

This Opinion is Not a
Precedent of the TTAB

Mailed: December 2, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Derrick Coleman
—

Serial No. 90231251
—

Rob L. Phillips of Fisherbroyles, LLP,
for Derrick Coleman.

Chris Wolfson, Trademark Examining Attorney, Law Office 129,
Pamela Y. Willis, Managing Attorney.

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Before Wellington, Lykos and Allard, Administrative Trademark Judges,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Applicant Derrick Coleman seeks registration on the Principal Register of the
mark:



great lakes
DISTRIBUTION

(with a disclaimer of DISTRIBUTION) for “distribution services, namely, delivery of third-party goods” in International Class 35.¹

The Examining Attorney refused registration under Section 2(d) of the Trademark Act (“the Act”), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark is likely to cause confusion with the following four separately-owned registered marks:

GREAT LAKES FABRICS (in standard characters, FABRICS disclaimed) for “distributorship in the field of upholstery fabrics and textiles; distributorship in the field of upholstery supplies,” in International Class 39;²

GREAT LAKES PETROLEUM (in standard characters, PETROLEUM disclaimed) for “fuel delivery services; storage, distribution, and transportation of liquefied petroleum gas,” in International Class 39;³

GREAT LAKES TIRE (in standard characters, TIRE disclaimed) for “distribution services, namely, delivery of new and retread tires,” in International Class 39;⁴ and



(GREAT LAKES PIPE AND SUPPLY COMPANY disclaimed) for “distribution services, namely, delivery of

¹ Application Serial No. 90231251; filed October 2, 2020, based on an allegation of bona fide intent to use the mark in commerce, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Registration No. 3730961 (“Reg. ’961”), issued on the Principal Register December 29, 2009, and has been renewed. The registration contains a claim of acquired distinctiveness, under Section 2(f) of the Act, as to the whole mark.

³ Registration No. 4798477 (“Reg. ’477”), issued on the Principal Register on August 25, 2015, based on a claim of acquired distinctiveness, under Section 2(f), as to the whole mark.

⁴ Registration No. 5337302 (“Reg. ’302”), issued on the Supplemental Register on November 14, 2017.

pipe, fittings, and valves used for the conveyance of liquid, gas, and electricity,” in International Class 39.⁵

The Examining Attorney also refused registration under Section 2(e)(2) of the Act, 15 U.S.C. § 1052(e)(2), on the ground that Applicant’s mark is primarily geographically descriptive of the origin of the services.

After the refusal became final, Applicant appealed. Applicant and the Examining Attorney filed briefs. For the following reasons, we affirm the refusal under Section 2(e)(2) of the Act, and under Section 2(d) of the Act based on each of the four cited registrations.

I. Primarily Geographically Descriptive

We first address the primarily geographically descriptive ground for refusal to registration. The elements for proving that a mark is primarily geographically descriptive, and thus prohibited from registration on the Principal Register absent a showing of acquired distinctiveness,⁶ under Section 2(e)(2) of the Act, are as follows:

- (1) The mark is the name of a place known generally to the public;
- (2) The services for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to believe that the services originate in the geographic place identified in the mark (make a services-place association).

⁵ Registration No. 5081342 (“Reg. ’342”), issued on November 2, 2004. The mark is described in the registration as “consist[ing] of concentric circles, each attached to straight, diagonal lines to the left of the words ‘GREAT LAKES PIPE AND SUPPLY COMPANY.’”

⁶ Applicant does not argue, nor has it alleged, that the proposed mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

See In re Newbridge Cutlery Co., 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Broken Arrow Beef & Provision, LLC*, 129 USPQ2d 1431, 1432 (TTAB 2019); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853 (TTAB 2014). *See also Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at *5 (TTAB 2020).

