

This Opinion is Not a
Precedent of the TTAB

Mailed: April 29, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hella Gutmann Solutions GmbH

Serial No. 79135477

John J. O'Malley of Volpe and Koenig, P.C.,
for Hella Gutmann Solutions GmbH.

Niya Rafari-Pearson, Trademark Examining Attorney, Law Office 112,¹
Matthew J. Cuccias, Managing Attorney.

Before Kuczma, Lynch, and Coggins,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Hella Gutmann Solutions GmbH (“Applicant”) seeks registration on the Principal Register of the mark HGS DATA in standard characters (with DATA disclaimed) for goods and services including the following services at issue:

¹ This application was reassigned to the current Examining Attorney at the briefing stage.

Updating, systematization, collection and maintenance of technical and diagnostic data for motor vehicles for the purpose of assisting motor vehicle mechanics to maintain and repair motor vehicles in International Class 35.²

The Examining Attorney refused registration, as to the Class 35 services set out above, under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the following two registered marks owned by the same entity, both for services that include “compilation of information into computer databases” and “systemization of information into computer databases” in International Class 35:

HGS (standard characters);³ and



(GLOBAL SOLUTIONS disclaimed).⁴

After the Examining Attorney made the refusal final, Applicant requested reconsideration and appealed. The Examining Attorney denied reconsideration, and the appeal proceeded. Applicant and the Examining Attorney filed briefs. As explained below, we affirm the refusal to register as to Class 35.

² Application Serial No. 79135477 was filed on July 12, 2013 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, as a request for an extension of protection under the Madrid Protocol of International Registration No. 1173824. It includes a priority claim of February 2, 2013. The application also includes goods in Class 9 and services in Class 38, but they are not subject to a refusal. “DATA” is disclaimed.

³ Registration No. 5834968 (the standard-character mark) issued August 13, 2019.

⁴ Registration No. 4420468 (the composite mark) issued October 22, 2013, and has been maintained. The registration reflects that color is not claimed as a feature of the mark, and describes the mark as consisting “of the letters ‘HGS’ with the words ‘HINDUJA GLOBAL SOLUTIONS’ below them and two interlocking curved lines beside them.”

II. Likelihood of Confusion

Our determination under Section 2(d) involves an analysis of all the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). The Board considers only those *DuPont* factors for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances.” *Stratus Networks, Inc. v. UBTA-UBET Communs. Inc.*, 955 F.3d 994, 2020 USPQ2d 10341 *3 (Fed. Cir. 2020). Two key considerations are the similarities between the marks and the relatedness of the services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (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.”).

A. The Services

The second *DuPont* factor addresses the relatedness of the services. Under the second factor, “likelihood of confusion can be found ‘if the respective goods [or services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101

USPQ2d 1713, 1722 (Fed. Cir. 2012) (internal citations omitted). In analyzing the relatedness of the services at issue, we look to the identifications in the application and cited registrations. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018); *Stone Lion Cap. Partners v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any service encompassed by the identification in the class to which the refusal applies. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

As the Examining Attorney points out, some of Registrant's services are broad enough to encompass certain services in the application. The cited registrations recite "compilation of information into computer databases" and "systemization of information into computer databases" among their services. Applicant's recitation of "systematization, collection and maintenance" of a particular type of motor vehicle information for a particular purpose – "assisting motor vehicle mechanics to maintain and repair motor vehicles" – clearly falls within the scope of the cited registrations' services.

We must presume that Registrant's unrestricted recitations encompass all types of services and all activities included in the recited services – in this case, all types of compilation and systemization of information into computer databases. *See, e.g., Levi*

Strauss & Co. v. Abercrombie & Fitch Trading Co., 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re FCA US LLC*, 126 USPQ2d 1214, 1217 (TTAB 2018) (where a description of goods includes no restrictions or limitations, the Board must read the application to cover all goods of the type identified); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the services in an application or registration are broadly described, they are deemed to encompass all the activities of the nature and type described therein).

We reject Applicant's urging that "Registrant's Services must be read in context of all the services offered to understand the scope of the intended services."⁵ Applicant seeks to relegate the type of information compiled and systemized to the field of advertising and business administration, based on the nature of other services listed in the registrations. However, the quoted services on which the Examining Attorney relies are separated from the more specifically-focused advertising and business administration services in the recitations by a semi-colon, and thus are discrete services that are not so limited. *See* TMEP § 1402.01(a) ("Semicolons should generally be used to separate distinct categories of goods or services within a single class."). In an analogous situation in *In re Midwest Gaming & Ent. LLC*, 106 USPQ2d 1163, 1166 (TTAB 2013), the Board explained:

In the cited registration's identification of services, the "providing banquet and social function facilities for special occasions" are services separated by a semicolon from the "restaurant and bar services." Under standard examination practice, a semicolon is used to separate distinct categories of goods or services. We find that here,

⁵ 14 TTABVUE 15 (Applicant's Brief).

the semicolon separates the registrant's "restaurant and bar services" into a discrete category of services which is not connected to nor dependent on the "providing banquet and social function facilities for special occasions" services set out on the other side of the semicolon. We further find that the registrant's "restaurant and bar services," as separately set out in the identification of services by means of the semicolon, stand alone and independently as a basis for our likelihood of confusion findings under the second and third *du Pont* factors.

