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Federal Circuit Expands "Something More" Standard in Trademark Cases

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The US Court of Appeals for the Federal Circuit has issued a precedential decision in *In re St Helena Hospital* (No 14-1009, December 16 2013), extending the 'something more' standard for relatedness of goods and services in a likelihood of confusion analysis.

St Helena Hospital applied to register 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". The US Patent and Trademark Office (USPTO) rejected the application over two TAKE10! registrations for, in part, "printed manuals, posters, stickers, activity cards and educational worksheets dealing with physical activity and physical fitness". The Trademark Trial and Appeal Board affirmed, concluding that, while the marks were similar, the so-called 'something more' standard

did need not be applied regarding the relatedness of such goods and services (health care services and printed materials).

The 'something more' standard is frequently applied in determining whether goods and/or services are related. Where the goods and services could be used together, the USPTO had to show 'something more' than that fact. For example, a similar mark might be used for a restaurant and a beverage. Restaurants frequently offer third-party products such as a beer. The 'something more' standard required more than simple 'relatedness' because such a product and service could be used together. Just because a beer would be offered at a brewpub was not enough to find the goods and services sufficiently related to establish a likelihood of confusion. In such circumstances, the USPTO had to show 'something more.'

St Helena expands the 'something more' standard beyond the traditional areas (such as food and beverage) to goods and services that are not "well known" or "generally recognised" as having a common source of origin. The Federal Circuit provides guidance in *St Helena* as to what constitutes "well known." Brewpub services and beer, and electronic transmission of data via computers and computers/computer software, are two combinations considered to be well known in that consumers believe that the goods and services in such areas have a common source of origin. In those circumstances, the lower burden of proof applies.

However, where the relatedness between the services and goods is "less evident" or "obscure", the higher 'something more' standard applies and the fact that the goods and services can be used together is not sufficient, on its own, to establish similarity of the goods and services. The mere fact that the subject goods and services are used together does not show "relatedness."

In the *St Helena* application, the relatedness of the goods and services was at least less evident and, therefore, it was not sufficient for the USPTO to merely assert a relationship

between health care services and printed materials. The USPTO had failed to show relatedness under the 'something more' standard and the Federal Circuit reversed.

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