

ESTTA Tracking number: **ESTTA467069**

Filing date: **04/13/2012**

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

Name	Tiffany (NJ) LLC
Granted to Date of previous extension	04/15/2012
Address	15 Sylvan Way Parsippany, NJ 07054 UNITED STATES

Attorney information	Barbara A. Solomon Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES bsolomon@fzlj.com Phone:212-813-5976
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Applicant Information

Application No	85165687	Publication date	10/18/2011
Opposition Filing Date	04/13/2012	Opposition Period Ends	04/15/2012
Applicant	Tiffany Jo Allen P.O. Box 36503 Tucson, AZ 85704 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2010/10/01 First Use In Commerce: 2010/10/01 All goods and services in the class are opposed, namely: Charitable services, namely, coordination of non-monetary contributions to charities and non-profits

Grounds for Opposition

Other	Trademark Act section 2(a) Trademark Act section 2(d) Trademark Act section 2(f)
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Attachments	Notice of Opposition (F0992475).PDF (9 pages)(366860 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	/Barbara A. Solomon/
Name	Barbara A. Solomon
Date	04/13/2012

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

In the Matter of Application Serial No. 85/165,687
Published in the *Official Gazette* on October 18, 2011

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TIFFANY (NJ) LLC,	:	Opposition No.
	:	
Opposer,	:	
	:	
- v. -	:	NOTICE OF OPPOSITION
	:	
Tiffany Jo Allen,	:	
	:	
Applicant.	:	
-----X	:	

Tiffany (NJ) LLC (“Tiffany” or “Opposer”), a limited liability company duly organized and existing under the laws of the state of Delaware 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 KIDS, applied for in Application Serial No. 85/165687, filed October 31, 2010 for “charitable services, namely, coordination of non-monetary contributions to charities and non-profits” in International Class 35 and therefore opposes the same. As grounds for the opposition, Opposer, by its attorneys, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Opposer is one of the most well-known companies in the U.S. Opposer’s business consists of the design, manufacture and sale of high quality luxury consumer items for personal and household use and adornment as well as the provision of services relating thereto. Currently, Tiffany offers thousands of different items under the TIFFANY trademark.

2. The TIFFANY mark has been used in the U.S. by Opposer or its predecessors continuously for more than 160 years. Today, the TIFFANY brand is recognized worldwide as

designating goods and services exclusively from Opposer.

3. Numerous courts and tribunals worldwide have held that TIFFANY is a famous trademark. The well-known McCarthy treatise on trademarks highlights TIFFANY as being a famous mark that has the strong, distinctive quality which is deserving of protection from dilution. Courts have referred to TIFFANY as a household name. And no less than the U.S. Senate has deemed TIFFANY to be an extraordinarily famous mark. This fame is attributable to the more than 160 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.

4. Tiffany sells its products under the TIFFANY mark in more than 70 retail stores in the U.S., as well as through direct marketing channels including catalogs, and on its websites. All products sold by Tiffany are sold and packaged in boxes or bags that prominently bear the TIFFANY trademark. The TIFFANY trademark also is prominently displayed and used on Tiffany's website, on its catalogs (of which in excess of 20 million are distributed each year), in its stores and on its advertising. Since 1990, sales of Tiffany products in the U.S. alone have exceeded over 17 billion dollars (U.S.) and advertising under the TIFFANY mark in the U.S. alone since 1990 exceeds over 900 million dollars (U.S.).

5. Tiffany is the owner of more than 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. Some of these registrations date back to the 1920's.

6. Opposer's registrations for the TIFFANY mark 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). Registrations of Opposer, are incontestable and serve as conclusive evidence of Opposer's exclusive right to use the TIFFANY mark for the listed goods and services.

7. Tiffany has long been engaged in charitable activities. In 2000, Opposer established the Tiffany & Co. Foundation to spearhead many of Opposer's philanthropic endeavors.