A. The Mark Identifies a Generally-Known Place

As to the first element for proving that a mark is primarily geographically descriptive, Applicant does not dispute that “Great Lakes” is a known region of the United States and Canada. The evidence establishes that the “Great Lakes” is a well-known geographic region that “includes portions of the eight US states of Illinois, Indiana, Michigan, Minnesota, New York, Ohio, Pennsylvania and Wisconsin as well as the Canadian province of Ontario.”⁷ *In re Pan-O-Gold Baking Co.*, 20 USPQ2d 1761 (TTAB 1991) (holding that the primary significance of “New England” is geographic).

The addition of the disclaimed term, DISTRIBUTION, which is generic for Applicant’s distribution services, does not obviate the overall geographic significance of the mark. That is, “the presence of generic or highly descriptive terms in a mark

⁷ Printout from “Great Lakes region” entry from Wikipedia attached to Office Action issued on February 13, 2021, at TSDR p. 24. Printout of definition of “Great Lakes” from MERRIAM-WEBSTER online dictionary website (www.merriam-webster.com) also attached, *id.* at TSDR p. 24. Additional evidence attached to this Office Action further shows that the term is used to refer an identifiable and known region.

which also contains a primarily geographically descriptive term does not serve to detract from the primary geographical significance of the mark as a whole.” *Hollywood Lawyers Online*, 110 USPQ2d at 1853-54 (quoting *In re JT Tobacconists*, 59 USPQ2d 1080, 1082 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars from Minnesota). Similarly, despite the square black background design and stylized lettering in Applicant’s mark, GREAT LAKES retains its geographically descriptive importance. *See In re Consol. Specialty Rests., Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004) (“Neither the addition of the generic word ‘steakhouse’ nor the addition of the design feature (including a mountain) detracts from the primary geographical significance of the mark [including the word COLORADO].”).

B. Applicant’s Services Originate in the Great Lakes Region and Consumers Are Likely to Make This Services-Place Association

As to the second and third elements for establishing that the mark is primarily geographically descriptive, the Examining Attorney points out that “Applicant is located in Sterling Heights, Michigan—a Detroit suburb near the Great Lakes, especially Lake Erie, as demonstrated by previously attached Internet evidence,”⁸ and the “services-place association is therefore presumed because of the general recognition of the ‘GREAT LAKES’ as a geographic area and the services originate in the ‘GREAT LAKES’ area, at least in part.”⁹

⁸ 6 TTABVUE 15-16.

⁹ *Id.* at 16-17.

The Examining Attorney also contends that a services-place association may be presumed because 1) the Great Lakes region is generally known to the purchasing public, (2) the geographical significance “Great Lakes” is its primary significance, and (3) Applicant’s services do, in fact, originate from the Great Lakes region. In support, the Examining Attorney relies on Section 1210.04 of TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) (July 2022) for the proposition that “[w]hen the geographic significance of a term is its primary significance and the geographic place is neither obscure nor remote, for purposes of §2(e)(2), the ... services/place association may ordinarily be presumed from the fact that the applicant’s goods or services originate ... in or near the place named in the mark.” The Examining Attorney also cites to *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988) (services-place association was presumed between applicant’s restaurant services and California because the services originated in California); and *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889, 895 (CCPA 1982) (Nies, J., concurring) (“[W]e must start with the concept that a geographic name of a place of business is a descriptive term when used on the goods of that business. There is a public goods/place association, in effect, presumed.” (internal footnote removed)).

Applicant does not dispute that his place of business is in the Great Lakes region. However, Applicant’s sole argument against the refusal is that his “services do not always originate in the applicant’s place of business,” because they involve

“distributing third party goods” and thus “are not necessarily performed in the Great lakes area.”¹⁰ Applicant explains further:¹¹

For example, if a third party makes goods in Florida, Applicant would pick up those goods in Florida and distribute them where needed. While some goods may be distributed to the Great lakes area that is simply happenstance. The Great Lakes term was selected because Applicant is located there not to indicate that the services originate there.

