

ESTTA Tracking number: **ESTTA317292**

Filing date: **11/17/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

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|---------------------------------------|--|
| Name | Cristall USA, Inc. |
| Granted to Date of previous extension | 11/21/2009 |
| Address | 902 Clint Moore Road Suite 146 Boca Raton, FL 33487 UNITED STATES |
| Attorney information | David Garrison David L Garrison PS PO Box 16100 Seattle, WA 98116 UNITED STATES dlg@skaya.com, kristilyn@skaya.com Phone:(206) 441-3440 |

Applicant Information

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|--------------------------------|--|---------------------------------|------------|
| Application No | 79064457 | Publication date | 09/22/2009 |
| Opposition Filing Date | 11/17/2009 | Opposition Period Ends | 11/21/2009 |
| International Registration No. | 0990994 | International Registration Date | 12/03/2008 |
| Applicant | The Company "EPLAXA LIMITED" P.O. Box 3175 Road Town,; Tortola VIRGIN ISLANDS, BRITISH | | |

Goods/Services Affected by Opposition

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| Class 033. All goods and services in the class are opposed, namely: Alcoholic beverages, namely, vodka, brandy, gin, rum, spirits, liqueurs, bitters, whisky, digesters being liqueurs and spirits to be consumed after a meal; cocktails containing alcohol with the exception of wine, sparkling wine, and champagne-based cocktails; sake; hard cider |
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Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
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Marks Cited by Opposer as Basis for Opposition

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|-----------------------|------------|------------------|------------|
| U.S. Registration No. | 3646945 | Application Date | 12/05/2008 |
| Registration Date | 06/30/2009 | Foreign Priority | NONE |

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|---------------------|---|------|--|
| | | Date | |
| Word Mark | CRISTALL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1995/06/03 First Use In Commerce: 1995/06/03 Distilled Spirits | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3519736 | Application Date | 03/12/2008 |
| Registration Date | 10/21/2008 | Foreign Priority Date | NONE |
| Word Mark | CRISTALL ULTRA PREMIUM RUSSIAN VODKA SIGNATURE SERIES | | |
| Design Mark |  | | |
| Description of Mark | The mark consists of the word "Cristall" is gold in color and vertically displayed within a rectangular domed frame. the overall background color of the whole frame is black. The letter "i" in the vertical word "Cristall" is dotted with a red crown. The red crown is outlined in the color gold. Centered inside the domed frame towards the top of the frame is a red colored crown outlined in the color gold. The colors black, gold and red are an integral part of the mark. | | |
| Goods/Services | Class 033. First use: First Use: 2007/02/01 First Use In Commerce: 2007/02/01 alcoholic beverage, namely, vodka | | |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3396938 | Application Date | 07/09/2007 |
| Registration Date | 03/18/2008 | Foreign Priority Date | NONE |
| Word Mark | STANDING TALL WITH CRISTALL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 2007/02/26 First Use In Commerce: 2007/02/26 alcoholic beverages, namely, vodka | | |

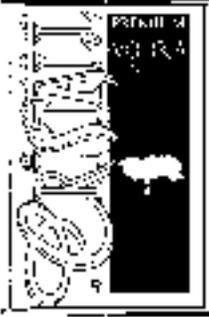
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|-------------------|---------|------------------|------------|
| U.S. Registration | 3061927 | Application Date | 01/28/2005 |
|-------------------|---------|------------------|------------|

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|---------------------|---|-----------------------|------|
| No. | | | |
| Registration Date | 02/28/2006 | Foreign Priority Date | NONE |
| Word Mark | CRISTALL LIMITED EDITION | | |
| Design Mark | CRISTALL LIMITED EDITION | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 2005/01/19 First Use In Commerce: 2005/01/19 alcoholic beverages, namely vodka | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3061926 | Application Date | 01/28/2005 |
| Registration Date | 02/28/2006 | Foreign Priority Date | NONE |
| Word Mark | CRISTALL SIGNATURE SERIES | | |
| Design Mark | CRISTALL SIGNATURE SERIES | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 2004/11/08 First Use In Commerce: 2004/11/08 alcoholic beverages, namely vodka | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2702794 | Application Date | 10/05/1998 |
| Registration Date | 04/01/2003 | Foreign Priority Date | NONE |
| Word Mark | CRISTALL LEMON TWIST | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1998/08/01 First Use In Commerce: 1998/08/01 alcoholic beverages, namely vodka | | |

