

This Opinion is not a
Precedent of the TTAB

Mailed: August 30, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Sears Brands, LLC
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Serial Nos. 86406352, 86406354, 86406361, and 86406370
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Joshua A. Aldort, McAndrews Held and Malloy Ltd.,
for Sears Brands, LLC

Thomas M. Manor, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

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Before Hightower, Goodman, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

In this consolidated appeal concerning four applications,¹ Sears Brands, LLC (“Applicant”) seeks registration on the Principal Register of the marks CAT & CO.²


¹ The Board granted the Trademark Examining Attorney’s motion for consolidation on May 9, 2016. *See* 11 TTABVue. Although not identical, the records for the applications are largely similar. Citations in this opinion are to the record in application Serial No. 86406352.

² Application Serial No. 86406352 for “cat litter” in International Class 31, alleging first use anywhere and use in commerce as of September 7, 2014; Application Serial No. 86406354 for “cat beds” in International Class 20, “cat toys” in International Class 28, and “cat food” in International Class 31, filed based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).



(in standard characters) and ³ for cat litter, cat beds, cat toys, and cat food. Each of the four subject applications includes a disclaimer of the term “cat,” and all were filed on September 25, 2014.

The Trademark Examining Attorney refused registration of Applicant’s proposed standard character mark CAT & CO. under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant’s mark is merely descriptive of Applicant’s goods.

The Trademark Examining Attorney refused registration of Applicant’s composite  mark (left) pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on Applicant’s failure to comply with an Office requirement to disclaim CAT & CO. because it is merely descriptive of Applicant’s goods within the meaning of Trademark Act Section 2(e)(1) and thus an unregistrable component of the mark.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeals were resumed. We reverse the refusals to register.

³ Application Serial No. 86406361 for “cat litter” in International Class 31, alleging first use anywhere and use in commerce as of September 7, 2014; Application Serial No. 86406370 for “cat beds” in International Class 20, “cat toys” in International Class 28, and “cat food” in International Class 31, filed based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The description of the mark in each application states: “The mark consists of the stylized words ‘CAT & CO.’ and a paw print inside a hexagon.” Color is not claimed as a feature of the mark.

Concerning Applicant's composite mark (right), a requirement under Trademark Act Section 6 for a disclaimer of unregistrable matter in a mark is appropriate when that matter is merely descriptive of the goods at issue.



See In re Stereotaxis Inc., 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). Merely descriptive or generic terms are unregistrable under Trademark Act Section 2(e)(1) and therefore are subject to a disclaimer requirement if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1954 (TTAB 2006).

As noted, Applicant has disclaimed "cat" from both its standard character and composite marks. Thus, our analysis of the refusals to register both marks turns on the same question: whether the remaining wording "& CO." as part of the marks is merely descriptive of Applicant's identified goods.

Trademarks can be categorized along a continuum of distinctiveness, from generic and descriptive to suggestive, arbitrary, and fanciful terms. *See In re Merrill Lynch, Pierce, Fenner, & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *In re Davia*, 110 USPQ2d 1810, 1814 (TTAB 2014). A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Arbitrary marks comprise terms "that are in common linguistic use but which, when used with the goods or services in issue,

neither suggest nor describe any ingredient, quality or characteristic of those goods or services.” 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 11:11 (4th ed. 2016); *see also Nautilus Group, Inc. v. ICON Health & Fitness Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as “a known word used in an unexpected or uncommon way”). Whether a mark is merely descriptive or inherently distinctive is determined in relation to the goods for which registration is sought, the context in which the mark is used, and the possible significance the term would have to the average consumer because of the manner of its use or intended use. *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015); *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219.

It is well-established that terms indicating business entity designations, such as “Co.,” “Corp.,” and “Inc.,” have no source-identifying significance. *See, e.g., In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2025 (TTAB 2010) (finding the term “company” in ELECTRIC CANDLE COMPANY to be “simply a designation for a type of entity without source-identifying capability”).

Applicant, however, relies on Trademark Manual of Examining Procedure (TMEP) § 1213.03(d) (April 2016), which states that “a disclaimer should not be required when the entity designation is used in an arbitrary manner and thus has trademark significance.” Applicant argues that the use of “CO.” in its mark likewise is arbitrary: “The Applicant is not an organization for or about cats. Indeed, there is

no such legal entity named CAT & CO. affiliated with the Applicant.”⁴ Consistent with this argument, Applicant’s legal entity type is a limited liability company, but Applicant’s name is Sears Brands, LLC, not Cat & Co.

We agree with Applicant that “Co.” in the phrase CAT & CO. serves not merely as an entity designation, but rather is an arbitrary use in association with the goods identified in the applications. As Applicant contends: “Here, the Applicant’s CAT & CO. connotes a faux company name suggesting the goods are produced by a firm where the principal is a cat, which on-its-face is fancifully absurd”⁵ We find that “& CO.” carries trademark significance as a component of Applicant’s marks in their entirety and therefore is not merely descriptive.

The Examining Attorney submitted third-party registrations in which “CO.” is treated as merely descriptive. Applicant, in turn, made of record other third-party registrations on the Principal Register including, e.g., KIDS INCORPORATED (“kids” disclaimed) for clothing items;⁶ TACOS & CO. (“tacos” disclaimed) for restaurant services;⁷ **FLOUR&CO** for bakery goods and desserts;⁸ DREAMS & CO. for sleepwear;⁹ and BAD CO. FIGHT GEAR (“fight gear” disclaimed) for apparel.¹⁰

⁴ Appeal Brief, 8 TTABVUE 9; *see also* Reply Brief, 13 TTABVUE 3 (“Simply stated, the term ‘& CO’ is simply part of a made up name.”).

⁵ Appeal Brief, 8 TTABVUE 14.

⁶ Registration No. 4538995, attached to July 16, 2015 Response to Office Action at 2-3.

⁷ Registration No. 3434875, attached to February 8, 2016 Reconsideration Request at 74.

⁸ Registration No. 4687717, *id.* at 40-41.

⁹ Registration No. 2805755, *id.* at 66.

¹⁰ Registration No. 4526483, *id.* at 46-47.

To be clear, although we have referenced some of the registrations submitted by Applicant, none of the third-party registrations of record controls our analysis of the particular marks before us. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to [Applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”).

Because we have found “& CO.” not merely descriptive as used in the subject marks, and because Applicant has disclaimed “cat” from both of its marks, we need not reach Applicant’s assertions that CAT & CO. is a unitary mark and a double entendre.¹¹

Considering the record as a whole, we find that Applicant’s standard character mark CAT & CO. (with “cat” disclaimed) is not merely descriptive of the goods recited in the applications under Trademark Act Section 2(e)(1), and that Applicant’s composite mark (right) is registrable with the existing disclaimer of “cat.”



Decision: The refusal to register is reversed as to each application.

¹¹ Appeal Brief, 8 TTABVUE 11-15.