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# a jewel of an opinion or missing the mark? second circuit holds that costco's use of "tiffany" may be descriptive

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In *Tiffany and Co et al v. Costco Wholesale Corp.*, No. 17-2798 (2d Cir., Aug. 17, 2020) the Second Circuit vacated and remanded for trial a 2017 decision issued by the Southern District of New York that awarded fine jewelry giant Tiffany & Co. over \$21 million in damages arising from Costco's use of the term "Tiffany" in connection with the sale of engagement rings in Costco stores nationwide. Although the court did not ultimately rule on the substantive issues, the Second Circuit's holding is a reminder to brand owners that even a trademark as famous as "Tiffany" may be descriptive in particular contexts—in this case, the use of the phrase "Tiffany setting" to refer to the six-pronged style that Tiffany & Co. made famous. The decision also clarifies that a district court's ability to make factual findings in trademark infringement cases on summary judgment is limited, particularly on the issue of likelihood of consumer confusion.

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