UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/280389

APPLICANT: STEELBUILDING ACQUISITION, INC.

CORRESPONDENT ADDRESS:
MICHAEL M. ZADROZNY
SHLESINGER, ARKWRIGHT & GARVEY LLP
1420 KING ST STE 600
ALEXANDRIA, VA 22314-2750

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: STEELBUILDING.COM

CORRESPONDENT'S REFERENCE/DOCKET NO: R-4540

CORRESPONDENT EMAIL ADDRESS:

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..

Serial Number 76/280389

Applicant is requesting reconsideration of a final refusals dated April 18, 2002 and November 4, 2003. The final requirement for a disclaimer and regarding the sufficiency of the claim of acquired distinctiveness are maintained and continued. The application is returned to the Board for resumption of the appeal.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Claim of Acquired Distinctiveness Remains Insufficient

In the request for reconsideration submitted on November 15, 2005, is based upon five years use. Additional evidence is needed to support the claim of distinctiveness. Applicant's allegation of five years' use alone is insufficient evidence of distinctiveness in this case because applicant's mark is highly descriptive of the services. TMEP §1212.05(a). *In re Kalmbach Publishing Co.*, 14 USPQ2d 1490 (TTAB 1989). The Federal Circuit, in In Re Steelbuilding.com, 75 USPQ2d 1420, (Fed. Cir. 2005), affirmed in part the refusal of the mark "steelbuilding.com" on the basis of descriptiveness.

The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985). More evidence is needed where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods and/or services would be less likely to believe that it indicates source in any one party.

See, e.g., In re Bongrain International Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Associates, Inc.*, 1 USPQ2d 1657 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984).

Applicant must establish acquired distinctiveness by a preponderance of the evidence. *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). This evidence may include specific dollar sales under the mark, advertising figures, samples of advertising, consumer or dealer statements of recognition of the mark, and any other evidence that establishes the distinctiveness of the mark as an indicator of source. The Office will decide each case on its own merits.

Accordingly, applicant's request for reconsideration is *denied.* The time for appeal runs from the date the final action was mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c).

/Khanh M. Le/
U.S. Patent & Trademark Office
Law Office 113
(571) 272-9435