

This Opinion is Not a
Precedent of the TTAB

Mailed: January 23, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Graphite Design + Build Limited

Serial No. 97037355

Michael E. Dockins of Shumaker, Loop & Kendrick, LLP for Graphite Design +
Build Limited.

Clinton Johnson, Trademark Examining Attorney, Law Office 107,
Leslie Bishop, Managing Attorney.

Before Lynch, Acting Deputy Chief Administrative Trademark Judge, and Lykos and
Larkin, Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Graphite Design + Build Limited (“Applicant”) seeks registration on the Principal
Register of the standard-character mark GREAT LAKES GREAT TIMES NO
SHARKS (GREAT LAKES disclaimed) for goods identified as “Hats; Shirts; Socks;
Sweatshirts; Hooded sweatshirts” in International Class 25.¹

¹ Application Serial No. 97037355 was filed on September 21, 2021 under Section 1(a) of the
Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claimed first use of the mark and
first use of the mark in commerce at least as early as September 1, 2021.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the standard-character mark NO SHARKS, registered on the Principal Register for "T-shirts, sweatshirts, hats" in International Class 25,² as to be likely, when used in connection with the goods identified in the application, to cause confusion, to cause mistake, or to deceive.

When the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration, which was denied. Applicant and the Examining Attorney have filed briefs.³ We affirm the refusal to register.

I. Record on Appeal and Evidentiary Issue⁴

The evidence in the record on appeal includes Applicant's specimen of use;⁵ USPTO electronic records regarding the cited registration;⁶ a Wikipedia entry and other webpages regarding the Great Lakes,⁷ and the city of Toledo, Ohio, where

² The cited Registration No. 5239928 issued on July 11, 2017 and has been maintained through the filing of a combined declaration under Sections 8 and 15 of the Trademark Act, 15 U.S.C. §§ 1058, 1065.

³ Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant's brief appears at 6 TTABVUE and the Examining Attorney's brief appears at 8 TTABVUE.

⁴ Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

⁵ September 21, 2021 Application at TSDR 3.

⁶ June 23, 2022 Office Action at TSDR 2-3.

⁷ *Id.* at TSDR 4-5.

Applicant is located;⁸ third-party webpages displaying the goods identified in the application and in the cited registration;⁹ USPTO electronic records of the file histories of four third-party registrations of marks containing the word SHARK for clothing;¹⁰ and Internet webpages regarding avoiding sharks when surfing, swimming, or diving.¹¹

Applicant's brief contains a five-page table of what Applicant calls a "representative list" of "numerous registrations (including the Cited Mark) and published applications for marks that incorporate the word SHARKS by itself and phonetic equivalents combined with one or more additional terms for clothing." 6 TTABVue 4-9. As discussed below, Applicant relies on the list to support its argument that the involved marks are dissimilar. *Id.* at 10.

For the first time, the Examining Attorney objects to the table, arguing that "the mere submission of a list of registrations or a copy of a private company search report does not make such registrations part of the record," and that "[t]o make third-party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal." 8 TTABVue 6 (citations omitted). He further argues that "the majority of

⁸ *Id.* at TSDR 6-8.

⁹ August 13, 2022 Final Office Action at TSDR 2-11; April 26, 2023 Denial of Request for Reconsideration at TSDR 7-12.

¹⁰ February 15, 2023 Request for Reconsideration at TSDR 14-233.

¹¹ April 26, 2023 Denial of Request for Reconsideration at TSDR 2-6.

these registrations should not be considered” and that only the four registrations noted above are of record. *Id.*

During prosecution, Applicant included the same list of applications and registrations in the body of its response to the first Office Action,¹² and made the same argument based on the list that it makes in its appeal brief.¹³ In the final Office Action, the Examining Attorney noted Applicant’s argument that “the shared wording ‘sharks’ is diluted in class 25, and therefore there is no likelihood of confusion between the applied-for mark and the cited mark,”¹⁴ but did not object to the list per se, instead arguing that Applicant’s argument “is unpersuasive because even though the wording ‘shark’ may arguably be diluted, the shared wording which conveys a different commercial impression, ‘no sharks’ is not diluted in class 25.”¹⁵

Applicant’s subsequent Request for Reconsideration included a list of 204 entries from the TSDR system together with what appear to be inactive links to the underlying records.¹⁶ Applicant described the list as the results of a “search of the electronic records of the [USPTO that] shows numerous registrations (including the Cited Mark) and a published application for the mark SHARK or a phonetic equivalents [sic] combined with one or more additional terms.”¹⁷ Based on the list,

¹² June 27, 2022 Response to Office Action at TSDR 4-10.