Applicant’s argument is not persuasive because the fact that his services may be offered both within and outside the Great Lakes region does not mean that it cannot be found to be primarily geographically descriptive under Section 2(e)(2). *See, e.g., In re Chalk’s Int’l Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (holding PARADISE ISLAND AIRLINES primarily geographically descriptive of the transportation of passengers and goods by air, because the applicant’s services included flights to and from Paradise Island, Bahamas, even though the flights were not based there); *Cal. Pizza Kitchen*, 10 USPQ2d at 1706 n.2 (holding CALIFORNIA PIZZA KITCHEN for restaurant services primarily geographically descriptive, where the services were rendered both in California and elsewhere). *See also In re Nantucket Allserve, Inc.*, 28 USPQ2d 1144 (TTAB 1993) (holding NANTUCKET NECTARS primarily geographically descriptive of soft drinks, even though the goods were manufactured elsewhere, but the record showed that applicant’s headquarters and research and development division were on Nantucket, the distributor of the goods was located on Nantucket, and the goods were sold in the applicant’s store on Nantucket). Here,

¹⁰ 4 TTABVUE 4-5.

¹¹ *Id.* at 5.

Applicant acknowledges that his services include distributing some goods to or from the Great Lakes. Although Applicant qualifies any such services being rendered in the Great Lakes region as “happenstance,” we find it very likely that due Applicant’s address of record being in the Great Lakes region, consumers will expect that Applicant’s distribution services will originate from his place of business. Applicant’s services, as described in the application, include delivery of third-party goods from Applicant’s place of business or from another location, e.g., a warehouse, a customer’s place of business, etc., in the Great Lakes region. In other words, consumers will likely contact Applicant at his place of business, located in the Great Lakes region, to obtain the distribution services that may also include delivery within the same region.

Because Applicant’s place of business is within the Great Lakes region and, as discussed, Applicant’s services are offered within the region from Applicant’s place of business, we find that a services-place association may be presumed in this case. *Cal. Pizza Kitchen*, 10 USPQ2d at 1705. Although this presumption is rebuttable, we do not find Applicant’s argument or the evidentiary record supports a rebuttal to the presumption.

C. Conclusion

In sum, we find the primary significance GREAT LAKES in Applicant’s mark is the geographic region that is generally known to the public; Applicant’s services originate in the Great Lakes region; and a services-place association will be made by Applicant’s customers and they will likely to believe that the Applicant’s services originate in Great Lakes region. Accordingly, we find the mark is primarily

geographically descriptive and thus affirm the refusal to registration under Section 2(e)(2) of the Act.

II. Likelihood of Confusion

We now turn to the Section 2(d) ground for refusal and, here, base our analysis on all of the probative evidence of record bearing on likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor about which there is evidence and argument. *See 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. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”). We discuss these factors below.

A. Legal Identity of Services; Trade Channels and Classes of Consumers

As to the second and third *DuPont* factors, we consider, respectively, the similarity or dissimilarity of Applicant’s services with those of the Registrants, and the “established, likely-to-continue channels of trade” for these services. *DuPont*, 177 USPQ at 567. *See also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018). For both factors, we must base our analyses on the services as they are described in Applicant’s application and each of the cited registrations. *See*

Stone Lion Cap. Partners, LP v. Lion Cap. LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Because Applicant’s recitation of “distribution services, namely, delivery of third-party goods,” does not limit the type(s) of goods it delivers other than those belonging to third-parties, it necessarily encompasses each of the Registrants’ distributorship services which are described as featuring the distribution and delivery of a particular type of product. *See, e.g., In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *4 (TTAB 2020) (“Collagen peptides for use as a nutritional supplement” are a type of “nutritional supplement,” subsumed within the broad identification of “dietary and nutritional supplements” in the cited registration, making these goods legally identical); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). Specifically, Applicant’s distribution services may include the delivery of upholstery fabrics, fuel, tires, or pipes and fittings for liquid, gas and electricity; we must therefore construe Applicant’s services as overlapping with, and legally identical to, the services rendered by each of the Registrants, respectively:

- Reg. ’961: “distributorship in the field of upholstery fabrics and textiles; distributorship in the field of upholstery supplies”;
- Reg. ’477: “fuel delivery services; storage, distribution, and transportation of liquefied petroleum gas”;

- Reg. '302: “distribution services, namely, delivery of new and retread tires”; and
- Reg. '342: “distribution services, namely, delivery of pipe, fittings, and valves used for the conveyance of liquid, gas, and electricity.”

