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THE T.T.A.B.

Hearing:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Steelbuilding.com, Inc.

Serial No. 78680792

Michael M. Zadrozny of Shlesinger, Arkwright & Garvey for
Steelbuilding.com, Inc.

Katina S. Mister, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney).

Before Quinn, Rogers and Zervas, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Steelbuilding.com, Inc. filed an application to
register the mark STEELBUILDING.COM for "computerized on-
line retail services in the field of pre-engineered metal
buildings and roofing systems" in International Class 35.¹
Applicant has claimed the benefits of Section 2(f) acquired

¹ Application Serial No. 78680792, filed July 28, 2005, alleging
first use anywhere on June 1, 2000, and first use in commerce on
September 29, 2000.

distinctiveness.

The trademark examining attorney refused registration on three grounds as follows: 1) the designation sought to be registered is generic; 2) if not generic, the designation sought to be registered is highly descriptive and the Section 2(f) evidence of record is insufficient to establish acquired distinctiveness; and 3) the recitation of services is indefinite.

When the refusals to register were made final, applicant appealed. Applicant and the examining attorney filed briefs,² and an oral hearing was held.

At the outset, it should be noted that applicant is no stranger to the Board when it comes to Office refusals to register the term STEELBUILDING.COM. The involved application is the fourth application to come before the Board, and obviously we are aware of the prior three cases (one of which was appealed successfully to the Federal Circuit) involving the same genericness and acquired distinctiveness issues as are present in the current appeal. Moreover, with only a few minor additions (as

² Both applicant and the examining attorney have requested that we take judicial notice of certain attachments to their briefs. Inasmuch as the dictionary definitions are proper subject matter for judicial notice, we have considered this evidence. Pursuant to the examining attorney's request, and over applicant's objections, we also have considered the excerpts from the identification of goods/services manual.

explained infra), the present record is the same as the ones under consideration in the prior applications.

In applicant's words, "[t]he examining attorney is directly at odds with the findings of both the Federal Circuit and the Trademark Trial and Appeal Board." (Brief, p. 13). We agree. It is almost as if the examining attorney and her managing attorney are so unhappy with the Federal Circuit's decision on genericness that they hope reconsideration of it may come by way of yet another refusal on the same ground. Simply put, the issue of genericness in the present case is controlled by the Federal Circuit's earlier decision. And given the Board's earlier findings on acquired distinctiveness of the same term STEELBUILDING.COM on the same record, we see no reason to reach a different result herein.

Background

In applicant's prior application Serial No. 75934927, registration was sought for the mark STEELBUILDING.COM for the identical services recited in the present application. The Federal Circuit, in a precedential opinion, held that the term STEELBUILDING.COM was not generic, but that it was merely descriptive, and that applicant had not demonstrated that the term had acquired distinctiveness. *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir.

2005). In affirming on the descriptiveness and lack of acquired distinctiveness issues, the Court held that the "...proposed mark is highly descriptive. Therefore, applicant had the burden to show a concomitantly high level of secondary meaning. The Board correctly determined that, on this record, 'applicant's evidence falls far short of its burden.'" 75 USPQ2d at 1424.

Applicant also had filed application Serial Nos. 76280389 and 76280390 to register the marks STEELBUILDING.COM and design, and STEELBUILDING.COM THE FUTURE OF METAL BUILDINGS, respectively, both for "computerized on-line retail services in the field of pre-engineered steel buildings and roofing systems." The examining attorney had required applicant to submit in each application a disclaimer of the term STEELBUILDING.COM on the basis of genericness. In response, applicant claimed that STEELBUILDING.COM had become distinctive as a result of its five years of use in commerce, and based on additional evidence. The examining attorney subsequently suspended the two applications pending the appeal to the Federal Circuit in application Serial No. 75934927. After the Federal Circuit's decision, the examining attorney withdrew the genericness refusal, but maintained that the term was merely descriptive and lacked acquired

distinctiveness under Section 2(f). Applicant appealed to the Board, and in a non-precedential opinion dated December 12, 2007, the Board found that the term STEELBUILDING.COM had acquired distinctiveness, and reversed the requirement for a disclaimer in each application.

Recitation of Services

Because the recitation of services plays a significant role in a genericness analysis, we first consider this issue.