8. Over the last decade, Opposer itself and through the Tiffany & Co. Foundation, has provided significant donations, grants and gifts to support charitable causes in the communities in which Tiffany operates. Among the charities Tiffany supports are scores of charitable causes focused on children ranging from various children's hospital to children's museums, boys & girls clubs, shelters and a host of other organizations. Opposer's charitable activities are provided under the name TIFFANY or TIFFANY & CO.

9. By virtue of Opposer's activities under its mark, the TIFFANY mark has become instantly recognizable to the public as exclusively denoting Opposer, its goods and its services, including its philanthropic activities. As a result of Opposer's substantial effort and investment on behalf of its brand, the goodwill inherent in the TIFFANY mark is an enormously valuable asset of Opposer.

10. Tiffany's reputation also has spread beyond normal marketing channels because of the high profile commissions it has received. Tiffany is responsible for the engraving found on the U.S. \$1 bill and has been commissioned to make, among other trophies, the Woodlawn Vase awarded annually to the winner of the Preakness Stakes; the NBA trophy; the NFL Superbowl trophy; the U.S. Open tennis championship trophies; the MLS Cup for soccer; the Indianapolis 500 trophy; the Breeder's Cup for horse-racing; the medals for the 1980 Winter Olympics in

Lake Placid; and the America's Cup Class World Championship trophy for yachting. Further raising Opposer's profile is Opposer's inclusion as one of the world's top 100 global brands and its inclusion in several Hollywood films including the iconic "Breakfast at Tiffany's." As a result, even consumers who have not visited Tiffany's retail locations or purchased Tiffany products are exposed to the TIFFANY mark.

11. In addition to using TIFFANY as a trademark for more than 160 years, Opposer has also used Tiffany as a trade name since the company's creation in 1837. As a result of such use, the TIFFANY name is associated exclusively with Opposer and connotes Opposer as a centuries-old institution.

12. On information and belief, Tiffany Jo Allen, a/k/a Tiffany Jo is a U.S. citizen with a U.S. mailing address of P.O. Box 36503, Tucson, Arizona 85704.

13. On October 31, 2010, Applicant filed Application Serial No. 85/165687 to register the mark TIFFANY'S KIDS for "charitable services, namely, coordination of non-monetary contributions to charities and non-profits" based on use of the marks since October 1, 2010.

14. Both Applicant's filing date and date of first use are decades after Opposer's date of first use of its TIFFANY mark, decades after the date the TIFFANY mark was first registered in the U.S. Patent and Trademark Office, and a decade after the establishment of the Tiffany & Co. Foundation.

15. When Applicant filed her application, she had, at a minimum, constructive knowledge of Tiffany's prior rights in and to the TIFFANY mark by virtue of Opposer's federal trademark registrations for TIFFANY and likely had actual knowledge of Tiffany's prior rights based on the extensive use and fame of TIFFANY.

16. The mark applied for, TIFFANY'S KIDS, incorporates Opposer's TIFFANY

trademark in its entirety, is confusingly similar to Opposer's TIFFANY mark, and is likely to call to mind Opposer's TIFFANY mark.

17. Applicant has disclaimed "kids" in her mark. As such, the only source identifying feature of the mark is "TIFFANY'S" which is identical to the recognizable and dominant portion of Opposer's mark, and which is identical to Opposer's commonly known name. Further, the inclusion of the descriptive and disclaimed term "kids" does not create a mark that is dissimilar from Opposer's mark and business name. Rather, the mark suggests that the services are being offered by Tiffany and are directed at kids. As such, viewed as a whole, Applicant's mark is substantially similar in sound, appearance, connotation and commercial impression to Opposer's TIFFANY trademarks and trade names.

18. The services for which Applicant seeks registration are identical to the philanthropic services provided by Opposer under its TIFFANY & CO. Foundation name.

19. Further, given the overwhelming fame of the TIFFANY mark, the presence of Opposer's TIFFANY mark in the opposed Application, will inevitably cause consumers to believe that Applicant's services are associated with Opposer.

20. The registration of Applicant's mark is inconsistent with Opposer's prior rights in the trademark and trade name TIFFANY as well as inconsistent with Opposer's statutory grant of exclusivity of use of its registered mark and would harm, damage or destroy Opposer's investment and goodwill in its mark.