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|-----------------------|----------------------|-----------------------|------------|
| U.S. Registration No. | 2603283 | Application Date | 10/05/1998 |
| Registration Date | 08/06/2002 | Foreign Priority Date | NONE |
| Word Mark | CRISTALL LEMON TWIST | | |

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| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 033. First use: First Use: 1998/08/01 First Use In Commerce: 1998/08/01 alcoholic beverages, namely, vodka |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2548695 | Application Date | 08/03/1998 |
| Registration Date | 03/19/2002 | Foreign Priority Date | NONE |
| Word Mark | CRISTALL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1997/02/15 First Use In Commerce: 1997/02/15 alcoholic beverages, namely vodka | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2770506 | Application Date | 01/02/1996 |
| Registration Date | 10/07/2003 | Foreign Priority Date | NONE |
| Word Mark | CRISTALL | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1995/06/03 First Use In Commerce: 1995/06/03 alcoholic beverages, namely vodka | | |

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|-----------------------|------------|------------------|------------|
| U.S. Registration No. | 2548656 | Application Date | 04/04/1997 |
| Registration Date | 03/19/2002 | Foreign Priority | NONE |

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|---------------------|--|------|--|
| | | Date | |
| Word Mark | ORIGINAL CRISTALL SIGNATURE SERIES MOSCOW | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1997/02/15 First Use In Commerce: 1997/02/15 alcoholic beverages, namely, vodka | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2770505 | Application Date | 11/16/1994 |
| Registration Date | 10/07/2003 | Foreign Priority Date | NONE |
| Word Mark | CRISTALL MOSCOW SIGNATURE SERIES | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1995/06/03 First Use In Commerce: 1995/06/03 alcoholic beverages, namely vodka | | |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2336937 | Application Date | 02/07/1995 |
| Registration Date | 04/04/2000 | Foreign Priority Date | NONE |
| Word Mark | CRISTALL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1990/05/00 First Use In Commerce: 1990/05/00 alcoholic beverages, namely, vodka | | |

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|-----------------------|------------|------------------|------------|
| U.S. Registration No. | 2301166 | Application Date | 02/22/1995 |
| Registration Date | 12/21/1999 | Foreign Priority | NONE |

| | | | |
|---------------------|--|------|--|
| | | Date | |
| Word Mark | CRISTALL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 1990/05/00 First Use In Commerce: 1990/05/00 alcoholic beverages, namely, vodka | | |

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| Attachments | 77627319#TMSN.gif (1 page)(bytes) 77420541#TMSN.jpeg (1 page)(bytes) 76679221#TMSN.gif (1 page)(bytes) 76629734#TMSN.gif (1 page)(bytes) 76629733#TMSN.gif (1 page)(bytes) 75564532#TMSN.gif (1 page)(bytes) 75529358#TMSN.gif (1 page)(bytes) 75269216#TMSN.gif (1 page)(bytes) 74631107#TMSN.gif (1 page)(bytes) 74637923#TMSN.gif (1 page)(bytes) 2009 11 17 Notice of Opposition.pdf (5 pages)(153340 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|------------------------|
| Signature | /s David L. Garrison / |
| Name | David Garrison |
| Date | 11/17/2009 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 79/064,457
For the Mark: ЧИСТЫЙ КРИСТАЛЛ
Date of Publication: September 22, 2009

CRISTALL U.S.A., Inc.

Opposer,

v.

