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

In the Matter of Application Serial No. 76/520,262
Published in the *Official Gazette* on February 24, 2004



06-09-2004

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

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 TIFFANY (NJ) INC., :
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 Opposer, :
 :
 - against - :
 :
 ANTHONY SIRAGUSA AND :
 MICHAEL ROMANELLI :
 :
 Applicants. :
 -----X

Opposition No.

NOTICE OF OPPOSITION

Director of the United States Patent and Trademark Office
2900 Crystal Drive
Arlington, VA 22202-3514

BOX TTAB - FEE

Tiffany (NJ) Inc. (“Tiffany” or “Opposer”), a corporation duly organized and existing under the laws of the state of New Jersey with a principal place of business at 15 Sylvan Way, Parsippany, New Jersey 07054, believes that it will be damaged by the issuance of a registration for the trademark TIFFANY’S RESTAURANTS applied for in application Serial No. 76/520,262, filed June 6, 2003 for “food restaurant services” in International Class 43 and therefore opposes the same. As grounds for the opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. The TIFFANY mark has been used in the U.S. by Opposer or its predecessors for more than 150 years. Today, Opposer is one of the most famous companies in the world and the

TIFFANY brand is recognized worldwide as designating goods and services exclusively from

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2. Numerous courts and tribunals worldwide have held that TIFFANY is a famous trademark. Similarly, the U.S. Senate has deemed TIFFANY to be an extraordinarily famous mark. This fame is attributable to the more than 150 years of use of the TIFFANY mark, the extensive sales of TIFFANY products, the extensive advertising and promotional efforts featuring the TIFFANY mark, and the extensive reference to TIFFANY in the media and popular culture, most notably “Breakfast at Tiffany’s.”

3. Tiffany sells its products under the TIFFANY mark in more than 47 retail stores in the U.S. Tiffany also sells through direct marketing channels including catalogs, and on its website.

4. All products sold by Tiffany are sold and packaged in boxes or bags that prominently bear the TIFFANY trademark. The TIFFANY trademark is also prominently displayed and used on Tiffany’s website, on its catalogs (of which in excess of 25 million are distributed each year), and in its stores.

5. Tiffany is the owner of over 60 U.S. federal trademark registrations for the mark TIFFANY and its variant TIFFANY & CO. (hereinafter collectively referred to as the “TIFFANY mark”) covering a wide variety of goods and services. Opposer owns, among others, the following U.S. trademark registrations for TIFFANY:

<u>REGISTRATION NO.</u>	<u>REGISTRATION DATE</u>	<u>GOODS/SERVICES</u>
132,262	6/15/20	Watches and clocks
133,063	7/06/20	Jewelry
1,737,875	12/8/92	Perfume

Opposer also owns, among others, the following U.S. trademark registrations for TIFFANY & CO.:

<u>REGISTRATION NO.</u>	<u>REGISTRATION DATE</u>	<u>GOODS/SERVICES</u>
1,251,356	9/13/83	Retail store services specializing in the sale of jewelry, watches, stationery, chinaware, figurines, bowls, picture frames, vases, candlesticks
1,283,306	6/26/84	Desk accessories, sewing items
1,292,942	9/4/84	Glasses, bowls, vases, candle holders of crystal
1,774,071	6/1/93	Travel bags, leather goods, picture frames
1,968,614	4/16/96	Watches and clocks
2,043,556	3/11/97	Stationery, diaries, pens, pencils
2,569,969	5/14/02	Flatware and cutlery

6. Opposer's registrations of the TIFFANY mark set forth above are valid, subsisting and in full force and effect and serve as evidence of Opposer's exclusive right to use the mark in commerce on or in connection with the goods and services identified in the registrations as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

7. By virtue of Opposer's extensive sales, advertising and promotion of its goods under its mark, the TIFFANY mark has become instantly recognizable to the public as exclusively denoting Opposer, its goods and services. In addition, the TIFFANY mark has come to symbolize the high quality of Opposer's products. As a result of Opposer's substantial effort and

investment on behalf of its brand, today the goodwill inherent in the TIFFANY mark is an enormously valuable asset of Opposer.

8. On information and belief, Anthony Siragusa and Michael Romanelli (together, “Applicants”) are individuals residing in Pine Brook, New Jersey.

9. On June 6, 2003, Applicants filed Application S.N. 76/520,262 to register the mark TIFFANY’S RESTAURANTS for food restaurant services in International Class 43, claiming a date of first use in commerce of September 1, 1980. On information and belief, Applicants have used the mark TIFFANY’S RESTAURANTS in connection with no more than four restaurants, all located in the State of New Jersey.

