

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: September 22, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Big River Steel LLC*  
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Serial No. 90887436  
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Jonathan C. Parks of United States Steel Corporation,  
for Big River Steel LLC.

Aisha C. Johnson, Trademark Examining Attorney, Law Office 101  
Zachary Sparer, Managing Attorney.

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Before Wellington, Pologeorgis, and Allard,  
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

Big River Steel LLC (“Applicant”) seeks registration on the Principal Register of  
the following composite mark:



a **U. S. Steel** company

for use with “Steel products, namely, steel sheets and coils,” in International Class 6.<sup>1</sup> The mark is described as “consist[ing] of an outline of a rectangular box with the letters BRS positioned therein, the letters are connected at the base of each of the letters, the words BIG RIVER STEEL are positioned in a solid bottom portion of the box and the words a U.S. Steel company are positioned below the box.” Applicant’s claim of acquired distinctiveness as to “U.S. STEEL” has been accepted. 15 U.S.C. § 1052(f).

The Examining Attorney ultimately refused registration of Applicant’s mark under Section 6(a) of the Trademark Act, 15 U.S. § 1056(a), based on Applicant’s failure to comply with a requirement to disclaim the exclusive right to use the term “STEEL” in the “U.S. STEEL” portion of the mark, asserting that it is generic, and thus an unregistrable component of the mark.

After the disclaimer requirement was made final,<sup>2</sup> Applicant appealed.<sup>3</sup> Both Applicant and the Examining Attorney filed briefs. For the reasons explained below, we affirm the refusal to register.

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<sup>1</sup> Application Serial No. 90887436 was filed on August 17, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce.

<sup>2</sup> December 7, 2022 Office Action.

Citations in this opinion to filings in this proceeding before the Board are to TTABVUE, the Board’s online docketing system. Citations to the application record are to pages in the Trademark Status and Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”).

<sup>3</sup> Notice of Appeal (1 TTABVUE).

## I. Pertinent Prosecution History

After the application was filed, the Examining Attorney issued a non-final action, requiring, among other things, a disclaimer of the terms “STEEL” (in the “BIG RIVER STEEL” portion of the mark) and “U.S. STEEL COMPANY”.<sup>4</sup> In response, Applicant agreed to disclaim the term “STEEL” in the “BIG RIVER STEEL” portion of the mark and, in an attempt to overcome the disclaimer requirement as to the “U.S. STEEL” portion, Applicant argued that the “U.S. STEEL” portion had acquired distinctiveness.<sup>5</sup> Applicant did not address the term “COMPANY”.<sup>6</sup>

In the following Office Action, the Examining Attorney accepted the claim of acquired distinctiveness as to “U.S. STEEL” and required a disclaimer as to “STEEL” and “COMPANY”.<sup>7</sup>

Applicant’s counsel spoke with the Examining Attorney by telephone and agreed to the following disclaimer: “No claim is made to the exclusive right to use ‘STEEL’ in the ‘Big River Steel’ portion of the mark and ‘COMPANY’ apart from the mark as shown.”<sup>8</sup> An Examiner’s Amendment consistent with the agreed-upon disclaimer was issued<sup>9</sup> and the application was advanced to publication.

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<sup>4</sup> May 19, 2022 Office Action.

<sup>5</sup> June 14, 2022 Response to Office Action at TSDR 2-6.

<sup>6</sup> *Id.*

<sup>7</sup> June 23, 2022 Office Action at TSDR 1-2.

<sup>8</sup> Applicant’s brief, p. 2 (4 TTABVUE 7); Examining Attorney’s brief (6 TTABVUE 2).

<sup>9</sup> June 27, 2022 Examiner’s Amendment.

However, the application was withdrawn from publication,<sup>10</sup> and the Examining Attorney subsequently issued a non-final Office action requiring a disclaimer of the term “STEEL” in the “U.S. STEEL” portion of the mark because it is “generic for the steel goods identified.”<sup>11</sup> Applicant argued against the disclaimer,<sup>12</sup> consequently, the Examining Attorney made the refusal final,<sup>13</sup> resulting in the present appeal.