EPLAXA LIMITED,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer, CRISTALL U.S.A., Inc., a corporation organized and existing under the laws of the State of Florida with a business address of 902 Clint Moore Rd., Suite 146, Boca Raton, Florida 33487 (hereinafter "Opposer"), believes it will be damaged by registration of the mark 79/064,457 in International Class 33, and hereby opposes the same.

As grounds of opposition, Opposer states as follows:

1. Applicant seeks to register the mark ЧИСТЫЙ КРИСТАЛЛ (hereinafter "Applicant's Mark") on the Principal Register for Alcoholic beverages, namely, vodka, brandy, gin, rum, spirits, liqueurs, bitters, whisky, digesters being liqueurs and spirits to be consumed after a meal; cocktails containing alcohol with the exception of wine, sparkling wine, and champagne-based cocktails; sake; hard cider in International Class 33 pursuant to the Madrid Protocol, 15 USC § 1141 et seq. as evidenced by the publication of said mark in the Notice of Publication under 12 (a) dated September 2, 2009.

2. On information and belief, Applicant is a corporation of the British Virgin Islands,

located at PO Box 3175 Road Town, Tortola, British Virgin Islands.

3. Opposer has acquired extensive rights, including a nationwide reputation for quality goods and other goodwill, in the trademarks “CRISTALL” and variations thereof, for alcoholic beverages namely vodka.

4. Opposer is the owner of the following U.S. Trademark Registrations:

| Reg # | Mark | Goods | Reg Date: | First Use: |
|-----------|---------------------------------------|--------------------------------------|-------------------------------|------------|
| 3,646,945 | CRISTALL | Distilled Spirits | 06/30/2009 | 06/03/1995 |
| 3,519,736 | CRISTALL + design | Alcoholic Beverages, Namely Vodka | 10/21/2008 | 02/01/2007 |
| 3,396,938 | STANDING TALL WITH CRISTALL | Alcoholic Beverages, Namely Vodka | 03/18/2008 | 02/26/2007 |
| 3,061,927 | CRISTALL LIMITED EDITION | Alcoholic Beverages, Namely Vodka | 02/28/2006 | 01/19/2005 |
| 3,061,926 | CRISTALL SIGNATURE SERIES | Alcoholic Beverages, Namely Vodka | 02/28/2006 | 11/08/2004 |
| 2,702,794 | CRISTALL LEMON TWIST | Alcoholic Beverages, Namely Vodka | 04/01/2003 (incontestable) | 08/01/1998 |
| 2,603,283 | CRISTALL LEMON TWIST | Alcoholic Beverages, Namely Vodka | 08/06/2002 (incontestable) | 08/01/1998 |
| 2,548,695 | CRISTALL + design | Alcoholic Beverages, Namely Vodka | 03/19/2002 (incontestable) | 02/15/1997 |
| 2,770,506 | CRISTALL | Alcoholic Beverages, Namely Vodka | 10/07/2003 (incontestable) | 06/03/1995 |
| 2,548,656 | CRISTALL SIGNATURE SERIES + design | Alcoholic Beverages, Namely Vodka | 03/19/2002 (incontestable) | 02/15/1997 |
| 2,770,505 | CRISTALL MOSCOW SIGNATURE SERIES | Alcoholic Beverages, Namely Vodka | 10/07/2003 (incontestable) | 06/03/1995 |
| 2,336,937 | CRISTALL | Alcoholic Beverages, Namely Vodka | 04/04/2000 (incontestable) | 05/00/1990 |
| 2,301,166 | CRISTALL + design | Alcoholic Beverages, Namely Vodka | 12/21/1999 (incontestable) | 05/00/1990 |

The registrations for Opposer's Marks are valid and subsisting and several of the registrations are incontestable under 15 USC § 1065.

5. There is no issue as to priority. Opposer has continuously used one or more of the Marks, or a derivative thereof, in connection with sale of vodka throughout the United States. Opposer or its predecessor in interest first used Marks anywhere at least as early as 1990. Opposer's predecessor in interest first used the Marks in U.S. Commerce as least as early as May 1990. Applicant has not begun use of the mark in the United States.

