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Subject: U.S. TRADEMARK APPLICATION NO. 86406361 - CAT & CO. - 38728US01 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86406361; 86406354;
86406361 and 86406370

MARK: CAT & CO.



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Sears Brands, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

38728US01

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION:

Applicant has appealed the Examining Attorneys refusal of registration of proposed variations on the mark "CAT & CO." which were either refused pursuant to Trademark Act Section 2(e)(1) as being merely descriptive, or had a final disclaimer statement requirement as to the terms "CAT & CO" follows:

Application Serial Number 86/406352 standard character mark "CAT & CO." for Class 31 Cat litter, Applicant has appealed the Examining Attorney's final refusal on the Principal Register, pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1). Application Serial Number 86/406354 standard character mark "CAT & CO." for: Class 20 cat beds, Class 28 Cat toys and Class 31 Cat food. Applicant has appealed the Examining Attorney's final refusal on the Principal Register pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1).

Application Serial Number 86/406361 composite mark "CAT & CO." and design for Class 31 Cat litter, Applicant has appealed the Examining Attorney's final Disclaimer Statement Requirement regarding the terms "CAT & CO." Application Serial Number 86/406370 composite mark "CAT & CO." and design for Class 20 cat beds, Class 28 Cat toys and Class 31 Cat food, Applicant has appealed the Examining Attorney's final Disclaimer Statement Requirement regarding the terms "CAT & CO."

The Examining Attorney notes the issues in application serial numbers 86/406352 and 86/406354 are identical; and, the issues in application serial numbers 86/406361 and 86/406370 are identical.

Statement of Facts:

On September 29, 2014, Applicant filed four trademark applications, two standard character marks consisting of the literal elements "CAT & CO." (serial numbers 86/406352 and 86/406354); and, two composite marks consisting of the literal element "CAT & CO." and a paw print design appearing within a hexagon (serial numbers 86/406361 and 86/406370) for the goods identified as: Class 21 cat beds, Class 28 cat toys and Class 31 cat food and cat litter.

On January 16, 2015, the Examining Attorney issued Office Actions refusing Application serial numbers '352 and '354 as descriptive of the subject of Applicant's goods and entity type pursuant to

Trademark Act Section 2(e)(1); and Office Actions for application serial numbers '361 and '370 requiring Applicant to disclaim the terms "CAT & CO." as descriptive of the intended use and subject matter of Applicant's goods and entity type.

On July 16, 2015, Applicant responded to all of the Office actions with arguments and evidence in support of registration of their marks as filed.

On August 7, 2015, the Examining Attorney issued Final Trademark Act Section 2(e)(1) refusals regarding application serial numbers '352 and '354, and Final disclaimer statement requirements regarding application serial numbers '361 and '370.

On February 8, 2016, Applicant instituted appeals in all four applications, and filed requests for reconsideration for all four applications as well.

On February 26, 2016, the Examining Attorney denied the requests for reconsideration for all four applications.

On April 29, 2016, Applicant filed appeal briefs in favor of registration of their marks for all four applications.

On May 9, 2016, the Examining Attorney filed a motion to consolidate all four applications.

ISSUES ON APPEAL:

The issues on appeal are whether trademark application serial numbers 86/406352 and 86/406354 for the standard character marks "CAT & CO." should be refused as merely descriptive pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); and, whether trademark application serial numbers 86/406361 and 86/406370 for composite marks making use of the literal element "CAT & CO." and a paw print design appearing within a hexagon should be required to disclaim the terms "CAT & CO." as unregistrable components of the mark as being descriptive of the use for and

subject matter of Applicant's goods and Applicant's entity type, namely, a Limited Liability Company. 15 U.S.C. §§1052(e)(1), 1056(a).

