

**DECISION OF THE REGISTRAR OF TRADEMARKS IN THE MATTER OF
TRADE MARK APPLICATION No. 1721/2017 TIFFANY IN CLASS 03 IN
THE NAME OF WILMAR RESOURCES PTE LTD AND OPPOSITION
THERE TO BY TIFFANY AND COMPANY PURSUANT TO THE
TRADEMARKS ACT CHAPTER 401 OF THE LAWS OF ZAMBIA AND
REGULATIONS THEREUNDER**

BETWEEN

WILMAR RESOURCES PTE LTD

APPLICANT

AND

TIFFANY AND COMPANY

OPPONENT

**Coram: Mr. Benson Mpalo, Deputy Registrar – Intellectual
Property**

**For the Applicant: Messrs Fisher Cormack & Botha, represented by
Howard & Marietta Legal Practitioners**

For the Opponent: Messrs Galloway and Company

RULING



Legislation referred to:

The Trade Marks Act Chapter 401 of the Laws of Zambia

Cases Referred to:

1. Britania Products Zambia Limited and Britania Industries Limited (2020) (Registrar's Decision)

2. British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281
3. Canon v. Cannon [1998] (C-39/97
4. Converse Rubber Corporation v Universal Rubber Products Inc 147 SCRA 155
5. DH Brothers (Pty) v. Olivine Industries (Pty) Limited SCZ JUDGMENT NO. 10/2012
6. Jellinek's Appn (1946) 63 RPC 59
7. John Crowther & Sons (Milnsbridge) Ltd's Appn (1948) 65 RPC 369

International Instruments referred to:

1. The Paris Convention
2. TRIPS Agreement



BACKGROUND

1. The trade mark subject of these proceedings is a word mark **TIFFANY** applied for by Wilmar Resources Pte Ltd (herein after called the Applicant) on 17th October, 2017. The application was made in class 3 of the Nice Classification of goods in respect of the following specifications of goods.

‘Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics; hair shampoos, hair conditioners; toothpastes and mouthwashes’

2. The mark was assigned an application number 1721/2017 and published on 25th October, 2018. After seeking extensions of time, Tiffany and Company of 727 Fifth Avenue, City and State of New York, United of America (herein called the Opponents) eventually filed a Notice of opposition on 20th May, 2019.

GROUND OF OPPOSITION

3. The Opponent advanced two grounds of opposition as follows:
 - i) That the trademark application 1721/2017 relies on the proud legacy and reputation of the name “Tiffany’s “.
 - ii) That registration will be contrary to Section 16 in that it shall not be lawful to register a trademark or part of it a trademark which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a Court of justice.

COUNTERSTATEMENT

4. On 4th October, 2019, the Applicant filed its counterstatement stating that it is the rightful owner of the trademark “TIFFANY” in Class 3 and that the Opponent has no valid grounds on which to oppose its application.



5. The Applicant further stated that it carries on business as a global leader in processing and merchandising of edible oils, oil seed crushing, production of oleochemicals, speciality fats, palm biodiesel, and consumer pack oils and their portfolio of high quality processed agricultural and oil products on which the TIFFANY trademark is used.
6. The Applicant further claimed that it has consistently used the trade mark TIFFANY since it was coined some years ago and that the Applicant was the first to apply for registration in relation to goods in class 3 in Zambia.
7. The Applicant prayed that its application should be accepted and that an order for costs be made in favour of the Applicant.

OPPONENT'S EVIDENCE

8. The Opponent's evidence comprised of a lengthy Statutory Declaration deposed by Lesley Matty who is Senior Counsel and Assistant Secretary of the Opponent. This was filed at the Registry on 10th December, 2019. I will summarise the evidence to capture facts which I consider relevant and of some evidential value to this matter.
9. Mr. Lesley Matty explains that the Opponent is sole and lawful proprietor incorporating "TIFFANY" "TIFFANY & Co" "T and Co" and or "T& Co" which are collectively referred to as TIFFANY Mark(s). He went on to state that the TIFFANY Marks have been used and are used on a broad range of luxury goods, including those in class 3.
10. He also explained that the Applicant's trade mark is identical to Tiffany's famous TIFFANY Marks and trade name and that the Applicant seeks to trade upon Tiffany's proud legacy.
11. Mr. Matty explained further that the Opponent has used the TIFFANY Marks globally on luxury goods since 1837 and that the mark Tiffany has



presence in several countries worldwide and that it has global recognition and reputation in many countries. In support of his evidence Mr. Matty, produced and exhibited a number of documents marked as **Exhibit 1 to 37.**

