

JUN 6 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Amvescap PLC	:	BEFORE THE
Trademark:	INVESCO FIELD AT MILE HIGH	:	TRADEMARK TRIAL
Serial No:	76/214,007	:	AND
Attorney:	Ian L. Saffer	:	APPEAL BOARD
Address:	Townsend and Townsend and Crew LLP Two Embarcadero Center, 8 th Fl San Francisco, CA 94111-3834	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark INVESCO FIELD AT MILE HIGH for "providing facilities for sporting events, namely football games and soccer matches; providing facilities for entertainment events,

namely music concerts.” Registration was refused under Trademark Act Section 2(d), 15 U.S.C. 1052 (d) for the mark having a likelihood of confusion with a prior registration.

FACTS

On February 21, 2001, the applicant filed application Serial No. 76/214,007 seeking to register the mark INVESCO FIELD AT MILE HIGH for a variety of goods and services, including “providing facilities for sports and entertainment events.” In an Office action dated June 6, 2001, the examining attorney refused registration under Trademark Act Section 2(d) on the ground that the applied-for mark so resembles the mark in Registration No. 2,291,174 as to result in a likelihood of confusion among consumers as to the source of the identified goods and services. The examining attorney also required that the applicant disclaim FIELD and respond to a number of other informalities. The applicant’s response of December 4, 2001 set forth arguments in favor of registration, amended the application to insert a disclaimer of FIELD and attempted to comply with the other requirements set forth in the first Office action. On January 16, 2002, the examining attorney made final the refusal to register under Section 2(d) and the requirement to amend the identification of goods. The applicant filed a request for reconsideration on April 16, 2002. On May 3, 2002, the examining attorney denied the request for reconsideration of the Section 2(d) refusal and accepted the amended identification of goods.¹ On July 15, 2002, the applicant filed a notice of appeal, a request to divide, a request for remand and a request to extend the time to file its appeal

¹ With the provision that the applicant correct the spelling of the term “signs.”

brief. As requested by the applicant, the Office divided the application into the instant parent application for Class 41 and child application serial number 76/975,167 for the remaining goods and services. On February 3, 2003, the examining attorney approved the child application for publication. The appeal was resumed as to the instant parent application and on April 7, 2003, the applicant filed its appeal brief. On April 30, 2003, the Office assigned the case to the undersigned examining attorney. No other issues remain.

ARGUMENT

CONFUSION IS LIKELY BETWEEN THE APPLICANT'S MARK "INVESCO FIELD AT MILE HIGH" AND THE PRIOR REGISTERED MARK, "MILE HIGH STADIUM".

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

With respect to the parties' services, the applicant's services, "providing facilities for sporting events, namely football games and soccer matches; providing facilities for entertainment events, namely music concerts", are legally identical to registrant's services, "providing stadium facilities for sports and recreational activities." The applicant's "facilities" encompass registrant's "stadium facilities", and registrant's "sports and recreational activities" encompass the applicant's "football games and soccer matches" and "music concerts." Therefore, the services of the parties are for all practical purposes identical. The applicant does not argue this fact. The only issue in this case is whether the marks of the parties are confusingly similar under Section 2(d) when used in connection with identical services in identical channels of trade.

With respect to the parties' marks, the examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

The applicant's mark is INVESCO FIELD AT MILE HIGH. The cited registered mark is MILE HIGH STADIUM. As discussed above, both marks are used in connection

with stadium services. The registered mark consists of the term MILE HIGH in conjunction with the generic term for stadium services, STADIUM. The applicant has merely added the name of the field to the registered stadium name and omitted the generic term for the services. It is well settled that the mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"). The impression of the applicant's mark when used in connection with its services is INVESCO FIELD AT MILE HIGH stadium services, which has a highly similar commercial impression to MILE HIGH STADIUM stadium services. Merely adding the field name and omitting a generic word is insufficient to obviate the likelihood of confusion.

The applicant argues that the examining attorney has impermissibly dissected the marks. The applicant is correct that under a Section 2(d) analysis the marks must be viewed in their entirety. As discussed above, when viewed in their entirety and in

relation to the services provided, the marks are likely to be confused because the impression of the applicant's mark is of a field name modifying a stadium name, i.e., field X at stadium Y. The registered mark is that stadium name. The applicant, in focusing on the number of syllables and characters in INVESCO FIELD, has, itself, impermissibly dissected its mark. See Applicant's Brief at 4 and 6.