We note, at the outset, that this issue was not raised until the third Office action. The examining attorney maintains that the recitation of services reading "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems" is indefinite because it "does not specifically or definitely convey the type of services offered by the applicant." More specifically, the examining attorney states that the type of retail services must be clearly described and, in this instance, "'retail services' is not precise enough for the Office to properly categorize the services intended." The examining attorney recommended that the recitation be amended to read, in pertinent part, "retail store services" or "on-line retail store services." According to the examining attorney, the Manual of Acceptable

Identifications of Goods and Services indicates that if retail services are involved, the recitation must include the term "store," "shop" or "outlet." The examining attorney apologized for not raising this issue at the beginning of examination, but further states that this timing has no effect on the merits of the issue.

The recitation of services as it presently reads was also the recitation in application Serial No. 75934927, the subject of the appeal to the Federal Circuit. The Federal Circuit paid very close attention to the recitation given its significant role in the genericness analysis. In that prior application, the examining attorney, the Board and the Federal Circuit did not even hint, let alone find that the recitation was indefinite or otherwise unacceptable. Later, when the Board considered application Serial Nos. 76280389 and 76280390, the recitation differed only by substituting the word "steel" for "metal." Again, neither the examining attorney nor the Board raised any concerns about the acceptability of the recitation. Applicant also owns Registration No. 3227303 (issued April 4, 2007, for the mark DESIGN-PRICE-BUY ONLINE and design); the recitation therein is identical to the one in the present application.

In summary, the recitation of services as it presently reads has been accepted by the Federal Circuit in one application, by the Board in two other applications, and by an examining attorney in an application that has matured into a registration. And, in the present case, the objection was not raised until the third Office action.

Given the focus of attention on the recitation of services as it relates to the issue of genericness on no less than three occasions, to raise an objection now, at least from our perspective, is untimely and manifestly unfair. The recitation of services has been found to be acceptable by the Examining Operation, the Board and the Federal Circuit, surviving close scrutiny in connection with the issue of genericness.

Accordingly, we find that the present recitation of services is acceptable. The recitation "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems" is therefore the operative recitation in the application.

Genericness

Based on the briefs, the Board presumes familiarity with the Federal Circuit's opinion, and we see no reason to recount in detail the Court's findings and conclusions of law regarding genericness. We likewise will not rehash the

examining attorney's arguments regarding genericness, none of which are well-taken, given the Federal Circuit's controlling decision.

What we will consider, however, is the significance of the new evidence submitted by the examining attorney that, under her theory, compels a different result on genericness. Her position is essentially that the new evidence constitutes a change in facts sufficient to justify a different result in this appeal. The present record, however, differs only minimally from the earlier records. Here the examining attorney has submitted evidence of two third-party domain names, and eight third-party registrations.³

As to the domain names, the examining attorney submitted excerpts of the third-party websites accessible at the web addresses www.steelbuilding.net and www.steelbuilding.cc. The examining attorney points out that these competitors in the field offer online retail services featuring steel buildings under "steelbuilding" plus a top level domain designation ("TLD").

The examining attorney argues that the two additional

³ The examining attorney also submitted one third-party application. This application has no probative value of any fact other than to show that the application was filed.

domain names show a competitive need to use both of the terms comprising applicant's mark, namely "steelbuilding" and ".com." However, as is the problem with all of the examining attorney's evidence on this point, and as highlighted by the Federal Circuit's concerns, the web sites accessed by the two domain names do not show generic use of the compound "steelbuilding." Further, these two third parties appear to be competing with applicant without the need to use "steelbuilding.com."

The third-party registration evidence includes one issued on the Supplemental Register with a disclaimer of "Steel Building" (two words, singular), and seven issued on the Principal Register with a disclaimer of "Steel Buildings" (two words, plural). From this evidence the examining attorney would have us conclude that others in the "'steel building' industry need to use this term to describe their goods and services." (Brief, p. 12). The examining attorney again misses the point made by the Federal Circuit in diminishing the probative value of third-party uses of "steel building" (two words). The registrations do not address the Federal Circuit's major concern that there is no evidence showing use of the compound "steelbuilding" (one word). That is to say, the registrations do not demonstrate that others in the field

need to use the compound "steelbuilding" in connection with their goods and services, and certainly do not show the need to use the entire term STEELBUILDING.COM.

In sum, the additional evidence in this case does not result in circumstances that are so materially changed from the prior applications that a different result is warranted herein. Rather, the Federal Circuit's prior determination that the term STEELBUILDING.COM is not generic controls here.

Acquired Distinctiveness

As in the case of the genericness issue, we likewise find that the issue of acquired distinctiveness of the term STEELBUILDING.COM has already been determined, and we see no reason to deviate from the Board's decision dated December 12, 2007 with respect to applicant's two prior applications. We presume familiarity with the Board's prior decision regarding acquired distinctiveness of the term STEELBUILDING.COM.