CLAIM FOR RELIEF UNDER SECTION 2(f)

21. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 20 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. Applicant's application to register TIFFANY'S KIDS was filed long after the TIFFANY mark became famous.

24. Applicant's mark is essentially identical to Opposer's famous TIFFANY mark. The addition of the generic and disclaimed term "kids" to Opposer's TIFFANY mark does not create a commercial impression distinct from Opposer's TIFFANY mark.

25. Registration of the mark TIFFANY'S KIDS is likely to and would dilute the distinctive quality of Opposer's TIFFANY mark by causing an association between the opposed mark and Opposer's famous mark that impairs the distinctiveness of the famous TIFFANY mark and that lessens the capacity of Opposer's TIFFANY mark to identify and distinguish exclusively goods and services of Opposer thereby harming Opposer.

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

27. By reason of the foregoing, Opposer is likely to be harmed by registration of Application Ser. No. 85/165687 for the mark TIFFANY'S KIDS

CLAIM FOR RELIEF UNDER SECTION 2(d)

28. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 27 as if fully set forth herein.

29. 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 Applicant can rely.

30. Applicant's TIFFANY'S KIDS mark incorporates and is substantially similar to Opposer's registered and prior used TIFFANY mark and has a similar sound, meaning, appearance and commercial impression to Opposer's mark. In addition, Applicant seeks to register its mark services long provided by Opposer under its mark.

31. By virtue of Opposer's longstanding use of the TIFFANY mark and the goodwill associated with the mark, the registration by Applicant of TIFFANY'S KIDS for services related to services provided by Opposer under its TIFFANY name and mark is likely to cause confusion or cause mistake or to deceive the public into mistakenly believing that Applicant's services offered under the TIFFANY'S KIDS mark originate from, come from or are otherwise associated with Opposer, or that Applicant's services are endorsed, licensed, or sponsored by or in some way connected with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

32. By reason of the foregoing, Opposer is likely to be harmed by registration of the mark TIFFANY'S KIDS, shown in Application Ser. No. 85/165687.

CLAIM FOR RELIEF UNDER SECTION 2(a)

33. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 32 as if fully set forth herein.

34. The name TIFFANY has been used as a business name by Opposer for more than 150 years and has come to designate uniquely and unmistakably Opposer and its business. Such use is prior to any claim of rights by Applicant.

35. The adoption of the mark TIFFANY'S KIDS falsely suggests a connection with Opposer and will cause consumers to make false connections between the services offered by

Applicant under the TIFFANY'S KIDS mark and Opposer.

36. Because the TIFFANY name unmistakably is associated with Opposer, and given that the use of the TIFFANY'S KIDS mark will falsely suggest a connection between Opposer and Applicant and that consumers would likely presume a connection with Opposer, registration of the TIFFANY'S KIDS mark violates section (2)(a) of the Lanham Act 15 U.S.C. § 1025(a).

37. By reason of the foregoing, Opposer is likely to be harmed by registration of the mark TIFFANY'S KIDS, shown in Application Ser. No. 85/165687.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that the registration sought by Applicant in Application Ser. No. 85/165687 be denied.

The Trademark Trial and Appeal Board is hereby authorized to charge the opposition filing fee of \$300.00 to oppose in one class to Opposer's counsel's deposit account No. 23-0825-0576900.

Dated: New York, New York
April 13, 2012

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

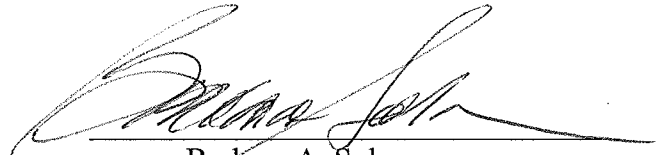
By: 

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing Notice of Opposition was served on April 13, 2012 by first-class mail, postage prepaid, on the listed correspondent of record for the opposed application at the following address:

Thomas David Ruth, Esq.
KTR Law Group
700 12th Avenue S
Unit 302
Nashville, Tennessee 37203-3367



Barbara A. Solomon