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Paper No. 12
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Amvescap PLC

Serial No. 75/529,866

David E. Sipiora of Townsend and Townsend and Crew LLP
for Amvescap PLC.

Rebecca Gilbert, Trademark Examining Attorney, Law Office
113 (Meryl Hershkowitz, Managing Attorney).

Before Walters, Wendel and Bottorff, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Amvescap PLC has filed an application to register the
mark INVESCO ENDEAVOR FUND for "financial services, namely,
mutual fund investment services."¹

Registration of applicant's mark has been finally
refused under Section 2(d) of the Trademark Act on the
ground of likelihood of confusion with the mark ENDEAVOR

¹ Serial No. 75/529,866, filed July 30, 1998, based on an
allegation of a bona fide intention to use the mark in commerce.
A disclaimer has been made of the word FUND.

which is registered for "investment management, advisory and administrative services and the offering of investment opportunities in an open ended management investment company."²

The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of the *du Pont*³ factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective marks, the Examining Attorney argues that this is a situation in which the general rule applies that the mere addition of a term to a registered mark is not sufficient to avoid the likelihood of confusion. She argues that applicant has merely added

² Registration No. 1,567,525, issued November 21, 1989; Section 8 & 15 affidavits accepted and acknowledged, respectively; first renewal.

³ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

the descriptive term FUND and its corporate house mark INVESCO to the registered mark ENDEAVOR.

Applicant acknowledges the general rule, but notes that there are two exceptions to the rule and argues that both are applicable in the present case. Applicant identifies the first exception as those situations in which the marks in their entireties convey significantly different commercial impressions. Here, applicant argues, the marks convey such significantly different impressions. Applicant's mark is alleged to follow the common practice in the investment field of denominating one's fund with the corporate name followed by the name of the specific fund whereas the cited mark conveys no such impression that it is associated with a fund or, in fact, with any particular goods or services.

The second exception is identified as those situations in which the matter common to the marks is not likely to be perceived by purchasers as source-distinguishing due to its mere descriptiveness or the commonness of its use. Here, applicant argues, the term ENDEAVOR is commonly used in the financial industry and points to the evidence which it has made of record of many companies which incorporate the word "endeavor" as part of their trade names. Applicant further

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argues that it has identified eighty-four marks on the register containing the term "endeavor."

As a general rule, the addition of a house mark to one of two otherwise similar marks will not serve to avoid a likelihood of confusion. See *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986); *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985); *Envirotech Corp. v. National Service Industries, Inc.*, 197 USPQ 292 (TTAB 1977). In fact, the addition may actually be an aggravation of a likelihood of confusion as opposed to an aid in distinguishing the marks so as to avoid confusion. Exceptions are made to this general rule, however, if (1) there are some recognizable differences between the assertedly conflicting marks or if (2) the common portion of the marks is merely descriptive or highly suggestive or plays upon commonly used or registered terms, so that the addition of the house mark may be sufficient to render the marks as a whole distinguishable. See *In re Christian Dior, S.A.*, *supra*; *Envirotech Corp. v. National Services Industries, Inc.*, *supra*.

The common portion of the marks before us is the word ENDEAVOR. There is no difference whatsoever between the term as used by applicant and registrant. Even with the addition of the descriptive term FUND by applicant, the

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marks are highly similar in commercial impression, when considered in relation to the investment services with which they are used, or are intended to be used. Although applicant argues that the mark ENDEAVOR gives no indication that it is being used with a fund or any particular goods or services, this is clearly not the proper manner in which to view the mark. The mark is registered for use in connection with various investment services and thus must be construed as being used in this manner. Whether or not the word FUND is actually present in the mark itself does not detract from the fact that it is being used in connection with services of this nature. Thus, the marks ENDEAVOR and ENDEAVOR FUND, when used in connection with investment services, create similar commercial impressions.