¹³ *Id.* at TSDR 10.

¹⁴ August 15, 2022 Final Office Action at TSDR 1.

¹⁵ *Id.*

¹⁶ February 15, 2023 Request for Reconsideration at TSDR 5-12.

¹⁷ *Id.* at TSDR 5.

Applicant argued that “[t]here are currently 204 active applications and registrations (nearly 75% are registrations) that contain the word SHARK or SHARKS in Class 025, the same class as Applicant’s mark and the Cited Mark.”¹⁸ Applicant stated that a “sampling of the files [sic] histories noted below are provided” and that “[a]ll of the file histories were not provided as being duplicate [sic] and unnecessary tax on the TEAS system.”¹⁹ Applicant made a similar argument based on the TSDR search that it makes in its appeal brief based on the table of registrations and applications.²⁰

In denying Applicant’s Request for Reconsideration, the Examining Attorney again did not object to Applicant’s TSDR list, but simply stated that “Applicant fails to show that the wording ‘no sharks’ is diluted in class 25 and that the cited mark is weak in class 25.”²¹

The Examining Attorney’s objection in his brief to Applicant’s table of registrations and applications comes too late. “Because he did not object during prosecution, which would have allowed Applicant to cure the deficiency, we consider the objection waived on appeal.” *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *4 n.17 (TTAB 2020) (citing *In re City of Hous.*, 101 USPQ2d 1534, 1536 (TTAB 2012), *aff’d*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013)). We have considered the table in Applicant’s brief for whatever probative value it may have.

¹⁸ *Id.*

¹⁹ *Id.*

²⁰ *Id.* at TSDR 12.

²¹ April 26, 2023 Denial of Request for Reconsideration at TSDR 1.

II. Likelihood of Confusion Refusal

“The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023) (cleaned up). Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). *Charger Ventures*, 2023 USPQ2d 451, at *4. We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the [goods or] services.” *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *14 (TTAB 2023), *civ. action filed*, No. 5:23-cv-00549-GW-PVC (C.D. Cal. Mar. 28, 2023) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). Applicant “submits that a comprehensive analysis based upon the multi-factor test commonly applied, leads to the conclusion that there will be no likelihood of confusion in the minds of the relevant public between the applicant’s mark and the Cited Mark.” 6 TTABVue 3. Applicant does not provide much of a “comprehensive analysis,” however, arguing only that the marks differ sufficiently to preclude confusion, *id.* at

3-4, when compared against the backdrop of what Applicant describes as “numerous registrations (including the Cited Mark) and published applications for marks that incorporate the word SHARKS by itself and phonetic equivalents combined with one or more additional terms all for clothing,” *id.* at 4, which invokes the sixth *DuPont* factor, the “number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567.

A. Similarity or Dissimilarity of the Goods, Channels of Trade, and Classes of Consumers

“The second *DuPont* factor ‘considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” *In re Embiid*, 2021 USPQ2d 577, at *22 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018)), “while the third *DuPont* factor considers ‘the similarity or dissimilarity of established, likely-to-continue trade channels.’” *Id.* (quoting *Detroit Athletic Co.*, 128 USPQ2d at 1052).

The goods “need not be identical or even competitive to find a likelihood of confusion.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *4 (TTAB 2019) (citations omitted). Here, however, they are identical in part because the goods identified in the application as “hats,” “shirts,” and “sweatshirts” also appear in the identification of goods in the cited registration, which covers “hats,” “T-shirts,” which the Board held long ago are encompassed within “shirts,” *Varsity Pajamas, Inc. v. Schackne*, 143 USPQ 428, 430 (TTAB 1964), and “sweatshirts.”²² Because these goods

²² The “Examining Attorney need not prove, and we need not find, similarity as to each [good] listed in the description of [goods]” in Class 25 in the application. *In re OSF Healthcare Sys.*,

are identical, “there is no need for us to further consider the relatedness of the goods.” *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

