker than other methods, is not desirable for surveys of the general population. The reason for this is that the population that is available online is not representative of the UK population. In particular older people and those of lower social class are under-represented. It is not just the demographic profile that is out of line with the national profile, but the type of people who are not represented. To some extent this bias in the sample can be corrected by adjusting the figures using a process called weighting. However, the nature of the bias means that the adjustments used to correct the figures in order to be able to predict national voting intentions correctly do not, for example, provide the correct results for use of financial services or healthcare. A further problem with these particular online surveys was that respondents were able to go back and change their answers after reading subsequent questions. Given the amount of information provided about Carbon Virgin prior to question 7 being posed, there is a possibility that some respondents changed their answers to the preceding questions. For these reasons, any observed differences between an online survey and the more traditional approaches of face-to-face or telephone interviewing need to be large before one can be confident that there is a real difference and that the observed difference is not the result of the method of interview used.

7. Mr Casey's questionnaire starts with four general questions which are set out in full below:

*Q.1 In 2010 32% of species examined by the International Union for the Conservation of Nature (IUCN Red List) are scientifically assessed as being threatened with extinction. The total number of threatened species has doubled since 1998.
It is estimated that 25% up to 36% of all Mammal species, 12% of all bird species and 40% up to 56% of all Amphibian species are now scientifically classed as being threatened or vulnerable to extinction (IUCN).
Multiple scientific studies also show that the abundance of many of the remaining known unthreatened species, even plankton in the open ocean, has fallen significantly since 1970.*

Do you personally believe, or know that the above statement is correct?

Please pick one option only.

- Yes I know this information to be broadly correct.*
- I do not factually know this but believe this information to be broadly correct.*
- I do not believe that this information is correct.*

I know for a fact this information is misleading and wrong

Q2 In 2011 Atmospheric CO2 makes up 0.039% of the atmosphere, a level which last occurred several million years ago. The level of atmospheric CO2 before industrialization was 0.028%.

The life span of an incremental ton of CO2 emissions in the atmosphere is many thousands of years. Indeed, some of it will still be in the air in 100,000 years time.

The average year round temperature for the whole of Earth would be approximately minus 15°C without any atmospheric CO2. Instead because of atmospheric CO2's ability to trap the sun's heat leaving Earth, the average year round global temperature is above 14°C.

The European Target to limit global warming to 2°C since pre-Industrialisation would mean an average global temperature similar to periods 3 to 5 million years ago. Sea levels were approximately 15 to 30 meters higher because the ice sheets were smaller. Yet humans had not even emerged as a species 3 million years ago.

Up to 70% of species are thought to be threatened with extinction if a global warming of 3.5°C occurred. The rate of temperature increase would be many thousands of times faster than previous global warming's on Earth meaning the soils, and species could not adapt quickly enough. The current status of the United Nations climate negotiations would create a 3.5°C warming or more.

Do you personally believe, or know that the above statement is correct?

Please pick one option only.

- Yes I know this information to be broadly correct.
- I do not factually know this but believe this information to be broadly correct.
- I do not believe that this information is correct.
- I know for a fact this information is misleading and wrong.
- Don't know

Q3 Approximately US\$ 7 billion, the equivalent to 0.01% of Global GDP (GDP means the money value of all economic activity) is spent each year on the protection of Nature in all types of protected areas worldwide.

Is this funding level adequate in your opinion?

Please pick one option only.

- Yes it is adequate
- No it is not adequate
- No opinion
- Don't know

Q4 Would you object to a 1% to 2% payment for the protection of nature being integrated into the prices of all goods and services? This would generate a 100 times more funding for the protection of nature.

Please pick one option only.

- Yes I think that is a great idea if the money was spent wisely.
- No I do not think it is a good idea.
- Don't know

8. In Mr Casey's witness statement paragraph 46 he explains that he wished to place the Mark in direct connection with CO2 and environmental data. I explained earlier that one of the problems with omnibuses is that questions prior to a question of interest to the court can

influence responses in a way that is difficult to interpret, by introducing a bias. I understand that Mr Casey's intent was to create a context for the next question which was:

Q5 *Do you understand, or think you know what Carbon Virgin is?*

Please pick one option only.

- Yes I know what it is for a fact.*
- Yes I believe I know what it is.*
- I do not know what it is.*

But there is no doubt that the preceding four questions will have led respondents to think about carbon and the environment, the issue is whether this was a realistic situation for the respondent. Personally I would have liked to be able to compare the result without the preceding question derived from a matched independent sample, in order to understand the impact of the focus on carbon and the environment on the answers. This is likely to have been significant, just as a prior question series on airlines or banking might have raised the association with Virgin in subsequent answers.

9. Q5 seeks to establish whether the respondent understands or thinks they know what Carbon Virgin is. Q6 asks those who said they "know for a fact" or "believe they know" what it is at Q5 to: "Briefly describe what Carbon Virgin is or what you think it could be". The answers are given in TABLE 1. Question 5 is not a neutral question to put the first time Carbon Virgin is mentioned. It mixes a question about understanding with one about what Carbon Virgin is. I would have preferred a simple "What is Carbon Virgin?" or "What does Carbon Virgin mean to you?" first, without adding in understanding or familiarity. It is impossible to say exactly what the effect of this question may have been, except that it is likely to have encouraged people who were not very sure what Carbon Virgin is to choose the "Don't know" answer. That having been selected they had no chance to answer question 6. This was an open question where respondents typed in the answer using their own words and the results were coded by professional coders working in the offices of TNS.

TABLE 1

		Total		Survey Wave 1		Survey Wave 2	
	Weighted sample size		2578		1272		1306
Q.5	<i>Do you understand or think you know what Carbon Virgin is?</i>						
	Yes, I know what it is for a fact	3%		3%	3%	3%	
	Yes, I believe I know what it is	11%		10%	10%	12%	
	I do not know what it is	86%		87%	87%	85%	
Q6	<i>Please briefly describe what Carbon Virgin is or what you believe it could be?</i> Coded answers						
	Sample size	14%	100%	13%	100%	15%	100%
	Net: Environmental, energy or carbon related	8%	52%	8%	63%	7%	49%
	Net: Virgin Group company or brand or Richard Branson	1%	6%	1%	3%	1%	6%
	Search engine/website that helps/gives profits to nature/environment	0%	1%	0%	0%	0%	2%
	A way of generating funds/raise money for nature/ environment	0%	0%	0%	0%	0%	1%

10. The first point to observe is that the two surveys, which were carried out two weeks apart, gave similar answers in response to question 5. This means the samples were well matched, even if the internet method introduced bias into the absolute level of the response. The second point to note is that at question 5 people were offered a choice of three answers and question 6, was only asked of people who did not state "don't know" at question 5. The answers to question 6 were grouped into headings by coders working in the offices of TNS. In Table 1 I have simply reproduced the most relevant groups of answers. Unfortunately, no net code was provided for Virgin, a Virgin Group company or Richard Branson. I have therefore added together the answers. It is likely that this has slightly inflated the result, but based on Mr Stobbs' survey where this was done in the analysis, probably not by much. Given the preceding questions it is not surprising that mentions of Virgin a Virgin group company or Richard Branson were low. Very few people mentioned spontaneously that Carbon Virgin was a website, or a way of generating money for nature or the environment.
11. The last three questions were posed after respondents had been asked to read four pages of description from Carbon Virgin's website describing what Carbon Virgin does. The answers are given in Table 2 on the next page. The results of the two waves are similar.

