

**BL O/739/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3283156**

**BY**

**VIRGINIC LLC**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 03:**

**VIRGINIC**

**AND**

**OPPOSITION THERETO (NO. 600000864)**

**BY**

**VIRGIN ENTERPRISES LIMITED**

## **Background and pleadings**

1. VIRGINIC LLC (the applicant) applied to register the trade mark:

### **VIRGINIC**

in the UK on 17 January 2018. It was accepted and published in the Trade Marks Journal on 09 February 2018, in respect of the following goods:

Class 03: Cosmetic creams and lotions; Cosmetic creams for skin care; Cosmetics; Cosmetics in the form of oils; Essential oils for cosmetic purposes; Body butter; Dentifrices.

2. Virgin Enterprises Limited (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is raised against all of the goods applied for. The opposition is based on an earlier UK Trade Mark and an earlier European Trade Mark (EUTM), namely:
3. UK 3163121, filed on 05 May 2016 and registered on 29 July 2017, for the mark:

### **VIRGIN**

4. EUTM 15255235, filed on 03 June 2013 and registered on 21 March 2016, for the mark:

### **VIRGIN**

5. The earlier marks are both registered in several classes including class 03, however, for the purposes of this opposition, the opponent relies only on a part of the class 03 element of their earlier registrations, namely:

Class 03: Essential oils, cosmetics, hair lotions; dentifrices; preparations for the scalp, skin and nails; shaving preparations; after-shave lotions, cream, gel, foam and balm; anti-aging skin preparations; day cream; eye cream; night

cream; facial cleansing mousse, foam, balm, milk, oil, polish and moisturiser; skin tonic; skin toner; non-medicated bath oils; bath cream, milk; body butter, cream, lotion, moisturiser, powder; hand cream, balm, lotion; cosmetic sun tanning preparations; sun screening preparations; bronzing preparations for the skin; preparations for the hair, hair lotions; non-medicated preparations for the care of the skin, hands, scalp and the body; skin cleansing preparations; creams and lotions for the skin; makeup; cheek colour; concealer; eye colour; eye liner; eye shadow; eye makeup remover; foundation; mascara; tinted moisturiser.

6. In its statement of grounds, the opponent claims that:

- The earlier marks consist of the word VIRGIN in standard block capital lettering. The application is for the mark VIRGINIC in standard block capital lettering.
- The earlier 'VIRGIN' marks are wholly contained within the first portion of the later mark 'VIRGINIC'. This creates a high degree of visual, aural and conceptual similarity between the marks. The only difference between the marks is the inclusion of the suffix "IC" in 'VIRGINIC', which does not sufficiently distinguish it from the earlier marks so as to create a different overall impression.
- The goods covered by the application are identical or highly similar to goods covered by the earlier marks.
- The application is for a trade mark which is highly similar to the earlier marks and covers goods which are either identical or similar. Therefore, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the earlier mark.

7. In its counterstatement the applicant put the opponent to proof of use however, whilst both of these registrations qualify as earlier marks under section 6A of the Act,

because they were registered less than 5 years before the date of publication of the later mark, they are not the subject of proof of use.

8. The applicant claimed:

- That it accepted that there is a level of similarity between the marks, by virtue of the inclusion of the word VIRGIN in both marks. However, the word VIRGIN does not have an independent existence within the applied for mark, due to the suffix 'IC'.
- The marks are not visually, aurally or conceptually highly similar, as the addition of 'IC' to the applied for mark creates a different visual and aural impression to that of the earlier marks.
- That there is some similarity or identity between the goods at issue.
- The average consumer of the opponent's goods would be predominantly female. The level of attention of the consumer would be high and brand loyalty would ensure that the average consumer would readily distinguish between the marks and as such confusion would be unlikely to arise.

9. The opponent submitted written submissions which will not be summarised here, but will be referred to in this decision if necessary.

