

IN THE MATTER OF AN OPPOSITION by Tiffany and Company to application No. 689,588 for the trade-mark THE TIFFANY COLLECTION filed by Akard Enterprises Ltd., and presently standing in the name of Signature Vacations Inc./ Vacances Signature Inc.

On September 17, 1991, the applicant, Akard Enterprises Ltd., filed an application to register the trade-mark THE TIFFANY COLLECTION based upon proposed use of the trade-mark in Canada in association with "travel services, namely, the organization of travel cruises". During the opposition, the applicant changed its name to Signature Vacations Inc./ Vacances Signature Inc.

The opponent, Tiffany and Company, filed a statement of opposition on September 18, 1992, a copy of which was forwarded to the applicant on November 23, 1992. As its first ground, the opponent alleged that the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the *Trade-marks Act* in that the trade-mark THE TIFFANY COLLECTION is confusing with the following registered trade-marks:

| <u>Trade-mark</u> | <u>Registration No.</u> |
|-------------------|-------------------------|
| TIFFANY & CO. | TMDA 29478 |
| TIFFANY & CO. | TMDA 30447 |
| TIFFANY & CO. | TMDA 30902 |
| TIFFANY & CO. | TMDA 30903 |
| TIFFANY & CO. | TMDA 30904 |
| TIFFANY & CO. | TMDA 30905 |
| TIFFANY Design | 258,309 |
| TIFFANY | 265,617 |
| TIFFANY | 310,199 |

As its second ground, the opponent alleged that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the trade-mark THE TIFFANY COLLECTION was confusing with the opponent's trade-marks and its trade-names, Tiffany and Company and Tiffany & Co., which had been previously used or made known in Canada, and had not been abandoned as of the date of advertisement of the present application. The opponent's third ground

is based on Section 16(3)(b) of the *Trade-marks Act*, the opponent alleging that the applicant is not the person entitled to registration in that, as of the filing date of the present application, the trade-mark THE TIFFANY COLLECTION was confusing with the opponent's previously-filed trade-mark application Nos.685,931 and 685,934 for the trade-marks TIFFANY & CO. Design and 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 affidavits of Janet Ozembloski, Robert W. White and Michael J. Kowalski while the applicant submitted as its evidence the affidavits of Robert William Sterling and Vanessa Lee.

The opponent alone submitted a written argument and neither party requested an oral hearing.

With respect to the ground of opposition based on Section 12(1)(d) of the *Trade-marks Act*, the material date is the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (FCA)]. Further, the material date for determining the non-distinctiveness ground of opposition is as of the date of opposition [September 18, 1992] while the material date for considering the non-entitlement ground is as of the filing date of the applicant's application [September 17, 1991]. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks and trade-names at issue, the Registrar must have regard to all the surrounding circumstances including, but not limited to, the criteria which are specifically enumerated in Section 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the applicant's trade-mark THE TIFFANY COLLECTION and one, or more, of the opponent's trade-marks and trade-names.

The opponent's first ground is based on Section 12(1)(d) of the *Trade-marks Act*, the opponent asserting that there would be a reasonable likelihood of confusion between the applicant's

trade-mark THE TIFFANY COLLECTION and one, or more, of its registered trade-marks identified above. While the opponent has not filed copies of its registrations as evidence, the Registrar does have the discretion to check the register in order to confirm the existence of the registrations relied upon by the opponent [see *Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410). In doing so, I noted that the registrations relied upon by the opponent are still in force and stand in the name of Tiffany & Company. Further, six of the registrations relied upon by the opponent were granted under the *Trade Mark and Design Act*, R.S.C. 1927, c. 201, and, as such, must be considered as a word mark or a design mark in accordance with the rules set forth in Section 27(2)(c) of the *Trade-marks Act* which provides as follows:

(2) Trade-marks on the register on September 1, 1932 shall be treated as design marks or word marks as defined in the *Unfair Competition Act*, chapter 274 of the Revised Statutes of Canada, 1952, according to the following rules:

(c) any trade-mark including words or numerals or both in combination with other features shall be deemed

(i) to be a design mark having the features described in the application therefor but without any meaning being attributed to the words or numerals, and

(ii) to be a word mark if and so far as it would at the date of registration have been registrable independently of any defined form or appearance and without being combined with any other feature;

Applying the above rules to the opponent's registrations, it would appear that the words "TIFFANY & CO." would have been independently registrable under the *Trade Mark and Design Act*. As a result, the six registrations will be treated as word marks covering the trade-mark TIFFANY & CO. as applied to the wares and services identified in the registrations in assessing the issue of confusion in this proceeding. In any event, the most relevant of the registered trade-marks relied upon by the opponent is its registered trade-mark TIFFANY, registration No. 265,617. Accordingly, the determination of the issue of confusion between the applicant's trade-mark THE TIFFANY COLLECTION as applied to 'organization of travel cruises' and the opponent's registered trade-mark TIFFANY as applied to the wares and services covered in the registration will effectively decide the Section 12(1)(d) grounds of opposition.