Applicant attempts to distinguish his services from those of the Registrants by arguing that it “is offering distribution services to third parties rather than distributing its own products.”¹² However, as described in the registrations, the distributorship services of the Registrants are not restricted to delivery of their own goods, but include wholesale distribution and delivery of goods that are manufactured by third parties.

Because Applicant’s services encompass and thus are legally identical to the Registrants’ services, we presume as a matter of law that the trade channels for the overlapping services are also the same and they will be offered to the same class of purchases. *See Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research 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”); *see also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

¹² 4 TTABVue 4.

In sum, in view of the legal identity of the services and presumption that these services will be offered in the same trade channels to the same classes of consumers, these factors weigh heavily in favor of finding a likelihood of confusion.

B. Similarity of the Marks

We now consider the *DuPont* factor involving the similarity or dissimilarity of Applicant's mark vis-à-vis each of the registered marks. In making our comparison, we consider the marks in their entirety in terms of their 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); *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 at 1746 (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 issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the goods offered under the respective marks is likely to result. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Moreover, the focus is on the recollection of the average purchaser, who normally retains a

general rather than specific impression of trademarks. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average purchaser is the recipient of distribution services that, as discussed, may involve the delivery of the same goods—whether it be upholstery fabrics, fuel, tires, or pipes and fittings for liquid, gas and electricity.

Also relevant to our comparison of the marks, we point out that merely descriptive or generic matter in marks generally has less significance in likelihood of confusion determinations because consumers tend to focus on the more distinctive parts of marks. *See Detroit Athletic Co.*, 128 USPQ2d at 1050 (citing *Dixie Rests., Inc.*, 41 USPQ2d 1533-34. *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“Given the descriptive nature of the disclaimed word ‘Technologies,’ the Board correctly found that the word ‘Packard’ is the dominant and distinguishing element of PACKARD TECHNOLOGIES.”); and *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (descriptive matter that is disclaimed often “less significant in creating the mark’s commercial impression”). In this case, Applicant has disclaimed the term DISTRIBUTION which is highly descriptive or generic for his distribution services. Similarly, the Registrants have disclaimed the descriptive or generic terms in their respective marks: FABRICS and TIRE and PETROLEUM and GREAT LAKES PIPE & SUPPLY COMPANY.

1. Applicant's mark

With regard to Applicant's mark in particular, we find the strongest possible source-identifying element of the mark to be the initial literal element, GREAT LAKES. The black square background is a carrier for the words. As a common, basic shape, it does little to distinguish the mark. *See Dixie Rests.*, 41 USPQ2d at 1534 (affirming finding that the "ordinary geometric shape that serves as a background for the word mark" did not change the commercial impression or distinguish the mark for likelihood of confusion purposes). Furthermore, the GREAT LAKES element of the mark appears first and figures prominently in the square. *Stawski v. Lawson*, 129 USPQ2d 1036, 1052 (TTAB 2018) ("The common term PROSPER, appearing first in [the] marks, is their dominant feature."). The secondary term DISTRIBUTION is in a much smaller font and, again, has little if any source-identifying value as it is generic for Applicant's distribution services and has been disclaimed. Finally, we point out that stylization and designs connecting the letters AT and LA is not so unusual so as to create a strong, separate commercial impression apart from the entirety of the words GREAT LAKES.

In terms of meaning and the commercial impression, and as already discussed in the context of the Section 2(e)(2) refusal, the term GREAT LAKES identifies a particular geographic region comprising, in part, eight states in the U.S.

