

Hearing:
May 21, 1998

Paper No. 39
EWH/cv

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB. 12, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

CPI FAB, Inc. and CONOPCO, Inc. dba Fabergé Co.
v.
SFS-Spirituosen GmbH

Opposition No. 94,301
to application Serial No. 74/309,677

Kenneth C. Leonard for CPI FAB, Inc. and CONOPCO, Inc. dba
Fabergé Co.

Morris Liss of Pollock, Vande Sande & Priddy for SFS-
Spirituosen GmbH.

Before Hanak, Quinn and Hairston, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

SFS-Spirituosen GmbH (applicant) seeks registration of
FABERGÉ for spirits, liqueurs and wine. Applicant's intent-

to-use application affords applicant a constructive first use date of April 22, 1992.

On April 14, 1994 CPI FAB, Inc. and CONOPCO, Inc. dba **Fabergé** Co. (hereinafter simply "opposer") filed a notice of opposition alleging that opposer "is the owner of the trademark FABERGÉ which is used in interstate commerce ... in connection with a wide variety of goods, including personal antiperspirants, cologne, after shave lotion, shaving cream, hair spray, soap, eye glass frames, fine china, fine crystal glassware, including wine glasses, cordial glasses, crystal decanters, jewelry, watches, soap, picture frames, and collectables." (Notice of Opposition paragraph one). Opposer further alleges that it is the owner of numerous registrations of FABERGÉ for a wide variety of goods. Finally, opposer alleges that applicant's use of the identical mark FABERGÉ in connection with spirits, liqueurs and wine is likely to cause confusion, mistake and deception in view of opposer's superior rights in the mark FABERGÉ for a wide variety of goods.

Applicant filed an answer which denied the pertinent allegations of the notice of opposition.

Both parties filed briefs and were present at a hearing held on May 21, 1998.

There is no dispute as to what constitutes the record in this case, which is summarized at pages two and three of

opposer's brief and at page six of applicant's brief. In their briefs, both opposer and applicant have a section entitled "Question Presented." Opposer articulates the question in the following manner: "Where [opposer's] registered trademark FABERGÉ is well-known for fragrances, toiletries, as well as for a wide variety of high-end luxury goods, including cordial, high ball, champagne and wine glasses used on social occasions to serve alcoholic beverages, is use of the identical trademark FABERGÉ [by applicant] for alcoholic beverages likely to cause confusion?" (Opposer's brief page three). Applicant articulates the "Question Presented" in the following manner: "Where [opposer's] registered trademark FABERGÉ has been established for toiletry, personal care products, luxury goods and collectables, is the use of the identical trademark FABERGÉ [by applicant] for alcoholic beverages likely to cause confusion?" (Applicant's brief page six).

A review of the record in this case causes us to conclude that the answer to the question is "yes," and accordingly we sustain the opposition. Our reasons are as follows.

As the parties agree, the roots of the FABERGÉ trademark date back to 19th century Russia where Peter Carl Fabergé, in his famous St. Petersburg workshops, created his unique works of jewelry and crafts, including the world-

famous FABERGÉ Imperial Easter Eggs. In approximately 1937, opposer's predecessor-in-interest (Samuel Rubin) adopted the FABERGÉ mark for use in connection with the sale of fragrances in the United States. Mr. Rubin subsequently acquired the rights to the FABERGÉ mark from the heirs of Peter Carl Fabergé.

Opposer, through its predecessor-in-interest, has made continuous use in the United States of the mark FABERGÉ in connection with fragrances since the 1930's. In more recent times, opposer has expanded the use of its FABERGÉ mark to include a wide array of items besides fragrances and toiletries. These include jewelry, watches, eye glasses, fabrics, china, various collectables and, of particular interest to this proceeding, glassware, specifically including glassware designed for use with various alcoholic beverages.

Applicant's principal owner, Boris Fuchsman, testified that he was unaware of opposer's use of its FABERGÉ mark at the time he selected the identical mark. Mr. Fuchsman -- a resident of Düsseldorf, Germany -- was well aware of Peter Carl Fabergé. Mr. Fuchsman testified that he specifically selected the mark FABERGÉ for use in connection with alcoholic beverages because said beverages "should have the same [high] standards as the pieces of art which the Master Fabergé had produced at a former time."

(Fuchsman deposition page 10). While applicant has yet to use its mark, it has created "labels [which] have been designed to include art designs reminiscent of those developed in another era by Peter Carl Fabergé."

(Applicant's brief page 8). Mr. Fuchsman went on to note that he "only wanted to make profits from the name [Peter Carl] Fabergé, which is known to certain part of customers [sic]." (Fuchsman deposition page 23).

Thus, opposer's rights in its FABERGÉ mark can be traced through opposer's predecessor-in-interest to Peter Carl Fabergé, the individual who inspired applicant to select the identical mark FABERGÉ for use in connection with alcoholic beverages.

In any likelihood of confusion analysis, two key considerations are the similarity of the marks and the similarity of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to cumulative effect of differences in the essential characteristics of the goods and differences in the marks.")

In this case, the marks are absolutely identical, even down to the accent mark over the final letter. The fact the marks are identical "weights heavily against applicant." In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Indeed, the fact that

applicant has selected the identical mark long used by opposer "weights [so] heavily against the applicant" that applicant's proposed use of the mark on "goods ... [which] are not competitive or intrinsically related [to opposer's goods] ... can [still] lead to the assumption that there is a common source." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993).

Turning next to a consideration of the goods, while they need not be intrinsically related for a finding of likelihood of confusion, we find that, in point of fact, applicant's goods and certain of opposer's goods are clearly related. Under such circumstances, there is not a mere likelihood of confusion, but a strong likelihood of confusion.

To elaborate somewhat, the evidence shows that since 1986, opposer through licensees has continuously marketed under its FABERGÉ mark glassware which is specifically designed for use in conjunction with spirits, liqueurs and wine. This is over five years prior to applicant's constructive first use date. Obviously, spirits, liqueurs and wine are clearly related to glassware designed specifically for use in drinking spirits, liqueurs and wine. For example, we have little doubt that a consumer encountering a FABERGÉ wine glass and FABERGÉ wine would

assume that both products had common sponsorship, although perhaps were produced by different entities.

Moreover, one final factor should be mentioned. Much of opposer's promotional literature for its glassware, including glassware designed to hold alcoholic beverages, makes specific reference to Peter Carl Fabergé and his works of art. As applicant notes at page 8 of its brief, while applicant's "mark has not been used ... labels have been designed to include art designs reminiscent of those developed in other era by Peter Carl Fabergé." Thus, applicant not only has adopted a mark identical to opposer's long standing FABERGÉ mark, but in addition, applicant proposes to do exactly what opposer has done for many years, namely, promote its goods by making reference to Peter Carl Fabergé or his works of art. If applicant were to do so, confusion would be almost certain.

Finally, we note that opposer has argued that its mark FABERGÉ is famous. We find that as applied to fragrances, opposer has established the fame of its mark, a fact which applicant does not seriously dispute. See applicant's brief pages 10 and 11. However, in finding there exists a strong likelihood of confusion resulting from the use of the identical mark FABERGÉ on glassware for alcoholic beverages and on alcoholic beverages, we need not rely upon the fact

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that opposer's FABERGÉ mark is famous for, at a minimum,
fragrances.

Decision: The opposition is sustained.

E. W. Hanak

T. J. Quinn

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board