“Because the goods identified in the application and the cited registration are in-part identical as to [‘hats,’ ‘shirts,’ and ‘sweatshirts’], we must presume that the channels of trade and classes of purchasers of [‘hats,’ ‘shirts,’ and ‘sweatshirts’] are the same as to these goods.” *Id.* (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). The *DuPont* factors “of the relatedness of goods, channels of trade and classes of consumers weigh in favor of likelihood of confusion.” *Id.*

B. The Number and Nature of Similar Marks in Use on Similar Goods

Before turning to the issue of the similarity or dissimilarity of the marks, we consider “the sixth *DuPont* factor, ‘[t]he number and nature of similar marks in use on similar goods,’” *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, at *4 (Fed. Cir. 2023) (quoting *DuPont*, 177 USPQ at 567), which “is a measure of the extent to which other marks weaken the assessed mark.” *Id.* (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)).²³ We consider the sixth factor at this juncture in our *DuPont*

2023 USPQ2d 1089, at *3 (TTAB 2023) (quoting *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at *3-4 (TTAB 2020)). “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any [good] encompassed by the identification of [goods] within a particular class in the application.” *Id.* (quoting *St. Julian Wine Co.*, 2020 USPQ2d 10595, at *4 (internal quotation omitted)). *See also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

²³ Applicant discusses third-party marks under the first *DuPont* factor, 6 TTABVUE 4-10, arguing that the involved marks are dissimilar because “the appearance, sound, and overall commercial impression of Applicant’s mark are at least as different from those of the Cited Mark as the Cited Mark are [sic] from the other formative SHARK marks that currently coexist in the Registry.” *Id.* at 4-5. The weakness of a mark or portion of a mark should be

analysis because “[m]arks that are descriptive or highly suggestive are entitled to a narrower scope of protection, i.e., are less likely to generate confusion over source identification, than their more fanciful counterparts.” *Id.* (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). *See also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.”) (quoting *Juice Generation*, 115 USPQ2d at 1674)).

“There are two prongs of analysis for a mark’s strength under the sixth factor: conceptual strength and commercial strength.” *Spireon*, 2023 USPQ2d 737, at *4. “Conceptual strength is a measure of a mark’s distinctiveness,” *id.*, while commercial strength is “the marketplace recognition value of the mark.” *Id.* (quotation and quotation marks omitted).

Applicant addresses only the conceptual strength of the cited mark NO SHARKS. “The existence of third-party registrations on similar goods can bear on a mark’s conceptual strength,” *id.*, and Applicant claims that “electronic records of the U.S. Patent and Trademark Office shows [sic] numerous registrations (including the Cited Mark) and published applications for marks that incorporate the word SHARKS by itself and phonetic equivalents combined with one or more additional terms all for

discussed under the sixth *DuPont* factor rather than under the first factor. *Spireon*, 2023 USPQ2d 737, at *4.

clothing.” 6 TTABVUE 4. Applicant offers no evidence of the use of any of the listed marks, or any other SHARK-formative marks, and “[a]s to *commercial* weakness, ‘[t]he probative value of third-party trademarks depends entirely upon their usage,’” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059 (TTAB 2017) (emphasis in original) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693), and “[t]he existence of these registrations is not evidence of what happens in the marketplace or that customers are familiar with them.” *Spireon*, 2023 USPQ2d 737, at *6-7 (quoting *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973)).

Applicant’s table lists 132 marks containing the word “SHARK” or “SHARKS” with corresponding registration numbers. 6 TTABVUE 5-9.²⁴ Applicant represents that all of these marks are registered for “clothing,” *id.* at 4, but the specific goods for which they are registered are not listed.²⁵ Because Applicant’s mark and the cited mark are used for in-part identical goods, the universe of **relevant** third-party registrations is limited to those covering “hats,” “shirts,” and “sweatshirts,” or legally

²⁴ Applicant’s table also lists 59 third-party applications by serial number. 6 TTABVUE 5-9. We have given the listed applications no consideration because they “are evidence only of the fact that they have been filed . . . and have no other probative value.” *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *26 (TTAB 2022) (citations omitted).