TABLE 2

		Total	Survey Wave 1	Survey Wave 2
	Weighted sample size	2578	1272	1306
Q7	<i>Having read the screenshots of the website on the previous page, please detail what comes to mind when you see the term Carbon Virgin, or say the term carbon Virgin to yourself? Coded answers</i>			
	Net: Environmental energy or Carbon CO2 related	31%	30%	31%
	Net: Virgin Group company or brand or Richard Branson	2%	3%	2%
	Carbon virgin	3%	2%	3%
	Search engine/website that helps/gives profits to nature/environment	8%	9%	6%
	A way of generating funds/raise money for nature/ environment	4%	4%	4%
Q8	<i>Which organisation or group of organisations is responsible for the Carbon Virgin Initiative?</i>			
	Carbon Virgin	25%	24%	26%
	Carbon Virgin, the World Land Trust and the Birdsong Trust	19%	19%	19%
	The World Land Trust	9%	8%	10%
	The Virgin Group of companies (Richard Branson)	4%	4%	4%
	The Birdsong Trust	3%	3%	3%
Q9	<i>Do you like the Carbon Virgin brand for Nature concept?</i>			
	Yes I like the idea	37%	36%	39%
	No I do not like it	11%	10%	12%
	No opinion	44%	45%	42%
	I do not know what the idea is	7%	8%	6%
	It is a fantastic idea	1%	1%	1%

12. Q7 was another open question which allowed respondents to answer in their own words. These were then subsequently coded by TNS coders. The answers do not add much to what we already know, except that they give an insight into what respondents recalled from the website pages they were given to read. After reading the information provided about Carbon Virgin a lot more people spontaneously said that Carbon Virgin was a website, or a way of generating money for nature or the environment (12% compared with less than 0.5% at Q6). Q8 was a precoded question where respondents had to choose one answer from a list. As Mr Casey points out, the majority of people correctly recalled one of the organisations involved in the Carbon Virgin initiative. However, it is important to note that five times as many respondents thought the Carbon Virgin Initiative was the responsibility of

the Virgin Group compared with Q6, albeit still a small proportion of the total sample. Only 23 respondents (1% of the total) mentioned Virgin, a Virgin Group company or Richard Branson at question 6, compared with 111 (approximately 4% of the total) who thought the Virgin Group Companies or Richard Branson were responsible at question 7 after reading the information on the Carbon Virgin website, making the assumption, set out in paragraph 5, that the three codes covering this comments can be added together. This result highlights the problem with the filtering introduced by question 5 excluding people who did not know of Carbon Virgin. It is firm evidence that some people exposed to very detailed information about Carbon Virgin and its sponsoring organisations nevertheless believe that it is associated with the Virgin Group.

13. My conclusion from the two surveys provided by Mr Casey is that the bias introduced by the four introductory questions which led the respondents to focus on the environment, CO2 and carbon, coupled with the filter introduced by question 5 make it impossible to draw any conclusion about the true extent to which the Virgin brand is associated with Carbon Virgin. However the fact that at Q8 one in 25 people associate the Virgin Group or Richard Branson with Carbon Virgin after exposure to four extremely detailed pages taken from the Carbon Virgin website suggests that there is clearly still an association for some people even after the organisation's fund raising purpose has been explained to them.
14. A further survey has been submitted by Mr Stobbs. This survey was an omnibus survey using face-to-face interviewing among 1957 people, representative of adults in Great Britain, who were interviewed in the week beginning 30 May 2011 by Ipsos MORI. Ipsos MORI is also a reputable market research firm and I have no reason to doubt that the surveys were executed in a professional manner. The sample size is adequate for the purpose. Mr Stobbs' survey is also an omnibus survey. However, the fact that the interviewing was face-to-face means that the sample should more accurately represent the population of Great Britain and that the respondents had no opportunity to review and change their answers after hearing subsequent questions. Furthermore, there were no questions before Mr Stobbs' questions which related to airlines, banking, fund raising, or Virgin which might have introduced a bias to consider Virgin in the answers, as confirmed by Linda Joseph Quality Manager at Ipsos in the email marked as Exhibit AP4.
15. The questionnaire used is marked as Exhibit AP2. The first question involved showing respondents a card with the words Carbon Virgin on it marked as Exhibit AP3 and asking them: "if you saw this ... [SHOW 'Carbon Virgin' PROMPT], would it bring anything to mind?" This was followed by the question: "if you were to see the phrase CARBON VIRGIN [SHOW 'Carbon Virgin' PROMPT AGAIN], used as a trade mark, in relation to fund raising and fund management services, would it make you think of anything?" Finally, respondents were asked: "if you were to see the phrase CARBON VIRGIN [SHOW 'Carbon Virgin' PROMPT AGAIN], used as a trade mark, in relation to fund raising and fund management services,

who would you think is responsible for providing them?" Unlike the surveys commissioned by Mr Casey, the answers were allocated by the interviewers to precoded headings provided by Mr Stobbs. Only if the interviewer thought the answer did not fit one of the precoded answers was it coded in the office. Unfortunately this means that we do not have access to the verbatim answers given by respondents, unless the interviewer did not think they fitted the codes provided to them. The answers are summarised in Table 3. It is also unfortunate that no net codes were provided, other than for "Virgin Group of companies/Richard Branson". However, the way the coding was done, the great majority of coded answers related to environmental or carbon issues. Subtracting the answer "none of these" and the net "Virgin Group of companies/Richard Branson" from 100% gives a reasonable idea of the level of response relating to environmental or carbon issues.

TABLE 3

		Total	
	Weighted sample Size	1919	
Q1	<i>If you saw this ... Would it bring anything to mind?</i>		
	Net: Virgin Group of companies/Richard Branson	23%	} 82%
	None of these	57%	
	Don't know/nothing	2%	
Q2	<i>If you were to see the phrase Carbon Virgin used as a trade mark, in relation to fund raising and fund management services, would it make you think of anything?</i>		
	Net: Virgin Group of companies/Richard Branson	21%	
	None of these	63%	
	Don't know/nothing	0%	
Q3	<i>If you were to see the phrase Carbon Virgin, used as a trade mark, in relation to fund raising and fund management services, who would you think is responsible for providing them?</i>		
	Net: Virgin Group of companies/Richard Branson	46%	
	A company called Carbon Virgin	5%	
	Don't know	46%	
	No answer	0%	

16. The first point to note is that one in four people (23%) in a representative sample shown a card with Carbon Virgin on it and asked; "If you saw this...Would it bring anything to mind?" give an answer relating to Virgin, Virgin Group companies or Richard Branson. This is much larger than the figures provided by Mr Casey's surveys and relates to the nature of the introductory four questions and the filtering effect of question 5 in Mr Casey's survey. If we attempt to estimate the responses relating to environmental issues in the way which I

outlined in paragraph 5, it appears that around 18% of people mentioned environmental issues (100% - 82%= 18%), a much lower proportion than in the surveys provided by Mr Casey and less than those mentioning Virgin, Virgin Group companies or Richard Branson.

17. The next two questions probe further into the association of the name with question 3 demonstrating that almost half of respondents (45%) answering the question; "if you were to see the phrase *Carbon Virgin*, used as a trade mark, in relation to fund raising and fund management services, who would you think is responsible for providing them?" believe that it would be the Virgin Group of companies or Richard Branson. Only one in twenty (5%) mention that it would be a company called Carbon Virgin.
18. My conclusion in relation to the survey provided by Mr Stobbs is that of the order of one in four people exposed to the name Carbon Virgin without further information or context would be likely to associate it with the Virgin Group or Mr Richard Branson. The reason it is impossible to say anything more is that the methodology of this survey, using an omnibus and allowing the interviewers to allocate the answers to codes, rather than using independent coders to do the work on the verbatims taken down by interviewers introduces a degree of uncertainty in what was actually said.
19. My conclusions based on three rather imperfect surveys is that, in the absence of any context, around one in four people will associate Carbon Virgin with the Virgin Group of companies. Providing an environmental context to the questioning may well reduce the level of association with Virgin Group. Unfortunately the design of Mr Casey's surveys makes it impossible to make any estimate of the scale of this effect. When considering the results of Mr Casey's surveys, it is worth noting that at Q8 one in 25 people associate the Virgin Group or Richard Branson with Carbon Virgin after exposure to four pages taken from the Carbon Virgin website explaining its purpose. This suggests that there is an association for a small number of people with Virgin Group, even after the Carbon Virgin's fund raising purpose has been explained to them.
20. I understand that my role as an expert witness in these proceedings is to assist the Registry in making its determination and that my paramount duty is to the Registry. I have complied with and will comply with that duty.

