04-1447
(Serial No. 75/934,927)

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

IN RE STEELBUILDING.COM

APPEAL FROM THE UNITED STATES
PATENT AND TRADEMARK OFFICE,
TRADEMARK TRIAL AND APPEAL BOARD

REPLY BRIEF FOR APPELLANT

Michael M. Zadrozny
SHLESINGER, ARKWRIGHT &
GARVEY, LLP
1420 King Street, Suite 600,
Alexandria, Virginia 22314
(703) 684-5600

December 22, 2004

TP 14

AMENDED CERTIFICATE OF INTEREST

Counsel for appellant, Steelbuilding.com, certifies the following:

1. The full name of the party represented by me is Steelbuilding.com, Inc.

2. Steelbuilding.com, Inc. is the real party in interest.

3. NCI Building Systems, Inc., a publicly-traded Delaware corporation with shares listed on the NYSE is the parent company of Steelbuilding.com, Inc.

4. Michael M. Zadrozny and Shlesinger, Arkwright & Garvey LLP have appeared for Steelbuilding.com, Inc. in the proceedings before the Trademark Trial and Appeal Board. James E. Shlesinger, also of Shlesinger, Arkwright & Garvey LLP, has also appeared for Steelbuilding.com, Inc. in the proceedings below. No other law firm is expected to appear for the Appellant in this court.

Date: DEC. 22, 2004

Michael M. Zadrozny
SHLESINGER, ARKWRIGHT &GARVEY LLP
1420 King Street, Suite 600,
Alexandria, Virginia 22314
(703) 684-5600

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STATEMENT OF RELATED CASES

(1) Other than the Trademark Trial and Appeal Board proceeding from which this appeal is taken, this case has not previously been before this court or any other court.

(2) There are no cases known to undersigned counsel that are pending in this or any other court that will directly affect or be directly affected by this Court's decision in this appeal.

INTRODUCTION

This brief is submitted in reply to appellee's brief as provided by Fed. Cir. R. 28.

ARGUMENT[1]

1. *Appellant's genus of services was presented to the examining attorney during prosecution of the application and to the Trademark Trial and Appeal Board on appeal.*

The Director is mistaken in asserting that appellant never objected to the examining attorney's definition of the genus of services, either during examination [DB at 3, DB at 9] or on appeal before the Board [DB at 4, DB at 12]. The Director is also mistaken in asserting that appellant has consistently agreed with the examining attorney's statement of the genus [DB at 18-21].

In the initial generic refusal, the examining attorney stated the genus of services to be "a retailer of steel buildings" [A168, A169]. Appellant did not accept this genus but instead stated the genus to be "shop-at-home services for pre-engineered metal buildings and roofing systems" [A222, A223]. In the final refusal, the examining attorney revised the

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[1] Citations to the Director's brief are referred to as [DB at___], citations to Appellant's brief are referred to as [Br. at ___], and citations to the Joint Appendix are referred to as [A___].

genus to "online retail services for steel buildings" [A288, A289]. Appellant did not adopt online retail services as the genus but restated shop-at-home services for pre-engineered metal buildings and roofing systems as the genus [A349, A350]. Thereafter, the examining attorney in her appeal brief ignored appellant's genus of services and proposed "retail store services featuring steel buildings" [A341, A343]. In appellant's reply brief, appellant stated the genus to be "interactive on-line services for designing and building metal structures with a computer including the purchase of the built structure" and referenced for the examiner and the Board the relevant record evidence supporting that genus [A351-353].

The relevant record evidence comprised the Hockersmith Declaration at ¶¶ 3,8 [A95-96], the specimen which includes the phrase "Design Price Buy Online" and shows a web browser logged on to appellant's interactive website and midway in the process of framing a building [A92-93], and various advertisements which show customers using their PC to custom design and build a structure online via the interactive website [A105] including an advertisement describing how the services may be used to custom design a mini storage unit online [A119], and two articles in the trade press describing in detail the computer-aided design and interactive nature of the services [A115-118].

The genus was also argued before the Board during Oral Hearing.

At the very least, an argument raised in a reply brief before a PTO appeal board will be considered by a reviewing court. See Haskell, Hench, and Yates v. Colebourne, Rolfe, McAloon, and Orton, 671 F.2d 1362, 1367 (CCPA 1982).

In the present case, the genus of services was a contested issue between appellant and the examining attorney from the outset and appellant's proper statement of the genus was before the Board prior to their decision.

