

To: Svobodny, Raymond D. (tarnlund@winthrop.com)
Subject: TRADEMARK APPLICATION NO. 76505447 - TABBY'S SCRATCH PAD - N/A
Sent: 5/24/04 6:46:46 AM
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/505447

APPLICANT: Svobodny, Raymond D.

CORRESPONDENT ADDRESS:
Troy E. Arnlund, Esq.
Winthrop & Weinstine, P.A.
Suite 3500 225 South Sixth Street
Minneapolis MN 55402-4629

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

MARK: TABBY'S SCRATCH PAD

CORRESPONDENT'S REFERENCE/DOCKET NO : N/A

CORRESPONDENT EMAIL ADDRESS:
tarnlund@winthrop.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 76/505447

This letter responds to the applicant's communication filed on March 27, 2004.

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified goods/services.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(e)(1) is maintained and made FINAL.

Applicant's mark is TABBY'S SCRATCH PAD for intended use on a cat scratching pad.

Applicant asserts that the examining attorney has improperly dissected the mark. Although the applicant is correct in stating that a composite mark is tested for its validity and distinctiveness by looking at it as a whole rather than dissecting it into component parts, the examiner notes the following observation made by the Trademark Trial and Appeal Board:

It is perfectly acceptable to separate a compound mark and discuss the implications of each part thereof with respect to the question of descriptiveness provided that the ultimate determination is made on the basis of the mark in its entirety. An Examining Attorney's discussion of each word separately in order to show that the term in its entirety is descriptive is not the same thing as dissecting a mark. *In re Hester Industries, Inc.*, 230 USPQ 797, n.5 (TTAB 1986).

Here, applicant argues that the phrase "scratch pad" is suggestive. The Lexis/Nexis® materials reproduced a the end of this office action, clearly establish that a "scratch pad" is an item for use by a cat and also establish that "tabbys" are a type of cat. Judging the mark in relation to the goods its descriptiveness is clear. The goods are a pad that tabbies/tabby's scratch. Accordingly, the refusal under Section 2(e)(1) is maintained and made FINAL.

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). *See* 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matter. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Nora Buchanan Will/
Trademark Attorney, Law Office 116
ph 703-306-7915/ fax 703-746-8116

*****045060*****

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YOUR SEARCH REQUEST AT THE TIME THIS MAIL-IT WAS REQUESTED:
CATS SCRATCH PAD

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*****04531*****

February 29, 2004 Sunday REGION EDITION

SECTION: ARTS & ENTERTAINMENT, Pg.F-1

LENGTH: 1581 words

HEADLINE: TRAVEL INDUSTRY TAKES A NEW LOOK AT PET POLICIES

BYLINE: MICHAEL MARTINEZ, SAN JOSE MERCURY NEWS

BODY:

... shops and medical references. Weight limit: none. Fee: none.

*Le Parker Meridien, Palm Springs, Fla., and New York (1-800-543-4300; www.parkermeridien.com) has a special room-service menu for dogs and wild animals (the New York property has hosted birds, frogs, rabbits and even elephants and giraffes appearing on TV's "Late Night with David Letterman" and "Today"). For dogs, it offers a CD with mood music for \$30 and bones and treats for \$25; for **cats, scratch pads** can be purchased for \$45. Weight limit: none in New York, 35 pounds in Palm Springs. Fee: none.

*Ritz-Carlton Bachelor Gulch, Colo. (1-800-241-3333; www.ritzcarlton.com) has a Loan-A-Lab program for guests without dogs. Bachelor, a yellow Labrador who lives with a hotel employee, is available for walks and companionship but not overnight stays. For guests who bring their own dogs, the hotel provides ID tags, ...

February 29, 2004 Sunday REGION EDITION

SECTION: ARTS & ENTERTAINMENT, Pg.F-6

LENGTH: 719 words

BODY:

... shops and medical references. Weight limit: none. Fee: none.

