

**This Opinion is Not a
Precedent of the TTAB**

Hearing:
February 23, 2016

Mailed:
April 8, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

———
Trademark Trial and Appeal Board
———

In re United States Steel Corporation
———

Serial No. 86174180
———

Jonathan C. Parks for United States Steel Corporation.

Toby E. Bulloff, Trademark Examining Attorney, Law Office 119,
Brett Golden, Managing Attorney.

———
Before Quinn, Cataldo and Lynch,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

United States Steel Corporation (“Applicant”) seeks registration on the Principal Register of the proposed mark COPPER-TEN (in standard characters) for “prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered copper” in International Class 6.¹

¹ Application Serial No. 86174180, filed January 24, 2014 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first anywhere and first use in commerce on February 28, 2010.

The Trademark Examining Attorney refused registration under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), on the ground that Applicant's proposed mark, when applied to the goods, is deceptive.

When the refusal was made final, Applicant appealed and requested reconsideration. Upon denial of the request, proceedings in the appeal resumed, and Applicant and the Examining Attorney filed briefs. An oral hearing was held before this panel.

We affirm the refusal to register.

Applicant argues that the COPPER portion of its proposed mark does not misdescribe the goods as having copper material, but rather accurately describes the visual appearance simulated by the goods, namely, that the sheet steel has been prepainted to simulate naturally weathered copper. Thus, Applicant contends, COPPER-TEN does not misdescribe the goods, and consumers would not find the mark to be deceptive. Further, Applicant relies on what it characterizes as a "family of trademarks," comprising GALV-TEN, COR-TEN AZP, DUAL-TEN and the present proposed mark. To this point, Applicant asserts that consumers will associate not only the individual marks, but the common characteristic of the family, with Applicant, and that this common characteristic eliminates the possibility that consumers are likely to believe any possible misdescription. The relevant consumers, according to Applicant, are home builders, construction experts and professional architects, all of whom are sophisticated and understand that the goods are specially coated steel and do not necessarily contain any copper metal or materials. In support

of its arguments Applicant submitted printouts of web pages from third-party websites, and identical declarations of Applicant and Applicant's licensee.

The Examining Attorney maintains that the term COPPER appearing in the proposed mark indicates that the goods contain copper when, in fact, they do not; that consumers are likely to believe this misrepresentation; and that this misrepresentation is likely to materially affect consumers' decisions to purchase the goods. The Examining Attorney introduced excerpts of third-party websites.

Before turning to the merits of the refusal, we direct our attention to a procedural matter. In its reply brief Applicant asserts for the first time a claim that its proposed mark has acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). (10 TTABVue 7-8). Applicant essentially relies upon certain statements in the two declarations regarding deceptiveness, and couches them in terms of acquired distinctiveness.

First, marks that are deceptive under Section 2(a), as we have found here, are not registrable either on the Principal Register, even under Section 2(f), or the Supplemental Register. Second, a claim of acquired distinctiveness raised for the first time in a reply brief is manifestly untimely. *See* Trademark Rule 2.142(d) (record should be complete prior to appeal). Accordingly, we have given no consideration to Applicant's late claim of acquired distinctiveness.

I. Applicable Law – Section 2(a) – “Deceptive Matter”

Section 2(a) is an absolute bar to registration of an applied-for mark comprised of deceptive matter. The Examining Attorney has the initial burden of putting forth

a *prima facie* case that a trademark falls within the prohibition of Section 2(a). *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988) (LOVEE LAMB deceptive for “automotive seat covers”); *In re E5 LLC*, 103 USPQ2d 1578, 1579 (TTAB 2012) (mark consisting of alpha symbol and the letters “CU” deceptive of dietary supplements not containing copper). A mark is deceptive if the following criteria are met:

- 1) The applied-for mark consists of or contains a term that misdescribes the character, quality, function, composition, or use of the goods;
- 2) Prospective purchasers are likely to believe that the misdescription actually describes the goods; and
- 3) The misdescription is likely to affect the purchasing decision of a significant portion of relevant consumers.

See In re Budge Mfg. Co., 8 USPQ2d at 1260; *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391-92 (TTAB 2013); *see also In re Spirits International, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492-93, 1495 (Fed. Cir. 2009) (holding that the test for materiality incorporates a requirement that a “significant portion of the relevant consumers be deceived”). A mark is deceptive even if only a portion of the mark is deceptive. *See American Speech-Language-Hearing Assoc. v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984). This includes marks, such as Applicant’s, that comprise both deceptive matter and a non-deceptive term. *Id.* The law is clear; Section 2(a) of the Trademark Act prohibits registration of deceptive matter, not merely deceptive marks. *See In re White Jasmine LLC*, 106

USPQ2d at 1391 (“It is well established that a mark may be found deceptive on the basis of a single deceptive term that is embedded in a larger mark.”).