10. Applicants’ claimed date of first use in commerce is subsequent to Opposer’s date of first use of its TIFFANY mark and subsequent to the date the TIFFANY mark was first registered in the U.S. Patent and Trademark Office. Indeed, Opposer owns registrations for its mark dating to the 19th century. (*E.g.*, Registrations Nos. 23,572 and 23,573, both registered in 1893.) Applicants’ claimed date of first use in commerce is also far after the TIFFANY mark achieved extraordinary fame in the U.S. and throughout the world.

11. Upon information and belief, Applicants had actual knowledge of Tiffany’s prior rights to and interest in the TIFFANY mark prior to adopting or seeking to register TIFFANY’S RESTAURANTS. At a minimum, as a matter of law, Applicants were on constructive notice of Tiffany’s rights in its mark based on Tiffany’s registrations therefor.

12. In Application Serial No. 76/520,262, Applicants disclaim the word RESTAURANTS. As such, the only source-identifying word sought to be registered is TIFFANY’S, which is virtually identical in sound, appearance, meaning and commercial impression to Opposer’s registered and long-used TIFFANY mark.

13. Several owners of well-known marks in the fashion and luxury consumer goods markets have extended the use of their marks to in-store restaurants, with ARMANI CAFÉ, DKNY CAFÉ and NICOLE'S AT NICOLE FARHI being a few prominent examples. Consumers seeing the TIFFANY mark used in the name of a restaurant are likely to believe that Opposer has similarly expanded its business to include restaurant services.

14. Applicants' application is unrestricted as to the consumers for its services. As a result, it is presumed that Applicants' services will be offered to all consumers of food restaurant services of any kind.

15. The registration of Applicants' mark is inconsistent with Opposer's prior rights in its TIFFANY mark as well as inconsistent with Opposer's statutory grant of exclusivity of use of its registered mark and would destroy Opposer's investment and goodwill in its mark.

CLAIM FOR RELIEF UNDER SECTION 2(d)

16. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 15 as if fully set forth herein.

17. Opposer's TIFFANY mark is exclusively associated with Opposer and has been used continuously by Opposer since a date prior to any date on which Applicants can rely.

18. The portion of Applicants' mark TIFFANY'S RESTAURANTS that is not disclaimed is virtually identical to Opposer's registered and prior used TIFFANY mark and strikingly similar in sound, meaning, appearance and commercial impression to Opposer's mark. In addition, Applicants seek to register their mark for services closely related in consumers' minds to the goods and services long provided by Opposer under its marks.

19. By virtue of Opposer's longstanding use of the TIFFANY mark, the goodwill associated with the mark, and Opposer's incontestable registrations therefor, the registration by

Applicants of a mark that is strikingly similar to the TIFFANY mark for services related to the goods and services provided by Opposer is likely to cause confusion or cause mistake or to deceive the purchasing public into mistakenly believing that Applicants' services offered under the mark TIFFANY'S RESTAURANTS originate from, come from or are otherwise associated with Opposer or that Applicants' services are endorsed, sponsored or in some way connected with Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d). See Tiffany & Co. v. Boston Club, Inc., 231 F.Supp. 836 (D. Mass. 1964).

20. By reason of the foregoing, Opposer is likely to be harmed by registration of Application S.N. 76/520,262 for the mark TIFFANY'S RESTAURANTS.

CLAIM FOR RELIEF UNDER SECTION 2(f)

21. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 15 as if fully set forth herein.

22. The TIFFANY mark is inherently distinctive, has been used in commerce and widely advertised by Opposer for many years, is instantly recognized by consumers as a symbol of Opposer and its products and services, and is the subject of incontestable federal trademark registrations. Courts and legislatures have deemed the TIFFANY mark to be a famous and distinctive mark entitled to protection from dilution. As a result, the TIFFANY mark is a famous mark under the Lanham Act.

23. Applicants' application to register TIFFANY'S RESTAURANTS was filed long after the TIFFANY mark became famous.

24. Registration of the mark TIFFANY'S RESTAURANTS is likely to and would dilute the distinctive quality of Opposer's TIFFANY mark by lessening the capacity of TIFFANY to identify and distinguish exclusively goods and services of Opposer.

25. Registration of the mark TIFFANY'S RESTAURANTS is likely to dilute the TIFFANY mark in violation of Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).

26. By reason of the foregoing, Opposer is likely to be harmed by registration of Application S.N. 76/520,262 for the mark TIFFANY'S RESTAURANTS.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Applicants in Application S.N. 76/520,262 be denied.

Duplicate copies of this Notice of Opposition are enclosed. Also enclosed is a check for the Notice of Opposition filing fee in the sum of \$300. To the extent that there is any payment due to the Trademark Trial and Appeal Board or to the extent that there is any overpayment, the Trademark Trial and Appeal Board is hereby authorized to charge any additional opposition filing fee or to credit any extra payment to Opposer's counsel's deposit account No. 23-0825-0576900.

Dated: New York, New York
June 8, 2004

Certificate of Express Mailing

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

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Donna O'Daniel
(Printed name of person mailing paper or fee)

Donna O'Daniel
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