100) In *Bach and Bach Flower Remedies Trade Marks* [1999] RPC 1 Neuberger J considered omnibus surveys:

—More specifically, I was also impressed by Mr Barter's evidence as to the general unreliability of surveys of the sort conducted in the present case. They are known as "omnibus surveys" as the interviewees are asked a

wide variety of different questions based on NOP's clients' requirements. Mr Barter said: "While omnibus surveys are suitable for commercial purposes they are generally considered to be inappropriate for the purposes of legal proceedings."

The use of an omnibus survey, therefore, comes freighted with problems. The requirements for survey evidence are outlined in the head note of *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293:

—A survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (g) the exact answers and not some abbreviated form must be recorded, (h) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed."

The evidence of VEL fails to satisfy points d, e, h, i and j. There is also a problem with surveys conducted after the date of application (see to this effect *El Du Pont de Nemours & Company v ST Dupont* [2004] FSR 15).

101) The criticisms of Mr Phillips in relation to both surveys are valid. Taking into account the guidance of the courts in relation to the surveys and the evidence of Mr Phillips, no weight is given to the surveys.

Legal precedents

102) The Act implements, inter alia, Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive) (as it is now). Consequently, interpretation of the Act is made on the basis of judgments of the Court of Justice of the European Union (CJEU) and the General Court (GC), both with their seats in Luxembourg, as well as those of the courts of England and Wales. All of the judgments of the GC (previously the Court of First Instance) and the CJEU can be found at the url:

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

Decisions of the appointed persons, one of the two fora for appeal from decisions of the registrar, can be found on the website of the Intellectual Property Office at the url:

<http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

Decisions of the appointed persons can be identified by the prefix BL.

Earlier decisions

103) Both parties have referred to decisions made in relation to proceedings between them. As all of the proceedings related to opposition proceedings no estoppel can arise (see *Special Effects Ltd v L'Oréal SA and L'Oréal UK Ltd* [2007] RPC 15ⁱⁱ). The arguments and findings of the earlier decisions have, however, been read and considered.

Reputation

104) In relation to the reputation of VEL there has been some conflation between the trade mark Virgin and Sir Richard Branson. Sir Richard Branson is clearly identified with Virgin and he receives a great deal of publicity. Consequently, references to Sir Richard Branson do help keep the Virgin name before the public.

105) Mr Stobbs submitted that VEL has a reputation as being a company that cares about and is involved with matters relating to the environment. This is an issue of the perception of the relevant public(s); it is not necessary for VEL to establish that this is in fact the case. Consequently, the evidence of Mr Casey in relation to Sir Richard Branson committing VG transportation services to giving an estimated \$3 billion over 10 years into tackling global warming but not apparently being on course to achieve this is not necessarily of significance.

106) The Virgin Climate Change Fund was launched in February 2008; it “invests in companies who are driving outstanding growth and who are environmental leaders in their field”. There is little detail in relation to this. Such a fund may be one of several run by VG, it is not necessarily indicative that VG is showing concern for the environment but that it is catering for those who are concerned about their investments doing this. There is no indication as to the size of the fund, the number of investors or promotion in relation to it.

107) Virgin Fuels, which changed its name to Virgin Green Fund has invested in bio-fuels. There is nothing to suggest that this undertaking will be known widely. Exhibited in relation to this is a copy of *Thomson Venture Capital Journal*, Included in the magazine is the following comment on biofuels:

—The Earth Policy Institute recently said ethanol production will consume more than twice as much corn in the next two years as previously thought. With global demand for farm products expected to double over the next 40 years, critics say America’s farmland is best used – from both a social and economic standpoint – to grow food for the world’s population.

And a recent academic study concluded that the manufacture of corn-based ethanol – with its attendant fertilizers, tractors and harvesters – actually produces more greenhouse gases than petroleum.”

The fund’s managing partner was reported in *The Jewish Chronicle Online* as stating

—SirRichard saw that rising fossil fuel prices could potentially hurt his business dramatically. So he wanted to mitigate the risk. He had the timing spot on.””

The venture is seen as a business opportunity. Expert investors are likely to be aware that biofuels are not necessarily environmentally friendly. The fund has two investments in solar power. Taking into account the nature of the fund, the nature of those who likely to be interested in it; this fund is unlikely to assist VG in gaining a reputation as being concerned about the environment.

108) The Virgin Earth Challenge may have been announced with a blast of publicity but there is nothing to suggest that it is known to many people or that the blast of publicity has led to its name still circulating. There is nothing to suggest that the Carbon War Room is widely known or just because of Sir Richard Branson’s presence that it is particularly associated with Virgin, taking into account all of the others involved.

109) The press articles exhibited at MJ44/MJ45 include the following:

- msnbc.msn.com from 21 September 2006 on Sir Richard Branson pledging —to commit all profits from his transportation business over 10 years to combat global warming – profits that he estimated would reach \$3 billion”.
- CNNMoney.com from 2 October 2006 on a —Virgin superfuel that will let us jet around the world guilt-free”.
- Guardian Unlimited of 11 September 2006 headed —Virgin pumps £214m into ‘green’ fuel initiatives.
- CNNMoney.com from 30 January 2006 on Sir Richard Branson’s interest in ethanol
- Environmentalleader.com of 2 July 2008 advising that Sir Richard Branson intends to turn —Mosquito Island in the British Virgin Islands into the most environmentally-friendly resort in the world”.

All of these are Internet sources. Other than Guardian Unlimited there is no indication as to where the websites are based and who is interrogating them.

110) There is no indication as to the circulation of *Virgin Group’s Corporate Responsibility and Sustainable Development Report 2010*.

111) There are references to passengers of Virgin Atlantic being able to offset carbon emissions by clicking through to the website of myclimate. VG is not supplying the offsetting service.

112) The *Telegraph* article, —Aborn again carbon Virgin” is double edged in relation to the environmental credentials of one of Sir Richard Branson’s ventures:

—Here are two ways of looking at the announcement last week that Sir Richard Branson has bought a second British Virgin Island to turn into a holiday resort. It heralds either a state-of-the-art demonstration of how tourism can adapt and survive in a time of climate change – Sir Richard’s version – or the despoliation of a near pristine hump or scrub and rock in the middle of the Caribbean.”

113) There are no concerted media campaigns to promote VG as a company that cares about and is involved in environmental issues. This is not something that has been put in front of the customers on a consistent and persistent basis. One of the major businesses of VG is Virgin Atlantic; a long haul airline. The public are aware of the environmental damage that flights and particularly long distance flights cause. VG has also been involved in short haul flights with Virgin Express. It is involved in long haul holiday destinations and cruising. It is trying to enter space tourism. The Virgin trade mark is used in relation to balloon flights. VG has been involved with grand prix motor racing. All of these undertakings are heavy emitters of carbon.

114) On one side there are intermittent links to environmental concerns, on the other there are highly promoted businesses, the very natures of which are widely known as being environmentally unfriendly. Taking an overall view of the matter, VEL has not established that the reputation that VG enjoys is one of being a company that cares about and is involved with matters relating to the environment.

115) Mr Stobbs, whilst not abandoning more general claims in relation to reputation for the purposes of section 5(3) of the Act, submitted that Virgin and the Virgin signature trade marks had a reputation in relation to travel, airline services, mobile telephone services and media.