12. There was evidence also relating to the reputation of the Opponent's trade marks in Zambia. The deponent averred that the TIFFANY trade name is famous and protectable in Zambia. He explained that the Tiffany's well known status and far reaching reputation became established in Africa as early as 1968 when Tiffany discovered a blue violet gemstone in the foothills of Mount Kilimanjaro which was named as Tanzanite.
13. Reference was also made to the Opponent's trade mark registration number 307/2013, namely "TIFFANY & CO." in Class 14. I have also taken note of the worldwide sales figures of the Opponent's products bearing the TIFFANY trade mark from 1986 to 2017. International advertising figures from 1992 to 2017 were also provided which I have taken note of.
14. In conclusion Mr. Matty averred that the Applicant's mark is calculated to deceive and confuse the public. He explained that the Applicant's use and registration of a trademark which is confusingly similar to Tiffany and Company's TIFANNY marks and trade name will also allow it to improperly benefit from the extensive popularity and goodwill that the TIFFANY marks and Tiffany and Company's worldwide promotional efforts have generated through many years. It was submitted that such use and registration will violate the Paris Convention Articles 6bis, 8 and 10bis.

APPLICANT'S EVIDENCE IN SUPPORT

15. On 15th September, 2020 the Applicant filed its evidence in support through a statutory declaration which was deposed by one Amit Suri, a General Manager at Wilmar Resources Pte Ltd. The Applicant denied all the allegations by the Opponent. In brief, Mr. Suri deposed that the Opponent in its affidavit failed to show proof or evidence that they have a



trademark TIFFANY in Class 3 registered in Zambia. The Applicant further stated that the Opponent failed to prove reputation in Zambia with regards to the trademark TIFFANY in Class 3. It was stated in this regard that the Opponent failed to show proof of promotion and advertising with respect to the trademark TIFFANY in Class 3 in Zambia. Mr. Suri further stated that the Applicant was the first in Zambia to file for registration of the trademark TIFFANY in Class 3.

16. In view of the foregoing it was contended by Mr. Suri that the Opponent has no rights to the trademark TIFFANY in Class 3 in Zambia and that the Opponent's opposition was therefore made in bad faith.

OPPONENT'S EVIDENCE IN REPLY

17. On 29th January, 2021, the Opponent deposed a statutory declaration in reply which was basically intended to rebut the allegations made by Mr. Suri in his statutory declaration in support of the Applicant's application. I have taken note of the averments and exhibits contained therein.

THE HEARING OF THE PROCEEDINGS

18. The matter was set for a hearing on 14th December, 2021. During the hearing, Counsel representing the Applicant, Mr. Wesley Silungwe proceed to make oral arguments which are summarized herein below. On the other hand, the Opponent's Agent represented by Ms. Ireen Nambule, indicated that in addition to the Notice of Opposition, and statutory declarations the Opponent will file written arguments at a later date.

OPPONENT'S ORAL ARGUMENTS

19. In brief, it was submitted on behalf of the Opponent that the Opponent is the lawful proprietor of trade marks incorporating the word "TIFFANY" which is registered in various countries. It was further submitted that in Zambia the trademark "TIFFANY & CO" is registered in Class 14 under registration number 307/2013. Mr. Silungwe argued that the Applicant's mark "TIFFANY" is identical to the Opponent's famous "TIFFANY" marks



- and the Opponent's trade name. He submitted that the Opponent's TIFFANY mark is a well-known global brand and has been used on a broad range of goods in different classes around the world and is should be accorded protection as stipulated in Article 6(bis)(i) of the Paris Convention and Article 16 of the TRIPS Agreement.
20. Reference was made to the decision of the US Supreme Court in **Converse Rubber Corporation v Universal Rubber Products Inc 147 SCRA 155** where the Court ruled that a corporation is entitled to cancellation of a mark that is confusingly similar to its corporate name.
21. In terms of Section 16 of the Trade Marks Act, it was argued that the Applicant's decision to apply for the mark 'TIFFANY', was calculated to ride on the reputation of the Tiffany marks, leading to confusion and deception to consumers. That the consumer upon encountering the Applicant's mark in the market place will be misled into believing that the goods sold by the Applicant originate from or are associated with the Opponent.
22. On 24th January, 2022 the Opponent filed its written submissions to augment the oral arguments made at the hearing. However, the arguments canvassed in the written submissions are not in any way different from the oral arguments and therefore not necessary to replicate in this ruling.