When Applicant filed the present application, Applicant contemporaneously filed another application to register the same mark for “metal processing, namely, custom steel fabrication to the order and specification of others” in International Class 40 (the “Companion Application”).<sup>14</sup> Although there is no evidence of its registration in record, Applicant asserts that this Companion Application was not withdrawn from publication but rather was allowed to mature into a registration (Reg. No. 6875790) without a disclaimer of the term “STEEL” of the “U.S. STEEL” portion of the mark.<sup>15</sup> The Examining Attorney acknowledges that the mark of the Companion Application was registered without a disclaimer of the term “STEEL” in the “U.S. STEEL” portion of the mark, but maintains that the failure to require a disclaimer in the Companion Application was in error and should have been required, and that the failure to

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<sup>10</sup> Examining Attorney’s brief (6 TTABVUE 2).

<sup>11</sup> August 11, 2022 Office Action at TSDR 1-2. Applicant does not dispute the disclaimer requirements as to the term “STEEL” in “BIG RIVER STEEL” and “COMPANY”.

<sup>12</sup> November 10, 2022 Response to Office Action.

<sup>13</sup> December 7, 2022 Office Action.

<sup>14</sup> Applicant’s brief, p. 1 (4 TTABVUE 6).

<sup>15</sup> *Id.* at 1-2 (4 TTABVUE 6-7).

require a disclaimer in the Companion Application does not void the requirement in the present application as each case stands on its own.<sup>16</sup>

As an initial matter, the Examining Attorney concedes and the record is clear that Applicant's claim of acquired distinctiveness as to the "U.S. STEEL" portion of the mark has been entered.<sup>17</sup> The sole issue before us is whether the term "STEEL" in the "U.S. STEEL" portion of the mark is generic and must be disclaimed, even where the portion "U.S. STEEL" is deemed to have acquired distinctiveness, or rather is "U.S. STEEL" a unitary mark such that a disclaimer is not necessary?<sup>18</sup>

## II. Analysis

### A. Disclaimers and Genericness

Section 6(a) of the Trademark Act reads in relevant part: "The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." 15 U.S.C. § 1056(a). A disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark in a trademark application or registration. The USPTO may require a disclaimer as a condition of registration if the term in the mark is generic with respect to at least some of the goods or services in the genus, and registration is properly refused in the absence of a disclaimer. *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1082 (TTAB 2010) (citing *In re Analog Devices, Inc.*, 6 USPQ2d 1808, 1810 (TTAB

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<sup>16</sup> December 7, 2022 Final Office Action at TSDR 3.

<sup>17</sup> Examining Attorney's brief (6 TTABVUE 5-6) ("As this record shows, the Examining Attorney agrees that the term "U.S. STEEL" has acquired distinctiveness.").

<sup>18</sup> Applicant's brief, p. 3 (4 TTABVUE 8); Examining Attorney's brief (6 TTABVUE 2).

1988), *aff'd without pub. op.*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (registration is properly refused if the subject matter for registration is generic of any one of the goods for which registration is sought)). “[I]t is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f).” *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986). Failure to comply with a requirement for a disclaimer is a basis on which to refuse registration. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395, 1399-1400 (Fed. Cir. 2006); *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

“A generic term ‘is the common descriptive name of a class of goods or services.’” *Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (*quoting H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). “Because generic terms ‘are by definition incapable of indicating a particular source of the goods or services,’ they cannot be registered as trademarks.” *Id.*; *see also, In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111513, \*2 (TTAB 2019) (“[A] generic designation is incapable of functioning as a [trade] mark.”). Even if a portion of a mark is registrable under Section 2(f), but it includes an unregistrable component, such as a generic term, the mark may not register without a disclaimer of the unregistrable component. *See e.g., In re Am. Inst. of Certified Pub. Acts.*, 65 USPQ2d 1972, 1984 (TTAB 2002) (applicant seeking

registration of the mark “UNIFORM CPA EXAMINATION” under Section 2(f) required to disclaim generic terms “CPA EXAMINATION”).

Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *Marvin Ginn*, 228 USPQ at 530; *see also Princeton Vanguard*, 114 USPQ2d at 1830 (“[T]here is only one legal standard for genericness: the two-part test set forth in *Marvin Ginn*”). “[A]n inquiry into the public’s understanding of a mark requires consideration of the mark as a whole.” *Id.* at 1831 (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005)).

