TTAB

R-4540

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Trademark Application of :
:
Steelbuilding.com, Inc. :
:
Serial No. 76/280,389 :
:
Filed: July 3, 2001 :
:
Mark: STEELBUILDING.COM & Design :

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TRADEMARK OFFICE

REQUEST TO REMAND

In view of the Trademark Trial and Appeal Board's analysis regarding appellant's mark in In re DNI Holdings Ltd., 77 USPQ2d 1435 (TTAB 2005), it is requested this appeal be suspended and the application be remanded to the trademark examining attorney for reconsideration of the disclaimer requirement.

Remand is additionally warranted because the trademark examining attorney has raised a new factual issue in the January 5, 2006 Office action to which appellant has the right to respond. See In re Mine Safety Appliances Co., 66 USPQ2d 1694 (TTAB 2002) at footnote 7. In particular, the trademark examining attorney has asserted that appellant's *prima facie* presumption of acquired distinctiveness based upon five years use is inadequate because the mark is "highly descriptive".

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Remand is also proper because additional evidence not available to applicant prior to filing of this appeal is now available. See TBMP §1207.02. The additional evidence is in the form of specific dollar sales under the mark, advertising figures, customer data and related evidence that further establishes the distinctiveness of the mark as an indicator of source. See the attached Response including Declaration of Todd R. Moore.

It is believed each of the above constitutes good cause for suspension of this appeal and remand to the trademark examining attorney for further examination.

In the event this request is denied, appellant alternatively requests a thirty day extension of time for filing of its appeal brief.

Respectfully submitted,

Date: MARCH 9, 2006 By:

Michael M. Zadrozny
Attorney for Appellant
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RESPONSE

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

Dear Sir:

In response to the Office action of January 5, 2006 applicant submits the following.

The trademark examining attorney now maintains that applicant's *prima facie* presumption of acquired distinctiveness based upon five years use is inadequate because applicant's mark is highly descriptive. The trademark examining attorney cites In re Steelbuilding.com, 75 USPQ2d 1420, (Fed. Cir. 2005) in support of her position.

First, the Court in In re Steelbuilding.com did not have the issue of acquired distinctiveness based upon five years use

before it. Accordingly, the trademark examining attorney's reliance on that decision to rebut applicant's *prima facie* establishment of acquired distinctiveness is misplaced.

More importantly, the Trademark Trial and Appeal Board in their recent In re DNI Holdings Ltd. decision, 77 USPQ2d 1435 (TTAB 2005), held the opposite of what the trademark examining attorney maintains is the Federal Circuit's finding in the In re Steelbuilding.com decision. The Board states the following in DNI Holdings Ltd. regarding the Court's analysis of the STEELBUILDING.COM trademark:

> The Court in *Steelbuilding.com* also found that joinder of the separate words 'steel' and 'building' with the TDL '.com' created a 'formulation' that, in context, could be perceived by the relevant public as meaning either 'steel buildings' available via the Internet for 'the building of steel structures' via an Internet website. While not using the term 'double entradre,' the Court's reasoning in *Steelbuilding.com* suggests a non-descriptive connotation. Specifically, given the interactive design features of that applicant's goods and services, the Court concluded that STEELBUILDING could also refer to 'the building of steel structures.'

Id. At 1430 [emphasis added].

In view of the above the trademark examining attorney is at odds with the Trademark Trial and Appeal Board in reaching her conclusion that applicant's mark is merely descriptive.

Attached is a declaration of Todd R. Moore, Vice President, General Counsel and Corporate Secretary of Steelbuilding.com Inc. Annual sales for the services provided under the STEELBUILDING.COM mark during 2002 amounted to $11,930,938.00, the annual sales during 2003 amounted to $12,379,618.00, the annual sales during 2004 amounted to $22,535,464.00 and the annual sales during 2005 amounted to $21,472,368.00.