APPLICANT'S WRITTEN SUBMISSIONS

23. The Applicant's written submissions were filed on 31st March, 2022. The salient points raised in the submissions can be summarized as follows:
24. It was argued that there is no evidence in the Opponent's Statutory Declarations or the exhibits to confirm that the Opponent has a valid registration with respect to any of "TIFFANY", "TIFFANY & CO" or indeed "T & Co" in Class 3. It was also submitted that the Opponent has not shown any evidence that they have been using the Tiffany mark on goods



in Zambia. The Applicant contended that the Opponent has not shown any evidence with respect to the reputation of the mark Tiffany in class 3 that the Opponent purports.

25. It was contended the Opponent has also failed to demonstrate that the Applicant's application for Tiffany in Class 3 is against the law.

DECISION

26. I have considered the grounds of opposition raised by the Opponent as well as the counter-statement filed by the Applicant. I have also considered the evidence adduced by both parties by way of statutory declarations filed in support of their respective cases. I will now proceed to make a decision in this matter.

27. According to the Notice of Opposition, the Opponent is objecting to the registration of the mark application No. 1721/2017 'TIFFANY' on the grounds that;

- (i) That the trademark application 1721/2017 relies on the proud legacy and reputation of the name "Tiffany's".
- (ii) That registration will be contrary to Section 16 in that it shall not be lawful to register a trademark or part of it a trademark which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a Court of justice.

28. I will deal with these grounds in the order in which they were presented by the Opponent.

29. The first ground of opposition is difficult to fathom as there is no such ground of opposition under the Trade Marks Act. However, I note from the oral submission by the Opponent during the hearing of this matter, that this ground was argued from the point of view of the protection accorded



to a well-known marks under Article 6 *bis* of the Paris Convention. The issue of protection of well-known marks in Zambia in accordance with Article 6 *bis* of the Paris Convention has from time to time come up in opposition proceedings before the Registrar. In the Opposition proceeding between **Britania Products Zambia Limited and Britania Industries Limited (2020)** relating to Trade mark Application Numbers 438-439/2010 'Britania', it was held by the Registrar that Article 6*bis* of the Paris convention is non self-executing and that this provision requires domestication in national law. For the avoidance of doubt, this provision states as follows: -

“(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.” (Emphasis mine)

30. As was stated in the Registrar's decision in the Britania matter, there is not provision in the Trade Marks Act, Cap 401 of the laws of Zambia, which permits the Registrar to refuse or to cancel the registration of on the basis that it is likely to create confusion with a well-known mark. Furthermore, there is no procedure either under the Act or the Regulations for granting of marks the status of a well-known mark. It is therefore difficult for me or any other person to hold that the Opponent's 'TIFFANY' marks are well-known in the country.



31. Further, our Supreme Court has held in ***DH Brothers Industries (Pty) Limited Vs. Olivine Industries (Pty) Limited***, that unregistered trademarks do not enjoy protection under the Trade Marks Act. This decision clearly extends to well-known marks which are not registered under the Zambian Register. In view of the foregoing, the Opponent's opposition based on the first ground cannot be sustained and it is accordingly dismissed.
32. I will now turn to consider the second ground of opposition which is premised on section 16 of the Trade Marks Act.
33. Section 16 of the Trade Marks Act provides as follows:
- 16. 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 justice or would be contrary to law or morality, or any scandalous design.***
34. It has been explained in many decisions of the Registrar that section 16 of the Trade marks Act provides different specific grounds of objection for the registration of a mark. These grounds can be summarized as follows:-
- (i) Where a mark or part of the mark applied for is likely to deceive or cause confusion, or otherwise be disentitled to protection in a court of justice
 - (ii) Where a mark or part of the mark applied for would be contrary to law or morality
 - (iii) any scandalous design.
35. Like many oppositions which are filed before the registry, the Opponent in this matter did not in its Notice of Opposition specify the specific ground on which its objection is anchored. However, judging by its statutory declaration and arguments, it is clear that the Opponent relied



on the first ground which is that, the Applicant's mark 'TIFFANY' is likely to deceive or cause confusion, or otherwise be disentitled to protection in a court of justice. It has also been explained in the previous decisions of the Registrar that likelihood of deception or confusion can be attributed to many factors such as where the mark makes reference to the character, quality, intended use or geographical origin of the goods or because of the resemblance of the marks and goods associated with those marks. (See **Britania Products Zambia Limited and Britania Industries Limited (2020)**)

36. In this matter the evidence and the submission by the Opponent suggest that the Opponent's contention of likelihood of deception or confusion is based on the resemblance between its TIFFANY marks and the TIFFANY mark which the applicant seeks to register. It is now settled that where an opposition under section 16 is anchored on likelihood of deception or confusion due to the resemblance of marks and the goods associated with those marks, section 16 must be read together with section 17(1) of the Trade Marks Act. (See **DH Brothers (Pty) Vs. Olivine Industries (Pty) Limited SCZ JUDGMENT NO. 10/2012**).