2. The mark is suggestive of the computerized feature of the services.

The Director disagrees that the "STEELBUILDING" portion of appellant's mark, which is a joined term, may plausibly render the overall mark suggestive of appellant's interactive platform services i.e. a customer is provided with the capacity to "build" a structure online with their computer. The Director states that there is no evidence purchasers would perceive the mark in such a manner [DB at 38].

However, appellant has described in their brief evidence tending to show the relevant public would perceive the mark as suggestive of the services [Br. at 21]. The evidence presented is the following.

Each of the print advertisements depict the mark together with a computer (or a screen shot of an Internet browser) logged on to appellant's interactive website and midway in the process of *building a structure* online [A105,A109,A111]. One such advertisement encourages customers to build structures ("You can do it together.") [A105] whereas another emphasizes the variety of options available when building a structure online ("Design your own building or entire complex online", "Configure buildings up to 40' X 22'", "View color choices as you make them" and "Add doors to your building or buy them separately")[A109]. In yet another advertisement, a browser logged on to appellant's website is framing the endwalls of a structure and the customer is advised that "once you have finished placing framed openings, you can continue designing your building by choosing any of the options tabs at the top of the page" [A111]. All advertisements urge the purchaser to "Design Price Buy Online" [A112].

The Metal Construction News interview shows the relevant public (resellers and end-users) would understand the mark is suggestive of the computerized design aspect of the services [A58]. Scott House, owner of appellant company, is quoted as saying:

> "We're putting the customer in control. On our website, customers can design, price and buy custom buildings without ever talking to anyone. Everything happens online in real time."
>
> "When a customer is buying a building from Steelbuilding.com, he is designing a made-to-order product ... he cannot get anywhere else."

The article goes on to describe the interactive design platform that enables a customer to build a structure online:

> "The ... most remarkable feature is a powerful, online design and pricing system. Users specify the dimensions of a building, and the program returns a footprint diagram and base price. Users can then browse through dozens of priced options to add to the design. They can place framed openings and precisely locate them within bays. They can select from numerous brand-name door models, trim and base configurations, color choices, and insulations options."

Appellant's services do not provide a retail store or warehouse that is stocked with an inventory of barns, stables, mini-storage complexes, or other such buildings nor do the services provide ready-for-purchase structures. A customer may buy these structures if they first "build" it in cyberspace using the computer-aided design feature of the services and then price the built structure. The mark is suggestive of that feature of the services.

3. *The competitor's declarations refer to both appellant's mark and the associated services.*

In rebuttal to the various declarations from appellant's competitors submitted in connection with the claim of acquired distinctiveness, the Director states these declarations "repeatedly use the term 'steel building' in a generic manner" and "show that it is virtually impossible to discuss appellant's services without using the term 'steel building'" [DB at 40].

The Holder, Ginn and Jurney declarations [A151-152, A154-155, A156-157] and the Napolitan letter [A153] evidence a recognition by appellant's competitors of the mark in the industry. The fact these declarations refer to appellant's STEELBUILDING.COM mark in same sentence as "steel building" shows the Declarant does not consider the mark to be synonymous with "steel building" or a generic term for any steel building retailer. This reasoning is equally applicable with respect to the numerous customer emails [A52-57, A159-165].

The Director suggests the declarations are of little value since none are from competitors whose company names contain the term "steel building" [DB at 40]. The relevance of such evidence in connection with a claim of acquired distinctiveness is not understood. Whether or not the company name of Declarant contains the term "steel building" is unrelated to whether the

Declarant considers the mark distinctive of the services in the industry.

The Director states customer recognition of the mark evidenced within the emails is "attributed to domain name recognition" [DB at 41]. However, none of the emails refer to STEELBUILDING.COM as a domain name. In each letter, the customer refers to the services offered under the mark.

4. The mere fact a mark includes the name of a product offered under the associated services does not per se render the mark generic of those services.

The Director argues that even if appellant's genus includes the computerized design services which allow a customer to build the structure, "steel buildings remain a significant focus of its online retail services" and "a term that is the generic name of a particular product or category of goods is likewise generic for the services that are directed to of focused on that product or class of goods" [DB at 21, DB at 24-27].

