Examining Attorney: LE, KHANH
Serial Number: [redacted]

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

CONSOLIDATION:

In re STEELBUILDING.COM INC.
Serial No. [redacted]
Filed: 07/03/2001
&
In re STEELBUILDING.COM INC.
Serial No. **76280390**
Filed: 07/03/2001

APPLICANT'S REPLY BRIEF

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I. INTRODUCTION

This brief is responsive to the examining attorney's brief mailed November 22, 2006 and as provided under 37 CFR 2.142(b)(1).

II. ARGUMENT

A. *Evidence of acquired distinctiveness is cumulative and must be considered as a whole.*

The examining attorney argues any evidence of acquired distinctiveness submitted on or before November 1, 2002 is *per se* insufficient because the Board has previously considered that evidence. See Examiner's Brief at pages 5 and 6.

Acquired distinctiveness is established from a consideration of the 'totality of evidence' on record. See In re Owens-Corning Fiberglas Corp., 227 USPQ 417, 425 (Fed. Cir. 1985). The advertising expenditures, sale revenue and website visits during the first sixteen months of operation, representative advertisements in trade journals and other examples showing how the mark is used, unsolicited publicity in the trade press, customer emails referring to the mark, competitor affidavits concerning how the mark is perceived within the industry and comparative sales information (Key Declaration) are all relevant in determining how consumers *currently* perceive the mark.

For example, the rapid rise in sales growth, increase in website ranking among manufacturers, yearly increase in

advertising expenditures and increase in visitor traffic (See Moore Declarations including Exhibit A) from 2002 through early 2006 are apparent when compared to that during the first sixteen months of operation. The earlier evidence and later evidence are by their very nature cumulative and must be considered in context. There is no *res judicata* with respect to applicant's early evidence of acquired distinctiveness and the examining attorney provides no case law that would support her position.

In the alternative, the examining attorney states the In re Steelbuilding.com decision, 75 USPQ2d 1420 (Fed. Cir. 2005), has previously held applicant's early evidence of acquired distinctiveness is insufficient. However, the Court's decision in that case was not unanimous on the issue of acquired distinctiveness. In a lengthy dissent, Judge Linn held the Board had committed legal error in according too little weight to some evidence (customer letters, declarations for competitors, advertisements via banner ads and other Internet channels) and had acting arbitrarily in failing to consider other evidence (marked rise in sales during the first year and a half). Id. at 1425-1426. The examining attorney now urges the Board to dismiss the very evidence Judge Linn considered to be highly relevant.

B. *Applicant's advertisements evidence trademark use and identify a single source for the services.*

Applicant's sales, which are in excess of Seventy Three Million Dollars ($73,318,388), are stated to not show consumer

recognition of the mark but merely be the result of advertising expenditures. See Examiner's Brief at page 8, last ¶ and page 9, first ¶.

In support of the above, the examining attorney refers to a directory from the January 2001 issue of *Metal Construction News* (Hockersmith Declarations at Exhibit 3a) which is asserted to show the "average consumer of a steel building would be likely to conclude from viewing applicant's advertisement containing several descriptive and informational uses of the terms 'steelbuilding.com', that one may either find information on the Internet about steel buildings or be able to buy a steel building via the Internet, *rather than a single source for the services*" [emphasis added]. See Examiner's Brief at page 9, last ¶.

The *Metal Construction News* directory shows applicant's mark along with the marks of other manufacturers and each includes a description of the services and contact information. None of applicant's competitors uses 'steelbuilding.com' within their mark, or in their description of services or in their contact information. It is not understood how a directory showing trademark use by applicant and no descriptive use by competitors is proof that applicant's seventy three million in sales are simply the result of advertising expenditures and do not reflect consumer recognition of the mark.

The remaining advertisements of record show consistent trademark use of STEELBUILDING.COM by applicant and in

a manner that would project to the public a single source or origin of services and without misuse of the term descriptively. See applicant's specimen at filing, the Hockersmith Declarations filed November 13, 2001 and the Supplemental Hockersmith Declarations filed October 17, 2002.

