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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re St. Helena Hospital

Serial No. 85416343

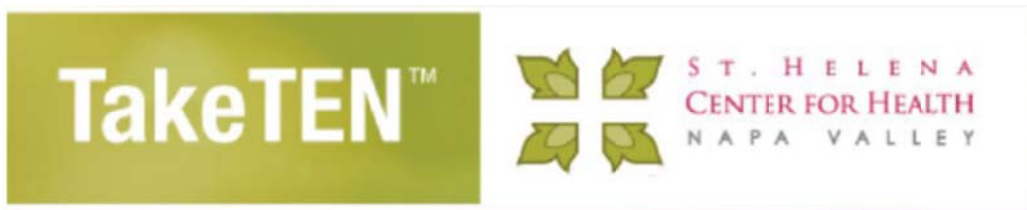
Bradley P. Heisler of Heisler & Associates for St. Helena Hospital.

Benji Paradewelai, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Holtzman, Bergsman and Greenbaum, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Applicant St. Helena Hospital filed a use-based application to register the mark TAKETEN, in standard character form, for “health care services, namely, evaluating weight and lifestyle health and implementing weight and lifestyle health improvement plans in a hospital-based residential program,” in Class 44. Applicant displays its mark on its specimen of use as TakeTEN as shown below.



The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), citing the two previously-registered marks listed below owned by the same entity as bars to registration:

1. Registration No. 2577657 for the mark TAKE 10!, in typed drawing form, for "printed manuals, posters, stickers, activity cards and educational worksheets dealing with physical activity and physical fitness," in Class 16;¹ and

2. Registration No. 2674182 for the mark TAKE 10! and design, shown below, for "pre-recorded videocassettes featuring physical activity and physical fitness promotion programs," in Class 9, and "printed manuals, posters, stickers, activity cards, and educational worksheets dealing with physical activity and physical fitness," in Class 16.²



Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of

¹ Registered Jun 11, 2002; renewed.

² Registered January 14, 2003; Section 8 and 15 affidavits accepted and acknowledged. Registrant's Section 8 affidavits and Section 14 renewal application were due on January 14, 2013, but have not been filed. The grace period expires July 14, 2013. Because of the uncertainty regarding the status of this registration, we will not consider it any further.

likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

1. The similarity or dissimilarity of the marks in terms of appearance, sound, meaning and commercial impression.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v.*

JFD Electronics Components Corp., 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

TAKETEN and TAKE 10! are phonetically identical.

When used in the marks TAKETEN or TAKE 10!, the word “ten” and the numeral “10” mean the same thing. *Cf. In re Vanilla Gorilla L.P.*, 80 USPQ2d 1637, 1640 (TTAB 2006) (“There is no difference between using the Arabic numeral ‘30’ or the word ‘thirty.’ Both mean exactly the same thing.”). The term “take ten” is defined as “taking a break especially from work.”³ Thus, the marks have similar meanings and engender similar commercial impressions (*e.g.*, take ten minutes for health and physical fitness). In this regard we note that applicant’s specimen advertises that spending “ten days with us can put you on the road to a lifetime of good health.” Registrant’s specimen advertises “Healthier Lifestyles 10 Minutes at a Time.”⁴

³ *Merriam-Webster* (m-w.com). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁴ Applicant’s June 27, 2012 response to Office action.

Because the marks sound alike and because the marks have similar meanings and engender similar commercial impressions, the difference between the word “ten” and the numeral “10” in the marks is minimal and, therefore, the marks are similar in appearance.

In view of the foregoing, we find that the marks are similar in terms of appearance, sound, meaning and commercial impression.

2. The similarity or dissimilarity and nature of the goods and services, established likely-to-continue channels of trade, and classes of consumers.

Registrant’s mark is used in connection with “printed manuals, posters, stickers, activity cards and educational worksheets dealing with physical activity and physical fitness.”

Applicant is seeking to register its mark for “health care services, namely, evaluating weight and lifestyle health and implementing weight and lifestyle health improvement plans in a hospital-based residential program.”

The evidence of record shows that printed materials are used in connection with the rendering of applicant’s health care services. For example,

a. The Allina Hospitals & Clinics offer a weight management program, including basic skills for living with diabetes which includes forms and worksheets, including “Effects of diabetes,” “Food and exercise diary,” and “My eating guide.”⁵

b. The Inova medical weight loss program includes a special notebook to collect tips and educational materials that are distributed during its program.⁶

⁵ December 27, 2011 Office action.

⁶ December 27, 2011 Office action.

c. The Duke Diet & Fitness Care Program provides an informational newsletter.⁷ The Pritikin Center weight loss and spa program also includes a newsletter.⁸

d. The Hilton Head Health Weight Loss Spa provides “helpful handouts that will support you in setting manageable workout goals, trying new exercise routines (with video instruction), tracking your progress in strength training log, and more!”⁹

e. The River Oaks Hospital weight management program includes a heart disease worksheet.¹⁰

The evidence shows that printed material in the nature of forms, worksheets, newsletters, and notebooks are used in connection with “health care services, namely, evaluating weight and lifestyle health and implementing weight and lifestyle health improvement plans in a hospital-based residential program” such that consumers are likely to believe that the services and similarly marked products come from the same source or are somehow connected with or sponsored by a common company. The printed products and the weight and lifestyle services, while not interchangeable, are complementary in that they can be used together. *Visual Info. Inst., Inc. v. Vicon Indus., Inc.*, 209 USPQ 179, 190 (TTAB 1979). *See also Kohler v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1110 (TTAB 2007) (goods

⁷ July 18, 2012 Office action.