ARGUMENTS

I. Trademark Act Section 2(e)(1) Refusal of Registration: Applicant's Mark in Application Serial Numbers 86/406352 and 86/406354 for the Standard Character Marks "CAT &CO." are Descriptive of the Intended Use and Subject Matter of Applicant's Goods and Entity Type:

Registration of trademark application serial numbers '352 and '354 for the standard character marks "CAT &CO." was refused because the applied-for mark merely describes the intended use and subject matter of Applicant's products, namely, for "cats" and the Applicant's entity type, namely, a "Limited Liability Company" or "CO." Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, use or subject matter of the specified goods, or is descriptive or generic of the Applicant. TMEP §1209.01(b); see *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a mark that identifies a group of users to whom an Applicant directs its goods is also merely descriptive. TMEP §1209.03(i); see *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004). The name of an ingredient, a key aspect, a central focus or feature, or a main characteristic of goods may be generic for those goods as well. See *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009) (holding TIRES TIRES TIRES generic for retail tire store services); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (holding ATTIC generic for automatic sprinklers for fire protection used primarily in attics); TMEP §§1209.01(c) *et seq.*; see also *In re Northland Aluminum Prods. Inc.*, 777 F.2d 1556, 1559-60, 227 USPQ

961, 963-64 (Fed. Cir. 1985) (holding BUNDT generic for cake mix); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895, 1900 (TTAB 2001) (holding RUSSIANART generic for art dealership services); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 292, 1 USPQ2d 1364, 1365 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas). Thus, a term does not need to be the name of a specific product to be found generic.

The determination of whether a mark is merely descriptive is made in relation to an Applicant's goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by Applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In the instant case, Applicant seeks registration of "CAT & CO." for the goods identified by Applicant as: "cat beds," "cat toys," "cat food" and "cat litter." The entire mark and the terms used therein directly describe the intended use of Applicant's goods, namely, for "cats", and Applicant's entity type, namely, a "Limited Liability Company." Registration of Applicant's mark on the Principal Register must be refused as merely descriptive under Trademark Act Section 2(e)(1).

Applicant's Arguments and Evidence in Favor of Registration of their Mark:

In favor of registration of their mark Applicant has stated their mark is not merely descriptive because: (1) Nothing about the term “CO.” describes the exact nature of the goods and does not tell the consumer anything about the goods; (2) There are a number of meanings for the term “CO.” meaning “COMPANY” and some of these other meanings are not descriptive of Applicant or their goods; (3) With Applicant’s unique combination of the terms “& CO.” and “CAT” the consumer will not immediately determine the “exact function, nature or purpose of such goods”; (4) Applicant is not a “company” but a “corporation”, not an organization for or about cats; and Registration No. 4538995 “KIDS INCORPORATED” and other registrations have previously been permitted registration on the principal register. These arguments and cited evidence is not persuasive for the following reasons:

The standard of determination for whether a mark is merely descriptive is made in relation to an Applicant’s goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by Applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system).

Applicant has stated their mark is suggestive and not descriptive because the mark does not immediately convey the nature of Applicant’s goods, and purchasers would not be able to deduce anything about the goods from the term “CAT & CO.” This argument should not be found to be persuasive. Applicant seeks registration of “CAT & CO.” for “cat beds, toys, food and litter” goods. In

this case, the term “CAT” clearly describes the intended use of Applicant’s goods, and the term “CO.” indicates Applicant’s entity type, e.g. a “Limited Liability Company” both the individual components and the composite result are descriptive and do not create a unique, incongruous, or non-descriptive meaning in relation to the goods. Although the terms “CAT” and “& CO.” are descriptive of two very different things, combining these terms makes them no less descriptive in the mind of the consumer. Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes, because “each component term retains its merely descriptive significance in relation to the goods, resulting in a mark that is also merely descriptive”); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013). In this case, Applicant’s combination of the terms “CAT” “& CO.” does not create a unitary, inseparable alliterative double entendre as Applicant

contends. Both the individual mark components and the composite result are descriptive of Applicant's goods and entity type and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods.

Applicant has also stated the term "CO." or "COMPANY" is not descriptive in connection to Applicant's entity because a number of dictionary definitions or meanings exist which do not describe Applicant. This position is not persuasive because descriptiveness is considered in relation to the relevant goods. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). It is well founded that "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the Applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371. *The American Heritage Dictionary of the English Language: 2014*; Houghton Mifflin Harcourt, defines "CAT" and "COMPANY" in relevant part(s), as: Cat: a. A small domesticated carnivorous mammal (*Felis catus*), kept as a pet and as catcher of vermin, and existing in a variety of breeds; and, Company: a. A business enterprise; a firm, b. A partner or partners not specifically named in a firm's title: Lee Rogers and Company. (See 01/16/2016 Office action for complete definitions; and 08/07/2015 Office action: attached dictionary definition of "Limited Liability Company" or "LLC" and Wikipedia® article regarding Corporations, pages 58-62 and 66-73).