Similarly, we cannot accept Applicant's invitation to restrict the services in the cited registration based on the alleged marketplace reality that "Registrant is in the advertising and business administration fields."⁶ Contrary to Applicant's contentions, we rely on the identification of services. *Octocom Sys.*, 16 USPQ2d at 1787; *see also Midwest Gaming*, 106 USPQ2d at 1165 ("An applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence") (quoting *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008)). We must "give full sweep" to the recitation of services regardless of a registrant's actual business. *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973). As the Board stated in *FCA US LLC*, 126 USPQ2d at 1217 n.18, "[i]n innumerable cases, the Board hears arguments about how the parties' actual goods, services, customers, trade channels, and conditions of sale are narrower or different from the goods and services identified in the applications and registrations," but "as stated in equally innumerable decisions of our primary reviewing court, we may consider any such restrictions only if they are included in the identification of goods

⁶ 14 TTABVUE 15 (Applicant's Brief).

or services.” For this reason, none of the caselaw cited by Applicant is analogous, because in those cases, the goods or services did not overlap.⁷

We find that on the face of the identifications, the services overlap in part, obviating the need for evidence of relatedness.⁸ Applicant’s and Registrant’s services are legally identical in part. This factor weighs heavily in favor of likely confusion.

B. Trade Channels and Classes of Consumers

The third *DuPont* factor addresses the trade channels in which the services travel, and the classes of consumers of such services. Where, as here, the services overlap and are legally identical in part, we presume that they travel through at least some of the same channels of trade to the same classes of purchasers, considerations under

⁷ The proper remedy for an applicant to limit the scope of a registrant’s identified services is via an inter partes proceeding seeking partial cancellation or restriction pursuant to Section 18 of the Trademark Act, 15 U.S.C. § 1068. *See e.g., In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1384-85 (TTAB 2012).

⁸ Nonetheless, the Examining Attorney submitted some evidence that entities provide a wide range of data management services under the same marks. TSDR July 11, 2020 Office Action at 2-18. While the evidence does not explicitly pertain to motor vehicle-related data, it reflects consumer exposure to data management services for many different types of data, all under the same mark. *See Detroit Athletic Co.*, 128 USPQ2d at 1050 (crediting relatedness evidence that third parties use the same mark for the goods or services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (stating that evidence that a single company sells the goods or services at issue, “if presented, is relevant to a relatedness analysis”).

In addition, the Examining Attorney introduced several use-based, third-party registrations showing that the same entity has registered a single mark identifying database updating and maintenance services, as well as database systemization and compilation services. Such registrations are relevant to show that such services may emanate from a single source under one mark. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1140 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff’d*, No. 88-1444, 864 F.2d 149 (Fed. Cir. Nov. 14, 1988).

The record corroborates the relatedness of the services at issue.

the third *DuPont* factor. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); see also *Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Rsch. Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, “the marketing channels of trade and targeted classes of consumers and donors are the same”); *L. & J.G. Stickley, Inc. v. Cosser*, 81 USPQ2d 1956, 1971 (TTAB 2007) (“Because the goods of both parties are at least overlapping, we must presume that the purchasers and channels of trade would at least overlap.”).

To the extent Applicant asks that we narrow the trade channels based on its assertions about the actual marketplace, again, we cannot do so. We must rely on the identifications of services. *Octocom Sys.*, 16 USPQ2d at 1787.

The recited services travel in overlapping trade channels to some of the same classes of consumers. Thus, the third *DuPont* factor weighs in favor of likely confusion.

C. Similarity of the Marks

We turn to comparing Applicant’s and Registrant’s marks “in their entirety 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, 1691 (Fed. Cir. 2005) (quoting *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 mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs.*, 101 USPQ2d at 1721; *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

1. HGS Registration

Applicant's standard-character mark HGS DATA is highly similar to the registered standard-character HGS mark because the dominant element of Applicant's mark is identical to this registered mark. The first part of Applicant's mark, HGS, is its dominant term that "is most likely to be impressed upon the mind of a purchaser and remembered." *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (first part of a mark); *see also Palm Bay Imps.*, 73 USPQ2d at 1692. The dominance of HGS in Applicant's mark is reinforced because the second word, DATA, describes Applicant's services and has been appropriately disclaimed.⁹ This reduces its significance in the likelihood of confusion analysis because consumers are less likely to rely on descriptive wording to indicate source. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (in comparing THE DELTA CAFÉ to DELTA, the generic term CAFÉ lacks sufficient distinctiveness to create a different commercial impression) While we accept

⁹ Applicant's recitation makes clear that the services are data-related. The record also includes a definition of "data" supporting its descriptiveness in this context. TSDR November 1, 2013 Office Action at 4 (collinsdictionary.com).

Applicant's premise that no per se rule applies to marks with common elements, in this case the marks look and sound quite similar because of the shared element HGS.

