

IN THE MATTER OF AN OPPOSITION by Tiffany & Co. to
application No. 581,900 for the trade-mark TIFFANY CORNERS
filed by Edenborough Limited

On April 8, 1987, the applicant, Edenborough Limited, filed an application to register the trade-mark TIFFANY CORNERS based upon use of the trade-mark in Canada in association with "self adhesive appliquéés for windows, doors, mirrors and cabinets" since at least as early as October 28, 1986.

The opponent, Tiffany & Co., filed a statement of opposition on February 23, 1988 in which it alleged that the applicant's trade-mark is not registrable in that the trade-mark TIFFANY CORNERS is confusing with the opponent's registered trade-mark TIFFANY, registration No. 265,617 and with the opponent's corporate name Tiffany & Co. The opponent further alleged that the applicant is not the person entitled to registration of the trade-mark TIFFANY CORNERS in that the applicant's trade-mark is confusing with the opponent's previously used registered trade-mark TIFFANY and its trade-name Tiffany & Co. Finally, the opponent alleged that the applicant's trade-mark is not distinctive.

The applicant served and filed a counterstatement in which it denied the allegations of confusion set forth in the opponent's statement of opposition.

The opponent filed as its evidence the affidavit of Francine Gilberto, two statutory declarations of Sandra J. Boettcher, dated November 4 and December 2, 1988 and two affidavits of Catherine Anne Allan, dated November 2 and November 7, 1988. The applicant submitted as its evidence the affidavit of Diane L. Way.

Both parties filed written arguments and both were represented at an oral hearing.

The opponent's first ground of opposition is based on s. 12(1)(d) of the Trade-marks Act, the opponent asserting that there would be a likelihood of confusion between its registered trade-mark TIFFANY, registration No. 265,617 and the applicant's trade-mark TIFFANY CORNERS as applied to the wares covered in the applicant's application. In determining whether there would be a likelihood of confusion between the trade-marks at issue as of the date of opposition, the material date in respect of the s. 12(1)(d) ground of opposition, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion.

With respect to the inherent distinctiveness of the trade-marks at issue, the trade-mark TIFFANY does possess a surname significance, as was pointed out in the first Boettcher statutory declaration, as well as being a given name, as confirmed by the following dictionary definitions of the words "tiffany", Tiffany" and "Tiffany glass":

In The Houghton Mifflin Canadian Dictionary of the English Language, the following appears:

Tiffany Louis Comfort, 1848-1933. American painter, stained-glass artist, and glass manufacturer.

tiffany A thin, transparent gauze of silk or cotton muslin.

Tiffany glass Stained or iridescent glass of a kind popular in the early 1900's for decorative objects or lamps.

The Funk & Wagnalls Standard College Dictionary includes the following definitions:

tiffany 1. A very thin transparent cotton gauze. 2. Formerly, a very thin silk.

Tiffany glass Decorative glassware usually having a lustrous, iridescent surface.

The Random House Dictionary of the English Language The Unabridged Edition includes the following definitions:

tiffany a sheer, mesh fabric constructed in plain weave, originally made of silk but now often made of cotton and man-made fibers.

Tiffany 1. Charles Lewis, 1812-1902, U.S. jeweler. 2. his son Louis Comfort, 1848-1933, U.S. painter and decorator, especially of glass. 3. a boy's or girl's given name.

Tiffany glass See Favrite glass. [named after C.L.Tiffany]

In The Shorter Oxford English Dictionary, the following definitions appear:

Tiffany 1. the festival of the Epiphany or Twelfth Day. 2. A kind of thin transparent silk; also, a transparent gauze muslin, cobwebs lawn. b. An article made of tiffany, as a head-dress, a sieve, etc.

Finally, Webster's Third New International Dictionary includes the following definitions:

tiffany \.. \ n -ES [...] **1:** any of several very thin transparent textiles: as **a:** a sheer silk gauze formerly used for clothing or trimmings **b:** a plain-weave open-mesh cotton fabric (as cheesecloth) **2:** an article (as a sieve) made of tiffany

tiffany \ " \ adj : DELICATE, FILMY, FRAGILE <a tiffany- winged fly>

tiffany \ " \ adj, usu cap [after Charles L Tiffany 1902 Am. jeweler] of a jewelry setting: having long prongs to hold a gem

tiffany \ " \ adj, usu cap [after Louis C. Tiffany 1933 Am. artist] : exhibiting or characterized by irregular areas of translucent blended color due to the use of a glazed liquid over a suitably painted surface (as of a wall) <a Tiffany effect> <the popularity of Tiffany finishes>

tiffany glass n, usu cap T [after L.C.Tiffany]: American glassware made in the late 19th and early 20th century and often characterized by an iridescent surface

The Preface to Webster's Third New International Dictionary includes a form of disclaimer which provides that no investigation has been made of common law trade-mark rights in any words although words which are believed to be trade-marks "have been investigated in the files of the United States Patent Office" and those which "have current registrations are shown with an initial capital and are also identified as trademarks". Based on this statement, the opponent submitted that Exhibit "B" to the Way affidavit is of no significance in this opposition. However, there is no reason to assume that the above definitions in Webster's Dictionary are not accurate, nor has the opponent indicated that it has objected to the inclusion in Webster's Third New International Dictionary of any of the definitions noted above, even after the applicant submitted evidence of the definitions as an exhibit to the Way affidavit. As a result, and as the inclusion of the definitions of the words "tiffany" or "tiffany glass" in the dictionary generally reflects the public perception as to their meaning, I consider that I can have regard to the definitions in Webster's Dictionary as set forth above.