37. Thus, section 17(1) of the Trade Marks Act provides as follows:

"17(1) Subject to the provisions of subsection (2), 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"

38. For an opposition to succeed under the above provision, the opponent must show that it is the proprietor of an identical or similar registered



trademark and secondly that the trade mark sought to be registered is in respect of the same goods or description of goods.

39. In relation to the first requirement under section 17(1), I have also considered the fact that according to the evidence on record, the opponent is the proprietor of trade mark registration number 307/2013 "TIFFANY & CO" which precedes the Applicant's application. Though the trade marks 'TIFFANY' and "TIFFANY & CO" are not entirely identical because of the additional element "& CO" in the Opponent's earlier mark. However I don't consider that this additional element "& CO" is by itself sufficient to distinguish the Opponent's trade mark from that of the Applicant or vice versa. I therefor find that there is high degree of similarity between the applicant's mark and the Opponent's trade mark already on the register.

40. However, to prove likelihood of deception or confusion, the Opponent must go further and demonstrate as required under section 17(1) that the goods under its already registered trade mark are the same goods or of the same description as those under the Applicant's application. This means I have to compare and determine whether the goods under the respective trade marks are the same or of the same description.

41. Let me reiterate that, in view of my ruling in relation to the first ground of opposition and in view of section 17(1) of the Trade Marks Act, for purposes of comparison of goods, the relevant earlier trademarks to consider are those registered in Zambia. According to the evidence, there is only one registration in Zambia which the Opponent are relying on, which is trade mark registration number 307/2013 "TIFFANY & CO". This registration is in class 14 in respect of the following specification of goods:

"precious metals and their alloys and goods in precious or semi-precious metals or coated therewith, not included in other classes, semi-precious metals, jewellery, precious stones, semi-precious stones and pearls, cuff



links, studs, tie clips, tie pins, lapel pins, and collar stays,, horological and chronometric instruments, including wristwatches, clocks, pocket watches, and parts, fittings and accessories thereof, rings, bracelets, earrings, necklaces, brooches, pins (jewellery-);purse and belt buckles, hat ornaments of precious metals, shoe ornaments of precious metals, shoe horns, compacts, hair brushes and brushes, perfume containers, card holders and card cases, key chains, key rings, money clips, trophies, trays, vases, boxes, candelabra, candlesticks, bar related devices, ice pliers, jiggers, shakers and corkscrews, napkin holders and napkin rings, babies' pacifiers, rattles and teething rings, picture frames, photo frames, stands for clocks, coffee and tea services, salt and pepper sets, serving pieces, tableware, lighters, candle snuffers, bookmarks, cigarette and cigar cases, all made of precious or semi-precious metals, decorative objects and ornaments, figurines, and works of art made of or using precious or semi-precious metals, cell phone accessory charms, bijoux and costume jewellery.”

42. On the other hand, the Applicant wishes to register the TIFFANY mark in class 3 in respect of the following goods.

‘Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics; hair shampoos, hair conditioners; toothpastes and mouthwashes’

43. The criteria for comparing goods has been established by case law including **John Crowther & Sons (Milnsbridge) Ltd’s Appn (1948) 65 RPC 369; Jellinek’s Appn (1946) 63 RPC 59; British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281; and Canon v. Cannon [1998] (C-39/97**

44. For example, in **Canon v. Cannon [1998] (C-39/97, Judgment of 29 September 1998)** the European Court of Justice held that:-



“In assessing the similarity of the goods or services concerned, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary”.

45. In the present case the goods under the respective trade marks are not only in different classes but also completely distinct having regard to the nature of the goods, the uses thereof and the trade channels through which they are bought and sold. Furthermore, the goods in class 3 and class 14 are neither complementary nor are they in competition with each other.
46. Therefore, despite my finding that there is a high degree of similarity between the Applicant’s trade mark and the Opponent’s already registered trade mark, I find that due to the dissimilarity of the goods under the respective trade marks, no likelihood of deception or confusion is bound to occur either under section 16 or section 17(1) of the Trade Marks Act. This means that the Opponent’s second ground of opposition also fails.

CONCLUSION

47. Since all the substantive grounds which were raised by the Opponent in these proceedings have failed, the opposition is accordingly dismissed.
48. Consequently, the Applicant’s trademark application number 1721/2017 TIFFANY in Class 3 can proceed to registration.
49. Each party shall bear its own costs incidental to this opposition. Leave to appeal if dissatisfied with this decision is hereby granted.



Dated this.....^{25th}.....day of July.....2023



BENSON MPALO

DEPUTY REGISTRAR OF TRADE MARKS