²⁵ As noted above, Applicant made of record during prosecution what it described as the file histories of four of the listed registrations. The file histories identify the goods for which those four marks are currently registered. February 15, 2023 Request for Reconsideration at TSDR 14-100 (U-SHARK for “T-shirts” and other clothing), 101-51 (GIRL SHARK for “sweatshirts” and other clothing), 152-202 (SHARK SZN for “hoodies and shirts”), and 203-33 (SHARK TEE and design for “Tops as clothing” and “bottoms as clothing”). It was unnecessary and counter-productive for Applicant to include the full file histories of these four registrations. It would have been more helpful to have included TSDR electronic records regarding the current status of each of the listed registrations.

equivalent goods. *Made in Nature*, 2022 USPQ2d 557, at *24 (where “Opposer’s MADE IN NATURE marks are registered for fresh fruit, dried fruits and vegetables, and chocolate covered fruit,” evidence of “third-party registrations of NATURE or MADE marks that Applicant submitted for products other than Opposer’s identified goods have little or no probative value in showing the conceptual weakness of the terms NATURE or MADE in Opposer’s marks.”) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017)); *see also Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694-95 (Fed. Cir. 2018) (holding that where the involved goods were legally identical meat products, third-party uses of OMAHA-formative marks on other goods, such as popcorn, wine, oriental foods, and alcoholic beverages, were improperly considered by the Board because “these goods bear no relationship to meat or meat-based products” and had “no real probative value for the analysis at hand,” where “the evidentiary universe is much smaller.”).

As noted above, Applicant made of record four of the listed third-party registrations that cover “shirts” or “sweatshirts,” or equivalents.²⁶ These registrations have negligible probative value because none of the registered marks contains the words “NO SHARKS,” the “common segment” or “shared segment” of the involved marks. *Spireon*, 2023 USPQ2d 737, at *5. We have given no consideration to the other 128 registered marks listed in Applicant’s table because the “list does not include enough information to be probative” where “the goods are not listed [and] we do not

²⁶ *Id.* at 14-233.

know whether the listed . . . registrations are relevant.” *Made in Nature*, 2022 USPQ2d 557, at *27 (quoting *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018)).

“Applicant has presented no evidence of third-party use, and at most, [four] third-party registrations’ of [SHARK]-formative marks for clothing,” *Embiid*, 2021 USPQ2d 577, at *38 (quoting *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)), and no third-party registrations of marks containing the “NO SHARKS” shared segment of the involved marks. This “is a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant in both *Jack Wolfskin* and *Juice Generation*.”²⁷ *Id.* We find that the sixth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

C. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.’” *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *26 (TTAB 2021) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1691). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quotations omitted).

²⁷ “[I]n *Juice Generation*, there were at least twenty-six relevant third party uses or registrations of record” and in “*Jack Wolfskin*, there were at least fourteen.” *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1746 n.8 (TTAB 2016).

“The proper test regarding similarity ‘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.’” *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)). The average customer here is a purchaser of hats, shirts, and sweatshirts, the type of goods that the Board has characterized as “off-the-shelf items purchased by all manner of people,” *id.*, at *32 (quoting *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973)), and “worn by virtually everyone.” *Id.* (citing *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *7-8 (TTAB 2020)).

The similarity of marks “is not a binary factor but is a matter of degree.” *Monster Energy*, 2023 USPQ2d 87, at *31 (quoting *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (internal quotation omitted)). “Because the identified goods are identical in part, a lesser degree of similarity between the marks is required for confusion to be likely.” *Sabhnani*, 2021 USPQ2d 1241, at *27 (citations omitted).

Applicant’s mark is GREAT LAKES GREAT TIMES NO SHARKS in standard characters, while the cited mark is NO SHARKS in standard characters. Applicant argues that its

mark consists of the words “GREAT LAKES GREAT TIMES NO SHARKS”. The Cited Mark NO SHARKS does not include any [sic] the four words “GREAT LAKES GREAT TIMES.” These additional words make the applicant’s mark noticeably longer than the Cited Mark [and] create the distinct visual impression of multiple words instead of one word. Furthermore, Applicant’s mark begins with the words GREAT LAKES GREAT TIMES with the words common with the Cited Mark coming at the end portion of the mark. That is to say, the marks have very different leading words and this is yet another reason Applicant’s mark has a distinct visual impression from the Cited Mark.