As to the marks' connotations and commercial impressions, we also find them similar. We find that consumers would attribute the same meaning to the lettering HGS in Applicant's mark as they would to the identical lettering in the cited mark. The additional word DATA in Applicant's mark merely refers to the nature of the services, does not change the meaning or impression of the shared dominant term HGS, and only minimally contributes to the overall meaning and connotation. Thus, the addition of the descriptive word DATA does not significantly distinguish the marks in terms of meaning or impression. *See e.g., In re Detroit Athletic*, 128 USPQ2d at 1049-50 (finding "[t]he identity of the marks' two initial words is particularly significant because consumers typically notice those words first" and additional descriptive wording "do[es] little to alleviate the confusion that is likely to ensue"); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression").

The cases cited by Applicant involving the comparison of different marks are distinguishable. These comparisons of marks are highly fact-specific, and we do not find the caselaw analogous. *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1027 (TTAB 2017) (comparisons to other cases "are rarely helpful, because the critical facts of different cases almost always differ substantially").

Considering the marks in their entireties, we find them similar in look, sound, meaning and commercial impression.



2. **Registration**

Turning next to the cited composite mark registration, we also find this mark similar to Applicant's. The additional wording in the respective marks creates some difference between them in appearance and sound, but we find the marks overall more similar than dissimilar, particularly because we must consider the marks "in light of the fallibility of memory." See *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)).

Where, as with this cited mark, a mark is comprised of both literal elements and a design, the literal elements are normally accorded greater weight in weighing similarity, because consumers are likely to remember and use them to request the goods. *Viterra*, 101 USPQ2d at 1911 ("the verbal portion of a word and design mark likely will be the dominant portion"); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that "if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services" and "because applicant's mark shares with registrant's mark that element responsible for creating its overall commercial impression, the marks are confusingly similar"). This general rule seems appropriate here, where the design feature of "interlocking curved lines" in the cited mark appears decorative and does not play a significant role in the overall commercial impression of the mark.

Turning to the literal elements of the cited mark, HGS clearly dominates, for several reasons. First, its very large size and visual prominence relative to the other elements of the mark makes it stand out. Second, as noted above, consumers often focus on the first part of a mark, and HGS appears as the first literal element. Third, we agree with Applicant that in the cited mark, consumers likely would view HGS as an initialism for HINDUJA GLOBAL SOLUTIONS,¹⁰ which appears in smaller font just beneath, and therefore points back to and emphasizes HGS.

However, we disagree with Applicant's contention that the status of HGS as an initialism in this cited mark forms a point of distinction from Applicant's HGS DATA mark. Consumers would perceive HGS (unpronounceable as a word) as an initialism in Applicant's mark as well, and those consumers already familiar with the cited mark for data compilation and systemization services likely would assume that HGS DATA is a variation by Registrant, using its initialism. Thus, while the relatively small wording HINDUJA GLOBAL SOLUTIONS forms a difference between the marks, it does not obviate likely confusion.

As discussed above in connection with the cited standard-character mark, the inclusion of DATA in Applicant's mark creates some additional difference from the cited composite mark, but it is not significant for likelihood of confusion purposes, because consumers would not rely on the descriptive wording as source-identifying.

As urged by Applicant, we compare the marks in their entirety. However, for rational reasons, we may give more or less weight to a particular feature of a mark,

¹⁰ Applicant refers to it as an "acronym." 14 TTABVue 8 (Applicant's Brief).

such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *See Viterra*, 101 USPQ2d at 1908. Here, because the dominant term of both marks is identical, and given the nature of the other elements of the respective marks, we find them similar.

D. Conditions Under Which and Buyers to Whom Sales Are Made

The fourth *DuPont* factor involves “[t]he conditions under which and buyers to whom sales are made, i.e., impulse vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Applicant makes the assertion, without any supporting evidence, that “consumers of Applicant’s Services and Registrant’s services are **often** sophisticated and discriminating.”¹¹ Applicant’s use of “often” implicitly concedes that at least some customers are not so sophisticated, and “Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’” *See Stone Lion Cap. Partners*, 110 USPQ2d at 1163. The recitations of services, on their faces, do not necessarily involve sophisticated purchasing, and consumers could include ordinary members of the general public.¹² Without supporting evidence that proves the relative sophistication of purchasers or elevated degree of care, *see Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (“Attorney argument is no

¹¹ 14 TTABVUE 19 (Applicant’s Brief) (emphasis added).

¹² While Applicant’s recitation provides that the motor vehicle data ultimately is “for the purpose of assisting motor vehicle mechanics,” the services of collecting and maintaining such data may be provided, for example, to car owners who are ordinary members of the public, who then would furnish the information to their mechanics.

substitute for evidence.”) (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)), we find this factor neutral.

III. Conclusion: Balancing the *DuPont* Factors

The similarity of Applicant’s mark to both cited marks for overlapping and related services that move in some of the same channels of trade to the same classes of customers renders confusion likely.

Decision: The refusal to register Applicant’s mark as to the services in Class 35 is affirmed, based on both cited registrations. The application will proceed in due course with the remaining goods in Class 9 and services in Class 38, which were not subject to the refusal.