In sum, Applicant's mark GREAT LAKES DISTRIBUTION, stylized with design, is dominated by the wording GREAT LAKES, and the overall conveys geographical meaning.

2. Applicant's mark versus GREAT LAKES FABRICS (Reg. '961)

The dominant element of the mark in Reg. '961 is the term GREAT LAKES. Indeed, the mark registered based on a claim that the Registrant's use of this term in connection with its services has acquired distinctiveness (see Note 2). We further note that Registrant disclaimed the descriptive word FABRICS.

Thus, Applicant's mark, GREAT LAKES DISTRIBUTION (stylized with design), and Registrant's mark, GREAT LAKES FABRICS, share the same dominant element—GREAT LAKES.

The term has geographic significance and the two marks will convey the same or a very similar commercial impression in that the services may originate or be offered in the Great Lakes region. The addition of FABRICS in the registered mark does not help distinguish the two marks in terms of their commercial impressions because it merely informs the customer of the type of goods that is being distributed by Registrant and, as discussed, may also be distributed by Applicant. In other words, consumers familiar with Registrant's mark and services may, upon hearing Applicant's mark, believe the two marks refer to the same source, especially given that "consumers engage in 'the penchant of consumers to shorten marks,'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *36 (TTAB 2021) (quoting *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016)), by "drop[ping] the non-source-identifying word [FABRICS and/or DISTRIBUTION] when verbalizing" the cited mark. *Id.*

The fact that the marks begin with same first two words, they will be verbalized and heard by consumers in a very similar manner. In terms of appearance,

Registrant's standard character mark is not limited to any particular "font, style, size, or color...." Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a), and thus may be used in any stylized font, including the same or similar style used by Applicant. *Viterra*, 101 USPQ2d 1909; *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1742-43 (TTAB 2016). "[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display." *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) *quoted in In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017).

For the aforementioned reasons, we find Applicant's mark and the mark in Reg. '961 to be very similar in commercial impression, meaning, sound, and appearance. This factor weighs strongly in favor of finding confusion likely between these marks.

3. Applicant's mark versus GREAT LAKES PETROLEUM (Reg. '477)

As with the previously-discussed registered mark, the dominant element of the mark in Reg. '477 is the term GREAT LAKES and, again, this mark registered based on a claim that this term acquired distinctiveness based on the Registrant's use of the term in connection with its services (see Note 3). Registrant disclaimed the highly-descriptive word PETROLEUM.

Thus, Applicant's mark, GREAT LAKES DISTRIBUTION (stylized with design), and Registrant's mark, GREAT LAKES PETROLEUM, share the same dominant element—GREAT LAKES. As discussed, this term has geographic significance and the two marks will convey the same or very similar commercial impression in that the services may originate or be offered in the Great Lakes region.

The additions of the words PETROLEUM in the registered mark and DISTRIBUTION in Applicant's mark do little to distinguish the two marks in terms of the marks' overall commercial impressions. PETROLEUM merely informs the customer of what is being distributed by Registrant and, as discussed, may also be distributed by Applicant, and both Applicant and Registrant provide "distribution" services. Thus, because Applicant and Registrant may be rendering petroleum distribution services, the addition of these terms will not help distinguish the marks for consumers. Rather, consumers familiar with Registrant's mark and services may, upon hearing Applicant's mark, believe the two marks refer to the same source for distribution of petroleum, especially given that "consumers engage in 'the penchant of consumers to shorten marks,'" *Sabhnani*, 2021 USPQ2d 1241, at *36 (quoting *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016)), by "drop[ping] the non-source-identifying word [PETROLEUM and/or DISTRIBUTION] when verbalizing" the cited mark. *Id.*

For the same reasons already stated above in the context of the other registered mark, Applicant's mark and the mark subject of Reg. '477, are similar in appearance and sound.

For the aforementioned reasons, we find Applicant's mark and the mark in Reg. '477 to be very similar in commercial impression, meaning, sound, and appearance. This factor weighs strongly in favor of finding confusion likely between these marks.