In addition, promotion and marketing of the STEELBUILDING.COM mark nationally through print media and other advertisements and trade shows for the year 2002 amounted to $673,296.00, for the year 2003 amounted to $560,423, for the year 2004 amounted to $966,805.00 and for the year 2005 amounted to $981,040.00.

Visitor traffic to applicant's STEELBUILDING.COM website during 2005 ranged between about 50,000 visitors per month to over 100,000 visitors per month. The daily averages of website visitors during 2005 ranged between 1,600 visitors per day to over 3,000 visitors per day.

Exhibit A of the declaration shows that visitor traffic to applicant's website is greater than that of any of their competitors. In particular, Internet traffic ranking compiled by Alexa.com as of March 3, 2006 shows that applicant's website

is currently ranked first in visitor traffic among the various manufacturers.

In view of the above applicant's mark is entitled to registration under the Principal Register without disclaimer of the STEELBUILDING.COM portion of the mark.

Respectfully submitted,

STEELBUILDING.COM

Date: MARCH 9, 2006

By: _____

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

mr

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Applications of	:
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Steelbuilding.com, Inc.	:
	:
Serial No. 76/280,389	:
	:
Serial No. 78/680,792	:
	:
Serial No. 76/280,390	:

DECLARATION OF TODD R. MOORE

I, Todd R. Moore, hereby declare that:

1. I am Vice President, General Counsel and Corporate Secretary of Steelbuilding.com, Inc., applicant for each of the above identified trademark applications, and I am authorized to make this declaration.

2. In further support of our claim of distinctiveness of the STEELBUILDING.COM trademark, I submit the following annual sales figures for applicant corporation.

3. Annual sales for our services under the trademark STEELBUILDING.COM during 2002 amounted to $11,930,938.00. The annual sales during 2003 amounted to $12,379,618.00. The annual sales during 2004 amounted to $22,535,464.00. The annual sales during 2005 amounted to $21,472,368.00.

4. In addition, we have actively promoted and marketed our services under the STEELBUILDING.COM trademark nationally through various print media, internet advertisements and trade shows. Money spent for advertisement promotion during 2002 amounted to $673,296.00. The advertisement promotion for 2003 amounted to $560,423.00. The advertisement promotion for 2004 amounted to $966,805.00. The advertisement promotion for 2005 amounted to $981,040.00.

5. During 2005, website traffic to our STEELBUILDING.COM website ranged between 49,789 visitors per month to 102,806 visitors per month. The daily average of website visitors to our site during 2005 ranged from 1,606 visitors per day to 3,316 visitors per day.

6. Visitor traffic to our STEELBUILDING.COM website is greater than that of any of our competitors and among our competitors we are currently ranked first in visitor traffic. See the attached Exhibit A which provides internet traffic rankings compiled by Alexa.com for our website and the websites of our competitors as of March 3, 2006. Yahoo.com is included for comparison purposes.

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All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true and these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom

Date: March 9, 2006

By: _____
Todd R. Moore

EXHIBIT A

ALEXA Ranking	Website Name
1	Yahoo
120,570	**Steelbuilding.com**
140,022	olympiabuildings.com
222,700	steelmastersusa.com
237,143	americansteelspan.com
259,264	heritagebuildings.com
292,512	alliedbuildings.com
311,692	premiersteel.org
316,611	usmetalbuildings.com
345,738	rhinobldg.com
374,482	Gensteel.com
393,093	butlermfg.com
563,114	pioneersteel.com
463,153	mortonbldgs.com
578,307	us-buildings-direct.com
588,931	Nucorbuildingsystems.com
589,180	metalbuildingdepot.com
1,000,212	rigidbuilding.com
1,003,803	americansbuilding.com
1,136,012	nclip.com
1,905,655	sheltersdirect.com
2,060,594	atsteelbuildings.com
2,159,629	nwsteel.com
2,533,647	qsbinc.com
3,431,434	arcosteel.com
4,901,718	metaldepots.com
5,504,343	best-steel-building.com

As of March 3, 2006