⁸ July 18, 2012 Office action.

⁹ July 18, 2012 Office action.

¹⁰ July 18, 2012 Office action. *See* transformationsriveroaks.com.

may be viewed as complementary when they are used together). In other words, it is not uncommon for a weight loss or lifestyle health improvement program to include printed materials.

In view of the foregoing, we find that the registrant's printed materials and applicant's services are related and would be encountered by the same persons under conditions and circumstances that could, because of the similarity of the marks, cause them to believe that they emanate from the same source.

Applicant contends to the contrary that the evidence proves just the opposite. While conceding that facilities that render weight loss and lifestyle improvement programs "often provide a large volume of information to discerning prospective customers," "[o]nly in rare instances ... are any printed materials or pre-recorded videocassettes supplied relating to physical activity or physical fitness." "Also, when provided, such goods rarely bear the same mark under which the lifestyle improvement services are provided."¹¹ Applicant's contention is not supported by the record. For example, the Duke Diet & Fitness Center has a newsletter for participants that features the Duke Diet & Fitness Center trademark.



The Pritikin Center distributes a newsletter, *Pritikin Perspective*, to patients to help them maintain healthy lifestyles after they leave the Pritikin facility.

¹¹ Applicant's Brief, p. 9.

The Hilton Head Health Weight Loss Spa provides “helpful handouts that will support you in setting manageable workout goals, trying new exercise routines ... tracking your progress in weight training log, and more!”

The Transformations at River Oaks weight loss management program includes “[o]ngoing behavior modification ... addressed through our 12 week LEARN® program. This program provides nutrition education and addresses behaviors that can lead to weight gain. It is designed to change the way you think about dieting.” It is inconceivable that the programs noted above are conducted without printed materials for the patients and that the printed materials do not feature the trademarks or trade names of the respective facilities.

Applicant further supports its position that registrant’s goods and applicant’s services are not related by citing *In re Coors Brewing Co.*, 343 F. 3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) (BLUE MOON and design for beer is not likely to cause confusion with BLUE MOON and design for restaurant services). However, when analyzing whether food or beverages are related to restaurant services, the fact that restaurants serve food and beverages is not enough to render food and beverages related to restaurant services for purposes of determining likelihood of confusion. “To establish likelihood of confusion a party must show *something more* than that similar or even identical marks are used for food products and for restaurant services.” *In re Coors Brewing Co.*, 68 USPQ2d at 1063, quoting *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982). In *Coors*, the court found that the evidence of record did not support the “something

more” standard to find that restaurant services and beer were related for purpose of the likelihood of confusion analysis. In this case, there is no “something more” standard and, as discussed above, we find that the evidence is sufficient to support finding that weight loss and lifestyle health improvement services are related to “printed manuals, posters, stickers, activity cards and educational worksheets dealing with physical activity and physical fitness” that may be used in connection with weight loss and lifestyle health improvement.

Applicant argues that the goods in the cited registrations “would be marketed to those who are in the business of buying printed materials such as ‘educational worksheets dealing with physical activity and physical fitness.’ Such buyers would primarily be educators, such as teachers or other curriculum buyers for educational institutions.”¹² However, in analyzing the channels of trade factor in the present case, it is of significant importance that the issue of likelihood of confusion must be determined on the basis of registrant’s goods as they are set forth in the involved registration, rather than in light of what the goods actually are as shown by any extrinsic evidence. *See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); and *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). Thus, where the goods in an involved registration are broadly identified

¹² Applicant’s Brief, p. 13.

as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses all the goods of the nature and type described therein, that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof, including facilities that render weight loss and lifestyle health improvement programs. *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139, 139-40 (CCPA 1958); and *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

C. Degree of consumer care.

Applicant argues that consumers or patients considering applicant's services exercise a high degree of care because of the significant time commitment and expense.¹³ Also, applicant asserts that because registrant's printed materials are sold to educators or physical fitness promoters, such educational professionals are likely to exercise a high level of care.¹⁴ As discussed above, we may not restrict the channels of trade or classes of consumers for registrant's goods unless that restriction is part of the identification of goods.

While we acknowledge that patients considering applicant's services will exercise a high degree of care, we have no basis to conclude that they exercise the same level of care analyzing printed materials that they receive while participating

¹³ Applicant's Brief, p. 15.

¹⁴ *Id.*

in applicant's services. Accordingly, we find that the degree of care factor is neutral.

D. Balancing the factors.

Because the marks are similar, the goods and services are related, and the channels of trade and classes of consumers are the same, we find that applicant's mark TAKETEN for "health care services, namely, evaluating weight and lifestyle health and implementing weight and lifestyle health improvement plans in a hospital-based residential program" is likely to cause confusion with the mark TAKE TEN! for "printed manuals, posters, stickers, activity cards and educational worksheets dealing with physical activity and physical fitness."

Decision: The refusal to register is affirmed.