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THE TTAB

Oral Hearing: November 20, 2008

Mailed: February 27, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re United Steel, Paper and Forestry, Rubber, Manufacturing,  
Energy, Allied Industrial and Service Workers International Union  
AFL-CIO.CLC

Serial No. 78815310

J. Matthew Pritchard of The Webb Law Firm, P.C. for applicant.

Andrea Koyner Nadelman, Trademark Examining Attorney, Law Office  
110 (Chris A. F. Pedersen, Managing Attorney).

Before Bucher, Holtzman and Ritchie, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by United Steel, Paper and  
Forestry, Rubber, Manufacturing, Energy, Allied Industrial and  
Service Workers International Union AFL-CIO.CLC (applicant)  
to register the collective membership mark STEELWORKERS in  
standard character form for "indicating membership of a[n] (sic)  
labor organization" in Class 200.

The application was filed on February 15, 2006 based on an allegation of a bona fide intent to use the mark in commerce.

The trademark examining attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of the membership of applicant's organization and that applicant's evidence of acquired distinctiveness is insufficient.<sup>1</sup>

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.<sup>2</sup> An oral hearing was held.<sup>3</sup>

As a preliminary matter, we address the procedural points raised by applicant in its brief and its concerns regarding the issues on appeal.

Following the examining attorney's initial refusal to register the mark under Section 2(e)(1), applicant filed an amendment to allege use on February 7, 2007, accepted by the

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<sup>1</sup> We note the arguments made by applicant and the examining attorney regarding the "services" provided by applicant's organization. However, the application in this case is for a collective membership mark, the sole function of which is to indicate membership in an organization, and our determination of descriptiveness must be based solely on that function. See *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1701 (TTAB 2001).

<sup>2</sup> The attachments submitted for the first time with applicant's reply brief are untimely and will not be considered. See Trademark Rule 2.142(d). Nor will we consider applicant's unsupported arguments in its reply brief which are based on or relate to this untimely evidence.

<sup>3</sup> The application was reassigned to the examining attorney whose name is shown in the caption to prepare the appeal brief and to argue the case at the oral hearing.

examining attorney, wherein applicant asserted dates of first use and first use in commerce on December 31, 1950. Then on September 4, 2007, applicant responded to the refusal by amending the application to seek registration of the mark under Section 2(f) of the Act without any argument that the mark is inherently distinctive. Applicant based its Section 2(f) claim on a declaration of five-years' substantially exclusive and continuous use of the mark in commerce.

The examining attorney rejected applicant's 2(f) evidence and continued the refusal under Section 2(e)(1) contending that the mark is "highly descriptive," and that applicant's claim of five years use was "insufficient to show acquired distinctiveness." She further noted that the mark is "so highly descriptive" that "it is likely that no amount of evidence" would be sufficient to show acquired distinctiveness.

Applicant responded to the refusal with additional evidence and argument that the mark has acquired distinctiveness.

On September 27, 2007, the examining attorney issued a final refusal on the basis of the highly descriptive nature of the mark and the insufficiency of the evidence to show acquired distinctiveness. She further stated that the mark "appears to be generic" and that "no amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark."

On March 26, 2008, applicant filed a request for reconsideration together with a timely notice of appeal. In its request for reconsideration, applicant specifically noted that the examining attorney: "has maintained the refusal to register" the mark as descriptive; "has indicated that the evidence submitted to demonstrate acquired distinctiveness is insufficient"; and "has indicated that the mark 'appears to be generic.'"

In denying the request for reconsideration, the examining attorney argued that the mark "is highly descriptive or generic for a collective membership mark." In particular, she stated that "the term STEELWORKERS describes the services offered by the members of the applicant's organization" and summarily concluded that "therefore the term is also generic."

