

IN RE ST. HELENA HOSPITAL, Appeal No. 2014-1009 (Fed. Cir. December 16, 2014).  
Before Lourie, Linn and O'Malley. Appealed from TTAB.

Background:

St. Helena Hospital applied to register the mark "TAKETEN" for services relating to a 10-day residential health improvement program. The examiner refused to register the mark, citing likelihood of confusion with a registered "TAKE 10!" mark for goods such as printed manuals, posters, educational worksheets and other items dealing with physical activity and physical fitness. St. Helena appealed to the TTAB (Board). The Board analyzed the likelihood of confusion of the two marks by examining the first four *DuPont* factors, and affirmed the examiner's refusal to register the mark. St. Helena appealed to the Federal Circuit.

Issue/Holding:

Did the Board err in determining likelihood of confusion? Yes, reversed and remanded.

Discussion:

With regard to the first *DuPont* factor (similarity or dissimilarity of the marks in terms of appearance, sound, meaning and commercial impression), the Court agreed with the Board. The Court held that the actual differences in the mark, such as spacing, punctuation, and use of the numeral "10" was minimal. The Court noted that the marks also have similar connotations, since both marks relate to fitness and health, and also found that the use of the exclamation point in the "TAKE 10!" mark does not affect the commercial impression of the mark.

With regard to the second *DuPont* factor (similarity or dissimilarity and nature of the goods and services), the Court disagreed with the Board that the marks would be generally recognized as related because the goods and services of both marks are complementary and could be "used together." The Court pointed out that when the types of goods and services associated with the marks are obscure, the PTO needs to demonstrate more than the fact that the goods and services could be "used together."

With regard to the third *DuPont* factor (similarity or dissimilarity of established, likely-to-continue channels of trade), the Court disagreed with the arguments of both parties. First, the Court stated that St. Helena's argument that the registrant's goods are directed only to educators is incorrect. Second, the Court found that the Board was incorrect in finding that because St. Helena's services and the registrant's goods are promoted through websites, the channels of trade are similar. The Court noted that advertising on the Internet is ubiquitous and proves little, if anything, about the likelihood that consumers will confuse similar marks.

With regard to the fourth *DuPont* factor (the degree of customer care), the Board conceded that participants in a health care program would exercise a high degree of care in entering the program, but concluded that the level of care exercised by consumers once in the program would be low. The Court found no substantial evidence to support that conclusion. Thus, when balancing each of the factors, the Federal Circuit found for St. Helena, and reversed the Board's refusal to register the mark.