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 Kowalski affidavit, 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 [...] **I**: 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". However, there is no reason to assume that the above definitions in Webster's Dictionary are not accurate. 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 significance 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 THE TIFFANY COLLECTION as applied to the organization of travel cruises possesses at least some measure of inherent distinctiveness when considered in its entirety, despite the surname and given name significance of the element TIFFANY.

The Lee affidavit establishes that the applicant's trade-mark THE TIFFANY COLLECTION has become known to some extent in Canada in association with the organization of travel cruises. The Kowalski affidavit provides evidence relating to the extent to which the opponent's trade-marks have become known in Canada. In particular, Mr. Kowalski has submitted evidence relating to purchases made by Canadians through the opponent's mail order service, as well as providing details

relating to the distribution in Canada of the opponent's catalogues and brochures. Also, Mr. Kowalski has pointed out that the opponent opened its first store in Canada on November 15, 1991 and has provided copies of several articles appearing in Canadian publications relating to the opening commencing in April of 1991. According to Mr. Kowalski, total sales in the opponent's store from November of 1991 to the end of January of 1993 exceeded \$6,700,000. Further, the Kowalski affidavit establishes that total charges by Canadian charge account holders from 1984 to 1988 were approximately \$630,000. As a result, the opponent's evidence establishes that its trade-mark TIFFANY has become known in Canada in association with various high quality products for household use and personal adornment.

The length of time that the trade-marks have been in use clearly favours the opponent in this opposition, having regard to the evidence of use of the trade-mark TIFFANY submitted by way of the Kowalski affidavit.

In assessing the issue of confusion between the trade-marks of the parties in respect of a Section 12(1)(d) ground of opposition, the Registrar must consider the services as set forth in the applicant's application and the wares and services covered in the opponent's registration and the channels of trade that the average consumer would consider as normally being associated with such wares and services [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.*, 19 C.P.R. (3d) 3, at pages 10-12 (F.C.A.)]. In this regard, the applicant's organization of travel cruises bear no similarity to any of the wares or services covered in any of the opponent's registration. Moreover, I would not expect there to be any similarity in the channels of trade of the parties.

As to the degree of resemblance between the trade-marks at issue, the trade-marks TIFFANY and THE TIFFANY COLLECTION are similar in appearance, sounding, and in the ideas suggested by them, the applicant's trade-mark including the entirety of the opponent's registered trade-mark.

As a further surrounding circumstance in assessing the issue of confusion, the applicant submitted evidence of the state of the register by way of the Sterling affidavit. However, the state of the register disclosed the existence of only eight registrations including the word TIFFANY, one

of which has since been expunged from the register. Having regard to the limited number of registrations disclosed by the search, I am not prepared to draw any inferences concerning the possible use of any of these marks in the marketplace.

As yet a further surrounding circumstance in assessing the issue of confusion, the opponent has pointed to the manner of use by the applicant of its trade-mark THE TIFFANY COLLECTION in certain of the exhibits to the Lee affidavit. In particular, at page 15 of its written argument, the opponent submits the following:

'The strong resemblances are also enhanced by the fact that the Applicant often prints the Proposed Mark so that the word **TIFFANY** is many times larger than the other components of the mark, and is clearly predominant (see page 12 of both Exhibits B and C to the Lee affidavit). The particular script style used for the word TIFFANY almost exactly replicates that of the Opponent's Reg. No. 258,309...'

I agree with the opponent's submission and have set out below a representation of the manner in which the applicant has used its trade-mark THE TIFFANY COLLECTION, as well as the trade-mark covered by trade-mark registration No. 258,309.

Representation of manner of use
Applicant's mark

Reg. No. 258,309

Apart from the above, and as yet a further surrounding circumstance in respect of the assessment of the issue of confusion, the opponent has submitted evidence of its frequent use of the combination TIFFANY and COLLECTION including its use of such phrases as: 'Tiffany's extraordinary collection'; 'the Tiffany's Classics Collection'; 'the Tiffany Private Stock collection' and 'Tiffany's exclusive collection'.

Having regard to the above, and even bearing in mind that the applicant's services differ from the opponent's wares and services, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between the applicant's trade-mark THE TIFFANY COLLECTION and the opponent's registered trade-mark TIFFANY. Accordingly, the applicant's trade-mark THE TIFFANY COLLECTION is not registrable in view of the provisions of Section 12(1)(d) of the *Trade-marks Act*.

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I refuse the applicant's applicant pursuant to Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 28th DAY OF JUNE, 1996.

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