

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Hyundai Motor Company

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Serial Nos. 88599435 and 88599451¹

Charles P. Guarino of Moser Taboada,
for Hyundai Motor Company.

Christina Calloway, Trademark Examining Attorney, Law Office 122,
Kristin Dahling, Managing Attorney.

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Before Lykos, Greenbaum, and Hudis,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On August 30, 2019, Hyundai Motor Company (“Applicant”) filed two applications, Serial Nos. 88599435 and 88599451, each seeking registration on the

¹ Because we deem the cases to have common questions of fact and of law, and the records are largely identical, the Board has consolidated the appeals and is issuing a single opinion. *See, e.g., In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1043 (TTAB 2013) (two appeals involving common issues of law and fact decided in a single opinion); *In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009) (because appeals involved common questions of law and fact and records were practically identical, Board decided both in a single opinion). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 1214 (2022). Unless otherwise noted, Trademark Status & Document Retrieval (“TSDR”) record citations and TTABVUE docket entries are to Serial No. 88599435, the parent case.

Principal Register of the same standard character mark, HYUNDAI CARPAY (CARPAY disclaimed), for goods and services ultimately identified as:

Downloadable AVN (Audio Video Navigation) software for in-vehicle simple payments; downloadable AVN (Audio Video Navigation) for vehicles with in-vehicle simple payment function; secure terminals for in-vehicle electronic transactions; downloadable computer firmware for in-vehicle simple payment platforms; downloadable smart phone application software for in-vehicle simple payments; remote control apparatus for radios, televisions, stereos, and in-vehicle electronic systems for in-vehicle simple payments; downloadable computer software for in-vehicle simple payments; downloadable smart phone application software connectable to in-vehicle systems for in-vehicle simple payments; downloadable computer programs for simple payments through in-vehicle AVN (Audio Video Navigation); apparatus for processing in-vehicle electronic payments, namely, electronic payment terminal; downloadable smart phone application software allowing in-vehicle use of and simple payment for fueling, parking, tollgates, food and drink, and various other stores; downloadable computer software allowing the in-vehicle use of and simple payment for fueling, parking, tollgate, garage, food and drink, and various other stores; terminals for electronic transaction with built in cars; downloadable computer e-commerce software to allow users to perform electronic business transactions via a global computer network in International Class 9;² and

Providing access via a wireless local area network to applications for vehicles, for in-vehicle simple payments; providing access to the Internet via mobile devices to information for vehicles, for in-vehicle simple payments; providing access to wireless internet, for simple in-vehicle payments; transmission of membership benefit messages via applications for smart phones, concerning in-vehicle

² Application Serial No. 88599435, filed under Trademark Act Sections 1(b) and 44(d), 15 U.S.C. §§ 1051(b) and 1126(d), based upon Applicant's allegation of a bona fide intention to use the mark in commerce and claiming a priority date of June 20, 2019 based on the filing date of Applicant's South Korean application. During prosecution, Applicant perfected its filing basis from Section 44(d) to Section 44(e) based on International Registration No. 1618953 issued June 25, 2020.

simple payments; providing on-line access to databases, for in-vehicle simple payments; providing access to e-commerce platforms on the Internet; electronic transmission of vehicle information and data, for in-vehicle simple payments; electronic order transmission services; electronic transmission of vehicle-connected smart phone application data, for in-vehicle simple payments; wireless communication network services for vehicles for the transmission of data for in-vehicle simple payments for in-vehicle simple payments; providing long distance telecommunications services for vehicles, for in-vehicle simple payments; telephone communication services provided for call centers, concerning in-vehicle simple payments; providing access to the Internet mobile content for vehicles via mobile phones, for in-vehicle simple payments in International Class 38.³

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's applied-for mark so resembles the mark CARPAY in standard characters on the Principal Register for "software as a service (SAAS) services featuring software for facilitating auto loan payments" in International Class 42, that it is likely to cause confusion or mistake or to deceive.⁴

³ Application Serial No. 88599451, filed under Trademark Act Sections 1(b) and 44(d), 15 U.S.C. §§ 1051(b) and 1126(d), based upon Applicant's allegation of a bona fide intention to use the mark in commerce and claiming a priority date of June 20, 2019 based on the filing date of Applicant's South Korean application. During prosecution, Applicant perfected its filing basis from Section 44(d) to Section 44(e) based on International Registration No. 1618956 issued June 25, 2020.