*Le Parker Meridien, Palm Springs, Fla., and New York (1-800-543-4300; www.parkermeridien.com) has a special room-service menu for dogs and wild animals (the New York property has hosted birds, frogs, rabbits and even elephants and giraffes appearing on TV's "Late Night with David Letterman" and "Today"). For dogs, it offers a CD with mood music for \$30 and bones and treats for \$25; for **cats, scratch pads** can be purchased for \$45. Weight limit: none in New York, 35 pounds in Palm Springs. Fee: none.

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Knight Ridder/Tribune News Service
San Jose Mercury News

January 20, 2004, Tuesday

SECTION: TRAVEL

KR-ACC-NO: K7552

LENGTH: 1662 words

HEADLINE: On the go with Fido: Tips for traveling with man's best friend

BYLINE: By Michael Martinez

BODY:

... pet shops and medical references. Weight limit: none. Fee: none.

_Le Parker Meridien, Palm Springs, Fla., and New York, www.parkermeridien.com, (800) 543-4300, has a special room-service menu for dogs and wild animals (the New York property has hosted birds, frogs, rabbits and even elephants and giraffes appearing on TV's "Late Night with David Letterman" and "Today"). For dogs, it offers a CD with mood music for \$30 and bones and treats for \$25; for **cats, scratch pads** can be purchased for \$45. Weight limit: none in New York, 35 pounds in Palm Springs. Fee: none.

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The Washington Post

June 2, 2002 Sunday
Final Edition

SECTION: BOOK WORLD; RECIPES FOR FUNREVIEWED BY KAREN MACPHERSON; Pg. T09

LENGTH: 1612 words

HEADLINE: Food, crafts, bugs, codes and baseball tips: books to brighten those desultory summer days.

BODY:

... Just think of it as gathering the supplies for an art project.

For art projects crafted from more traditional materials, check out two new books, Dog Crafts and Cat Crafts (Kids Can, \$5.95 each). Linda Hendry, the author and illustrator of both books, has devised two dozen or so crafts that will enthrall pet lovers, ages 8-12 (and younger siblings, with adult help).

Some of the projects create items for the family pet. such as a spiffy dog collar cover or a **cat "scratch pad"** made from cardboard and twine.

Many of the crafts, however, are for the pet lovers themselves: "crazy cat" earrings created from polymer clay, a "doggy desktop organizer," and lampshade designs featuring either a canine or feline theme, depending on your fancy. There's a range of crafts, from simple to challenging. Also, certain projects are obviously geared more to girls' interests, while others would work for both sexes. Hendry's directions are easy to follow, and gain further clarity from her simple illustrations. With these two books, plus some basic craft supplies, ...

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Dayton Daily News (Ohio)

January 20, 2002 Sunday CITY EDITION

SECTION: LIFE; CRITTER CORNER; Pg. 2E

LENGTH: 795 words

HEADLINE: NEW FOOD EASES CANINE BRAIN AGING SYMPTOMS

BYLINE: LAURIE DINGER

BODY:

... pets for a book.

All proceeds from the book will support the group's animal abuse and neglect education programs for Cleveland area youth. The proceeds will also help PAX conduct animal rescue, rehabilitation, adoption and lobbying on the behalf of animals.

Write a short story and mail it to PAX-Story, 5882 Pearl Road, Cleveland, Ohio, 44130. Include your name and phone number in case there are questions. If you have questions about writing a story, call the organization at 440-888-3575.

CAT SCRATCH PAD APPEARS PROMISING

We're still in the testing phase of the Cat Scratch Pad, but the early results appear promising.

The new product, which looks like a carpeted corner guard, is supposed to give cats something other than your couch on which to sharpen those claws. The inventor happened on the idea for his own cat and a new product was born.

Selling for \$14.95, the **cat scratch pad** panel easily screws into the wall and then the carpeted scratch pad is slid down on it. Advertised as a way to eliminate scratching posts, it is supposed to last for years.

I am trying it out in my home and the cats seem interested. One advantage I can see immediately is that it allows a cat to stretch out to its full length while scratching, something they supposedly like to do. And many cats like the carpeted surface to scratch - which you've probably noticed on your own carpeting from ...

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Idaho Falls Post Register (Idaho Falls, Idaho)

August 15, 1999

SECTION: Column; Pg. E7

Explore Litigation Insights

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