

Hearing:
March 11, 1998

Paper No. 18
PTH

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Fine Fragrances, Inc.
v.
Pavion Ltd.

Opposition No. 98,991
to application Serial No. 74/507,384
filed on March 31, 1994

Donald L. Dennison of Dennison, Meserole, Pollack and
Scheiner for Fine Fragrances, Inc.

Lawrence D. Mandel for Pavion Ltd.

Before Hohein, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Pavion Ltd. to register the mark CAFE COLORS for "perfumes, colognes, cosmetics, namely, non-medicated nail care preparations, non-medicated skin care preparations and non-medicated hair care preparations."¹

¹ Application Serial No. 74/507,384 filed March 31, 1994, alleging a bona fide intention to use the mark in commerce. Applicant has disclaimed the right to use the term "COLORS" apart from the mark as shown.

Opposition No. 98,991

Registration has been opposed by Fine Fragrances, Inc. under Section 2(d) of the Trademark Act. Opposer alleges that since at least November 1979, opposer and its predecessors have used the mark CAFÉ and a coffee bean and leaf design in connection with perfumes and toilet water; that opposer is the owner of a registration for this mark, as set forth below,

for "perfumes and toilet waters;"² and that applicant's mark, if used in connection with the identified goods, so resembles opposer's previously used and registered mark as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations in the notice of opposition. As affirmative defenses, applicant asserted that opposer was barred from claiming exclusive rights in the word CAFE for cosmetics because opposer did not oppose and has not petitioned to

² Registration No. 1,177,730 issued November 17, 1981; Sections 8 & 15 affidavit filed. The registration states that "[t]he English translation of the term 'Café' is 'Coffee'."

Opposition No. 98,991

cancel other registrations which include the word CAFE; and that in view of the numerous other registrations and applications for marks which include the word CAFE for cosmetics, opposer's mark is extremely weak and is entitled to little protection apart from the composite mark which includes a design element.³

The record consists of the pleadings; the file of the opposed application; opposer's notice of reliance on a status and title copy of its pleaded registration and a copy of the assignment of the registration to opposer; and the testimony deposition of Felipe Kreiezmar, opposer's director of marketing. Applicant took no testimony and offered no other evidence herein. Only opposer filed a brief on the case and only opposer's counsel appeared at the oral hearing.

Opposer is the exclusive United States distributor of fragrances which are manufactured by Compagnie Francaise de Commerce International (COFCI), a French company. Opposer markets a number of brands for COFCI, including the CAFÉ and design brand. Included in the CAFÉ and design line are perfumes, perfumes de toilette in spray and splash form, men's cologne, and deodorant. According to opposer's witness, Mr. Kreiezmar, the CAFÉ and design brand was introduced in 1979 and the first products were shipped to

³ We should note that, strictly speaking, these are not

Opposition No. 98,991

the United States around 1986. Opposer has a network of sales representatives who market its fragrances to wholesalers and retailers such as mass merchandisers, chain stores, and department stores. Opposer promotes its fragrances at retail by way of product displays, in store promotions, counter testers and product give-aways. Opposer also advertises in magazines, and appears at about ten trade shows each year. Opposer spends approximately \$50,000 annually advertising and promoting its products. Opposer's fragrances retail from \$13.00 to \$26.00 a bottle. For the year 1996, opposer's sales were in excess of \$820,000. Mr. Kreizemar testified that opposer recently launched a new fragrance under the mark CAFÉ CAFÉ.

The record contains no information about applicant.

As indicated above, opposer has made of record a status and title copy of its pleaded registration. Thus, there is no issue with respect to opposer's priority. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

This brings us to the issue of likelihood of confusion. Turning first to the goods, perfumes, colognes and cosmetics--the goods on which applicant intends to use its mark--are identical in part or otherwise closely related to opposer's perfumes and toilet waters. Thus, if the goods

affirmative defenses.

Opposition No. 98,991

were to be sold under the same or substantially similar marks, confusion as to source or sponsorship would be likely to occur.

Turning then to a consideration of the marks, we begin our analysis of whether confusion is likely by keeping in mind the principle that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Second, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In comparing opposer's mark CAFÉ and design with applicant's mark CAFE COLORS, we find the commercial impressions engendered by the marks to be sufficiently similar that, when the marks are used in connection with identical and otherwise closely related goods, consumers are likely to be confused. In the present case, applicant's mark is clearly dominated by the word CAFÉ, which is

Opposition No. 98,991

identical to the dominant portion of opposer's CAFÉ and design mark. Applicant has disclaimed exclusive rights to use COLORS, thereby acknowledging the descriptiveness of this term. Further, the coffee leaf design in opposer's mark is subordinate and less likely to be remembered by consumers. It is the literal portion of opposer's mark, CAFÉ, which would be used by purchasers in referring to opposer's products. In re Appetito Provisions Co., 3 USPQ2d 1553, 1554 (TTAB 1987).

Further, although applicant affirmatively asserted in its answer that there are numerous other registrations and applications for marks which include the word CAFE for cosmetics, and thus opposer's mark is weak, the record is devoid of any such registrations or applications, or evidence of third-party uses of similar marks in the marketplace. Also, applicant failed to offer any proof with respect to its other affirmative defense that opposer was barred from claiming exclusive rights in the word CAFE for cosmetics.

In sum, we conclude that purchasers familiar with opposer's perfumes and toilet waters sold under the mark CAFÉ and design, would be likely to believe, upon encountering applicant's CAFE COLORS mark for perfumes, colognes, and cosmetics, that such goods emanate from or are otherwise sponsored by the same source. Even if purchasers

Opposition No. 98,991

were to notice the minor differences in the marks, they may well believe that opposer is now selling a new line of fragrances and cosmetics under the mark CAFE COLORS.

Decision: The opposition is sustained.

G. D. Hohein

P. T. Hairston

C. E. Walters
Administrative Trademark
Judges, Trademark Trial and
Appeal Board