Citations to the prosecution file refer to the USPTO's Trademark Status & Document Retrieval ("TSDR") system. Citations to briefs refer to actual page number, if available, as well as TTABVUE, the Board's online docketing system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

⁴ Registration No. 5772963, issued on June 11, 2019.

Following issuance of the final refusals, Applicant timely filed notices of appeal in each application. Each appeal is now briefed.⁵ We affirm the refusals to register.

I. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence or argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the goods and services, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 26 USPQ2d at 1688 (“the

⁵ Applicant submitted with its appeal briefs materials that appear to be part of the prosecution record. This was unnecessary. *See In re Information Builders Inc.*, 2020 USPQ2d 10444, at *2 n.4 (TTAB 2020) (attaching previously submitted evidence to an appeal brief is unnecessary and impedes efficient disposition of the appeal by the Board), appeal dismissed, No. 20-1979 (Oct. 20, 2020). Furthermore, if any of the materials attached to Applicant’s appeal briefs were not previously made of record, they are untimely and have not been considered. *See Trademark Rule 2.142(d)*, 37 C.F.R. § 2.142(d) (“The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.”).

various evidentiary factors may play more or less weighty roles in any particular determination”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)); *see also In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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 others, are discussed below.

A. The Similarity or Dissimilarity of the Marks

We commence with the first *DuPont* factor, an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (citing *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019); (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). *Accord Krim-Ko Corp. v.*

Coca-Cola Bottling Co., 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). The respective marks “must be considered ... in light of the fallibility of memory” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)).

Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). “No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)). Nonetheless, there is

nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

Applicant acknowledges that both marks contain the term CARPAY but argues that they differ not only visually and aurally but also in meaning and commercial impression due to the addition to its mark of the initial term HYUNDAI, Applicant's "well-known"⁶ corporate name. In terms of appearance and sound, Applicant notes that its mark is comprised of two words, commencing with HYUNDAI, as opposed to Registrant's mark which is comprised of only the single term CARPAY. As to connotation and commercial impression, Applicant argues that because HYUNDAI is distinctive, it differentiates the two marks.

To state the obvious, both marks share the term CARPAY, making them similar in appearance and sound. With regard to determining the dominant element in Applicant's mark, we acknowledge our case law that consumers are generally more inclined to focus on the first word in a trademark. *See, e.g., Palm Bay*, 73 USPQ2d at 1692 (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"). This principle, however, is merely a guide. "[T]he presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical." *In re Mighty Leaf*

⁶ 4 TTABVue 11.

Tea, 601 F.3d, 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). Consumers familiar with the registered mark CARPAY are likely to perceive Applicant's mark HYUNDAI CARPAY as a variant mark denoting a product line extension. *See, e.g., Schieffelin & Co. v. Molson Cos., Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) ("Those consumers who do recognize the differences in the marks may believe that applicant's mark is a variation of opposer's mark that opposer has adopted for use on a different product."); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN "more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices"). This is especially true given that Applicant's applied-for mark HYUDAI CARPAY incorporates the entirety of the cited mark CARPAY. *See, e.g., Glamorene Prods. Corp. v. Procter & Gamble Co.*, 538 F.2d 894, 190 USPQ 543, 545-46 (CCPA 1976) (affirming Board's sustaining of opposition against the application to register the mark BOUNCE BACK for a rug cleaning aerosol composition on grounds of likely confusion with the registered mark BOUNCE for dry cleaning detergent); *Toshiba Medical Sys.*, 91 USPQ2d at 1271 (affirming the Board's refusal to register VANTAGE TITAN as likely to be confused with the registered mark TITAN, stating: "Applicant has taken registrant's mark and added its 'product mark' to it. It is not clear why the addition of the word VANTAGE would avoid confusion. It is more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices.").