The applicant also argues that the term MILE HIGH is weak, therefore, confusion is not likely. The applicant argues at length that the term MILE HIGH is geographically descriptive. However, whether or not the term is geographically descriptive is not the issue before the Board. The issue in the instant case is whether the marks are confusingly similar when used in connection with identical services. The applicant has shown that Denver is referred to as the Mile High City, however, the applicant has not shown that the term MILE HIGH is weak on the federal register for the services of providing stadium facilities. Use of the term MILE HIGH in relation to other goods and services is not controlling and does not establish that the mark is weak in relation to stadium facility services.² The applicant's additional allegations that registrant has "acknowledged" that MILE HIGH is descriptive, and that registrant "does not believe confusion is likely based simply on usage of the common element MILE HIGH" has no basis in law or in the record. See Applicant's Brief at 10-11. The applicant's speculations as to what registrant believes or has acknowledged are irrelevant.

² The examining attorney notes the applicant's reference to MILE HIGH SALUTE for "entertainment services in the nature of professional football games and exhibitions", however, the services are not identical and there is no way of establishing at this ex parte appeal what agreements have been made between that registrant and the instant registrant.

In comparing the marks, the applicant contends that the term MILE HIGH in its mark refers to Denver and not to the stadium. The applicant also states that field and stadium are synonymous, so people would not refer to a field at a stadium. In other words, the applicant states that its mark is INVESCO FIELD AT MILE HIGH CITY and not INVESCO FIELD AT MILE HIGH STADIUM. However, it is clear that many people refer to the applicant's stadium service as INVESCO FIELD AT MILE HIGH STADIUM. See the forty-two (42) articles from the examining attorney's search in a computerized database attached to the final Office action, including, inter alia, the following content:

"they crunched the Denver Broncos in their new home Invesco field at Mile High Stadium", "in the wintry mix yesterday at Invesco Field at Mile High Stadium", "when they visit the Broncos at INVESCO Field at Mile High Stadium", "victory over the Chiefs on Sunday at Invesco Field at Mile High Stadium."³

Note also article 55 which is a Poll about "mileage left in old stadium name" and which finds that 81% of people will call the new stadium Mile High Stadium; Article 64 which states,

"...Invesco declined to specify whether its bid would preserve the name of the old stadium while including its own name, such as Invesco Field at Mile High Stadium";

and Article 67, which states,

"told the News that the district and Invesco had talked about a hybrid that would include the corporate name and the popular Mile High, perhaps Invesco Field at Mile High Stadium".

³ See articles 1, 2, 10 and 17 attached to the final Office action.

Therefore, it is likely that the public would view the missing term at the end of the applicant's mark to be Stadium and not City. See also the articles attached to the final Office action showing that Mile High Stadium is often referred to without the generic "stadium" designation, simply as "Mile High", and to the articles showing stadium and field used together in the same name.⁴ Note also that in proper English grammar, if "Mile High" referred to a city, the phrase would be "in Mile High", i.e. Invesco Field in Mile High and that "at Mile High" refers only to the stadium. The examining attorney notes the applicant's argument that "at" refers to altitude, however, under the applicant's argument "Mile High" refers to Denver itself, therefore, the appropriate term would be "in". Moreover, "Mile High" is not an actual altitude name, such as "sea level" or "1000 feet." Further, in reference to the phrase "AT MILE HIGH", see the articles attached to the final Office action: out of the 47 hits listed for "at mile high", each referred to sports and each referred to the stadium. None referred to "at mile high" as merely the city of Denver. The examining attorney printed only the first 25 stories.

Finally, the applicant argues that there is no actual consumer confusion, that MILE HIGH STADIUM has been demolished and that the history surrounding the marks demonstrates that there is no likelihood of confusion. The applicant supports much of this argument with conclusory statements and evidence that was not properly made of record before the filing of the Appeal Brief, as per Rule 2.142(d). See Applicant's Brief at 11-13. The examining attorney objects to the untimely submission of the photograph as well as to the references to the content of online web sites that were never properly

⁴ For example, "Qualcomm Stadium at Jack Murphy Field"; "Morse Field at Alford Stadium"; "Scott Stadium at Harrison Field at Boozler Complex"; "Rex Dockery Field at Liberty Bowl Memorial Stadium"; "Coors Field tour... Take a trip to the rarely seen areas of the Rockies' stadium."

made of record. None of the statements based upon the content of the web sites have support either in web site print outs or in a signed declaration attesting to the truth of the information asserted. However, to the extent that the arguments are supported in the record, the examining attorney notes that the test under Section 2(d) of the Trademark Act is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein. TMEP §1207.01(d)(ii). In addition, in discussing the history surrounding the marks and in arguing that the stadium has been demolished, the applicant appears to be casting a shadow of doubt on the validity of registrant's registration and suggesting that it should no longer be accorded any validity. If this is applicant's tacit intention, then the proper forum for applicant's remedy would be a cancellation proceeding. Such argument at this time is inappropriate and inapposite.

CONCLUSION

The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). In the instant case, the services are legally identical and the marks have a highly similar commercial impression, therefore, confusion is likely among consumers as to the source of those services. Accordingly, the refusal to register under Trademark Act Section 2(d) should be affirmed.

Respectfully submitted,

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