Any term that the relevant public uses or understands to refer to the genus of goods, or a key aspect or subcategory of the genus, is generic. *Royal Crown Co., Inc. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046-47 (Fed. Cir. 2018). “[A] term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1638 (Fed. Cir. 2016) (holding CHURRASCOS, a word that is generic for a type of grilled meat, to be generic for restaurant services because it referred to a key aspect of those services); *see also In re Nordic Nats., Inc.*, 755 F.3d 1340, 111 USPQ2d 1495 (Fed. Cir. 2014) (CHILDREN'S DHA generic for DHA supplements for children).

“Evidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)); *see also Cordua Rests.*, 118 USPQ2d at 1634; *Princeton Vanguard*, 114 USPQ2d at 1830.

A. What is the Genus of Goods?

Addressing the first part of the *Marvin Ginn* genericness inquiry, we find that and agree with the Examining Attorney that the genus of goods is appropriately defined by the identification of goods in the application: “Steel products, namely, steel sheets and coils.”<sup>19</sup> *Cordua Rest.*, 118 USPQ2d at 1636 (“[A] proper genericness inquiry focuses on the description of [goods] set forth in the [application or] certificate of registration.”) (quoting *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

B. Who are the Relevant Purchasers

Prior to considering the second part of the *Marvin Ginn* inquiry, we must first determine the “relevant public.” *Marvin Ginn*, 228 USPQ at 530. The Examining Attorney argues that “the relevant public comprises ordinary consumers who purchase applicant’s goods, because there are no restrictions or limitations to the channels of trade or classes of consumers.”<sup>20</sup> Applicant does not dispute this or even

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<sup>19</sup> Examining Attorney’s brief (6 TTABVUE 4).

<sup>20</sup> *Id.* (6 TTABVUE 4).



discuss the matter directly in its brief, instead referring to “consumers”<sup>21</sup> and the “general public.”<sup>22</sup>

The identification of Applicant’s goods does not contain any limitation as to trade channel or consumer class. Thus, we agree with the Examining Attorney that the goods are presumed to move in all channels of trade usual for such goods and to be available to all potential classes of ordinary consumers. *See e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000). Thus, we find that the relevant public consists of ordinary consumers of Applicant’s recited goods. *In re GJ & AM, LLC*, 2021 USPQ2d 617, \*6 (TTAB 2021).

#### C. How Does the Relevant Public Perceive the Term “STEEL”?

Now we must determine whether the term “STEEL” is understood by the relevant public primarily to refer to that genus of goods. “Evidence of the public’s understanding of term [STEEL] may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications.” *Merrill Lynch*, 4 USPQ2d at 1143; *see also USPTO v. Booking.com B.V.*, 2020 USPQ2d 10729, at \*7 n.6 (“Evidence informing [a genericness] inquiry can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term’s meaning.”). In some cases, dictionary definitions and an applicant’s own description of its goods may suffice to show genericness. *In re*

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<sup>21</sup> Applicant’s brief, pp. 5, 7, 9 (4 TTABVUE 10, 12, 14).

<sup>22</sup> *Id.* at 3 (4 TTABVUE 8).

*Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987); *see also In re Am. Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999).

In support of her position that the term STEEL is generic when considered in light of the identified goods, the Examining Attorney points to dictionary evidence from The Penguin® English Dictionary that shows that the term “STEEL” means “a bluish grey alloy of iron with carbon, notable for its strength and hardness, distinguished from cast iron by its malleability under certain conditions, and widely used in construction work;”<sup>23</sup> thus, the Examining Attorney concludes, the relevant public would understand the term “STEEL” to refer primarily to that genus of goods because the goods are made of steel.<sup>24</sup> Moreover, the Examining Attorney continues, the term “STEEL” appears in the identification of goods as the generic name for the goods, i.e., “**Steel** products, namely, **steel** sheets and coils” (emphasis added).<sup>25</sup> Applicant does not dispute this evidence or even address the matter at all in its brief.