6 TTABVUE 4.

The remainder of Applicant’s argument under the first *DuPont* factor focuses on the third-party registrations of SHARK-formative marks that Applicant claims prove the conceptual weakness of the cited mark NO SHARKS. *Id.* at 4-10. Applicant argues that “the appearance, sound, and overall commercial impression of Applicant’s mark are at least as different from those of the Cited Mark as the Cited Mark are [sic] from the other formative SHARK marks that currently coexist in the Registry.” *Id.* at 4-5. Applicant concludes that in comparing the involved marks, “consumers do not rely solely on the word SHARK as the dominant or distinguishing feature of the marks. SHARK-inclusive marks in the clothing space is, in short, a crowded field.” *Id.* at 10.

The Examining Attorney responds that the “applied-for mark completely encompasses the cited mark,” 8 TTABVUE 4, and that “adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d).” *Id.* He further argues that “[w]hen comparing the respective marks in their entirety, each mark does not convey a significantly different commercial impression from the

other because the wording ‘no sharks’ conveys such a strong and particular message of overall safety.” *Id.* at 5. He points to Internet evidence in the record that he claims “shows that the idea and message of a place/instance where sharks are not present immediately conveys the idea of safety because of the common widespread fear of sharks.” *Id.*

The Examining Attorney argues in the alternative that

even if potential purchasers realize the apparent differences between the marks, they could still reasonably assume, due to the overall similarities in sound, appearance, connotation, and commercial impression in the respective marks, that applicant’s goods sold under the “GREAT LAKES GREAT TIMES NO SHARKS” mark constitute a new or additional product line from the same source as the goods sold under the “NO SHARKS” mark with which they are acquainted or familiar, and that “GREAT LAKES GREAT TIMES NO SHARKS” is merely a variation of the registrant’s “NO SHARKS” mark.

Id. at 6.

The Examining Attorney concludes that “the marks share the same very strong arbitrary wording, ‘no sharks’, with both marks conveying a highly similar, if not identical, overall commercial impression of safety,” and “[t]herefore, the marks would be likely to cause confusion especially when used in connection with virtually identical goods.” *Id.* at 7.

Applicant’s mark GREAT LAKES GREAT TIMES NO SHARKS contains the entirety of the cited mark NO SHARKS, and “[l]ikelihood of confusion often has been found where the entirety of one mark is incorporated within another.” *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6-7 (TTAB 2019) (quoting *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014)). “[I]f a junior

user takes the entire mark of another and adds a generic, descriptive or highly suggestive term, it is generally not sufficient to avoid confusion.” *Id.*, at *7. For the reasons discussed below, we find that the addition of the phrases GREAT LAKES and GREAT TIMES to the cited mark NO SHARKS is not sufficient to avoid confusion.

The words GREAT LAKES that appear at the beginning of Applicant’s mark have been disclaimed as geographically descriptive given Applicant’s location in Toledo, Ohio,²⁸ which is at the western tip of Lake Erie, one of the Great Lakes.²⁹ The descriptive words GREAT LAKES thus have little or no source-identifying capacity with respect to the goods.

The phrase GREAT TIMES that appears after the words GREAT LAKES in Applicant’s mark is not disclaimed, but it is laudatory in nature. The adjective “great” means “markedly superior in character or quality to others of the same class.” *In re The Place, Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (citing WEBSTER’S THIRD INTERNATIONAL DICTIONARY (1993)). When combined with the plural noun “times,” which means, in the singular, “a person’s experience during a specified period or on a particular occasion,”³⁰ the phrase GREAT TIMES suggests a “superior experience,” and it too has little source-identifying capacity. *See Palm Bay Imps.*, 73 USPQ2d at 1692 (finding that the word ROYALE in the applicant’s mark VEUVE ROYALE had

²⁸ September 21, 2021 Application at TSDR 1.

²⁹ June 23, 2022 Office Action at TSDR 6.