Contrary to Applicant's position, a mark does not need to be merely descriptive of all the goods specified in an application. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1089 (TTAB 2012). "A descriptiveness refusal is proper 'if the mark is descriptive of any of the [goods or] services for which registration is sought.'" *In re The Chamber of Commerce of the U.S.*, 675 F.3d at 1300, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)).

Applicant has also argued their combination of the terms "& CO." and "CAT" will lead the consumer to not immediately determine the "exact function, nature or purpose of such goods". This argument should be given little consideration because generally, if the individual components of a mark retain their descriptive meanings whether in relation to the goods or some other aspect of the Applicant, the combination results in a composite mark that is itself descriptive and not registrable.

Registration has been properly refused because Applicant's mark is derived from the combination of two descriptive terms which in this instance is clear and not in the abstract. Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013). See the copies of printouts from the USPTO X-Search database attached to the 08/07/2015 Office action which evidence third-party registrations of marks used in connection with the same or similar goods as those of Applicant in this case, which have probative value to the extent they serve to suggest that in connection with the goods or related goods at issue, the Registrant's have disclaimed the terms "CO." or "COMPANY" from their marks, which is indicative these terms are

descriptive of the goods and/or services being offered. (See Office Action dated 08/07/2015 attached pages 2-57).

Additionally, Applicant has stated they are a "Limited Liability Corporation" and not a "Limited Liability Company". This statement is at odds with the original applications which identify Applicant as a "Limited Liability Company". Further, the term "Limited Liability Corporation" is not a legally recognized entity in any jurisdiction in the United States. TMEP §803.03(h). (See 08/07/2015 Office action: attached dictionary definition of "Limited Liability Company" or "LLC" and Wikipedia® article regarding Corporations, pages 58-62 and 66-73).

Applicant has also referenced Registration No. 4538995 "KIDS INCORPORATED" and 8 marks where the term "CAT" were permitted registration on the Principal Register, not found to be merely descriptive and not disclaimed in support of their position. Additionally, 36 other marks incorporating the term(s) "CO.," "&CO" or "&CO." were permitted registration without a disclaimer. The Examining Attorney notes the "KIDS INCORPORATED" mark is for wholly unrelated human clothing goods in Class 25; additionally, that of the 8 "CAT" Registrations, 5 are arguably unitary; of the 36 registrations incorporating the term "CO." 9 are arguably unitary, 2 are registered pursuant to a 2(f) claim of acquired distinctiveness and 1 is on the Supplemental Register, and lastly 35 of these cited registrations are for wholly unrelated goods and services. Ultimately it must be recognized prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

Registration of Applicant's marks '352 and '354 on the Principal Register must be refused as merely descriptive under Trademark Act Section 2(e)(1).

II. Refusal of Registration Due to Applicant's Non-adoption of the Disclaimer Statement "CAT & CO." for Application Serial Numbers 86/406361 and 86/406370:

Refusal of registration of trademark application serial numbers 86/406361 and 86/406370 for failure to disclaim the wording "CAT & CO." from their marks was proper and appropriate because these terms are merely descriptive of the purpose and subject matter of Applicant's goods, namely, goods for cats; and, "CO." merely indicates Applicant's entity type, namely, a "company," and thus are an unregistrable components of the marks. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

Applicant seeks to register the '361 and '370 marks "CAT & CO." and design for Class 20 "cat beds," Class 28 "cat toys" and Class 31 "cat food" and "cat litter." The wording "CAT & CO." merely describes the purpose of Applicant's goods, namely, goods for cats; and, "CO." merely indicates

Applicant's entity type, namely, a "Limited Liability Company" and thus the terms "CAT & CO." are unregistrable components of the Applicant's marks.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods in the marketplace. See *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

An unregistrable component of a mark includes wording and designs that are merely descriptive of an Applicant's goods and services. 15 U.S.C. §1052(e); see TMEP §§1209.03(f), 1213.03 et seq. Such words or designs need to be freely available for other businesses to market comparable goods and should not become the proprietary domain of any one party. See *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983); Trademark Act Section 6(a), 15 U.S.C. §1056(a) and Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).