Several of this court's decisions undermine the Director's position. In In re Dial-A-Mattress Operating Corp., 240 F.3d 1341 (Fed. Cir. 2001) this court held that even though "mattress" was the generic name of a product sold under the associated retail store services, "1-888-M-A-T-R-E-S-S" was not generic since the record evidence failed to show the public

referred to shop-by-phone mattress retailers as a "1-888-M-A-T-R-E-S-S". See also In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567 (Fed. Cir. 1987) ("CASH MANAGEMENT ACCOUNT" not a generic name for stock brokerage services because the various usages shown in the NEXIS search results failed to establish the financial community used the mark as a generic common descriptive term for the brokerage services); In re American Fertility Society, 188 F.3d 1341 (Fed. Cir. 1999) ("SOCIETY FOR REPRODUCTIVE MEDICINE" not a generic name for services that promote the interests of reproductive medicine profession notwithstanding evidence directed to definitions and generic uses of the constituent terms of the phrase comprising the mark).

Even if appellant's mark is viewed as a compound (rather than a phrase as in "1-888-M-A-T-R-E-S-S"), the evidence relied upon by the Board is still insufficient under In re Gould Paper Corp., 834 F.2d 1017 (Fed. Cir. 1987) for the reasons set forth in appellant's brief [Br. at 16-17]. Nevertheless, the Director argues appellant's mark is a generic compound word under Gould because the evidence shows the term "steel building" (two words) identifies buildings made of steel and ".com" identifies a commercial entity on the Internet [DB at 35]. However, the record fails to provide any meaning common usage would ascribe

when "steel building" (two words) is joined into "steelbuilding" (one word) as is found in appellant's mark nor when "steel building .com" (three words) is joined into "steelbuilding.com" (one word). Further, appellant's genus of the services includes using the Internet for online computer aided design of a structure. Thus, ".com" is at least descriptive of the Internet feature of the genus and cannot be generic of that feature. See In re Oppedahl & Larson LLP, 373 F.3d 1171, 1176 (Fed. Cir. 2004).

5. *TLD's are not inherently devoid of source indicating significance.*

The Director suggests the burden of proof has shifted to appellant to show the TLD portion of the mark is perceived by the relevant public as something more than just a commercial entity [DB at 34]. However, it is not appellant but the Director of the United States Patent and Trademark Office who bears the burden of proving a term is generic. In re American Fertility Society, 188 F.3d at 1345. The Director has not met this burden since there is no evidence showing purchasers would *not* consider the TLD of appellant's mark to refer to the Internet aspect of the services. On the other hand, the record does include evidence showing the relevant public does associate

the overall mark with the online computerized design features of the services [A52-58, A118, A159-165].

Lastly, the earlier noted Dial-A-Mattress decision is instructive on how a seemingly ordinary term devoid of source-indicating significance can affect the commercial impression of a mark within which it is incorporated. Even though the "1-888-M-A-T-R-E-S-S" mark included a toll free area code designation (888) that was conceded to have no source-indicating significance, it functioned to modify how consumers perceived the overall mark i.e. as a phrase rather than a compound word, and therefore dictionary definitions alone were insufficient to establish genericness. Id. at 1345-46.

CONCLUSION

Appellant resubmits, on the basis of its principal brief and this reply, that reversal of the Board's decision is in order.

Respectfully submitted,

Date: DECEMBER 22, 2004

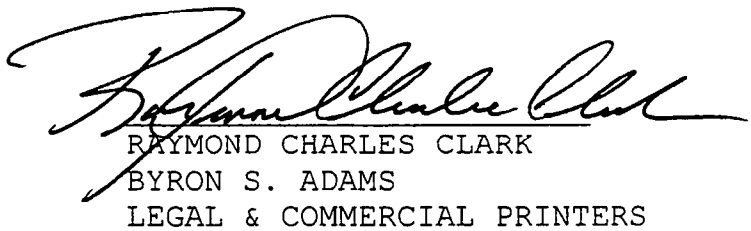
By: _____

Michael M. Zadrozny
Attorney for Appellant
SHLESINGER, ARKWRIGHT & GARVEY LLP
1420 King Street, Suite 600,
Alexandria, Virginia 22314
(703) 684-5600

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 22nd day of December, 2004, two (2) copies of the foregoing REPLY BRIEF OF APPELLANT were served by sending same via FIRST CLASS MAIL, postage prepaid, addressed to:

John Whealan
Office of the Solicitor
P.O. Box 15667
Arlington, Virginia 22215



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