6. Opposer currently sells and offers for sale vodka marked with its trademarks throughout the United States. Applicant seeks registration under provisions of the Madrid Protocol without alleging use in the United States.

7. Opposer's predecessor in interest and supplier of premium Russian vodka, Moscow Distillery Cristall began selling CRISTALL vodka through Pepsico, Inc. in 1990. Many cases of STOLICHNAYA CRISTALL vodka were sold in the United States through Pepsico's distribution system, primarily its marketing arm Monseieur Henri. In 1995 Moscow Distillery Cristall terminated its relationship with Pepsico, established a distribution relationship with the Opposer and filed a complaint against Pepsico for trademark infringement, due to Pepsico obtaining counterfeit CRISTALL vodka from another Russian distillery. Moscow Distillery prevailed and the decision that it was the rightful owner of the CRISTALL trademark was affirmed by the Ninth Circuit Court of Appeals. See 1998 US App Lexis 4428, 4 USPQ 2d 1217 (9th CIR 1998).

8. Moscow Distillery CRISTALL is formally known as "Московский завод КРИСТАЛЛ". Moscow Distillery Cristall advertises widely over the internet, connecting the terms CRISTALL and КРИСТАЛЛ as its company name in english and cyrillic formats.

9. By virtue of Opposer and Opposer's predecessors in interest prior and widespread use of Opposer's Marks, the public has come to associate Opposer's marks with Opposer's goods in the alcoholic beverage industry. As a result of the association and recognition, Opposer has developed a valuable reputation in connection with Opposer's marks. Furthermore, by virtue of its efforts, the expenditure of considerable sums for promotional activities, and the highest quality of its goods, Opposer has acquired extensive goodwill in connection with Opposer's marks.

10. Since Opposer and its predecessors in interest commenced importation and sales of vodka in the United States in 1990, the trademark CRISTALL has been featured in numerous newspapers and magazine reviews and advertising publications with nationwide circulation. Opposer maintains a website featuring its trademarks CRISTALL and others which is widely consulted.

11. As set forth above, Applicant's mark is visually and phonetically similar to Opposer's marks. Applicant's goods are identical to Opposer's goods. Applicant targets a customer base very similar to that targeted by Opposer. Opposer's predecessor in interest and vodka supplier is known throughout the United States and internationally as Moscow Distillery Cristall and as Московский завод КРИСТАЛЛ.

12. Applicant's mark so resembles Opposer's mark as to be likely, when used in connection with the services set forth in Applicant's application, to cause confusion, mistake, or deception with the meaning of Section 2(d) of the Trademark Act.

13. If the Applicant is permitted to use and register its marks for its services, as specified in the application herein opposed, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between the Applicant's mark and Opposer's marks. Persons familiar with Opposer's marks would likely to purchase

Applicant's goods believing that such goods originate from, are associated with, or are sponsored by Opposer, thereby enabling Applicant to misappropriate and unfairly trade upon Opposer's valuable goodwill and reputation in Opposer's marks to the perils and hazards arising out of Applicant's business activities, over which Opposer has no control.

14. Furthermore, any defect, objection or fault found with Applicant's products to be marked under its mark would necessarily reflect upon and seriously injure the reputation which Opposer has established for its quality goods marked under and sold under Opposer's marks. Thus the grant of a registration to Applicant for Applicant's mark would create statutory rights in Applicant in violation of the established prior rights of Opposer in Opposer's marks, and will damage Opposer's reputation and goodwill in Opposer's marks.

WHEREFORE, Opposer prays that this Opposition be sustained and that registration to Applicant be refused.

Pursuant to 37 C.F.R. § 2.6(a)(17), the statutory Notice of Opposition Filing Fee of \$300.00 will be paid via the ESTTA credit card form.

Dated this 16th day of November 2009.



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