4. Applicant's mark versus GREAT LAKES TIRE (Reg. '302)

As with the previously-discussed registered marks, the dominant element of the mark in Reg. '302 is the term GREAT LAKES. We further note that this registration is on the Supplemental Register with a disclaimer of the secondary and highly descriptive or generic term TIRE (see Note 4). In this regard, we point out initially that despite the fact that Registrant's mark is registered on the Supplemental Register and, therefore, is not inherently distinctive, we note that even marks on the Supplemental Register are afforded protection, in particular, where the involved marks are overall very similar and the involved goods or services are legally identical, as is the case here. *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978). *See also King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In sum, "a mark registered on the Supplemental Register can be used as a basis for refusing registration to another mark under §2(d) of the Act." *In re Clorox Co.*, 198 USPQ at 340-41.

Thus, Applicant's mark, GREAT LAKES DISTRIBUTION (stylized with design), and Registrant's mark, GREAT LAKES TIRE, share the same dominant element—GREAT LAKES. As discussed, this term has geographic significance and the two marks will convey the same or very similar commercial impression in that the services may originate or be offered in the Great Lakes region.

The additions of TIRE in the registered mark and DISTRIBUTION in Applicant's mark do little to distinguish the two marks in terms of their overall commercial impressions. TIRE merely informs the customer of the type of goods distributed by Registrant and, as discussed, may also be distributed by Applicant, and both

Applicant and Registrant provide “distribution” services. Thus, because we must assume that Applicant and Registrant can be in the tire distribution field, the addition of these terms do extremely little for purposes of distinguishing the marks. Consumers familiar with Registrant’s mark and services may, upon hearing Applicant’s mark, are likely believe the two marks refer to the same source for distribution of tires, especially given that “consumers engage in ‘the penchant of consumers to shorten marks,’” *Sabhnani*, 2021 USPQ2d 1241, at *36 (quoting *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016)), by “drop[ping] the non-source-identifying word [TIRE and/or DISTRIBUTION] when verbalizing” the cited mark. *Id.*

For the same reasons already stated above in the context of the other registered mark, Applicant’s mark and the mark subject of Reg. ’302, are similar in appearance and sound.

For the aforementioned reasons, we find Applicant’s mark and the mark in Reg. ’302 to be very similar in meaning, sound, and appearance. This factor weighs strongly in favor of finding confusion likely between these marks.

5. Applicant’s mark versus GREAT LAKES PIPE AND SUPPLY COMPANY (stylized with design, Reg. ’342)

In contrast with our discussions involving the other registered marks, we do not find the term GREAT LAKES dominant element of the mark in Reg. ’342. We further note that, here, the Registrant has disclaimed the entire wording in the mark. In other words, the only claimed distinctive element of the registered mark:



is the design element, described as concentric circles with straight diagonal lines (see Note 5).

Although we do not find that Registrant's mark is dominated by the same element —GREAT LAKES— as that of Applicant's mark, the fact that both marks share this term helps bring them closer in terms of their overall commercial impressions, appearance and sound. The term does figure prominently in Registrant's mark, appearing in much larger letters than the remainder of the disclaimed wording PIPE AND SUPPLY COMPANY.

We also keep in mind that “[t]he verbal portion of a word and design mark ‘likely will appear alone when used in text and will be spoken when requested by consumers [.]’” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (quoting *Viterra*, 101 USPQ2d at 1911), and it “is normally accorded greater weight because it would be used by purchasers to request the goods [or services].” *Id.* (quoting *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008)). Thus, without ignoring the fact that GREAT LAKES is part of the disclaimed wording in Registrant's mark, we find that consumers will read and speak Registrant's mark by beginning with the words GREAT LAKES and use these words when referring to Registrant's distribution services.