C. *Applicant's target audience is relatively small and the services are necessarily purchased in a careful manner.*

The examining attorney cites the following TTAB decisions as providing support that applicant's sales revenue and advertising expenditures are insufficient to establish acquired distinctiveness. See In re Busch Entertainment Corp., 60 USPQ2d 1130 (TTAB 2000); In re Leatherman Tool Group Inc., 32 USPQ2d 1443 (TTAB 1994); and In re Behre Industries Inc., 203 USPQ 1030 (TTAB 1979). See also Examiner's Brief at page 9. However, the facts at issue in these decisions have little to no relevance to applicant's services and consumer class.

A purchaser of applicant's services is typically a rancher, farmer, small business owner or dealer who intends to resell the building to another purchaser. See Applicant's Brief at page 13. Barns, stables and warehouses are obviously not casual purchases or impulse buys. A consumer may only obtain a building from applicant by logging onto the website and designing it online using the offered computerized services, pricing the self-designed structure, purchasing it, and then waiting several weeks until the building arrives at their property where it is

eventually assembled. A certain degree of care and deliberation is therefore exercised when purchasing applicant's services. It is self-evident this target audience is a relatively sophisticated purchaser, if not a professional buyer, and comprises a far smaller group than consumers generally. Applicant's purchasers are discriminating buyers who are readily able to distinguish among the various services providers. See In re Mine Safety Appliances Co., 66 USPQ2d 1694 (TTAB 2002) [WORKMASK for a breathing apparatus held to have acquired distinctiveness because applicant's advertising and promotional materials showed clear and consistent trademark use for over six years and the ten million dollars in sales revenue for the narrow buyer class was substantial].

Applicant's sales revenue derived from their target class and the yearly advertising expenditures go a long way toward establishing, at the very least, a *prima facie* showing of distinctiveness. This is particularly true when one takes into consideration the unit price of an average building ($7,500 during 2001), applicant's ranking among other online suppliers (#1 as of 3/3/06) and the sheer number of visitors to applicant's website (about 50,000 to 103,000/month and 1,600 to 3,300/day). See Moore Declaration at ¶¶ 5, 6 and Exhibit A and Hockersmith Declaration at ¶ 24. When the above sales are compared to that of a long established supplier in applicant's industry, the significance of applicant's sales revenue are even more apparent. See Jennifer Key Declaration.

In response to the above evidence, the examining attorney states applicant's mark is descriptive. See Examiner's Brief at pages 10 and 11.

D. *A competitors need to use applicant's mark has no relevance to acquired distinctiveness.*

In discounting applicant's recent evidence of acquired distinctiveness based on six years use in commerce, the annual sales revenue, the annual advertising expenditures, customers hits to the website and applicant's ranking among other manufacturers, the examining attorney asserts a third party website (unitedsteelbuilding.com) shows "applicant's competitors have a need to use the words 'steelbuilding.com' in order to market their services via the Internet". See Examiner's Brief at page 8, second ¶.

Neither the cited website address nor a competitor's need to use applicant's mark have any relevance regarding whether or not the evidence shows *prima facie* distinctiveness of the mark. If the examiner is arguing applicant's mark is *de facto* generic, the Federal Circuit has roundly rejected that argument. See In re Steelbuilding.com at 1423. Applicant has previously discussed the lack of any reasonable amount of rebuttal evidence showing applicant's mark is routinely being used by others. See Applicant's Brief at pages 11 and 12.

In this connection, further attention is directed to the Website Directory of Industry Suppliers of record. See

Hockersmith Declaration at Exhibit 3b. Contrary to the examining attorney's assertions, applicant's competitors have *not* found it necessary to incorporate any features of applicant's mark within their website address or to otherwise use it in a descriptive manner. The assertion that applicant's competitors require applicant's mark to conduct business on the Internet is not supported by the evidence.

Respectfully submitted,

Date: *December 12, 2006*

By: _____

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