Likelihood of confusion – section 5(2)(b) of the Act

116) Although not abandoning other earlier registrations which had been pleaded, Mr Stobbs particularised his submissions by reference to a selection of these earlier registrations. (Unless indicated the earlier registrations are not subject to proof of use as per section 6A of the Actⁱⁱⁱ.) Certain of the earlier registrations had identical specifications; one registration being for the Virgin signature trade mark and one being for VIRGIN. As VEL’s position will not be

any better for the signature trade mark, only the VIRGIN trade marks are identified below.

- Community trade mark registration no 5272273 of the trade mark VIRGIN. It is registered for:

Class 4:

Candles; Christmas tree candles.

Class 6:

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

Class 8:

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

Class 14:

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

Class 21:

Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); articles for cleaning purposes; glassware, porcelain and earthenware not included in other classes; vases (not of precious metal); bowls and pot-pourri bowls; storage boxes for household use; storage box stacks for household use; ornaments made of ceramics, china, crystal, earthenware, glass or porcelain, table centre pieces made of glass; model figures (ornaments) made of earthenware, glass, porcelain or terracotta; crockery including dinner plates, side plates, soup bowls, teacups, saucers, teapots, sugar bowls, jugs and coffee mugs; napkin rings (not of precious metal); coasters; table dressing plates; glasses including stemmed glasses and water glasses; tealight holders; candlesticks (not of precious metal); toothbrush holders; beakers; soap dishes; tissue boxes; ceramic storage containers; toilet roll holders; toilet brushes; soap dispensers; coffee cup gift sets; baskets; bins; perfume bottles; unbreakable glasses; wine glass holders; glasses sets; busts of china, terracotta or glass; butter dishes; chopsticks; cocktail stirrers; coffee filters (non-electric); coffee grinders (hand operated); coffee percolators (non-electric); coffee services (not of precious metal); coffee pots (non-electric) not of precious metal; cooking pots and cooking pot sets; coolers (ice pails); corkscrews; cosmetic utensils; cruet stands for oil and vinegar (not of precious metal); cruets (not of precious metal); crystal (glassware); egg cups; decanters; cutting boards for the kitchen; flasks (not of precious metal); flower pots; glassware (painted); ice buckets; ice cube moulds; ironing boards and ironing board covers; insect traps; jugs (not of precious metal); kettles (non-electric); liqueur sets; mills for domestic purposes (hand operated); nailbrushes; paper plates; perfume burners; perfume sprayers and perfume vaporisers; picnic baskets; piggy banks (not of metal); pitchers (not of metal); salad bowls (not of precious metal); salt cellars and salt shakers (not of precious metal); spice sets; tableware; tankards (not of precious metal); tea caddies, tea infusers, tea services and tea strainers (not of precious metal); thermally insulated containers for food; trays for domestic purposes (not of precious metal); trivets (table utensils); watering cans; works of art of porcelain, terracotta or glass; plastic jugs.

Class 24:

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

of textile; mattress covers; mosquito nets; net curtains; quilts, wall hangings of textile.

Class 27:

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

- Community trade mark registration no 4262093 of the trade mark VIRGIN. It is registered for:

Class 35:

Advertising services relating to real property; management of incentive and loyalty programmes and other promotional schemes including those that reward healthy lifestyle choices with bonuses and benefits; information and advisory services relating to all the aforesaid services.

Class 36:

Health insurance services including bonus and reward payments made as part of the insurance service; private health insurance; medical insurance; provision of finance for health care; savings schemes relating to health and health care; savings schemes relating to health insurance; issuing of tokens of value in relation to incentive schemes; incentivised health and fitness programmes; real estate services; agency services for the leasing of real estate property; agency services for the selling on commission of real property; financial services relating to real estate property and buildings; estate management services relating to transactions in real property; financing of property development; management of property; property portfolio management; information and advisory services relating to all the aforesaid services.

Class 37:

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

Class 44:

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

- Community trade mark registration no 4391868 of the trade mark VIRGIN. It is registered for:

Class 11:

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

Class 20:

Furniture, mirrors, picture frames; goods (not Included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whale bone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; beds, bedsteads, blinds, boxes of wood or plastic, pots, tables, chairs, seats, settees.

Class 26:

Wigs; toupees, lace and embroidery, ribbon and braid; buttons, hooks and eyes, pins and needles; artificial flowers; hair slides, hair bands, false beards, bows, buckles, fasteners for clothing, non-electric hair curlers, hair curling papers, hair curling pins, false hair, hair grips, hair nets, hair ornaments, hair pins, plaited hair, tresses of hair, haberdashery (except thread), hat ornaments (not of precious metal), shoe ornaments (not of precious metal), ornamental novelty badges (buttons), knitting needles, crochet hooks, trouser clips, thimbles, sewing boxes, sewing needles, sewing thimbles.

- Community trade mark registration no 1471143 of the trade mark VIRGIN. This trade mark is subject to proof of use. Mr Stobbs submitted that the evidence filed by VEL shows use in relation to *books*, which term is included in the class 16 specification of the registration.
- Community trade mark registration no 8271058 of the trade mark VIRGIN. It is registered for:

Class 1:

Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.

Class 2:

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

Class 7:

Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

Class 10:

Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.

Class 12:

Vehicles; apparatus for locomotion by land, air or water; land vehicles and parts of all aforesaid goods.

Class 9:

Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

- United Kingdom registration no 2429892 of the trade mark VIRGIN MEDIA. It is registered for:

Class 9:

Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring apparatus and instruments; instruments and apparatus for reproducing sound and/or video and/or transmitting sound and/or video information and images; radio and television apparatus and instruments, all for reception and transmission; aerials; magnetic tapes; magnetic data carriers; compact discs, cassettes, cartridges, video discs; sound recordings and/or video recordings; sound and/or video recording media; video games; racks and cases, all adapted to hold recordings or to hold tapes; exposed cinematographic and photographic films; photographic slide transparencies; calculators; electronic games; mp3 players; electronic amusement apparatus; computer software, computer hardware, computer firmware; data-bearing record carriers for computers;

computer games; coin operated entertainment apparatus and instruments; CD-ROM discs, apparatus and instruments; sunglasses, spectacle frames, lenses, contact lenses; protective clothing; batteries; battery chargers; electrical or electronic apparatus and instruments, all for processing, logging, storing, transmission, reception, display and/or printout of data; electrical or electronic apparatus and instruments, all for management and/or performance analysis of telecommunications and data communications networks and circuits; electrical or electronic apparatus and instruments, all for transmitting, displaying, receiving, storing and searching electronic information; electrical or electronic apparatus and instruments, all for interrogating answering machines and/or accessing telephone services; electrical and electronic apparatus, instruments, circuits and components, all for use with computers, data processing apparatus and/or with communications networks and/or installations; photographic, cinematographic or video equipment; combined telephone, games, mp3 and camera equipment; binoculars; cameras, camcorders; computers, computer printers, computer keyboards; computer peripherals; telecommunication apparatus and instruments; cases for telephones and mobile telephones; pagers, telephone apparatus, mobile telephones; headphones; modems; photocopiers; alarms; fire-extinguishing apparatus; parts and fittings for all the aforesaid goods; sound, text and/or graphics delivered in electronic form; information provided in electronic form.

Class 35:

Advertising; business management; business administration; office functions; employment agencies; recruitment services; commercial information agency services; provision of business information; compilation of information into computer databases; rental of advertising space; accounting services; marketing studies; opinion polling; demonstration of goods; direct mail advertising; dissemination of advertising matter; management consultancy services; photocopying services; publicity services; transcription services; sales promotion for others; word processing services; telephone answering for unavailable subscribers; business enquiries; professional business consultancy; data search; the bringing together, for the benefit of others, of tapes, records, compact discs, videos, digital video discs, apparatus and instruments, all for recording, reproduction and/or transmitting sound, or video information, video recordings, CD roms, video games, telephonic apparatus and instruments, telecommunication equipment, mobile phones, mobile phone accessories, photographic equipment, cinematographic apparatus, data processing equipment and computers, computer software, radio and television apparatus, sound and/or video recordings, electronic games, electronic amusement apparatus, computer games, tapes, cases, bags, holdalls, carriers and containers all adapted for carrying or storing any of the aforesaid goods, parts and fittings for the aforesaid goods, jewellery,

watches and key rings, printed matter, photographs, posters, calendars, magazines, printed publications, mugs, clothing, footwear and headgear, handheld video and computer games and cuddly toys, enabling customers to conveniently view and purchase those goods through physical retail outlets and/or Internet sites.