II. Analysis

A. *Does the applied-for mark consist of or contain a term that misdescribes the character, quality, function, composition, or use of the goods?*

Applicant seeks registration for the proposed mark COPPER-TEN for goods described as “prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered copper.” Further, throughout prosecution, Applicant confirmed that its goods do not contain copper as an ingredient or component; rather, the goods are prepainted steel sheets meant to look like weathered copper. In accordance with Section 2(a), registration must be refused if a mark is deceptive of a feature or an ingredient the goods. *See In re E5 LLC*, 103 USPQ2d at 1579-81 (consumers would understand CU portion of the mark to indicate chemical symbol for copper, and because applicant’s dietary supplements do not contain copper, mark is deceptive).

Inasmuch as Applicant’s goods do not contain copper, the proposed mark COPPER-TEN misdescribes the goods.

Applicant advances several arguments in an attempt to show that purchasers would not understand the presence of the term COPPER in the proposed mark to indicate that the building material contains copper.

Contrary to Applicant’s contention, the addition of —TEN in the mark has no impact on the deceptiveness of the COPPER portion of the mark and, in turn, the mark as a whole. *See, e.g., R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d

Application Serial No. 86174180

786, 140 USPQ 276 (CCPA 1964) (DURA-HYDE held deceptive and deceptively misdescriptive of plastic material of leatherlike appearance made into shoes); *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982) (TEXHYDE held deceptive of synthetic fabric sold in rolls to be used in the manufacture of furniture, upholstery, luggage, etc.); *Caldwell Lace Leather Co., Inc. v. Western Filament, Inc.*, 173 USPQ 695 (TTAB 1972) (NEOHIDE held deceptive and deceptively misdescriptive of shoe laces which could be made to simulate leather). Applicant pointed to no meaning of the term –TEN that would change the meaning or impression of the reference to COPPER in the mark or of the mark as a whole. *See A. F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459, 460 (TTAB 1962) (COPY CALF not deceptive of non-leather goods because the term as a whole indicates the goods “are imitations or copies of wallets and billfolds made of calf skin”).

We further are entirely unpersuaded by Applicant’s argument that because it owns a purported family of –TEN marks, the present mark cannot be deceptive. Applicant owns the following registrations issued on the Principal Register: Reg. No. 3331634 for the mark COR-TEN AZP for “prepainted coated sheet steel, namely, corrosion-resistant coated sheet steel prepainted to simulate naturally weathered steel” in International Class 6; Reg. No. 4298490 for the mark FLANGE-TEN for “steel mill products, namely, advanced high-strength automotive sheet steels exhibiting improved stretch flangability” in International Class 6; Registration No. 4376566 for the mark TRIP-TEN for “steel mill products, namely, hot rolled steel and galvanized steel sheet” in International Class 6; Registration No. 4376567 for the

mark DUAL-TEN for “steel mill products, namely, hot rolled steel and galvanized steel sheets” in International Class 6; and Reg. No. 4702394 for the mark GALV-TEN for “prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered galvanized steel” in International Class 6.

We fail to see the applicability of a family of marks argument in the context of a deceptiveness case, to somehow transform an unregistrable deceptive mark into a source indicator. *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.”). Moreover, even if we believed that a family of marks argument had applicability in considering deceptiveness, Applicant has failed to establish that it owns a family of –TEN marks. The Federal Circuit has defined a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). In the past, the Board has looked at whether the marks asserted to comprise a “family” have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and,

thereafter, recognition of common ownership based upon a feature common to each mark. *American Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978). The mere use of the marks together in an advertisement for Applicant's Weathered Metal Series™ falls short of establishing a family in the absence of evidence to show a recognition among purchasers that the common characteristic of —TEN is indicative of a common origin of the goods. Further, ownership of a few registrations for marks that include the common element —TEN hardly suffices to establish a family of marks. In sum, the mere fact of adoption, use and/or registration of a few marks incorporating a common element does not in itself prove that a family of marks exists. *Polaroid Corp. v. Richard Mfg. Co.*, 341 F.2d 150, 144 USPQ 419 (CCPA 1965); *Trek Bicycle Corp. v. Fier*, 56 USPQ2d 1527, (TTAB 2000); *Consolidated Foods Corp. v. Sherwood Medical Indus., Inc.*, 177 USPQ 279 (TTAB 1973).

