

Keywords: Trademarks; likelihood of confusion; relatedness of goods and services

General: The Fed. Circuit reversed the Board's refusal to register the mark TAKETEN in view of a registered mark TAKE 10!. Although the marks are similar, substantial evidence did not support the USPTO's refusal to register the TAKETEN mark given the dissimilarities in the respective services and goods and the high degree of consumer care.

In re St. Helena Hospital
No. 2014-1009 (Fed. Cir. 2014)
Decided December 16, 2014

I. Facts

St. Helena Hospital ("St. Helena") applied to the USPTO to register the mark TAKETEN, which St. Helena used in connection with a 10-day health improvement program at its in-patient facility. The trademark application identified the service as "[h]ealth care services, namely, evaluating weight and lifestyle health and implementing weight and lifestyle health improvement plans in a hospital-based residential program."

The Examiner refused to register the mark, citing a likelihood of confusion with the registered marks, TAKE 10! and TAKE 10! (and Design) for "printed manuals, posters, stickers, activity cards and educational worksheets dealing with physical activity and physical fitness."

The Trademark Trial and Appeal Board ("Board") considered the following *DuPont* factors: (1) the similarity or dissimilarity of the marks in terms of appearance, sound, meaning and commercial application; (2) the similarity or dissimilarity and nature of the goods and services; (3) the similarity or dissimilarity of established, likely-to-continue channels of trade; and (4) the conditions under which and buyers to whom sales are made, i.e., degree of consumer care. The Board found that the balance of the *DuPont* factors supported a likelihood of confusion and affirmed the Examiner's rejection. St. Helena appealed to the Federal Circuit.

II. Issue

1) Does substantial evidence support a finding of a likelihood of confusion?

III. Discussion

1) No. The Court found that the TAKETEN and TAKE 10! marks are similar, but that substantial evidence did not support the Board's refusal to register St. Helena's TAKETEN mark given the dissimilarities in the respective services and goods and the high degree of consumer care.

Similarity or Dissimilarity of the Marks

The Court found that substantial evidence supported the Board's conclusion that the marks TAKETEN and TAKE 10! are similar. The Board found that the marks are similar in appearance, sound, meaning and commercial impression because the marks are "phonetically identical," the word "ten" and the number "10" mean the same thing, and both marks mean taking a break from work. In its arguments, St. Helena focused on three differences in appearance between the marks: that in its mark the number is spelled out rather than written as a numeral, that there is no space between the two words, and that there is no exclamation point. The Court found that none of the differences noted by St. Helena meaningfully distinguish the appearance of the marks. Additionally, the Court noted that the exclamation mark does not alter the pronunciation or the commercial impression of the mark.

Similarity or Dissimilarity and Nature of the Goods and Services

The Court found that substantial evidence did not support the Board's conclusion that St. Helena's services identified by the TAKETEN mark are related to the goods identified by the TAKE 10! marks. This factor considers whether the consuming public may perceive the respective goods and services of the parties as related enough to cause confusion about the source or origin of the goods and services. In its opinion, the Court extended the "something more" standard that they previously applied to restaurant services. In particular, the Court stated that if the relatedness of the goods and services is obscure or not generally recognized, the USPTO must show "something more" than the mere fact that the goods and services are "used together." Because the Board did not show that St. Helena's services and the TAKE 10! printed materials are generally recognized as being related and did not show "something more" to establish relatedness, the Board's conclusion that the services and goods are related lacks substantial evidence.

Similarity or Dissimilarity of Established, Likely-to-Continue Channels of Trade

The Court found that both sides' evidence regarding the channels of trade was lacking and noted that the Board did not state whether the Board found this factor to suggest a likelihood of confusion or to be neutral.

Degree of Consumer Care

The Court found that substantial evidence did not support the Board's conclusion with respect to the level of consumer care. The Board found that, although the customers of St. Helena's services will exercise a high degree of care, the customers would not exercise the same level of care in analyzing printed materials received while participating in the services. The Court noted that the record contains no evidence that the level of care exercised by consumers before entering a health-care program is lower than the level of care exercised once in the program.

IV. Conclusion

The Court reversed the Board's refusal to register the TAKETEN mark because substantial evidence did not support a finding of likelihood of confusion with the TAKE 10! marks.