Class 38:

Telecommunications services; broadcasting; television and radio broadcasting; communications by satellite; telecommunications services; transmission of voice, data, images, audio, video, and information via telephone, television, radio or the Internet; facsimile transmission; personal communications services; pager services; electronic mail services; broadcasting services; transmission or broadcast of news, music, information or images via telephone, television, radio, satellite or the Internet; message transmission services; teleconferencing services; providing information and telecommunications and broadcasting; providing telecommunications connections to a global computer network; electronic bulletin board services; news agency services; communications via computer terminals, telephone fibre optic networks or other media; rental of telecommunications equipment; telecommunications routing and junction services.

Class 41:

Education; provision of training; entertainment, sporting and cultural activities; theatre productions; television productions; radio productions; providing academic mentoring, education and training; organisation of sporting events and leisure activities; publication of books; publication of electronic books; publication of games and electronic games; rental of audio equipment, video cameras, cameras, photographic equipment, camcorders, lighting apparatus, motion pictures or sound recordings; news reporters services; lending library services; information regarding education, entertainment, sporting or cultural activities; presentation of live performances; recording studio services; amusement arcade services; production of films; arranging and conducting workshops; arranging and conducting competitions.

- Community trade mark registration no 8897878 of the trade mark VIRGIN. **This registration is only raised against application no 2555879 owing to its filing date.** It is registered for:

Class 36:

Insurance; financial affairs; monetary affairs; real estate affairs; creation, management and administration of investment funds, venture capital 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.

Class 42:

Advisory and consultancy services relating to environmental protection, pollution, building design, renewable energy, resource efficiency, energy efficiency and energy use; building design services; design of facilities for the transport and treatment of renewable energy including waste and water; design and implementation of renewable energy, resource efficient and energy efficient systems and technologies; environmental conservation; environmental hazard assessment; environmental monitoring services; research in the field of environmental protection and management; energy auditing; preparation of technical projects, technical research and consultancy services in the field of carbon offsetting.

- Community trade mark registration no 3421633 of the trade mark VIRGIN. **In respect of application no 2555879 this registration is subject to proof of use.** It is registered for:

Class 28:

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

Class 33:

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

Class 41:

Educational services; educational services in relation to films or other artistic productions; provision of educational or training material in relation to films or other artistic productions; arranging for seminars for educational purposes; showing of educational films; provision of entertainment; provision of cinema facilities; motion picture production, live performances, theatrical productions, stage, screen and television entertainment

services; audio programming; organising and conducting stage shows, theatre productions, contests, dances and parties; casino services; provision of recreational and sporting facilities; recording studio services for sound, films, videos and television; film distribution and production; publishing; concert and nightclub entertainment services; entertainer services; sporting and cultural activities; operation of leisure/fitness centres and health club services; entertainment services, amusement parks; rental of sports equipment; organisation of sporting events and competitions; publication of books; entertainment or educational club services; library services; camp services; arranging and conducting of conferences; club and resort entertainment and recreation services.

Class 43:

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

Class 44:

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

Class 45:

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

- Community trade mark registration no 5189923 of the trade mark VIRGIN. It is registered for:

Class 4:

Industrial oils and greases; lubricants; fuels and illuminants; candles and wicks for lighting.

Class 39:

Storage, distribution and transportation of energy and fuels.

Class 40:

Energy production; treatment of materials.

Class 41:

Education; providing of training; entertainment; sporting and cultural activities; gaming services; provision of access to online computer games; betting and gambling services; entertainment services; providing online computer games; provision of online games for remote users or remote competitors; downloadable electronic games provided via the Internet.

- Community trade mark registration no 4660221 of the trade mark VIRGIN. It is registered for:
Class 37:

Construction and maintenance of structures for the production of crude oil; construction and maintenance of structures for the storage of crude oil; construction and maintenance of structures for the transportation of crude oil; exploitation (extraction) of oil from oil-fields; extraction of oil; grout reinforcement for oil platforms; installation and maintenance of oil exploration instruments; installation and maintenance of oil production apparatus; installation and maintenance of oil refineries; oil drilling; oil pipeline construction and maintenance; oil pipeline laying; oil pumping; oil-field exploitation for the extraction of oil; pumping of oil-wells; construction and maintenance of structures for the production of natural gas and other energy forms; construction and maintenance of structures for the storage of natural gas and other energy forms; construction and maintenance of structures for the transportation of natural gas and other energy forms; beneath ground construction work relating to gas supply mains and pipes; repair of gas supply systems; installation of pipe systems for the conducting of gases; maintenance and repair of gas installations and equipment; vermin extermination; building construction; advisory services relating to the development of property; advisory services relating to the renovation of property; commercial retail property development services; property development; repair services; cleaning services; installation services; burglar alarm installation and repair; car valet services; installation, maintenance and repair of computer hardware, office machines and equipment; painting services (interior and exterior); furniture restoration; motor vehicle maintenance and repair; plumbing services; dry cleaning services; information and advisory services relating to the aforesaid services.

Class 40:

Refining services; refining of crude oil; refining of oil; production of energy; processing of oil; photographic film development; printing; treatment and processing of materials; destruction, incineration and recycling of waste; waste treatment; framing of works of art; tailoring; dress-making; key cutting; information and advisory services relating to the aforesaid services.

Class 42:

Analysis for oil-field exploration; analysis services for oil-field exploration; analytical services relating to the exploration of oil-fields; conducting feasibility studies relative to oil-field exploration; exploration services to locate oil; geophysical exploration for the oil industry; oil exploration; analysis for oil-field exploration; oil-field surveys; oil prospecting; conducting feasibility studies relative to gas exploitation and gas exploration; exploration services to locate gas; geophysical exploration for the gas industry; computer software design; computer programming services; design and development of computer hardware and software; installation and maintenance of computer software; rental of computer hardware and software; scientific and industrial research; industrial design; legal services, graphic arts design; packaging design; meteorological information; weather reports; weather forecasting; under water exploration services; quality control services; material testing; intellectual property services; engineering services; architecture services; consultation in environment protection; cosmetic research; dress design; interior design; geological prospecting, research and surveys; industrial design; land surveying; authenticating works of art; creating and maintaining websites for others; vehicle road worthiness testing; interior decorating services; information and advisory services relating to the aforesaid services.

Comparison of goods and services

117) In —~~con~~struing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade^{iv}”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^v. Consideration should be given as to how the average consumer would view the goods and services^{vi}. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods and services^{vii}. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{viii}. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J

also gave guidance as to how similarity should be assessed^{ix}. Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

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

118) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 the GC explained when goods are complementary:

—It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

119) Goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application^x.

Application no 2555879

120) The scope of the class 7 and 11 goods of registration nos 8271058 and 4391868 respectively covers all of the class 7 and 11 goods of application no 2555879 with the exception of parts and fittings. The parts and fittings have a symbiotic relationship with the principal goods and so are complementary. They will have the same channels of trade and the same users. They will be highly similar to the principal goods (see by analogy *Ford Motor Co v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-67/07). The class 7 and 11 goods of application no 2555879 are either identical or highly similar to the goods of VEL’s earlier registrations.

121) The class 19 goods of application no 2555879 are encompassed by the class 19 goods of VEL’s registration no 8271058; consequently, the respective goods are identical.