10. No hearing was requested and so this decision is taken following a careful perusal of the papers.

11. Throughout the proceedings the applicant has been professionally represented by Cohen Davies Solicitors. The opponent has represented itself.

## **Decision**

### **Section 5(2)(b) of the Act**

12.5(2)(b) of the Act states:

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

(a) ...

(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.”

13. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods and services**

14. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*, Case

T- 133/05, the General Court stated that:

“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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

17. The parties’ respective specifications are:

Earlier marks	Application
<p><b>Class 03:</b> Essential oils, cosmetics, hair lotions; dentifrices; preparations for the scalp, skin and nails; shaving preparations; after-shave lotions, cream, gel, foam and balm; anti-aging skin preparations; day cream; eye cream; night cream; facial cleansing mousse, foam, balm, milk, oil, polish and moisturiser; skin tonic; skin toner; non-medicated bath oils; bath cream, milk; body butter, cream, lotion, moisturiser, powder; hand cream, balm, lotion; cosmetic sun tanning preparations; sun screening preparations; bronzing preparations for the skin; preparations for the hair, hair lotions; non-medicated preparations for the care of the</p>	<p><b>Class 03:</b> Cosmetic creams and lotions; Cosmetic creams for skin care; Cosmetics; Cosmetics in the form of oils; Essential oils for cosmetic purposes; Body butter; Dentifrices.</p>



skin, hands, scalp and the body; skin cleansing preparations; creams and lotions for the skin; makeup; cheek colour; concealer; eye colour; eye liner; eye shadow; eye makeup remover; foundation; mascara; tinted moisturiser.	
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18. The applicant's goods are entirely contained within the earlier goods 'Essential oils, cosmetics, hair lotions; dentifrices; after-shave lotions; day cream; eye cream; night cream; facial cleansing oil; body butter, cream, lotion; hand cream, lotion'. Consequently, the goods at issue are identical.

**Average consumer and the purchasing act**

19. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

20. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

21. The applicant, in its counterstatement, claimed firstly, that the average consumer would predominantly be female and, secondly, that the level of attention paid during the selection of the goods at issue would be high.

22. I find no evidence to support these claims. The average consumer of goods such as skin creams or dentifrices is as likely to be male as female. To my mind the average consumer of 'cosmetics; cosmetic creams and lotions; essential oils; cosmetic oils; body butter and dentifrices' will be a member of the general public.

23. The selection of these goods is largely a visual process, as the average consumer will wish to see the goods and assess colour, fragrance, aesthetic appeal and suitability. I do not, however, ignore the potential for the marks to be spoken in a retail establishment, or when making a purchase over the telephone or via the internet. However, in those circumstances, the consumer will generally have had an opportunity to view the goods and therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer's mind.

24. Whilst it may be the case that sometimes some of these goods may be expensive and therefore commanding of a higher level of attention, equally these goods can often be relatively low cost. I must consider a typical product and a typical purchasing process. Generally, as the goods at issue are day to day items, the level of attention paid by the average consumer will be average.

### **Comparison of marks**

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

27. The respective trade marks are shown below:

Earlier marks	Contested trade mark
VIRGIN	VIRGINIC

28. The opponent’s marks are comprised solely of the plain word ‘VIRGIN’ in standard capital lettering. Consequently, the overall impression in the mark lies in the word itself.

29. The applicant’s mark is comprised of the word ‘VIRGINIC’ presented in standard capital lettering, therefore the overall impression lies in its totality.

**Visual similarity**

30. Visually, the respective marks are similar insomuch as they both share the letters ‘VIRGIN’ presented in identical order, and which constitute the whole of the earlier marks and the beginning of the later mark. They differ visually in the letters ‘IC’ of the later mark, which form the ending of that mark and which have no counterpart in the

earlier marks. As the initial parts of the marks are identical, the marks are considered to be visually similar to a high degree.