We also note that any clarifying features of an applicant's advertising do not serve to overcome deceptiveness in a mark. In this connection, Applicant's advertisements, indicating that its product is a prepainted steel sheet to "give your project the distinctive aged appearance and the rich, classic character that until now, only time — and the elements — could provide," do not diminish the deceptiveness of the proposed mark. Rather, the mark must stand on its own. *See In re Budge Mfg. Co.*, 8 USPQ2d at 1261; *In re ALP of S. Beach Inc.*, 79 USPQ2d 1009, 1014-1015 (TTAB 2006) (CAFETERIA deceptive for "restaurants providing full service to sit-down patrons, excluding cafeteria-style restaurants").

Accordingly, we find the first prong of the Section 2(a) deceptiveness test to be satisfied.

B. Are purchasers likely to believe that the misdescription actually describes the goods?

As noted above, the Examining Attorney introduced evidence to show that copper is a common feature or ingredient of building materials. The following details the popularity of copper:

Copper has earned a respected place in the related fields of architecture, building construction, and interior design.

The history of copper in architecture can be linked to its durability, corrosion resistance, prestigious appearance, and ability to form complex shapes. For centuries, craftsmen and designers utilized these attributes to build aesthetically pleasing and long-lasting building systems.

For the past quarter century, copper has been designed into a much wider range of buildings, incorporating new styles, varieties of colors, and different shapes and textures. Copper clad walls are a modern design element in both indoor and outdoor environments.

Copper's most famous trait is its display from a bright metallic color to iridescent brown to near black and finally to a greenish verdigris patina ... The metal's distinctive green patina has long been coveted by architects and designers.

Benefits

Corrosion resistance
Durability/Long-life
Low thermal movement
Low maintenance
Lightweight
Ventilation
Radio frequency shielding

Lightning protection
Wide range of finishes
Design continuity
Antimicrobial
Sustainability
Recyclability
Cost effectiveness
(Wikipedia, Office action, April 30, 2014)²

As just indicated, copper is very desirable for building materials because it is highly durable, corrosion resistant, low maintenance, lightweight, and has a distinctive green patina, which is the choice of architects and designers. An entire industry is developing to provide consumers with less expensive “faux copper.” (<decorativeceilingtiles.net>, <delformstudios.com>, Office action, November 19, 2014). Indeed, Applicant’s goods mimic the look of weathered copper with the use of less expensive prepainted steel sheets. The following website blog illustrates some differences between real copper and faux copper:

Metal and Copper Roofing Blog

Our previous blog posts on copper roof look-alikes (Copper Looking Metal Roofing – Is there a Good Fake? and “Metal Roofs that Look Like Copper Roofs (But Aren’t!)”) have proven to be quite popular, so we decide to elaborate on the topic once again.

The question of the hour is, can you fake the look of a real copper with another material. I certainly understand why we often receive requests for a metal roof that “looks like copper” but costs considerably less. Considering that a real copper roof can cost as much as \$10 to \$15 a square foot

² The Board gives guarded consideration to evidence taken from Wikipedia, bearing in mind the limitations inherent in this reference work, so long as the non-offering party has an opportunity to rebut the evidence by submitting other evidence that may call its accuracy into question. *See In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007). In the case before us, the Wikipedia evidence was submitted with the Examining Attorney’s initial Office action, and Applicant had an opportunity to rebut it.

(compared to finished steel roofs that can cost as little as \$1 a square foot), it makes perfect sense that a faux copper roof would have some appeal.

So, with that in mind, is there a good fake? Kind of. There are a big variety of finished (i.e. “painted”) metals (mostly steel or aluminum) that have colors which attempt to replicate various stages of the ageing of copper on a roof. With names such as “weathered copper,” “antique patina,” “dark bronze” and the like, we often get asked for samples of these colors as the labels conjure up some of the cache of a real copper roof.

It’s quite amazing how often the receiver of these samples is disappointed by what they see. Their imagination of what can be done to replicate copper is often far more creative than any finish that can be produced on a mass-production paint line.

(<metalroofnet.com>, Office action, November 19, 2014)

The final paragraph of the blog excerpt highlights our view that, because copper is a common component of building materials, purchasers are likely to believe, based on the mark and the goods at issue, that Applicant’s goods contain “the real thing,” namely copper when, in fact, they do not.