Moreover, to the extent, if any, HYUNDAI is a house mark, it is well-established

that “[w]here the marks are otherwise virtually the same, the addition of a house mark ... is more likely to add to the likelihood of confusion than to aid to distinguish the marks.” *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168, 170 (TTAB 1982) (finding likelihood of confusion between the SKIN SAVERS mark for face and throat lotion and the MENNEN SKIN SAVER mark for hand and body lotion). *See also In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1367 (TTAB 2007) (affirming refusal to register CLUB PALMS MVP based on prior registration of MVP, finding consumers “likely to believe that the CLUB PALMS MVP casino services is simply the now identified source of the previously anonymous MVP casino services”); *In re C.F. Hathaway Co.*, 190 USPQ 343, 345 (TTAB 1976) (affirming refusal to register the mark HATHAWAY GOLF CLASSIC for men’s dress and sport shirts based on the registered mark GOLF CLASSIC for men’s hats: “[T]he addition of a trade name or house mark to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion between them.”).

The marks also share a similar meaning and commercial impression. The phrase CARPAY conveys anthropomorphic attributes to Applicant’s and Registrant’s goods and services that somehow an inanimate object such as an automobile is able to process payments. Consumers are likely to take note of this nonsensical notion.

In sum, we acknowledge the fundamental rule that the marks must be considered in their entirety and not dissected. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492

F.2d 1399, 181 USPQ 272, 273-74 (CCPA 1974). We note the specific differences pointed out by Applicant. These differences, however, are outweighed by the similarity of the marks. Thus, we find that the marks HYUNDAI CARPAY and CARPAY, considered as a whole, are highly similar in appearance, sound, connotation and commercial impression. This *DuPont* factor weighs in favor of finding a likelihood of confusion.

B. Strength of the Cited Mark

Next we consider the strength of the cited mark CARPAY. In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. June 2018 update) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought

or at the time the mark is asserted in litigation to prevent another's use.”).

Applicant postulates that the cited mark CARPAY is weak and entitled to only a narrow scope of protection. Applicant has introduced no evidence (e.g., third-party uses) pertaining to the diminished commercial strength of the cited mark, the sixth *DuPont* factor. Rather, Applicant challenges the inherent or conceptual strength of the cited mark, contending that CARPAY “is arguably descriptive in connection with the parties’ respective (as it is literally the fusion of the terms “car” and “pay”).”⁷ In support thereof, Applicant points to the Examining Attorney’s requirement to disclaim the term CARPAY as merely descriptive.

We find otherwise. Registrant’s mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. *Tea Bd. of India*, 80 USPQ2d at 1889. *See also New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020). Registrant’s registration is “prima facie evidence of the validity of the registered mark ...” Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). Furthermore, the record is devoid of evidence that CARPAY is a term of art in the relevant industry. In the absence of such evidence, third-party registrations alone could be relevant, in the manner of dictionary definitions, to demonstrate that a cited mark “has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that [the mark] is relatively weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (internal quotation

⁷ 4 TTABVUE 12-13.

marks omitted). *See also Jack Wolfskin*, 116 USPQ2d at 1135-36. Here, however, we have no third-party registration evidence that might demonstrate the inherent weakness of the cited mark as a source identifier.

Thus, on this record, the cited mark for the identified services is conceptually strong, and Applicant has not shown that the mark has been weakened. When a mark is registered on the Principal Register, “we must assume that it is at least suggestive.” *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007). We therefore give Registrant’s CARPAY mark “the normal scope of protection to which inherently distinctive marks are entitled.” *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

C. The Similarity or Dissimilarity of the Goods and Services

We now compare the goods and services as they are identified in the involved applications and cited registration, the second *DuPont* factor. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

The goods and services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the

mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods and services are used together or used by the same purchasers; advertisements showing that the relevant goods and services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both an applicant’s goods and the goods listed in the cited registration. *See, e.g., Davia*, 110 USPQ2d at 1817 (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores).

“There is no rule that all computer products and services are related.” *The Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1168 (TTAB 2001) (internal citation omitted). With these principles in mind, we analyze each application’s identified goods and services below.

