

TRADE MARKS ACT, 1963

Decision in Hearing under Section 26

IN THE MATTER OF an application for registration of Trade Mark No. 161234 and in the matter of an Opposition thereto.

EMBALLAGES MIXTES ET PLASTIQUES

Applicant

TIFFANY AND COMPANY

Opponent

The application

1. On 15 April, 1992, EMBALLAGES MIXTES ET PLASTIQUES, a limited liability company organised and existing under the laws of France, of 20, Boulevard Montalembert, 59650 Villeneuve d'Ascq, France, Manufacturers and Merchants, made application (No. 92/2201) to register the word "TIFANY" as a Trade Mark in Part A of the Register in Class 16 in respect of the following goods:

“Paper, cardboard, articles of paper or of cardboard, (not included in other classes);
printed matter, books, brochures.”

2. The Application was subsequently advertised as accepted for registration in Part A of the Register under No. 161234 in Journal No. 1763 on 28 June, 1995.
3. Notice of Opposition to the registration of the mark pursuant to Section 26 of the Act was filed on 11 October, 1995 by TIFFANY AND COMPANY, a Corporation organised and existing under the laws of the State of New York, United States of America, of 727 Fifth Avenue, New York, 10022, United States of America. The Applicant filed a counter-statement on 29 December, 1995 and evidence was subsequently filed by the parties under Rules 37 and 38 of the Trade Mark Rules, 1963.

4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 23 January, 2004. The parties were notified on 11 March, 2004 that I had decided to uphold the opposition and to refuse registration of the mark. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of Opposition

5. In its Notice of Opposition the Opponent cites a number of facts and grounds of opposition, which may be summarised as follows:

- (i) The Opponent is a well-known manufacturer and vendor of high quality products and is the proprietor of a number of trade mark registrations for the marks TIFFANY and TIFFANY & CO. for goods in classes 3, 14 and 21.
- (ii) The Opponent's marks are amongst the most famous in the world for jewellery, engraved stationery, watches, high quality cutlery, crystal bowls, chinaware and other products.
- (iii) In view of the Opponent's extensive reputation under its marks and the high degree of similarity between those marks and the mark that the Applicant seeks to register, there is a likelihood of confusion between the marks and registration is prohibited under both Section 19 and Section 20 of the Act.
- (iv) The Applicant is not the *bona fide* proprietor of the mark sought to be registered and nor does it use or propose to use that mark. Registration would, therefore, be contrary to the provisions of Sections 2 and 25 of the Act.
- (v) The mark propounded for registration is neither adapted to distinguish nor capable of distinguishing the Applicant's goods and does not qualify for registration under either Section 17 or Section 18 of the Act.
- (vi) The mark as applied for offends against the provisions of Council Directive 89/104 EEC to approximate the laws of Member States relating to Trade Marks.
- (vii) Registration of the mark in favour of the Applicant would prejudice and embarrass the Opponent in the conduct of its business.

Counter-statement

6. In its Counter-Statement the Applicant denies all of the grounds of opposition contained in the Notice of Opposition, admitting only the Opponents' proprietorship of the Irish trade mark registrations referred to therein.

The evidence

Rule 37

7. Evidence submitted by the Opponent under Rule 37 consisted of an Affidavit (and Exhibits 1-40) dated 3 July, 1996 of Tarz F. Palomba, Assistant Secretary of Tiffany and Company. In a long and detailed statement, Mr. Palomba recounts the background and history of the Opponent from its origins as a "stationery and fancy goods" store opened in New York in 1837 by its founder Charles Lewis Tiffany to its present day status as one of the world's leading jewellers. The Opponent's business now consists of the design, manufacture and sale of collections of high quality luxury consumer items for personal and household use and the provision of services relating thereto. Mr. Palomba gives evidence as to the fame that attaches to the trade mark TIFFANY, which has been acknowledged in a number of publications and court judgements as amongst the most well-known in the world, alongside such marks as ROLLS ROYCE, POLAROID and KODAK. He places particular emphasis on the fact that the Opponent has traded for more than 150 years in items of stationery including high quality engraved cards, envelopes and paper, which goods fall within the specification of the opposed application. Since its beginnings in the 19th century, the Opponent has expanded both in the United States and internationally and now operates retail outlets in countries throughout the world, including a number of European countries. Advertising of goods bearing the TIFFANY mark has occurred in a number of publications that enjoy international circulation and worldwide sales of goods run to hundreds of millions of dollars (US).