We find that the evidence of record supports a finding that the term “STEEL” is generic for the identified goods. Consumers of Applicant’s identified goods will perceive the term STEEL in its ordinary dictionary sense. Additionally, Applicant’s identification of goods specifies “**Steel** products, namely, **steel** sheets and coils” (emphasis added). Inasmuch as the genus of these goods may be classified as “steel sheets” and “steel coils”, this further supports our finding that the term STEEL is

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<sup>23</sup> May 19, 2022 Office Action at TSDR 2.

<sup>24</sup> Examining Attorney’s brief (6 TTABVUE 4).

<sup>25</sup> *Id.* (6 TTABVUE 4-5).

generic for these goods. The expression “generic name for the goods or services” is not limited to noun forms but also includes “generic adjectives,” that is, adjectives which refer to a genus or species, category or class, of goods or services. *See, e.g., In re Reckitt & Colman, North Am. Inc.*, 18 USPQ2d 1389, 1390-91 (TTAB 1991).

Notwithstanding that Applicant acknowledges that the issue on appeal is whether “the word ‘Steel’ in the ‘U.S. Steel’ part of the Applied-for Mark [is] generic when used in commerce in connection with steel products,”<sup>26</sup> Applicant does not make any argument that the term STEEL is not generic, nor does it dispute the Examining Attorney’s dictionary or identification evidence in support thereof. Rather, Applicant argues that its mark is “famous and inherently distinctive.”<sup>27</sup> However, rather than arguing facts that support its position that the term STEEL is inherently distinctive, Applicant argues that

[d]isclaiming “Steel” in the “U. S. Steel” part of the mark would break up a famous and inherently distinctive trademark. To be considered well-known, highly reputable, or famous, a trademark must be recognizable to the general public, i.e., it must be a “household name.” Famous marks are afforded a broad scope of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark.

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Furthermore, Appellant asserts that the mark is not merely descriptive or primarily geographically descriptive, but rather is inherently distinctive. As a result of more than a century of continuous use, Appellant’s mark has acquired a secondary meaning indicative of

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<sup>26</sup> Applicant’s brief, p. 3 (4 TTABVUE 8).

<sup>27</sup> *Id.* at 3 (4 TTABVUE 8).

Appellant's steel manufacturing and related businesses, not just in the United States but around the world.<sup>28</sup>

Applicant's arguments are not persuasive. As an initial matter, Applicant's argument that the term STEEL is inherently distinctive is conclusory and does not specify where Applicant considers the term to fall on the distinctiveness spectrum (i.e., suggestive-arbitrary-fanciful). Second, Applicant appears to have conflated acquired distinctiveness with inherent distinctiveness; regardless, arguments that the involved mark is famous is irrelevant to the issue of where the term STEEL falls on the distinctiveness spectrum. Moreover, as indicated earlier, Applicant's claim of acquired distinctiveness has been accepted and entered into the record,<sup>29</sup> so it is not in dispute.

D. Is the "U.S. STEEL" Portion of the Mark Unitary?

Applicant argues that the "U.S. STEEL" portion of the mark is unitary and, as a result, "STEEL" is not separable for purposes of registration and need not be disclaimed.<sup>30</sup> Applicant makes three arguments in support of its position that the "U.S. STEEL" portion is unitary: (1) when consumers encounter the mark "U. S. Steel" used in connection with steel products, services and steel related activities, they are highly likely to perceive the term "U. S. Steel" as a unitary phrase pointing to a particular company; (2) the commercial impression engendered by the term "U. S. Steel" is the well-known steel company that has been around since the early 1900s;

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<sup>28</sup> *Id.* at 3-4 (4 TTABVUE 8-10).

<sup>29</sup> Examining Attorney's brief (6 TTABVUE 6).