1. Application Serial No. 88599435 – International Class 9 Goods

Registrant’s services are identified as “software as a service (SAAS) services featuring software for facilitating auto loan payments.” Application Serial No. 88599435 includes, among other goods,

Downloadable AVN (Audio Video Navigation) software for in-vehicle simple payments; ... downloadable smart phone application software for in-vehicle simple payments;... downloadable computer software for in-vehicle simple payments; ... downloadable smart phone application software connectable to in-vehicle systems for in-vehicle

simple payments; ... downloadable computer e-commerce software to allow users to perform electronic business transactions via a global computer network; ... downloadable computer programs for simple payments through in-vehicle AVN (Audio Video Navigation); apparatus for processing in-vehicle electronic payments, namely, electronic payment terminal; ... downloadable computer e-commerce software to allow users to perform electronic business transactions via a global computer network.

Applicant argues that,

The services covered by the cited '963 Registration are limited to the handling of loans and loan payments specifically for the purchase of automobiles. It would be reasonable to opine that the relevant consumers for such services are automobile dealers (acting as lenders) and automobile purchasers (acting as borrowers). In contrast, the goods covered by the Application relate to software embedded in the vehicle's audio/video/nav system to make in-vehicle electronic payments; that is, payments made directly from a Hyundai vehicle by a driver to purchase third party goods and services via the vehicle's electronic systems. In short, the Applicant's HYUNDAI CARPAY mark is used for purchases from the car (known as in-vehicle simple payments), while the cited CARPAY mark is used for the management of automotive loans (i.e., managing the payments towards the purchase of the car itself).⁸

Applicant's arguments imply that "in vehicle simple payments" and "electronic business transactions" are limited to the purchase of particular types of goods or services that by definition, expressly exclude auto loan payments. Nothing in the record supports this assertion. Rather, with regard to the goods we highlighted above, because the terminology "in-vehicle simple payments" and "electronic business transactions" is unrestricted as to field, it necessarily encompasses a myriad of

⁸ Applicant's Brief, p. 16; 4 TTABVUE 17.

payments and transactions, including auto loan payments. *See In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (“Registrant’s goods are broadly identified as computer programs recorded on magnetic disks, without any limitation as to the kind of programs or the field of use. Therefore, we must assume that registrant’s goods encompass all such computer programs including those which are for data integration and transfer.”). *Cf. In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1136 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). Accordingly, we find that Applicant’s software products for in-vehicle use summarized above and Registrant’s software offered as a software service perform the same function.

Furthermore, with regard to Applicant’s “downloadable smart phone application software allowing in-vehicle use of and simple payment for fueling, parking, tollgates, food and drink, and various other stores; downloadable computer software allowing the in-vehicle use of and simple payment for fueling, parking, tollgate, garage, food and drink, and various other stores,” the Examining Attorney made of record evidence that other car manufacturers provide the same type of in-vehicle downloadable software to perform such transactions as well as a SAAS to make auto loan payments:

Honda promotes its in-vehicle software payment product “Honda Dream Drive: [which] enables drivers to pay for goods and services like fuel, movie tickets and parking, make restaurant reservations, food ordering for pickup or delivery, and even share the driver’s location with friends and family”; “[m]ake restaurant reservations, pay for fuel,

movie tickets and parking, ...” Honda Financial Services shows that Honda also provides software as a service (SAAS) services featuring software for facilitating auto loan payments where consumers can login to make auto loan payments.⁹

Genesis offers Genesis Carpay, an in-vehicle and smartphone software app that “without any hassle of physical cards” allows the consumer to “pay with the navigation screen in affiliated parking lots & gas stations.” Genesis Finance also offers under the Genesis Concierge mark software as a service (SAAS) services featuring software for facilitating auto loan payments.¹⁰

BMW provides software for facilitating in-vehicle payments of simple payments for parking and that the same entity provides software as a service (SAAS) services featuring software for facilitating auto loan payments.¹¹

This evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both Applicant’s particular goods noted above as well as Registrant’s services. *See Detroit Athletic*, 128 USPQ2d at 1051.

Based on the foregoing, the goods and services are in part related. Likelihood of confusion must be found as to the entire class if there is likely confusion with respect to any good that comes within the identification in that class. *See Tuxedo Monopoly Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any item that comes within the identification of goods or

⁹ August 4, 2020 Office Action, TSDR p. 20-32.

¹⁰ July 13, 2021 Office Action, TSDR p. 2-10.

