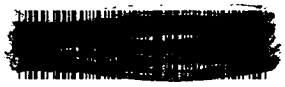
UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/280389

APPLICANT: STEELBUILDING ACQUISITION, INC.



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ALEXANDRIA, VA 22314-2750

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MARK: STEELBUILDING.COM

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2. Date of this Office Action.
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Serial Number 76/280389

REQUEST FOR RECONSIDERATION

Applicant is requesting reconsideration of the final refusals dated April 18, 2002 and November 4, 2003. The final requirement for a disclaimer and regarding the insufficiency 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 actions 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

The request for reconsideration submitted on March 9, 2006 includes additional evidence of acquired distinctiveness under Section 2(f) of the Trademark Act. The trademark examining attorney has considered applicant's arguments carefully and found them unpersuasive for the reason(s) below.

It is well established that the burden of demonstrating acquired distinctiveness rests with applicant. *In re Loew's Theatre's, Inc.* 769 F.2d 764. 769, 226 USPQ 865, 869 (Fed. Cir. 1985). The kind and amount of evidence necessary to establish that the mark has acquired distinctiveness in relation to the goods or services necessarily depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *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 536, 126 USPQ 381 (C.C.P.A. 1960); *In re Capital Formation Counselors*, 219 USPQ 916 (TTAB 1983).

The question to be resolved in not whether the mark is capable of becoming distinctive (which is the statutory standard to registration on the Supplemental Register), but whether the acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public. *In re Redken Laboratories, Inc.* 170 USPQ 526 (TTAB 1971); *In re Fleet-Wing Corp.*, 122 USPQ 335 (TTAB 1959).

In this instance, the applicant has failed to meet its burden. First, the applicant has only been using the mark since the year 2000, a relatively short period of time given the nature of the mark.

Second, the applicant has provided a relatively small number of declarations. The value of the affidavits or declarations depends on the statements made therein and the identity of the affiant or declarant. Proof of distinctiveness requires more than proof of the existence of a relatively small number of people who associate the mark with the applicant. *In re Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988)("Because these affidavits were sought and collected by applicant from ten customers who have dealt with applicant for many years, the evidence is not altogether persuasive on the issue of how the average customer of paints perceives the words "PAINT PRODUCTS CO." in conjunction with paints and coatings.") See also *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987) (affidavit of applicant's counsel expressing his belief that the mark has acquired secondary meaning accorded "no probative value whatsoever" because, among other reasons, the statement is subject to bias); *In re Petersen Mfg. Co.* 2 USPQ2d 2032 (TTAB 1987)(declarations from customers which stated that designs used by applicant indicate to the declarant that the applicant is the source of the goods, but which did not refer to or identify the designs with any specificity, not considered persuasive); *In re Bose Corp.*, 216 USPQ 1001, 1005 (TTAB 1983), *aff'd* 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985)(retailer's statement that he has been in contact with many purchasers of loudspeaker systems of whom a substantial number would recognize depicted design as originating with applicant deemed competent evidence of secondary meaning); *In re Flex-O-Glass, Inc.* 194 USPQ 203, 206 (TTAB 1977)("[T]he fact that the affidavits may be similar in format and expression is of no particular significance ... since the affiants have sworn to the statements contained therein.").

Finally, the applicant's advertising and sales expenditures are insufficient. The applicant specifies the annual dollar amounts for the sale of its goods, but has not specified the amount that is paid for each building. Thus, the significance of the annual sales amounts is difficult to analyze. *See In re Redken Laboratories, Inc.* 170 USPQ 526, 529 (TTAB 1971)(evidence adduced by applicant pursuant to §2(f) held insufficient to establish acquired distinctiveness of THE SCIENTIFIC APPROACH for lectures concerning hair and skin treatment, notwithstanding ten years of use, over $500,000 in promotion and sponsorship expenses and the staging of over 300 shows a year). *See also In re E.I. Kane Inc.*, 221 USPQ 1203, 1206 (TTAB 1984)(refusal to register OFFICE MOVERS INC., for moving services affirmed notwithstanding §2(f) claim based on, *inter alia*, evidence of substantial advertising expenditures. "There is no evidence that any of the advertising activity was directed to creating secondary meaning in the applicant's highly descriptive trade name."). It is well established that the burden of demonstrating acquired distinctiveness rests with applicant. *In re Loew's Theatre's, Inc.* 769 F.2d 764. 769, 226 USPQ 865, 869 (Fed. Cir. 1985). The kind and amount of evidence necessary to establish that the mark has acquired distinctiveness in relation to the goods or services necessarily depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *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 536, 126 USPQ 381 (C.C.P.A. 1960); *In re Capital Formation Counselors,* 219 USPQ 916 (TTAB 1983).