As applicant contends, and the examining attorney does not dispute, the evidence of acquired distinctiveness herein is identical to the evidence earlier submitted in connection with application Serial Nos. 76280389 and 76280390. The examining attorney has not provided any additional evidence to rebut applicant's showing, but

essentially maintains that distinctiveness cannot be acquired because the term STEELBUILDING.COM is generic.

In the wake of the Federal Circuit's decision that the term STEELBUILDING.COM is not generic but rather highly descriptive, this is the third instance where applicant has sought registration under Section 2(f). We thus turn to the only remaining issue in the case, namely whether applicant has met its burden of showing that the term STEELBUILDING.COM has acquired distinctiveness. Applicant has the burden of establishing acquired distinctiveness in ex parte proceedings before the Board. *See Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

According to the declarations of Todd Moore, applicant's vice president, general counsel and corporate secretary, applicant has been using its mark since 2000. Also of record are the declarations of Byron House, III, applicant's president, and Tom Hockersmith, applicant's marketing director. We briefly summarize the pertinent facts regarding applicant's substantially exclusive and continuous use.

Annual sales for applicant's services under the term STEELBUILDING.COM were almost \$12 million in 2002, and sales have steadily increased, amounting to approximately

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\$22 million in 2004 and 2005. Promotional expenditures also have increased over the years, with annual costs now approaching \$1 million.

Visitor traffic to applicant's STEELBUILDING.COM website in 2005 ranged from 50,000 per month to over 100,000 per month. This traffic is greater than that of any competitor in the field.

The record also includes declarations and statements from customers and professionals in the metal building industry. In every instance, the individual states that he associates the term STEELBUILDING.COM with the identified services offered by applicant, and not with any other entity offering similar services in the same field.

Applicant also submitted emails from customers to show that STEELBUILDING.COM has acquired distinctiveness. In each instance, consumers recognize the term STEELBUILDING.COM as a reference to applicant.

Applicant also has been the beneficiary of "a great deal of attention from the trade press." Applicant and its services have been the subject of feature articles.

When we review and weigh the evidence of record, we are persuaded, as was the Board panel deciding the appeals in application Serial Nos. 76280389 and 76280390, that applicant has demonstrated that the term STEELBUILDING.COM

has acquired distinctiveness for the identified services. Applicant's sales and advertising have substantially increased between 2001 and 2005. Since its initial use of the term in 2000, applicant has achieved significant success. Numerous competitors and others in the building trade have indicated that they recognize the term STEELBUILDING.COM as a term designating applicant as the source of the identified services. Customers have referred to applicant by the term STEELBUILDING.COM. The term is prominently displayed in the manner of a mark on applicant's website and in its advertising.

In view of the above, we agree with applicant that its evidence of extensive and successful use and promotion of the term STEELBUILDING.COM demonstrates that the term has become distinctive of applicant's services and that it is registrable on the Principal Register under Section 2(f). The fact that there are two similar third-party domain names, not used as trademarks, does not detract from this distinctiveness.

A final comment is in order. Four pages of arguments by the managing attorney were appended to the examining attorney's brief. The managing attorney states that he "is taking the unusual step of adding this post script to the brief to point out that the TTAB stands at the brink of

potentially creating two divergent bodies of case law regarding genericness for proposed marks consisting of generic terms plus TLDs." In arguing that the Federal Circuit's prior decision was erroneous, the managing attorney uses language such as "the purely academic atmosphere of the Court of Appeals for the Federal Circuit"; "the CAFC's attempt to pretend that 'steel building' is used like 'home building' was completely without merit, with no evidence in the record to support it whatsoever"; and that notwithstanding the prior decision by the Federal Circuit, the examining attorney has done "an exemplary job of showing that STEELBUILDING.COM is generic." The fact that the managing attorney disagrees, rather strongly, with the Federal Court's finding that STEELBUILDING.COM is not generic is irrelevant to the merits of this appeal.

Moreover, we disagree with the managing attorney's conclusion that the Board and the Federal Circuit stand at the brink of a body of case law about to diverge into two contradictory branches. Quite simply, there are no per se rules when it comes to determining whether a term combined with a TLD is or is not generic. And the law already has developed to the point of recognizing that some terms will be registered and others will be refused. In that sense,

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the Federal Circuit and the Board have passed the point the managing attorney thinks is only now at hand, and we anticipate that the Board and the Federal Circuit will continue to be able to differentiate which terms should be registered and which must be refused.

Decision: The refusals to register are reversed.