122) VEL’s registration no 5272273 includes *ironmongery* and *small items of metal hardware* which are included in the class 6 specification of application no 2555879. The application also includes *goods of common metal not included in*

other classes which will include *key rings, coat hangers, storage boxes, storage box stacks and wine racks made of metal*; consequently, the aforesaid goods of the application must be considered to be identical to the goods of the earlier registration. Consequently, *ironmongery, small items of metal hardware and goods of common metal not included in other classes* are identical to goods of VEL's earlier registrations. *Metal building materials, transportable buildings of metal and pipes and tubes of metal*, other than material of manufacture, are identical to the goods of class 19 of VEL's registration no 8271058 and are, therefore, highly similar to those goods. *Non-electric cables and wires* will include such goods for building and so the non metal equivalents will be covered by VEL's *building materials* in class 19. The respective goods are, for the reasons above, highly similar. *Safes* have a specific and particular purpose and consequently have a very precise purpose and user. They do not coincide within the parameters of the case law with the goods and services of VEL's registrations and so are not similar to the goods or services of VEL's earlier registrations.

123) *Insulating materials; materials for thermally insulating buildings; insulating materials for lofts and cavities; insulating materials consisting of mineral fibres; insulating materials consisting of or containing rock wool fibres; mastic; glass fibre rolls; goods made from rubber, gutta-percha, gum, asbestos, mica and not included in other classes; stopping and insulating materials; flexible pipes, not of metal; parts and fittings for all the aforesaid goods* of application no 2555879 could all be building materials and so share a common purpose with the class 19 goods of registration no 8271058. In this context they could, for instance, all be found in a builders merchant and so share the same channel of trade. Both sets of users would include builders and both sets of goods used for building; so they share the same users and purpose. There is a high degree of similarity between the goods rehearsed above and the class 19 goods of registration no 8271058. *Rubber, gutta-percha, gum, asbestos, mica* are raw materials that require processing before they can be used. These are products that will be bought by manufacturers to process into a finished product. Mr Stobbs submitted that these goods are similar to the class 19 goods of registration no 8271058 and the class 37 services of registration no 4262093. The respective goods and services do not coincide within any of the parameters of the case law; *rubber, gutta-percha, gum, asbestos, mica* are not similar to the goods and services of the earlier registrations. In relation to the class 16 goods of registration no 1471143 Mr Stobbs only claimed that there had been genuine use in respect of books. Consequently, he did not claim that there had been use in relation to packaging materials; the evidence does not support any such use. *Packaging* shares no common points with the class 19 goods and class 37 services of the registrations of VEL. *Packaging* is not similar to the goods and services of VEL's earlier registrations. *Plastic in extended form for use in manufacture* has the same basic nature as *unprocessed plastics* of registration no 8271058, both products being plastics. Both products will be used by manufacturers of finished goods and so have the same purpose, may share the same channel of trade and have the same end users. *Unprocessed plastics* are essential for the production of

plastic in extended form for use in manufacture in such a way that customers may think that the responsibility for those goods lies with the same undertaking. They are highly similar to *unprocessed plastics*.

124) Mr Stobbs accepted that, taking into account the proof of use that is required in respect of registration nos 3421633 and 342227 in relation to application no 2555879, *the provision of advice relating to social security benefits* in class 45 of the aforesaid application is not similar to the goods and services of the earlier registration.

125) In relation to *books; booklets; journals; leaflets* of registration no 2555879, Mr Stobbs relied upon registration no 1471143, in respect of which he claimed genuine use in relation to books had been established. VEL has to establish genuine use of the trade mark in respect of books for the period from 18 September 2005 to 17 September 2010, the date of publication of the application. The Court of Justice of the European Union (CJEU) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 considered the criteria for establishing genuine use^{xi}. Although the evidence furnished by VEL lacks some specificity; it still shows that in the material period VEL was maintaining a market in the European Union for books in relation to the trade mark VIRGIN. The VIRGIN trade mark was used for a range of books and so an appropriate specification is *books*^{xii}.

126) *Books* of the earlier registration are identical to *books* of the application. The remaining goods are all published printed matter. They are of the same nature, have the same purpose in educating or entertaining. They could follow the same channels of trade. *Books* are a potential alternative to *booklets; journals; leaflets* and so are in competition. *Booklets; journals; leaflets* are highly similar to *books*.

127) Registration no 5189923 of VEL covers all types of education and training and so the class 41 services of application no 2555879 are identical.

128) The class 35 specification of registration no 2429892 for the trade mark VIRGIN MEDIA encompasses all of the class 35 services of application no 2555879, consequently, the respective services are identical. Mr Stobbs also submitted that the class 35 services of registration no 4262093, for the trade mark VIRGIN, are similar or identical. The advertising services of the earlier registration are limited to *relating to real property*. The *advertising services* and *distribution of promotional material* of the application must be considered to be identical as they encompass the services of the earlier registration. The other advertising and promotional services of the application are for a different purpose. However, they are still advertising/promotional services and so have a common nature and general purpose. The specified advertising and promotional services of the application are similar to the services of the earlier registration.

The other class 35 services of application no 2555879 do not coincide, within the parameters of the case law, with the other services of registration no 4262093.

129) The class 37 services of registration nos 4262093 and 4660221 encompass the services of application no 2555879. The respective services are identical.

130) The class 36 services of registration no 8897978 encompass the class 36 services of application no 2555879. The respective services are identical.

131) The class 42 services of registration no 8897878 encompass or overlap with the class 42 services of registration no 2555879. The respective services are identical.

132) Other than in relation to the class 35 services, all of the comparisons of goods and services have been made in relation to registrations for the trade mark VIRGIN. Part of the comparison in relation to the class 35 services is based on the trade mark VIRGIN MEDIA, registration no 2429892

133) All of the goods and services of the application are identical or highly similar to goods and services of earlier registrations for the trade mark VIRGIN with the following exceptions:

Safes – not similar.

Rubber, gutta-percha, gum, asbestos, mica, packaging – not similar.

Advertising services relating to energy conservation; advertising services relating to installation of energy conservation measures and/or central heating systems; promotion of energy conservation and resource efficiency – similar.

Collection of data relating to energy consumption; collection of data in relation to energy conservation and resource efficiency, central heating schemes and/or the installation of energy efficient devices; business services; business management and administration; provision of commercial business information – not similar.

The provision of advice relating to social security benefits – not similar.

All of the class 35 services are, however, identical to the class 35 services for the trade mark VIRGIN MEDIA.

Application no 2526934

134) Mr Stobbs relied upon registration no 4262093 in relation to the class 36 services of the application:

Brokerage of Greenhouse Gas Emissions Credits; Trading of Greenhouse Gas Offsets and Emission Credits; provision of charitable fundraising services in relation to Greenhouse Gas offsetting; Fund management in relation to Avoided

Deforestation investment and the generation of Greenhouse Gas Offsets; Fund raising and fund management.

He submitted that the above services are identical or similar to *issuing of tokens of value in relation to incentive schemes* and *financing of property development*. The normal and reasonable reading of *issuing of tokens of value in relation to incentive schemes* is that it is a service which supplies some form of voucher as a part of an incentive scheme. It is not possible to see how such a service in any way shares any similarities with the class 36 services. Equally, applying a normal reading of *financing of property development*, without even applying the *Avnet* principle, there is no point of coincidence between that service and the services of the application in class 36. The respective services are not similar.

135) The pleadings also included Community trade mark registration no 6261473 for the trade mark VIRGIN GREEN FUND, which is not subject to proof of use. The class 36 specification of this registration is:

Insurance; financial affairs; monetary affairs; real estate affairs; creation, management and administration of investment funds, fund investment (services).

The above services encompass all of the class 36 services of the application and are, therefore, identical.

