

US: TRADE MARKS

Court expands something more standard

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In the case *In re St Helena Hospital*, the United States Court of Appeals for the Federal Circuit recently expanded the so-called “something more” standard for the relatedness of goods and services in analysing whether a likelihood of confusion existed between two marks.

The USPTO had refused to register St Helena’s trade mark for the mark *Taketen* covering certain health care services (class 41) based on a likelihood of confusion with a third party registration for the mark *Take 10!* covering printed materials dealing with physical activity and physical fitness (class 16). St Helena appealed the refusal to the Trademark Trial and Appeal Board, which affirmed the examiner’s refusal, concluding that consumers are likely to believe that health care services and similarly marked printed materials have a common source.

In support of its holding, the Board relied on several examples of organisations that render healthcare services and distribute printed materials. The Board acknowledged that in certain contexts (such as the potential relatedness between food products and restaurant services), something more than just the use of similar marks was required to demonstrate a likelihood of confusion between goods and services. However, the Board took the position that, in the case of healthcare services and printed materials, the so-called something more standard did not need to be applied.

St Helena subsequently filed an appeal of the Board’s decision with the Court of Appeals. The Court held that, although the references cited by the PTO show that printed materials are used in connection with various health services, substantial evidence does not support the Board’s assertion that printed materials distributed as part of a weight loss pro-

gramme bear the same mark as the facility offering the programme. Since the relatedness of the goods and services at issue is less evident than in the general recognised cases of common origin (such as in a case dealing with a mark used for a brewpub and a mark used for beer), the Court ruled that the PTO needed to show “something more than the mere fact that the goods and services are used together”. The Court noted that while it has applied the something more standard in the past in the context of restaurant services, “the rule is not so limited and has application whenever the relatedness of the goods and services is not evident, well-known or generally recognized”.

The Court ruled that the decision by the Board did not show that healthcare services and printed materials are generally recognised as being related. Nor did the Board’s decision demonstrate the existence of something more to establish relatedness. Accordingly, the Court found that the Board erred in its determination of likelihood of confusion and remanded the case for further proceedings applying the something more standard.

The Court noted that the majority of the references discussed by the Board were not included in the record. Consequently, the Court could not use such references to determine whether the printed materials feature the applicable healthcare facility’s mark. Had such references been of the record, it is possible that the Board may have been able to satisfy the something more standard to support a finding of a likelihood of confusion. At a minimum, this case demonstrates that the PTO will have to provide additional evidence to support a claim that categories of goods and services are “related”.