The Applicant has stated the term "CO." appearing in their mark is suggestive and not descriptive because the mark does not immediately convey the nature of Applicant's goods, and purchasers would not be able to deduce anything about the goods from the term "CO." or the combined terms "CAT & CO." This position is not persuasive because with the terms "CAT & CO." for "cat beds, toys, food and litter" goods, the term "CAT" clearly describes the use and subject matter of the goods and the term "CO." indicates Applicant's entity type, e.g. a "Limited Liability Company" both the individual components and the composite result are descriptive and do not create a unique, incongruous, or non-descriptive meaning in relation to the goods. The literal elements used in

Applicant's mark directly describe Applicant's proposed goods and entity type. The terms "CAT & CO." must be disclaimed for application serial number '361 and '370 as merely descriptive.

Applicant has also stated the term "CO." or "COMPANY" is not descriptive in connection with their mark because a number of dictionary definitions or meanings exist which do not directly describe Applicant or their entity type. This argument does not support Applicant's position because "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the Applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property and a mark does not need to be merely descriptive of all the goods specified in an application. "A descriptiveness refusal is proper 'if the mark is descriptive of any of the [goods or] services for which registration is sought.'" *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219; *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1089 (TTAB 2012) (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)). (See also the Examining Attorney's arguments in Section "I." of this brief)

Applicant has stated their combination of the terms "& CO." and "CAT" will lead the consumer to not immediately determine the "exact function, nature or purpose of such goods". This argument should not be considered to be persuasive because generally, if the individual components of a mark retain their descriptive meanings whether in relation to the goods or some other aspect of the Applicant, combining them does not create an overall different commercial impression in this instance. The literal element combination of the terms "CAT" "& CO." here results in a mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); see, e.g., *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the

evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to Applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

Applicant’s mark is derived from the combination of two descriptive terms which in this instance is clear and not in the abstract. (See 08/07/2015 Office action dictionary definition of “Limited Liability Company” or “LLC” and Wikipedia® article regarding Corporations, pages 58-61; 66-73) Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise no-descriptive meaning in relation to the goods is the combined mark registrable. See *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013). Printouts from the USPTO X-Search database, showing third-party registrations of marks used in connection with the same or similar goods as those of Applicant in this case have probative value to the extent they serve to suggest that in connection with the goods or related goods at issue, Registrant’s have disclaimed the terms “CAT,” “CO.” or “COMPANY” from their marks, which is indicative these terms are descriptive of the goods being offered or entity type of the Registrants. (See 01/16/2015 Office action pages 2-54; 08/07/2015 Office action pages 2-57)

Additionally, Applicant has stated they are a “Limited Liability Corporation” and not a “Limited Liability Company”. This statement is at odds with the original application which identifies Applicant as a “Limited Liability Company”. Further, the term “Limited Liability Corporation” is not a legally recognized entity in any jurisdiction in the United States. TMEP §803.03(h). (See 08/07/2015 Office

action dictionary definition of "Limited Liability Company" or "LLC" and Wikipedia® article regarding Corporations, pages 58-61; 66-73)

Applicant has also referenced Registration No. 4538995 "KIDS INCORPORATED" and 8 other marks where the term "CAT" was permitted registration on the Principal Register, not found to be merely descriptive and not disclaimed in support of their position as well as 36 other marks incorporating the term(s) "CO.," "&CO" or "&CO." which were permitted registration. The Examining Attorney notes the "KIDS INCORPORATED" mark is for wholly unrelated human clothing goods in Class 25; additionally, that of the 8 "CAT" Registrations, 5 are arguably unitary; of the 36 registrations incorporating the term "CO." 9 are arguably unitary, 2 are registered pursuant to a 2(f) claim of acquired distinctiveness and 1 is on the Supplemental Register, and lastly 35 of these cited registrations are for wholly unrelated goods and services. Ultimately it must be recognized prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); *see In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); *see In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566. Refusal of Applicant's '361 and '370 marks based upon failure to adopt disclaimer statements with regard to the terms "CAT & CO." must be affirmed.

CONCLUSION:

For the foregoing reasons, the Examining Attorney submits that the refusals to register the Applicant's marks '352 and '354 as being descriptive of the subject matter of the goods being offered and Applicant's entity type pursuant to Trademark Act Section 2(e)(1); and, refusal of registration of Applicant's '361 and '370 marks for failure to adopt disclaimer statements with regard to the terms "CAT & CO." should be affirmed.

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