We are not persuaded by Applicant’s argument that the relevant customers of its goods include home builders, construction experts and professional architects who, Applicant claims, are sophisticated and are not likely to be deceived by Applicant’s proposed mark. First, the identification of goods in the present application is not limited as to the channels of trade or the classes of purchasers to whom the goods are sold. Thus, the identification is broad enough to include do-it-yourself consumers or handymen who could purchase the goods at a building supply store such as Home Depot or Lowe’s. *See Evans Prods. Co. v. Boise Cascade Corp.*, 218 USPQ 160, 163

(TTAB 1983). Second, and in any event, there is no direct probative evidence from the relevant purchasers themselves to support the assertion that these purchasers are not likely to be deceived. The only evidence on this point are two identical declarations, both self-serving characterizations of alleged consumer perception and understanding, without providing any factual basis therefor. One is from David Durham, a Marketing Manager for Applicant, and the other is from Michael Blake, president of Sheffield Metals, a licensee of Applicant. Messrs. Durham and Blake state, in relevant part:

Applicant licenses a family of trademarks including GALV-TEN for “prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered galvanized steel” (see U.S. Reg. No. 4,702,394); COR-TEN AZP for “prepainted coated sheet steel, namely, corrosion-resistant coated sheet steel prepainted to simulate naturally weathered steel (see U.S. Reg. No. 3,331,634); and the captioned COPPER-TEN mark for “prepainted coated sheet steel, namely, coated sheet steel prepainted to simulate naturally weathered copper.”

Consumers for the products described [above] are sophisticated purchasers including home builders, construction experts, and professional architects.

With regard to the family of trademarks described [above], use of the “COPPER” or “GALV” terms, for example, with the “-TEN” element common to each mark indicates to the consumer a visual appearance associated with the product identified by the mark.

Consumers understand that the use of the term “COPPER” in the captioned COPPER-TEN mark indicates that the product will provide coated sheet steel prepainted to simulate naturally weathered copper as a visual appearance of the product.

Consumers understand that the use of the term “COPPER” in the captioned COPPER-TEN mark does not indicate that the product contains copper metal or is otherwise comprised of copper materials.

The choice of visual appearance of the sheet steel product connoted by the COPPER-TEN mark is merely a personal preference and not a material factor in the consumer’s decision to select the COPPER-TEN product to the extent that the consumer understands that the product does not contain copper metal or materials.

(4 TTABVUE 15-18)

Again, these declarations fail to rebut the Examining Attorney’s showing that purchasers are likely to believe that Applicant’s goods sold under the proposed mark COPPER-TEN contain copper.

In view of the above, we find that the second prong of the Section 2(a) deceptiveness test has also been satisfied.

C. Is the misdescription likely to materially affect the purchasing decision of a significant portion of relevant consumers?

Under this prong we look to whether the misdescription is material to consumers’ decision to purchase the goods. *See In re Budge Mfg. Co.*, 8 USPQ2d at 1260. The record is replete with evidence showing that genuine copper is commonly used and highly desirable for building materials. Copper sheets “are popping up everywhere” in home building and remodeling. (<homerenovations.about.com>, Office action, April 30, 2014); and “Steel is one of the most popular types of metal roofing for its high strength and relatively low price ... The major disadvantage of steel is that it can rust ... Copper roofing is beautiful, malleable and soft. It naturally resists corrosion thanks to the verdigris that forms over copper as it weathers ... Copper

looks great naturally and doesn't need to be painted. Although copper roofing has a number of desirable aesthetic traits, it is much more expensive than steel roofing.” (<armormetalroofing.com>, Office action, April 30, 2014).

Because copper is a commonly used component of building materials, and copper has several important and desirable advantages over other building material components, such as steel, we find that its presence as an ingredient or feature — or indeed its absence — would be material to the decision of consumers to purchase Applicant's goods. *See In re White Jasmine*, 106 USPQ2d at 1392. Thus, the third and final prong of the Section 2(a) deceptiveness test also has been satisfied.

III. Conclusion

In sum, after reviewing the evidence of record, we find that all three prongs of the deceptiveness test have been satisfied: 1) Applicant's proposed mark COPPER-TEN misdescribes its goods because consumers would understand the COPPER portion, in the context of the goods, to refer to copper, and the goods do not contain copper; 2) due to the common use and popularity of copper as an ingredient or feature of building materials, consumers are likely to believe the misdescription; and 3) due to the several advantages of copper as used for building materials, the misrepresentation will materially affect the decisions of consumers whether to purchase the goods. The Examining Attorney's evidence established a *prima facie* case against registration, and Applicant did not meet its burden to come forward with countering evidence to overcome the refusal. *See In re Budge Mfg. Co.*, 8 USPQ2d at 1260-61.

Application Serial No. 86174180

In view of the above, with the three prongs of the test satisfied, we find that Applicant's proposed mark is deceptive within the meaning of Section 2(a).

Decision: The refusal to register Applicant's proposed mark COPPER-TEN under Section 2(a) is affirmed.