¹¹ *Id.* at 11-31.

services in that class). The second *DuPont* factor therefore weighs in favor of finding a likelihood of confusion for Application Serial No. 88599435.

2. Application Serial No. 88599451 – International Class 38 Services

Application Serial No. 88599435 includes, among other services,

Providing access via a wireless local area network to applications for vehicles, for in-vehicle simple payments; providing access to the Internet via mobile devices to information for vehicles, for in-vehicle simple payments; providing access to wireless internet, for simple in-vehicle payments; ... electronic transmission of vehicle-connected smart phone application data, for in-vehicle simple payments; wireless communication network services for vehicles for the transmission of data for in-vehicle simple payments for in-vehicle simple payments; providing access to the Internet mobile content for vehicles via mobile phones, for in-vehicle simple payments.

Applying the same logic explained above, because the language “in-vehicle simple payments” is unrestricted as to field, we may assume that includes all types of payments, including auto loan payments. *See Linkvest*, 24 USPQ2d at 1716; *cf. Hughes Furniture Indus.*, 114 USPQ2d at 1136. As such, these particular services and Registrant’s software offered as a software service perform the same function making the services in-part related. The second *DuPont* factor also weighs in favor of finding a likelihood of confusion for Application Serial No. 88599451.

D. The Established, Likely-to-Continue Channels of Trade

Turning now to the third *DuPont* factor, the established, likely-to-continue channels of trade, we first look to how the trade channels are delineated, if at all, in the applications and registration. *See Stone Lion*, 110 USPQ2d at 1161; *see also Octocom*, 16 USPQ2d at 1787. According to the identifications in both applications,

the goods and services which we found were related to Registrant's are all offered "in-vehicle." As such, Applicant's trade channels are expressly limited to this discrete, specialized channel of trade.

By contrast, the identification of software services in cited registration is unrestricted as to trade channels. We acknowledge our established case law that "[w]hen the registration does not contain limitations describing a particular channel of trade ... the goods or services are assumed to travel in all normal channels of trade." *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000). *See also In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)). There is nothing in the record, however, to suggest that the ordinary trade channels for Registrant's software services are "in-vehicle." Put another way, Applicant's relevant goods and services are marketed solely and exclusively through vehicles previously purchased by consumers. The record does not support the proposition that the software services identified in the cited registration normally move in this limited channel of trade, notwithstanding that they do not recite any trade channel limitations.

For this reason, we find that the trade channels are distinct and do not overlap with the ordinary channels of trade for Registrant's services. Thus, the third *DuPont* factor weights against finding likelihood of confusion.

E. Conditions of Sale

Lastly, we consider the conditions under which the goods and services are likely to be purchased, *e.g.*, whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers, the fourth *DuPont* factor. A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

Applicant argues that given the specialized and technical nature of the goods and services, purchasers are highly knowledgeable and discerning. Nothing in the record supports this contention. Counsel's arguments are not evidence. *See Cai*, 127 USPQ2d at 1799 (quoting *Enzo Biochem, Inc. v. GenProbe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005) ("Attorney argument is no substitute for evidence.")). Based on the express language of Applicant's and Registrant's identifications, the consumers are members of the general public who purchase and drive vehicles and make car loan payments. Focusing on the least sophisticated potential customers of the respective goods and services, since this covers members of the general public, we find fourth *DuPont* factor to weigh in favor of a likelihood of confusion. *See Stone Lion*, at 110 USPQ2d at 1163 ("Although the services recited in the application also encompass sophisticated investors, Board precedent requires the decision to be based 'on the least sophisticated potential purchasers.'").

II. Balancing the *DuPont* Factors - Conclusion

We have carefully considered all of the evidence made of record, as well as all of

the arguments related thereto. On this record, Registrant's mark CARPAY is conceptually strong, and we have given the mark the normal scope of protection to which registered inherently distinctive marks are entitled. While there is no overlap in trade channels, overall, the cited mark is similar in sound, appearance, connotation and commercial impression when compared with Applicant's HYUNDAI CARPAY mark. The in-part identical function and relatedness of Applicant's and Registrant's goods and services, and purchasing conditions also weigh in favor of a finding of likelihood of confusion. On the other hand, we find that the lack of evidence showing an overlap in the channels of trade for Applicant's and Registrant's goods and services is not pivotal, because it is outweighed by our findings regarding the first, second, and fourth *DuPont* factors. Accordingly, we find that confusion is likely between Applicant's applied-for mark for the goods and services identified in Serial Nos. 88599435 and 88599451 and in the cited registration.