136) Mr Stobbs relied upon *consultation in environmental protection* in class 42 of registration no 4660221 in relation to *provision of information, advice and consultancy in relation to greenhouse gas offsetting*. *Environmental protection* will encompass *greenhouse gas offsetting*. As far as the consultation is concerned, the services are identical. As far as the information and advice are concerned, these will be part and parcel of consultation; if they are not identical they are similar to the very highest degree.

137) The class 44 services of the application are:

The planting of trees for Greenhouse Gas offsetting purposes, the preservation of trees, forests and landscapes for Greenhouse Gas offsetting purposes.

Mr Stobbs submitted that the class 44 services of registration no 4262093 are similar to the above services:

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

There is no point of coincidence within the parameters of the case law between the above services and the class 44 services of the application. Mr Stobbs also submitted that *educational services* of registration no 1471143 are similar. Again there is no point of coincidence between the respective services. Finally he relied upon *consultation in environment protection* and *geological prospecting* of registration no 4660221. The latter term identifies a service that surveys with the presumed intent of mineral exploitation. It not only has no points of coincidence with the services of the application, it represents the antithesis of those services. *Consultation in environment protection* and the services of the application both seek to protect the environment, so they have common purpose. The user of the consultation service could then seek to use the class 44 services of the earlier registration; so they have the same users. The respective services will not be substituted for each other, they are not fungible; the respective services are not in competition. There is no close connection between them, in the sense that one is indispensable or important for the use of the other. There is a degree of similarity between *consultation in environment protection* and the class 44 services of the application.

138) To summarise the findings above re VIRGIN trade marks:

Class 36 – not similar.

Class 42 – identical or highly similar.

Class 44 – degree of similarity.

In relation to the trade mark VIRGIN GREEN FUND, the respective class 36 services are identical.

Comparison of trade marks

139) The trade marks to be compared are:

VIRGIN

CARBON VIRGIN

VIRGIN MEDIA

VIRGIN GREEN FUND

140) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{xiii}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{xiv}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{xv}. The assessment of

the similarity of the trade marks must be made by reference to the perception of the relevant public^{xvi}.

141) Carbon is commonly used as short hand for carbon dioxide eg carbon footprint. In relation to some goods or services carbon will be indicative of the purpose of the goods and services. For certain goods carbon is directly descriptive of the product ie carbon drill bits. In relation to other goods and services carbon is neither indicative nor descriptive; eg metal building materials and goods made of asbestos. Where the use for goods and services will be indicative or descriptive, CARBON may be seen as describing a type of VIRGIN product or service and the latter element will be very much the dominant and distinctive component. In relation to other goods and services, taking into account the normal relationship between adjective and noun, CARBON will be seen as qualifying VIRGIN. It is the noun rather than the epithet which will normally have the greater effect upon the perception. (It is not always the case that the first element of a trade mark is of greater importance than later elements in considering similarity^{xvii}.) Consequently, in all three potential scenarios the VIRGIN element is both the more dominant component and in the first two scenarios it is the more distinctive component.

142) For the VIRGIN only trade marks VIRGIN is the dominant and distinctive component. In relation to class 36 services GREEN FUND, as part of VIRGIN GREEN FUND, clearly relates to a fund or services relating to a fund that makes investments with the environment in mind. These words lack any distinctive character. The dominant and distinctive component of the trade mark is VIRGIN; although, in comparing the trade marks the non-distinctive component has to be born in mind.

143) The MEDIA element of VIRGIN MEDIA will be seen as being the media wing of an undertaking with the name VIRGIN. In relation to services that relate or use media MEDIA is descriptive. The dominant and distinctive component of the trade mark is the word VIRGIN.

144) The trade marks share the use of VIRGIN, so in respect of this they coincide visually and phonetically. CARBON VIRGIN as a whole has no clear meaning or sense. (The article from telegraph.co.uk uses carbon Virgin as a pun in relation to the place the island is and Sir Richard Branson's business. It does not suggest that the term will be understood outside of the context of the pun.) The absence of a particular concept for CARBON VIRGIN means that there is a degree of conceptual similarity with VIRGIN and the two other trade marks of VEL, the final components of the trade marks not creating a conceptual whole.

145) The respective trade marks are similar.

146) Any reputation that VEL may have for some of the goods and services cannot be taken into account in the comparison of the signs as per in

Ravensburger AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-243/08:

—27It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51).”

A finding that can also be found in *Accenture Global Services GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-244/09*, *Lan Airlines, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-194/09* and *Ferrero SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-140/08*. The comparison is sign to sign, reputation may be taken into account in the global appreciation of a likelihood of confusion.

Conclusion

147) In considering whether there is a likelihood of confusion it is necessary to take into account the nature of the product or service. The care in purchasing a product or service varies. In this case *goods of common metal* will include nails and screws. These are items of low cost and the purchasing decision will not be particularly careful and educated; although the screw or nail will be chosen to be appropriate for the purpose. The purchasers of such goods will be the public at large. The customers of *brokerage of greenhouse gas emissions credits* will be businesses and the purchasing decision will be very careful and highly educated. In the former case the effects of imperfect recollection will be increased, in the latter case they will be lessened. The main method of purchasing most of the goods and services will be looking at them on retail shelves, viewing them on the Internet, consulting catalogues or prospectuses. Consequently, visual similarity will be of more importance than aural similarity. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) Joined Cases T-117/03 to T-119/03 and T-171/03* the GC stated:

—49However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the

mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

However, in this case the degree of visual and aural similarity, which revolves around the common presence of the word VIRGIN, is the same and will have the same effect. Consequently, whether the purchase is primarily the result of visual rather than aural stimuli does not matter.

148) It is necessary to take into account the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xviii}. (In the case of goods or services that are not similar there cannot be a likelihood of confusion as similarity is a prerequisite of such a finding.) For the most part the respective goods and services are identical or highly similar. Certain of the class 35 services of application no 2555879 are only similar to services covered by the VIRGIN word only trade mark. However, all of the class 35 services are identical to the class 35 services of the VIRGIN MEDIA trade mark registration. The class 36 services of application no 2526934 are identical to the services of the VIRGIN GREEN FUND trade mark. The class 44 services of this application only have a degree of similarity with the services of the earlier VIRGIN word only trade mark.

149) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xix}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services for which it is registered, secondly, by reference to the way it is perceived by the relevant public^{xx}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xxi}. VIRGIN and the VIRGIN element of GREEN FUND and MEDIA are neither descriptive nor allusive of the goods and services. It enjoys a good deal of distinctiveness in relation to the goods and services. For most of the goods and services upon which VEL relies it has no reputation, indeed no evidence of use. The evidence does support a reputation in respect of books and financial services in relation to the VIRGIN name.

150) Taking into account the VIRGIN MEDIA and VIRGIN GREEN FUND as well as the VIRGIN trade mark, all of the goods and services are identical or highly similar (where there is identity or similarity) with the exception of the class 44 services of application no 2526934. The degree of similarity and distinctiveness

of the VIRGIN trade mark is such that the limited degree of similarity of the services does not militate against a likelihood of confusion.

151) There is a likelihood of confusion in respect of all of the goods and services of the two applications with the exception of the following goods and services of application no 2555879:

***safes in class 6;
rubber, gutta-percha, gum, asbestos, mica, packaging in class 17;
the provision of advice relating to social security benefits in class 45.
Section 5(3) of the Act***

152) The application of this ground of opposition will be considered for the goods and services in relation to which there is not a likelihood of confusion ie those listed immediately above. Consequently, the ground is only considered in relation to application no 2555879.

153) Mr Stobbs specifically identified 2 earlier registrations of VEL for the trade mark VIRGIN. In relation to Community trade mark no 1798560 he relied upon travel and airline services, which are covered by the class 39 specification of the registration in the following terms:

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

This registration is subject to proof of use for the period 18 September 2005 to 19 September 2010.