Again, we also keep in mind that Applicant may be distributing the same goods as Registrant. Thus, consumers familiar with Registrant's mark and services may, upon hearing Applicant's mark, believe the two marks refer to the same source for

distribution of pipes, fittings, and valves used for the conveyance of liquid, gas, and electricity, especially given that “consumers engage in ‘the penchant of consumers to shorten marks,’” *Sabhnani*, 2021 USPQ2d 1241, at *36 (quoting *Bay State Brewing*, 117 USPQ2d 1960), by “drop[ping] the non-source-identifying word [PIPE AND SUPPLY and/or DISTRIBUTION] when verbalizing” the cited mark. *Id.*

For the aforementioned reasons, we find Applicant’s mark and the mark in Reg. ’342 are overall similar in terms of meaning and sound; however, less so than the other registered marks. This factor weighs in favor of finding confusion likely.

C. Weakness of the term GREAT LAKES

Applicant argues that “the use of Great Lakes is a crowded field as evidenced by the Cited Registrations,” and this “result[s] in weak marks.”¹³ Applicant goes on to assert that, “if the Cited Registrations are weak and not likely to cause confusion with one another, Applicant contends that the same holds true for GREAT LAKES DISTRIBUTION.”¹⁴

Weakness of cited marks may be found based on evidence showing that the marks, or elements thereof, are inherently or conceptually weak based on the nature of the mark itself. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“[a] mark’s strength is measured [in part] by its conceptual strength (distinctiveness)”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163,

¹³ 4 TTABVUE 3-4.

¹⁴ *Id.* at 4.

1171-72 (TTAB 2011) (the strength of a mark is determined by assessing in part its inherent strength).

Here, because we find, *infra*, the term GREAT LAKES is geographically descriptive, we find this element is not inherently distinctive term and is conceptually weak. Indeed, as already noted, the term is disclaimed with all other wording in Reg. '342, and Reg. Nos. '961 and '477 issued under Section 2(f) based on the term acquiring distinctiveness in connection with the respective services of the Registrants, and Reg. '342 issued on the Supplemental Register, all of which constitutes separate admissions by the Registrants that GREAT LAKES is not an inherently distinctive term. *See, e.g., In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1932 (citing *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988)).

To the extent that Applicant may be arguing that the term GREAT LAKES is commercially weak based on consumer exposure to this term in marks in connection with the same or similar services, there is no evidence to support such a finding. *See Palm Bay*, 73 USPQ2d at 1693 ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection."); *see also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). The cited registrations, by themselves, are not evidence that the cited marks are used in

commerce, let alone to what extent. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009).

Thus, we find the shared term GREAT LAKES is conceptually weak, but not commercially weak. The weakness of a cited mark is only one factor and, in this case, favors Applicant's contention that confusion is not likely. This certainly does not end our analysis because, as often stated, even weak marks are entitled to protection against the registration of a very similar mark, especially when the involved goods or services are closely related or, as in this case, are legally identical. *See King Candy*, 182 USPQ 109; *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010); *see also Morinaga*, 120 USPQ2d 1746 (affirming refusal to register a composite word-and-design mark containing the words MT. RAINIER for espresso coffee drinks on the basis of the mark MOUNT RAINIER COFFEE COMPANY registered on the Supplemental Register for coffee).

D. Conclusion

Because Applicant's mark is overall very similar to each of the registered marks and Applicant's services are legally identical to the respective services identified in each of the registrations, and these services may be offered in the same trade channels to the same class of purchasers, we find confusion is likely. We make this ultimate conclusion keeping in that the shared term GREAT LAKES is conceptually weak.

We would also be remiss if we did not point out that while the four cited registrations cover distribution services and coexist on the Principal and

Supplemental registers, we do not see inconsistency in the Trademark Examining corps' treatment of the term GREAT LAKES in connection with distribution services. There are clear discernible differences in the distribution services rendered by the Registrants—notably each registration covers distribution services for a particular type of good within a certain field that that is different from the others. Applicant's distribution services, on the other hand and as explained supra, are legally identical to each of the Registrants.

Decision: The refusal to register Applicant's mark under Sections 2(d) and 2(e)(2) of the Trademark Act is affirmed.