Rule 38

8. Evidence submitted by the Applicant under Rule 38 consisted of a Statutory Declaration (and Exhibits T1-T5), made on 6 January, 1997 by Marc Glorieux, Secrétaire Général of Emballages Mixtes et Plastiques. Mr. Glorieux states that the Applicant has used the trade mark TIFANY in Ireland since 1983 and that

goods bearing the mark have been sold through outlets of the large retail chains, Quinnsworth, Dunnes Stores and SuperValu; he exhibits invoices bearing dates between 1983 and 1996. Mr. Glorieux exhibits brochures showing some of the goods on which the mark is used and the manner of that use. The goods in question are disposable paper or plastic plates and cups as well as serviettes. The mark is represented in a somewhat stylised form of writing and in lower case lettering. Total turnover of goods under the mark in Ireland is stated to be £97,000 with advertising expenditure running at approximately 5% of turnover. Mr. Glorieux states that the Applicant has secured international registrations of the mark TIFANY in respect of goods in Classes 8, 16, 21 and 24 and he exhibits copies. He also exhibits the result of a search of the Irish Register showing a number of existing registrations of marks consisting of or containing the word “Tiffany” that have been registered in the names of proprietors other than the present Opponent; this, he says, is evidence that the Opponent does not enjoy exclusive rights in that word and that marks consisting of or containing it co-exist without confusion.

The hearing

9. At the Hearing the Opponent was represented by Brian O’Moore, SC instructed by Tomkins & Co., Trade Mark Agents and the Applicant by Denis McDonald, SC instructed by F.R. Kelly & Co., Trade Mark Agents. Both Counsel provided me with written outlines of their submissions, which I found to be very helpful when making my decision in this matter and for which I am grateful to Counsel. Of the grounds stated in the Notice of Opposition, Mr. O’Moore canvassed only those under Sections 19 and 20 of the Act and I am satisfied that my consideration of the matter may be confined to those Sections only. A decision in favour of the Opponent under either of those Sections determines the matter and obviates the need for a decision under the other but I have considered the opposition under each Section separately so that, in the event of a possible appeal, any matter that could have been addressed at this stage will have been.

Preliminary matter

10. At the hearing, Mr. McDonald, for the Applicant, sought to introduce in evidence a copy of an extract from the Official Journal of the Patents Office from 1929,

(Journal No. 46), which contained an entry concerning the registration of the mark TIFFANY & CO. in respect of various goods that would now fall within Class 16 (then in Class 1) and made in the name of the present Opponent. As the registration in question is not now extant, Mr. McDonald sought to argue that, whatever interest the Opponent might at one time have had in the protection of its trade mark in respect of goods in Class 16, that interest had not been maintained and the Opponent could not now object to the registration of the Applicant's mark in respect of such goods. Mr. O'Moore objected to the admission in evidence of the Journal extract on the basis that he had not been given any notice of it and had not had an opportunity to take instructions on the issue raised. Having heard both sides on the matter, I take the view that the Official Journal is a publication of the Controller and is, therefore, already known to the Controller. To that extent, the question of whether or not the particular extract in question here is admissible in evidence in these proceedings does not arise. Mr. McDonald could have made his argument on the point simply by referring to the contents of the relevant Journal and he could not have been denied the right to make that argument for the sole reason that the relevant extract was not in the evidence, as such. As to the argument itself, it is, in my view, based on conjecture as to the motives of the Opponent in not maintaining a registration secured more than seventy years ago. There could be any number of reasons why that registration no longer exists and I am not prepared to speculate on the matter or to draw the inference suggested by the Applicant. The simple fact is that the Opponent does not currently hold a registration in Class 16; the fact that it once did is immaterial to the matters at issue in the present proceedings.

The issues

Section 19 – would the mark be disentitled to protection in a court of law?

11. Section 19 of the Act reads as follows:

“It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design.”