154) The other registration which Mr Stobbs specifically identified was Community trade mark no 611459. He submitted that VEL had the requisite reputation in respect of mobile telephone services and media. The trade mark is registered for:

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

This registration is also subject to proof of use for the period 18 September 2005 to 19 September 2010.

155) VEL must establish that its trade mark was known by a significant part of the public concerned by the products or services covered^{xxii}. The CJEU in *General*

Motors Corporation v Yplon SA Case C-375/97 stated how a party would establish this reputation:

—27 In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

In *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07, the CJEU considered Article 4(4)(a) of Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive), which is the basis of section 5(3) of the Act:

—26 Article 4(4)(a) of the Directive establishes, for the benefit of trade marks with a reputation, a wider form of protection than that provided for in Article 4(1). The specific condition of that protection consists of a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, in respect of Article 5(2) of the Directive, *Marca Mode*, paragraph 36; *Adidas-Salomon and Adidas Benelux*, paragraph 27, and Case C-102/07 *adidas and adidas Benelux* [2008] ECR I-0000, paragraph 40).

27 The types of injury against which Article 4(4)(a) of the Directive ensures such protection for the benefit of trade marks with a reputation are, first, detriment to the distinctive character of the earlier mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark.

28 Just one of those three types of injury suffices for that provision to apply.

29 As regards, in particular, detriment to the distinctive character of the earlier mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

30 The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the

public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, *General Motors*, paragraph 23; *Adidas-Salomon and Adidas Benelux*, paragraph 29, and *adidas and adidas Benelux*, paragraph 41).

31 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

32 However, the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute, as was stated in paragraph 26 of this judgment, the specific condition of the protection of trade marks with a reputation laid down by that provision.....

37 In order to benefit from the protection introduced by Article 4(4)(a) of the Directive, the proprietor of the earlier mark must adduce proof that the use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.

38 The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.

44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which

that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique – that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets – it must be ascertained whether the earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, inter alia, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59).

58 However, as is apparent from paragraphs 27 to 31 of the judgment in *Adidas-Salomon and Adidas Benelux*, implementation of the protection introduced by Article 4(4)(a) of the Directive does not require the existence of a likelihood of confusion.

59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 4(4)(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.

64 The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services,

does not necessarily imply that there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.”

156) VEL must establish that a link would be created between the services for which it claims a reputation and the goods and services which are under consideration here ie:

safes in class 6;
rubber, gutta-percha, gum, asbestos, mica, packaging in class 17;
the provision of advice relating to social security benefits in class 45.

The link is dependent not just upon the trade marks but upon the goods and services in question. Goods and services may be so distant that a link will not be established. There is no connection between the goods and services above and the services for which a reputation is claimed by VEL. Outwith the services upon which Mr Stobbs made specific reliance at the hearing, the evidence does not support a reputation in any goods or services that have the least relationship with them. The goods and services are completely alien to the businesses that have traded under VEL's trade marks. It is borne in mind that VEL has used its trade marks in a diverse range of goods and services but not so diverse a range that use of the trade mark of Mr Casey would bring to mind the trade marks of VEL in relation to the above goods and services. Taking into account the differences in the trade marks and the nature of the goods and services, no link will be established in the minds of the consumers for the goods of the application nor in the minds of those who use the services of VEL's trade marks for which a reputation is claimed or shown. **Consequently, the grounds of opposition under section 5(3) of the Act are dismissed against the above goods and services.**

Passing-off – section 5(4)(a) of the Act

157) The section 5(4)(a) objection will be considered in relation to the goods and services in relation to which the other grounds of opposition have failed (ie those identified in paragraph 156).

158) In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”

In the same case he went on to state:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

Goods and services do not have to be similar to be in a “common field of activity”. (In *Lego Systems A/S v Lego M Lemelstricht Ltd* [1983] FSR 155 there was no common field of activity but the gap was bridged by evidence showing the deception of the public. There is no such evidence in this case.)

159) In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade LJ said:

“Even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

160) The goods and services in relation to which the trade marks of VEL have been used are not only not in a common field of activity with the goods and services of the application under consideration, they are at an enormous distance. Owing to this distance there would be neither a misrepresentation nor damage. **Consequently, the grounds of opposition under section 5(4)(a) of the Act are dismissed against:**

safes in class 6;

rubber, gutta-percha, gum, asbestos, mica, packaging in class 17;

the provision of advice relating to social security benefits in class 45.

Overall result

161) Application no 2526934 is to be refused in its entirety. Application no 2555879 is to be refused in respect of all goods and services with the exception of:

***safes in class 6;
rubber, gutta-percha, gum, asbestos, mica, packaging in class 17;
the provision of advice relating to social security benefits in class 45.***

Costs

162) VEL has been for the most part successful and is entitled to a contribution towards its costs. Costs are awarded upon the following basis:

Opposition fees x 2:	£400
Preparing statements and considering the statements of Mr Casey:	£600
Preparing evidence and considering evidence of Mr Casey:	£1,500
Preparation for and attendance at hearing:	£500
Total:	£3,000

Mr Michael Casey is ordered to pay Virgin Enterprises Limited the sum of £3,000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of October 2012

**David Landau
For the Registrar
the Comptroller-General**

ⁱ The Advertising Standards Agency considered the relevance of hits on a web site in its ruling in the Cool Diamonds.com Ltd case:

The ASA noted Cool Diamonds kept a log of all the 'hits' to their website on their servers. We noted they had used the 'hits' figure because they believed it was an accurate reflection of the interest generated by their website. We acknowledged their point that a previous ASA adjudication had considered that the term 'hits' was unlikely to mislead readers.

We noted 'hits' referred to the number of items, such as files or images, retrieved from a website and that it was not equivalent to the number of pages viewed by a user or the number of visitors. We noted the more files or images present on a certain webpage, the more 'hits' the website received, which meant that one visitor could generate a high number of hits. We understood that 'hits' was not recognised as a measurement of website traffic by the Joint Industry Committee for Web Standards in the UK (JICWEBS); it only recognised measurements of unique users, page impressions or visits. We also noted the Institute of Direct Marketing website stated "Hit - a highly contentious term that rarely indicates the number of visitors to a website ... So from a marketing point of view, the bottom line is that the hits are misleading - they are never synonymous with the number of site visitors or page-views".

We considered that readers were likely to understand that the claim "5 million hits" was a reference to the websites popularity and that hits was a reliable measure of that popularity. We considered that some readers might go so far as to infer that each month Cool Diamonds had five million visitors or that five million web pages had been viewed by visitors. Because the number of hits a website received was unlikely to reflect, or be a reliable measure of, the number of visitors to the site or pages viewed, we concluded that the claim was likely to mislead readers into thinking the website was more popular than it was."

ⁱⁱ The full judgment can be found at the url: <http://www.bailii.org/ew/cases/EWCA/Civ/2007/1.html>.

ⁱⁱⁱ Section 6A of the Act reads:

(1) This section applies where –

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

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

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

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

^{iv} *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^v *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{vi} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWCA/Civ/2002/1828.html>

^{vii} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34. The full judgment can be found at the url:
<http://www.bailii.org/ew/cases/EWCA/Civ/2001/1928.html>

^{viii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97*.

^{ix} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

^x See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* paragraph 29:

In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

^{xi} 36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the

economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

^{xii} A description must not be over pernickety. It is necessary to consider how the relevant public would describe the goods. The General Court (GC) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant subdivisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

–However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining

not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

^{xiii} *Sabel BV v Puma AG* Case C-251/95.

^{xiv} *Sabel BV v Puma AG* Case C-251/95.

^{xv} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{xvi} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xvii} See for instance: *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-438/07 and *CureVac GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-80/08.

^{xviii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xix} *Sabel BV v Puma AG* Case C-251/95.

^{xx} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xxi} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.

^{xxii} *General Motors Corporation v Yplon SA* Case C-375/97.