Although applicant argues that only its mark follows the common practice of denominating the fund with the corporate name as well as the name of the specific fund, registrant is not limited in any way by its registration to use of its ENDEAVOR mark as either the name of a specific fund or as a house or corporate mark. While applicant has introduced evidence showing registrant's present practice of using the mark in the manner of a house mark, registrant is clearly not so restricted by its registration. Furthermore, since registrant has been shown to use its

mark in connection with highly descriptive terms such as "variable annuity," it would appear that purchasers might still assume that ENDEAVOR was the specific name given by registrant to a particular fund, as opposed to being used as a house mark. Whatever the case, if purchasers familiar with use of the mark ENDEAVOR with investment services and investment funds come upon the mark INVESCO ENDEAVOR FUND, they are likely to assume that INVESCO is merely being used as an identifier of the corporate entity behind the previously known ENDEAVOR funds. This is not a matter of the use of two separate house marks in connection with a specific fund name such that two separate commercial impressions are created. Instead applicant has simply appropriated the ENDEAVOR mark of registrant, added the highly descriptive term FUND which is devoid of source-indicating significance, and attached its corporate name INVESCO to registrant's mark. Thus, the first exception is not applicable here.

As for the second exception, applicant has failed to establish that the term "endeavor" is so commonly used in the relevant field that the addition of its house mark would be sufficient to render the marks of applicant and registrant distinguishable. In the first place, applicant's information gathered from the Internet (Exhibit

H) as to the existence of 236 companies using the term "endeavor" as part of their trade names is for the most part totally irrelevant. By and large these are companies directed to businesses or activities completely different from the investment services involved here. Moreover, in many the term used is "endeavors" rather than "endeavor." Thus, we find the probative weight of this evidence to be minimal. While applicant has also introduced evidence obtained from a Dun & Bradstreet Report (Exhibit G) of approximately five entities⁴ doing business in financial services having the term "endeavor" as part of their trade name, we do not find this number of companies across the United States to be such a significant number as would cause us to classify "endeavor" as a commonly used term in the field.⁵ Although applicant also refers to registered marks containing the term, applicant has made no evidence of record to substantiate this claim. Thus, the second

⁴ We note that one of these entities appears to be related to registrant, namely, Endeavor Group. (Note reference to same in Exhibit A).

⁵ While the Dun & Bradstreet Report may be sufficient to establish the existence of these businesses at the time the report was prepared, we have no evidence of the date of the report or the timeliness of the information. Moreover, the information is of even more limited probative weight, in that the report does not show to what extent the company names have been used or public awareness with the same. See *Tiffany & Co v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1839 n.5 (TTAB 1989).

exception is equally inapplicable. The common portion of the marks, ENDEAVOR, has not been shown to be so commonly used in the investment field or to be so insignificant as an indicator of source that the addition of a house mark would render applicant's and registrant's marks as a whole distinguishable.

Turning to the respective services, we have applicant's acknowledgment that "its recitation of services is highly similar to those encompassed by the cited mark." (Request for Reconsideration p.3). The overlap of applicant's particular investment services with the more broadly recited services of registrant is clear.

Applicant, however, argues that the channels of trade for the services differ, on the basis of information applicant learned with respect to the availability of registrant's services only through a broker (Exhibit A), whereas applicant's services are available to anyone using the Internet.

There are no restrictions, however, in the registration or the application as to the channels of trade and thus we must presume that the services of both are offered in all the normal channels of trade to all the normal purchasers of such services. See Kangol Ltd. v. KangaROOS U.S.A., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir.

1992). The distinctions argued by applicant based on present practices are irrelevant.

Applicant also raises for consideration the sophistication and degree of care exercised by persons entrusting their money to investment companies. Applicant further argues that these purchasers would be familiar with the practice in the trade of using the company name as the first word in a fund name and thus would be able to readily distinguish between the INVESCO ENDEAVOR FUND and a fund offered by the ENDEAVOR company. As we have pointed out, however, registrant is in no way limited to using the mark ENDEAVOR as a company name, rather than a specific fund name. Purchasers, regardless of sophistication or care taken, are not immune from confusion as to origin if already aware of an ENDEAVOR fund and then coming upon an INVESCO ENDEAVOR FUND. Whether applicant's fund is thought to originate with registrant or vice versa, confusion as to source is likely. Purchasers may be sophisticated in the investment world, but this does not mean they are immune from confusion as to the origin of investment services when confronted with confusingly similar marks. See *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992).

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Accordingly, upon consideration of the relevant *du Pont* factors, we find confusion likely with the contemporaneous use by applicant of its INVESCO ENDEAVOR FUND mark and registrant of its ENDEAVOR mark for the highly similar investment services recited in the application and registration.

Decision: The refusal to register under Section 2(d) is affirmed.