In the request for reconsideration, the applicant through its attorney argues that the Trademark Trial and Appeal Board's decision in *In re DNI Holdings Ltd.*, 77 USPQ 2d 1435 (TTAB 2005) is

dispositive in the present case. The issue in the present case is whether a disclaimer of "steelbuilding.com" is required because the words are merely descriptive and the evidence supporting a claim of acquired distinctiveness is insufficient. In contrast, the issue before the Board in *In re DNI Holding Ltd.* was whether the words "sportsbetting.com" was generic. The applicant has mischaracterized the Trademark Trial and Appeal Board's dicta in *In re DNI Holding Ltd., supra.* The excerpted portion of the Board's decision in the applicant's request for reconsideration refers to the Federal Circuit's holding in *In re Steelbuilding.com,* 75 USPQ2d 1420, (Fed. Cir. 2005), which held in part that the terms "steelbuilding.com" were not generic. The holdings of the Board's decision in *In re DNI Holding Ltd., supra,* and the Federal Circuit's decision in *In re Steelbuilding.com, supra,* were on the issue of genericness not mere descriptiveness. Thus, the requirement that the applicant disclaim the words "steelbuilding.com" on the basis that is merely descriptive of the services is entirely consistent with the holdings in *In re DNI Holding, Ltd.* and *In Re Steelbuilding.com, supra.*

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/
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Public Works
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Welding shops

Automotive
Garages
Body and Repair Shops
Dealerships

Trucking Industry
Garages and Storage Facilities
Repair and Service

Aircraft
Hangars and Storage

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Gymnasiums
Indoor Pools
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Recording studio
Bowling alley
Ice Skating rinks
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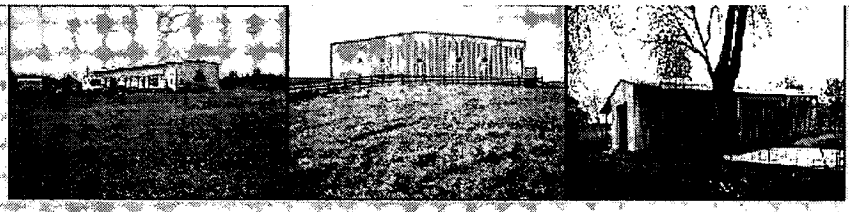

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- Apartment building
- Boat building
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- Building codes
- Building construction
- Building contractor
- Building department
- Building for sale
- Building inspection
- Building insurance
- Building kits
- Building maintenance
- Building material
- Building movers
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- Building product

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- building california northern office prefabricated
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- **building custom designed prefabricated**
- building including metal prefabricated steel
- building metal prefabricated steel
- building pre cut prefabricated whol

Building society
Building stairs
Building supply
Commercial building
Deck building
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Garage building
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Built to Ship

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prefabricated metal building
prefabricated metal storage building
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Properties Magazine - August 2000 Article

... building than KS Associates President Lynn Miggins and Vice President Mark Skellenger, who are proud to have their own, custom-designed ... is made of prefabricated wood. " Theres all ...