Having regard to the above and, in particular, to the surname and given name significances of the word "Tiffany", I have concluded that the opponent's trade-mark TIFFANY possesses little inherent distinctiveness. On the other hand, the applicant's trade-mark TIFFANY CORNERS as applied to self adhesive appliquéés possesses some measure of inherent distinctiveness when considered in its entirety.

As to the extent to which the trade-marks have become known, the only evidence relating to any reputation associated with the applicant's trade-mark in Canada is Exhibit "E" to the Way affidavit. However, Exhibit "E", which is identified as an advertising flyer of the applicant, is hearsay with respect to the affiant Way and is therefore not admissible evidence insofar as establishing the truth of its contents. In any event, the existence of the flyer must be considered as of the date of the Way affidavit which is subsequent to the date of opposition, the material date in respect of the s. 12(1)(d) ground of opposition. Accordingly, the applicant's trade-mark must be considered as not having become known to any extent in Canada as of that date.

The opponent submitted evidence relating to purchases made by Canadians through the opponent's mail order service or at its retail store located in the United States. This evidence establishes that the opponent's trade-mark had become known to some extent in Canada in association with various high quality products for household use and personal adornment. In this regard, paragraph 13 of the first Boettcher statutory declaration evidences approximately \$35,000

in shipments by the opponent to clients in Canada from 1977 to 1987 and appears to indicate that total charges by Canadian charge account holders from 1984 to 1988 were approximately \$630,000. Neither of the amounts has been shown to represent a significant number of sales, having regard to the prices of the opponent's wares as set forth in its various catalogues. Further, the opponent's evidence of advertising in Canada appears to be based on Audit Bureau Circulation Statements which are hearsay with respect to the Ms. Boettcher. In any event, the distribution of the opponent's catalogues to at most 200 card holders in Canada does not establish that the opponent's mark had become known to any significant extent in Canada.

The length of time that the trade-marks have been in use does favour the opponent in this opposition, having regard to the evidence of use submitted by way of the first Boettcher statutory declaration and the Gilberto affidavit.

In assessing the issue of confusion between the trade-marks of the parties in respect of a s. 12(1)(d) ground of opposition, the Registrar must consider the wares as set forth in the applicant's application and the opponent's registration and the channels of trade that the average consumer would consider as normally being associated with such wares (see Mr. Submarine Ltd. v. Amandista Investments Ltd., 19 C.P.R. (3d) 3, at pages 10-12 (F.C.A.)). Thus, the fact that the applicant may have been using its trade-mark TIFFANY CORNERS in association with wares manufactured from stained glass is of little relevance, bearing in mind that it is the wares covered in the applicant's application as opposed to the wares associated with the applicant's trade-mark as it has been used in the marketplace which determine the scope of the monopoly which would be accorded the applicant should its trade-mark proceed to registration. Indeed, in its written argument, the applicant submitted:

"As will be apparent from Exhibit "E" to the Way affidavit, the applicant's wares are also manufactured from stained glass, and the adoption of the generic term "tiffany" is allusive to their being of stained glass.

The applicant has already proposed to the opponent a settlement under which it would restrict its statement of wares to "self adhesive stained glass appliques for windows, doors, mirrors and cabinets", and insert a disclaimer in respect of the word "tiffany", and the applicant remains willing to restrict its statement of wares in this manner."

Having regard to the applicant's submission, it is clear that the applicant's statement of wares is not limited to its appliques being of stained glass. Further, I am not prepared to infer that the trade-mark TIFFANY CORNERS when applied to self adhesive appliques would immediately lead the average consumer to conclude that the appliques would only be made of stained glass. Further, I consider the applicant's reference to its alleged attempt to settle this opposition to be quite inappropriate. While

the applicant did not file evidence of its alleged offer of settlement or the opponent's response to that offer, I am of the view that reference by the applicant to such matters even in its written argument was only made with the view to embarrassing the opponent. I would, in this regard, note the following comments of the Acting Registrar of Trade-marks in Mothercare Ltd. v. "Precious Secret" Maternity Inc., 27 C.P.R. (2d) 171, at pages 174-175:

The applicant's wares, namely, self adhesive appliquéés for windows, doors, mirrors and cabinets appear to be decorative items intended for household use. Likewise, a number of the opponent's wares covered by its registration are for household use and some also appear to be decorative in nature, such as ornamental sculptures, table centre pieces, vases, candle-sticks, paper weights, book ends, desk sets and pen stands. As a result, and while the wares of the parties differ, I consider there to be at least some degree of similarity in the general nature of the wares of the applicant and certain of the wares covered in the opponent's registration. Further, to the extent that there is some resemblance in the general nature of the wares of the parties, there might well be a

potential overlap in the channels of trade through which these wares could travel to the public.

As to the degree of resemblance between the trade-marks at issue, the trade-marks TIFFANY and TIFFANY CORNERS are quite similar in sounding and appearance and, indeed, the applicant's trade-mark includes as the first word thereof the entirety of the opponent's registered trade-mark.

Having regard to the above, I have concluded that the applicant has failed to discharge the burden upon it of establishing that there would be no reasonable likelihood of confusion between the trade-marks of the parties. Accordingly, the applicant's trade-mark TIFFANY CORNERS is not registrable in view of the provisions of s. 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to s. 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF December, 1990.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.