Decision: The Section 2(d) refusals are affirmed.

Opinion by Hudis, Administrative Trademark Judge, concurring in part:

I agree with the majority opinion regarding its overall treatment of the likelihood of confusion factors under *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), and the balancing thereof. I write separately to express my disagreement with the section of majority opinion labeled “The Established, Likely-to-Continue Channels of Trade.” Specifically, I disagree with the majority opinion’s finding that “the trade channels [for Applicant’s goods and services] are distinct and do not overlap with the ordinary channels of trade for Registrant’s services” as well as the reasoning used to make this finding.

In Registration No. 5772963, Registrant’s services are defined as “software as a service (SAAS) services featuring software for facilitating auto loan payments” in International Class 42. In Application Serial No. 88599435, Applicant’s goods, in part are defined as:

Downloadable AVN (Audio Video Navigation) software for in-vehicle simple payments; downloadable AVN (Audio Video Navigation) for vehicles with in-vehicle simple payment function; ... downloadable computer programs for simple payments through in-vehicle AVN (Audio Video Navigation); ... downloadable computer e-commerce software to allow users to perform electronic business transactions via a global computer network in International Class 9.

Similarly, in Application Serial No. 88599451, Applicant’s services, in part, are defined as:

Providing access via a wireless local area network to applications for vehicles, for in-vehicle simple payments; providing access to the Internet via mobile devices to information for vehicles, for in-vehicle simple payments;

providing access to wireless internet, for simple in-vehicle payments; ...; providing on-line access to databases, for in-vehicle simple payments; providing access to e-commerce platforms on the Internet; electronic transmission of vehicle information and data, for in-vehicle simple payments; ...; electronic transmission of vehicle-connected smart phone application data, for in-vehicle simple payments; wireless communication network services for vehicles for the transmission of data for in-vehicle simple payments for in-vehicle simple payments; providing long distance telecommunications services for vehicles, for in-vehicle simple payments; ...; providing access to the Internet mobile content for vehicles via mobile phones, for in-vehicle simple payments in International Class 38.

The goods and services recited in the two applications essentially perform the same functionality to the consumer; one by means of downloadable software, the other over wireless networks – both via connectivity to the Internet. There are no limitations in either application on the types of payments that can be made via Applicant’s goods or services, which could include auto loan payments.

The auto loan payment services defined in the cited registration are rendered via software hosted on a remote platform, accessed by the consumer over the Internet. There are no limitations in the registration as to whether Registrant’s SAAS services can be accessed over the Internet by way of land-line/hard-wired connectivity or wirelessly (in-vehicle or otherwise).

As the majority opinion concedes, “[i]n the absence of meaningful limitations in either the application or the cited registrations, the Board [may] properly presume[] that the goods [and services] travel through all usual channels of trade and are offered to all normal potential purchasers.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Moreover, “the fact that the channels or

purchasers are actually different [, or may appear different,] is not controlling. *Glamorene Prods. Corp. v. Procter & Gamble Co.*, 538 F.2d 894, 190 USPQ 543, 545 (CCPA 1976).

We need not rely solely upon these presumptions afforded by the identifications of goods and services and controlling case law to find an overlap of trade channels. As noted in the section of the majority opinion labeled “The Similarity or Dissimilarity of the Goods and Services,” the Examining Attorney provided during prosecution three different examples of car manufacturers providing the same type of in-vehicle software functionality to perform payment transactions as well as an SAAS to make auto loan payments – Honda, Genesis and BMW.¹²

I therefore depart with the majority opinion’s finding on the third *DuPont* factor, and would instead find that Applicant’s and Registrant’s trade channels overlap. This additional finding would support the conclusion that confusion is likely. On the other hand, because of the majority opinion’s findings on the other *DuPont* likelihood of confusion factors, and the balancing thereof, with which I agree, I concur in the result that the refusals of registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) should be affirmed.

¹² July 13, 2021 Office Action, at TSDR pp. 11-31.