12. The Opponent says that it has an international reputation under its trade marks TIFFANY and TIFFANY & CO. That reputation is so great that it is inevitable that it has spilled over into this jurisdiction. In addition, the Opponent has sold goods to customers in the State, albeit to a limited extent. As a consequence, the use by the Applicant of the mark propounded for registration in relation to the goods of the application will cause consumers to believe that the goods so marked emanate from the Opponent or, at least, to wonder whether that might not be the case. Thus there will be deception and/or confusion in the minds of the public of the kind that constitutes a basis for mandatory refusal of an application for registration under Section 19.

13. The Applicant responds, firstly, that the Opponent's marks have not been proven to have sufficient reputation here to ground an objection to registration under Section 19 but that, even if it is admitted that those marks are internationally well-known, they are used in relation to goods that are sufficiently different from those of the present application to obviate the possibility of any confusion arising. Nor has any evidence of actual confusion been adduced on behalf of the Opponent notwithstanding that the Applicant's mark has been used here for several years prior to the date of the present application and since then.

The fame of the Opponent's marks

14. The first thing that I have considered in assessing the opposition under Section 19 is the extent of the recognition, if any, that the Opponent's marks enjoy in this jurisdiction. The standard test for an objection under Section 19, (as set down by Evershed J in the *Smith Hayden & Co. Ltd.* application [1946] RPC 97, and adapted by Lord Upjohn in the *Bali* case [1969] RPC 472), requires, first of all, that there be an existing "*user of the Opponent's marks*". At the hearing, Mr. O'Moore, while not abandoning the Opponent's claim to have directly used their marks here, relied on the decision of the Court of Appeal of New Zealand in *Pioneer Hi-Bred Corn Co. v Hy-Line Chicks Pty. Ltd* [1979] RPC [No. 19] 410 to argue that Section 19 also has application in situations where there is a public awareness of the Opponent's mark notwithstanding that there may have been no direct use of it in the market here. So, for example, a mark of a foreign trader may become known in this jurisdiction through extensive advertising in publications

that circulate here or through other means not involving the sale of goods under the mark here and that public knowledge of the mark, if proven, will be sufficient to ground an opposition under Section 19 to registration of the mark in the name of another entity. There is a significant difference in the language of Section 16 of the New Zealand Trade Marks Act, 1953, which was the basis for the decision in the *HY-LINE* case, and that of Section 19 of our Act (and its equivalent in the UK, Section 11 of the Trade Marks Act, 1938) but Mr. McDonald did not object to the adoption of the New Zealand case as a precedent and I understood him to accept that Section 19 could be invoked if the relevant public is sufficiently aware of the Opponent's mark, regardless of how that awareness has come about.

15. The Affidavit and Exhibits of Tarz F. Palomba filed on behalf of the Opponent are replete with evidence of the fame that the Opponent's marks enjoy internationally. There are articles about the Opponent from publications throughout the world, evidence of advertising in publications that circulate internationally and evidence of sales on a massive scale. In a number of judgements of foreign courts and tribunals and in academic papers, the Opponent's marks have been recognised as among the most famous in the world. The fame of the Opponent's name has extended beyond the realm of trade and commerce alone through its inclusion in the title of the Truman Capote novel, *Breakfast at Tiffany's*, subsequently made into a film starring Audrey Hepburn, which became very famous in its own right. On the whole, I think that the Opponent's evidence is confirmatory of the fact (which I would have thought to be true on the basis of my own knowledge and experience alone) that the marks TIFFANY and TIFFANY & CO. have achieved worldwide recognition. There is no concrete third party evidence, in the form of a survey, for example, to prove that the fame of those marks extends to Ireland and Irish consumers but I think it would be wrong to hold against the Opponent on the point for this reason alone. The circumstantial evidence is overwhelming and I see no reason to conclude that Irish consumers have been somehow insulated from the worldwide exposure and recognition that the Opponent's marks have achieved.