³⁰ MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, last accessed on January 23, 2024). “The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions.” *Monster Energy*, 2023 USPQ2d 87, at *20 n.41.

a “largely laudatory (and hence non-source identifying) significance”); *Sabhnani*, 2021 USPQ2d 1241, at *32 (finding that the word MIRAGE in the phrase “Royal Mirage” in the applicant’s composite mark “may have more source-identifying significance due to the laudatory nature of ROYAL”). A suggestive “term of this type is less likely to form a strong impression amongst prospective consumers seeking to distinguish similar marks.” *New Era*, 2020 USPQ2d 10596, at *15 (citing *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (holding that in comparing the marks STONE LION CAPITAL and LION CAPITAL, the Board did not err in finding that LION was the dominant portion of both marks or in according little weight to the adjective STONE in the applicant’s mark)).

In contrast to the words GREAT LAKES, which describe the geographic origin of the goods, and the phrase GREAT TIMES, which hints at a superior experience, the words NO SHARKS in Applicant’s mark are arbitrary as applied to the goods because the absence of sharks (literally or metaphorically) does not describe or suggest anything about hats, shirts, and sweatshirts, or have any known or demonstrated significance with respect to those goods.³¹ See *Monster Energy*, 2023 USPQ2d 87, at *21 (finding that the words MONSTER ENERGY were arbitrary and conceptually strong as applied to restaurant services). The words NO SHARKS are “used in an

³¹ In that regard, the cited mark NO SHARKS issued on the Principal Register without the requirement of a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), June 23, 2022 Office Action at TSDR 2-3, and “so is treated as inherently distinctive.” *Monster Energy*, 2023 USPQ2d 87, at *20.

uncommon or unexpected way” in Applicant’s mark for clothing, *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004), effectively serving as the “punchline” for the mark as a whole.

We must compare the marks NO SHARKS and GREAT LAKES GREAT TIMES NO SHARKS “‘in light of the fallibility of human memory’ and ‘not on the basis of side-by-side comparison.’” *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). Accordingly, we must adopt the perspective of a consumer with a general rather than specific recollection of the cited mark NO SHARKS for hats, shirts, and sweatshirts who separately encounters Applicant’s mark GREAT LAKES GREAT TIMES NO SHARKS for identical goods.

We agree with Applicant that there are differences in appearance and sound between the marks, resulting from the presence of the words GREAT LAKES GREAT TIMES in Applicant’s mark before the words NO SHARKS, that would be noticed by such a consumer, but as the Federal Circuit recently reiterated, “an additional word or component may technically differentiate a mark but do little to alleviate confusion.” *Charger Ventures*, 2023 USPQ2d 451, at * 5 (citing *Detroit Athletic Co.*, 128 USPQ2d at 1049-50). A consumer familiar with the cited arbitrary mark NO SHARKS for hats, shirts, and sweatshirts who separately encounters Applicant’s mark GREAT LAKES GREAT TIMES NO SHARKS for identical goods could readily view, hear, and understand Applicant’s mark simply to be a variant of the cited mark for hats, shirts, and sweatshirts specific to the Great Lakes region. Applicant’s mark

GREAT LAKES GREAT TIMES NO SHARKS “looks, sounds, and conveys the impression of being a line extension of [NO SHARKS].” *Double Coin Holdings*, 2019 USPQ2d 377409, at *7. Under the circumstances, “Applicant cannot avoid likelihood of confusion by adopting Registrant’s entire mark and adding subordinate matter thereto,” *Stawski v. Lawson*, 129 USPQ2d 1036, 1052 (TTAB 2018) (citations omitted), even if that subordinate matter precedes, rather than follows, the cited mark. We find that the first *DuPont* factor supports a conclusion that confusion is likely.

D. Summary

The key first and second *DuPont* factors, as well as the third factor, support a conclusion that confusion is likely, while the sixth *DuPont* factor is neutral, as there is no evidence of registration or use of any third-party NO SHARKS marks. The goods, channels of trade, and classes of consumers are identical in part, which reduces the degree of similarity between the marks NO SHARKS and GREAT LAKES GREAT TIMES NO SHARKS required for confusion to be likely, but those marks are quite similar in any event because Applicant’s mark appears to be a variant of the cited mark. We conclude that consumers familiar with the cited mark NO SHARKS for hats, shirts, and sweatshirts who separately encounter Applicant’s mark GREAT LAKES GREAT TIMES NO SHARKS for identical goods are likely to believe mistakenly that the goods have a common source.

Decision: The refusal to register is affirmed.