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- building material chicago
- building material company in dubai
- building material cost
- building material dallas
- building material denver
- building material distributor
- building material houston
- building material indianapolis

- Building society
- Building stairs
- Building supply
- Commercial building
- Deck building
- Florida building
- Garage building
- Green building
- Home building
- Metal building
- Model building
- Modular building
- Morton building
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- Ontario building
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- Portable building
- Prefabricated building
- Residential building
- Steel building
- Storage building
- Team building

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http://www.webtaxi.com/building-material.htm

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... Material Services - Warehouse Building 4095. Instructions: Click on the appropriate area located below ... Gilbertson, (445-0797) Description: Surplus Material. Total Square Footage: 120 ...
http://www.rci.rutgers.edu/~material/test/warehouse4095.html

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building material supply wholesale
building material tampa
deck building material
discount building material
green building material
hardware building material
hazardous material storage building
home building material
lowes building material
metal building material
recycled building

property disposal operation ... Home furnishings (couches, bicycles)
Building materials (bricks, electrical equipment ... SWAP collects over 900 tons of surplus material each year. Over 98% of those materials are ...
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My name is Craig Romero, and my research and engineering company has developed the nations most authoratative steel building web site which features resources for prefab buildings.

Whether you're looking for a metal building supplier for a pole barn or for your work shop. Engineering and plans are also availble.

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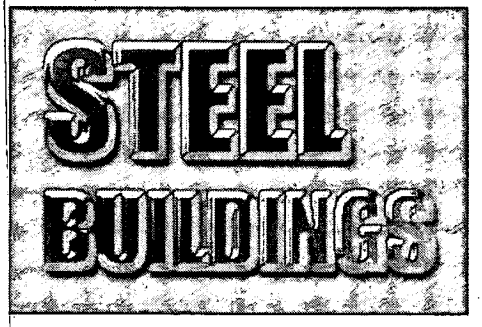

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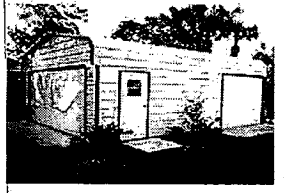

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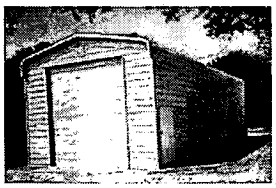

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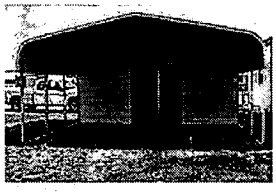

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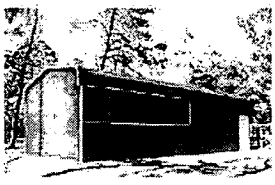

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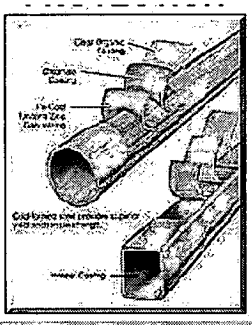

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SAMSULA FARMS Serving Florida's business and residential communities since 1994 steelbuildings@steelbuildingNet Samsula Farms began as a produce business in 1992.

We developed a large produce clientele; especially $25 a pound bananas and became known as the "Banana King" In 1993 we introduced the first line of outdoor buildings Today we specialize in steel buildings for residential, business, and commercial.

We build throughout the state of Florida and have many repeat customers We have always given excellent service to our customers, including problem satisfaction We have been at the same location for 11 years at 490 N Washington Ave Titusville, Fl.

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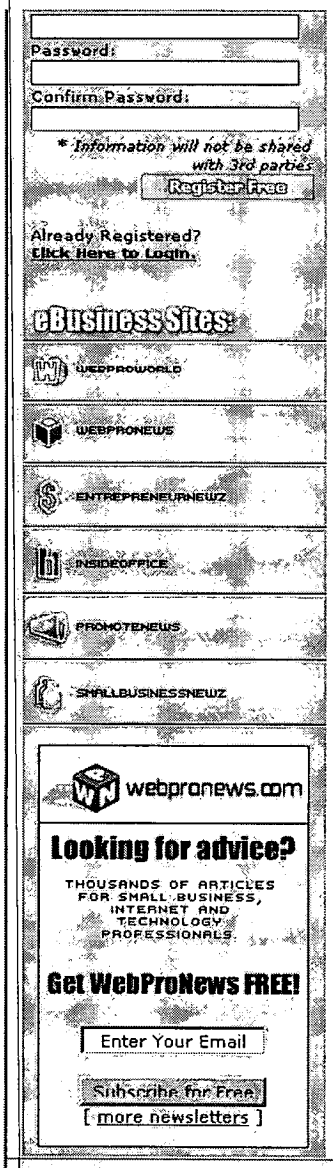

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