The Opponent's goods

16. Public awareness and recognition of the Opponent's marks may not be enough, of itself, to ground an opposition under Section 19 in all cases. Trade marks do not exist in a vacuum; they are, rather, perceived in relation to specific goods and it is always necessary to consider the extent to which the respective goods of the parties are similar when assessing the likelihood of confusion between marks. In the present case and having regard to the fact that the opposition under section 19 is based more on the fame of the Opponent's marks than on any substantial use of them here, it is necessary to ask what are the goods for which those marks are famous before a valid comparison of the goods of the parties may be undertaken. While I have accepted the evidence as proving that the Opponent's marks are famous throughout the world, I think it is open to interpretation as to what goods, precisely, those marks are famous for. For my own part, I would have associated "*Tiffany*" primarily with diamonds and I think that diamond jewellery is probably the core business of the Opponent or the line for which it is best known. However, the evidence shows that the Opponent has traded in stationery items and "fancy goods" generally right from its origins in the middle of the nineteenth century and that it also produces a range of booklets and other publications as well as a mail order catalogue under its marks. Looking at the evidence in its totality, I think that the following excerpt from the September, 1987 issue of "French Vogue Decoration", quoted in the Palomba Affidavit, may constitute a fair statement of what the Opponent's name has come to connote.

"To those who do not know precisely what Tiffany is, it is a name which suggests refinement and elegance, a sophistication and a particular luxury."

17. That statement is, of course, more helpful in identifying the qualities that the purchasing public might expect of goods bearing the Opponent's marks than in specifying the nature of the goods in question. Rather than trying to settle on an exhaustive list of the types of goods that the public here would be likely to associate with the Opponent's marks, I think it is sufficient for the purposes of the present proceedings to decide whether the public might not associate them with goods of the kind covered by the contested application for registration, viz., paper, cardboard, articles of paper or of cardboard (not included in other classes); printed

matter, books and brochures. The evidence shows that the Opponent trades in goods falling within that description and I have accepted the evidence as proving that the Opponent's marks are very well known. In the circumstances, it does not seem realistic to infer otherwise than that the public awareness of the marks themselves would translate into a public expectation of use of the marks in relation to goods of the type in question and, specifically, in relation to high-quality or luxury goods of that type.

The respective marks

18. The marks on which the Opponent bases its opposition are TIFFANY and TIFFANY & CO. The mark for which registration is sought is TIFANY. That mark so closely resembles the Opponent's TIFFANY as to be almost identical to it. It is also highly similar to TIFFANY & CO., of which TIFFANY is clearly the dominant element.

The likelihood of deception or confusion

19. Having found that the Opponent has the requisite reputation under its marks to ground an opposition under Section 19 and having regard to the high degree of similarity between the marks of the parties, I consider that the onus is on the Applicant to show that the use of its marks in relation to the goods of the application will not be reasonably likely to deceive or cause confusion. The Applicant relies to a considerable extent in making its argument on this question on the fact that its goods have been sold here and in other jurisdictions where the Opponent is just as likely to be known without any deception or confusion having arisen. The Applicant says that one of the important reasons for this is that it is not a competitor of the Opponent and its goods are aimed at an entirely different market and are retailed through entirely different trade channels to those of the Opponent. At one level, this is a persuasive argument and I cannot believe that a person who finds a packet of paper plates or serviettes on a supermarket shelf bearing the Applicant's mark in its stylised lettering could entertain any reasonable doubt that those goods might emanate from, or be in any way associated with, the Opponent.

20. Unfortunately for the Applicant, that is not determinative of the merits of the opposition to the present application. Most of the goods in relation to which the Applicant's mark has been shown (in its own evidence) to have been used are not, in fact, goods falling within the specification of this application. The application specifically excludes articles made of paper that are included in Classes other than Class 16. Thus, paper plates and cups, which would be included in Class 21, are not embraced by this application and the Applicant's use of the mark propounded for registration in relation to such goods is not the yardstick by which a likelihood of confusion arising from the use of the mark as applied for should be measured. That assessment requires consideration, rather, of a normal and fair use of the mark as a trade mark for the goods of the application. That would include the use of the mark in ordinary upper case lettering as applied for by the Applicant and would include its use in relation to items of stationery, including greeting cards, envelopes, writing paper, etc. Nor is it to be assumed that the goods offered for sale under the mark will be aimed at the "lower end" of the market or sold through outlets that are normally associated with low cost and value for money. The use of the mark in relation to expensive engraved stationery sold through luxury goods stores would be a normal and fair use of it within the scope of the present application. Such use would, in my view, inevitably lead to confusion. Having regard to the factors that I have already outlined concerning the notoriety of the Opponent's marks, the fact that the Opponent trades in stationery and the high degree of similarity between the respective marks of the parties, I believe that use of the mark by the Applicant in the manner described would be likely to be taken by the relevant consumers as an indication that the goods in question were those of the Opponent or were offered for sale under its authority. That being the case, the application for registration must be refused under Section 19 of the Act.