<sup>30</sup> Applicant's brief, pp. 8-9 (4 TTABVUE 13-14).

and (3) the vast majority of consumers are aware of U. S. Steel Corporation and its legacy and would automatically think of the famous company when the term “U. S. Steel” is presented as part of a mark.<sup>31</sup>

However, there is evidence of record that supports a finding that the “U.S. STEEL” portion of the mark is not unitary. Specifically, the record includes printouts of two prior registrations for the mark U.S. STEEL (in standard characters) (Reg. Nos. 4714744 and 2469301) (the “Prior Registrations”), each owned by United States Steel Corporation, each registered for steel products, each claiming distinctiveness under Section 2(f), and, most importantly, each of which disclaiming the exclusive right to use the term “STEEL”.<sup>32</sup> Thus, by these Prior Registrations, United States Steel Corporation has acknowledged “U.S. STEEL” is not unitary, and, by disclaiming the term “STEEL,” it acknowledges that the term “STEEL” is an unregistrable component of the mark when used with the steel-based goods identified therein. Because the portion “U.S. STEEL” has previously been treated as being comprised of separable elements capable of being disclaimed, we find that the “U.S. STEEL” portion of the involved mark is not unitary. *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (the elements of the mark as a whole are “not so merged together that they cannot be regarded as separate.”).

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<sup>31</sup> *Id.* at 9 (4 TTABVue 14).

<sup>32</sup> December 7, 2022 Office Action at TSDR 5-8. Registration No. 4714744 identifies “steel products, namely, steel coils,” while Registration No. 2469301 identifies “Flat-rolled, flat-rolled coated, and tubular steel products, namely, steel coils, sheets, and pipes,” all in International Class 6.

The Examining Attorney conceded that the Companion Application matured to a registration without a disclaimer of the term STEEL in the U.S. STEEL portion of the mark,<sup>33</sup> and we acknowledge that the Examining Attorney indicates that this was a mistake.<sup>34</sup> While we recognize that “consistency is highly desirable,” *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007), consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules. *See Cordua Rests.*, 118 USPQ2d at 1635. The Board must assess each application on its own facts and record. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Having found that the term “STEEL” in the “U.S. STEEL” portion of the mark is generic for Applicant’s goods, i.e., “steel products, namely, steel sheets and coils,” and that the portion “U.S. STEEL” is not unitary, the term “STEEL” thus constitutes an unregistrable component of the mark. Consequently, its disclaimer is required despite Applicant’s acceptable claim of acquired distinctiveness as to “U.S. STEEL”. *See Creative Goldsmiths*, 229 USPQ at 768 (“[W]e conclude that it is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f).”); *Am. Inst. of Certified Pub. Accountants*, 65 USPQ2d at 1981-85 (Applicant

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<sup>33</sup> Applicant’s brief, p. 2 (4 TTABVUE 7).

<sup>34</sup> December 7, 2022 Office Action at TSDR 3.

required to disclaim CPA EXAMINATION because these terms were found to be generic; disclaimer required despite acceptable claim of acquired distinctiveness as to entire mark UNIFORM CPA EXAMINATION); *see also In re Am. Furniture Warehouse Co.*, 126 USPQ2d 1400, 1407 (TTAB 2018) (generic term, standing alone, cannot acquire distinctiveness, but may be included in a Section 2(f) claim if the generic term is disclaimed).

#### E. Conclusion

In sum, we find that the term “STEEL” in the “U.S. STEEL” portion of the mark is generic for Applicant’s goods i.e., “steel products, namely, steel sheets and coils,” and that the portion “U.S. STEEL” is not unitary; consequently, the term “STEEL” constitutes an unregistrable component of the mark. Therefore, a disclaimer of the term “STEEL” is required despite Applicant’s acceptable claim of acquired distinctiveness as to the portion “U.S. STEEL”.

### **Decision**

The refusal to register Applicant’s mark based on the requirement, made under Trademark Act § 6(a), for a disclaimer of “STEEL” in the “U.S. STEEL” portion of the mark, is affirmed. If Applicant submits a properly worded disclaimer to the Board within 30 days from the date of this decision and prior to filing any appeal of this decision, the disclaimer will be accepted and entered, the refusal to register will be

set aside, and the application can proceed to publication.<sup>35</sup> Trademark Rule 2.142(g),  
37 CFR § 2.142(g).

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<sup>35</sup> The standardized printing format for the required disclaimer is as follows: “No claim is made to the exclusive right to use STEEL and STEEL COMPANY apart from the mark as shown.” *See re Omaha Nat’l*, 2 USPQ2d at 1861.