### **Aural similarity**

31. Aurally, the earlier marks will be enunciated as *VUR/JIN* and the applied for mark will be articulated as *VUR/JIN/IK*. The marks share identical beginnings, with the first two syllables being the same. The earlier marks are entirely contained in the later mark. Whilst the ending of the applied for mark differs from the earlier marks, these marks are found to be aurally similar to a high degree.

### **Conceptual similarity**

32. The earlier marks comprise the word 'VIRGIN', which conveys the concept of 'someone who has never had sex; something that has never been used or spoiled'<sup>1</sup>. The applied for mark 'VIRGINIC' has no clear or obvious meaning as a whole, however, it is likely that the element 'VIRGIN' which constitutes the beginning of that mark, will be perceived by the average consumer, as it is a fairly common English word. As such, the marks can be said to be conceptually similar to a medium degree as the later mark will be perceived to be evocative of 'VIRGIN'.

33. In conclusion, the marks are found to be visually and aurally similar to a high degree and conceptually similar to a medium degree.

### **Distinctive character of the earlier trade marks**

34. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

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<sup>1</sup> Collins English Dictionary

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

35. The opponent has made no claim that its earlier marks have acquired an enhanced degree of distinctive character. I must therefore assess the marks purely on their inherent distinctive character.

36. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be

confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

37. In this instance, the common element ‘VIRGIN’ has no link or association with the goods at issue and can be said to be an arbitrary choice when considering the nature of the goods. Consequently, the mark is found to have a normal degree of inherent distinctive character.

### **Likelihood of Confusion**

38. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

39. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

40. The marks have been found to be visually and aurally similar to a high degree, and conceptually similar to a medium degree. The goods at issue have been found to be identical.

41. During the selection process the visual impact of the marks will carry the most weight in the mind of the average consumer, however the aural and conceptual impacts of the marks cannot be dismissed.

42. The earlier marks comprise the common English language word ‘VIRGIN’, whilst the applied for mark is, when considered as a whole, an invented expression. Whilst the applied for mark might evoke the term ‘VIRGIN’ it remains the case that it is an

invented word which is unlikely to be mistaken for a common word by the average consumer. Consequently, I am satisfied that direct confusion will not occur. The relevant public will not mistake one of these marks for the other.

43. Having found that direct confusion will not occur when the average consumer is faced with one of the marks to hand, having previously encountered the other. I go on now to consider then, whether that consumer, having recognized that the marks are different, considers the common elements in the marks and determines, through a mental process, that the marks are related and originate from the same, or an economically linked undertaking.

44. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

“16. ...Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

45. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

46. I believe that the average consumer of the goods at issue will not, when faced with the mark ‘VIRGINIC’, assume that it is a logical brand extension or an evolution of ‘VIRGIN’ products. Whilst the earlier marks have been found to be inherently distinctive to a normal degree, it cannot be said to be the case that the word ‘VIRGIN’ is strikingly distinctive when applied to the goods at hand.

47. Therefore, although it is likely that the average consumer may recognise the element ‘VIRGIN’ within the applied for mark ‘VIRGINIC’, this will merely serve to bring the earlier marks to mind but will not, in my opinion, result in indirect confusion.

48. Taking all of this into consideration, I conclude that the marks at issue will not be indirectly confused by the average consumer.

### **Conclusion**

49. The opposition fails. Subject to appeal, the application may proceed to registration in respect of all of the applied for goods.

### **Costs**

50. The applicant has been successful and is entitled to a contribution towards its costs.



51. I bear in mind that the relevant scale is contained in Tribunal Practice Notice (“TPN”) 2/2015. I award costs to the applicant as follows:

Considering the statement of case and preparing a counterstatement	£300
<u>Total</u>	<u>£300</u>

52. I therefore order Virgin Enterprises Limited to pay VIRGINIC LLC the sum of £300. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 20<sup>th</sup> day of November 2018**

**Andrew Feldon  
For the Registrar  
The Comptroller-General**