Section 20 – should the application be refused in light of the Opponent's earlier registrations?

21. Section 20 of the Act prohibits the registration of marks that are identical with or closely resemble existing registered marks. The relevant part of the Section reads as follows:

“(1) no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.”

22. The Opponent holds a number of earlier registrations of its marks TIFFANY and TIFFANY & CO. but it relies primarily on its registration of TIFFANY & CO. under No. 112084, dated 27 March, 1984, which is in respect of “all goods included in Class 21”. At the hearing, Mr. O’Moore argued that the Applicant’s own evidence shows that it trades in a range of items that may be categorised generally as disposable tableware. These include paper napkins, paper and plastic plates and paper and plastic cups. The first of those items falls within Class 16 and would be covered by the present application for registration. The latter two are within Class 21 and are goods to which the Opponent’s registration No. 112084 extends. The fact that the items in question are sold together through the same trade channels, to the same customers and for use together for the same essential purpose means, says Mr. O’Moore, that they are goods of the same description and the provisions of Section 20 therefore operate to prohibit registration of the Applicant’s mark because of the existence of the Opponent’s earlier registration. Mr. McDonald rejected the assertion that the goods covered by the application were goods of the same description as those in respect of which the Opponent holds registrations. In this regard, he pointed to the fact that the application specifically excludes goods included in Classes other than Class 16.

23. The test for consideration of an opposition under Section 20, as formulated by Evershed J in the *Smith Hayden & Co. Ltd.* application [1946] RPC 97, if applied to the present case, would read as follows:

Assuming user by the Opponent of its mark TIFFANY & CO. in a normal and fair manner for any of the goods covered by Registration No. 112084 (and including particularly goods also covered by the proposed registration of the mark TIFANY), is the Hearing Officer satisfied that there will be no reasonable likelihood of deception and confusion amongst a substantial

number of persons if the Applicant also uses its mark normally and fairly in respect of any goods covered by its proposed registration?

24. It is evident that, while Section 19 is concerned primarily with the protection of the public interest and the avoidance of deception and confusion among the public, Section 20 is a weapon in the hands of an existing registered trade mark proprietor, which he can use to protect his private interest in preventing others from registering confusingly similar marks. Of course, an Applicant who faces a challenge to his application based on Section 20 may, if he considers it appropriate, counter-claim for revocation of the Opponent's mark on grounds of non-use and a proprietor who seeks to rely on his earlier registration as against an application by another is liable to be defeated if, or to the extent that, he has not used the mark in relation to the goods for which it is registered. In the present case, the Applicant has not challenged the legitimacy of the Opponent's earlier registrations but has relied instead on the argument that the goods covered by those registrations are not the same goods or the same description of goods as those of the present application. While I suspect that the Opponent might have had difficulty defending a counter-claim for revocation of its Class 21 registration on grounds of non-use, that issue is not before me and I consider that, in the present circumstances, I should assume user by the Opponent of its registered mark in relation to the goods covered by that registration.

25. Those goods include disposable tableware of the kind traded in by the Applicant. Referring again to the test set out by Evershed J, the question may then be put in the following terms: Assuming use by the Opponent of the mark TIFFANY & CO. on paper and plastic plates and cups, is it likely that there will be deception or confusion if the Applicant uses the mark TIFANY on paper table napkins? For the reasons advanced on behalf of the Opponent and referred to in paragraph 22 above, I think that the only answer that could be given is "yes". For this reason, I find that the application should be refused under Section 20 of the Act.

Tim Cleary

Acting for the Controller

20 April, 2004