Applicant argues that "it is unclear" whether the final Office action "comports with the procedures identified in TMEP Section 1209.02." (Brief, pp. 5-6.) Applicant maintains that it "was and is at a procedural disadvantage...due to the Examining Attorney's repeatedly dissuading Applicant from presenting any additional evidence of acquired distinctiveness during prosecution of the...application, arguing that the mark was generic and that no amount of evidence would suffice." (Reply Brief, p. 8.)

This is clearly not so. It can be seen in both the second and final Office actions that the refusal to register was based on the highly descriptive nature of the mark and the insufficiency of applicant's 2(f) evidence. It can also be seen in both actions that the examining attorney's statements regarding genericness were provided in an advisory context, which is proper examination practice under TMEP §1209.02 ("When issuing any refusal under §2(e)(1), if the designation appears to be a generic name for the goods or services, the examining attorney should provide an advisory statement that the subject matter appears to be a generic name for the goods or services, in conjunction with the refusal on the ground that the matter is merely descriptive.")

Furthermore, it is clear from applicant's statement of the issues in its request for reconsideration that applicant understood the examining attorney's position and that her refusal was not based on genericness. In any event, applicant was at all times free to rebut the examining attorney's refusal based on the insufficiency of the 2(f) evidence with additional arguments and evidence of acquired distinctiveness, regardless of the examining attorney's statements regarding genericness.

To the extent that the examining attorney asserted a refusal on the basis of genericness for the first time in her denial of applicant's request for reconsideration, and she appears to have

done so, albeit without any appropriate analysis, the refusal will not be considered.<sup>4</sup> Thus, the only issues on appeal, as stated in the examining attorney's brief, are whether the mark is merely descriptive, and whether applicant's evidence of acquired distinctiveness is sufficient.

Applicant also argues that the examining attorney "has created an alternative rubric of a 'highly descriptive' refusal" for denying registration of the mark. (Brief, p. 5.) This argument "disregards the existence of varying degrees of descriptiveness." See *In re The Clorox Company*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978). Because applicant is seeking registration under Section 2(f), we must analyze the degree of descriptiveness in order to determine whether the 2(f) evidence is sufficient. The more highly descriptive the term, the less likely it is to indicate source in any one party. See *In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990). Thus, "the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning." *Yamaha Intl. Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988).

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<sup>4</sup> The examining attorney also maintained the refusal on the basis of the "highly descriptive" nature of the mark. However, the record was closed at that point and any additional evidence of acquired distinctiveness would not have been timely.

We turn now to the question of descriptiveness. The term STEELWORKERS is used as a collective membership mark to indicate membership in a labor organization. In the context of a collective membership mark, a term is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, "if it immediately describes...a significant aspect of an organization or association." *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1837 (TTAB 1994). Furthermore, the term "need not describe all attributes of the organization or association; rather, it is sufficient for purposes of mere descriptiveness that the term immediately convey a meaningful idea or information about the group, such as its composition or membership." *Id.*

The examining attorney argues that STEELWORKERS identifies a significant attribute of applicant's organization, namely that the membership is comprised, in part, of steelworkers. To support this contention, the examining attorney has submitted an entry from *Encarta World English Dictionary* (North American Edition 2007), (from [encarta.msn.com](http://encarta.msn.com)) defining "steelworker" as "maker of steel: somebody whose job is making steel in a steelworks."

The examining attorney has also submitted printouts from various third-party websites referring to "steelworker groups" or steelworker organizations:

yale.edu under the heading Yale Bulletin & Calendar Visiting Campus, announces a labor law lecture given by Thomas Geoghegan who "has represented steelworker groups in plant closings and Teamster members seeking union democracy."

wecansolveit.org, under the heading "We can solve the climate crisis," provides a post from "Lauren Mack's Blog" who states, "welcome to the Green Steelworker Group!"

steelworkersofthesault.com, under the heading "S.W.O.T.S. News System Your Source for Union & Steel Industry News in Sault Ste. Marie," provides a "General Membership Meeting Summary Report" for April 19, 2006 and displays the organization's "STEELWORKERS METALLOS" logo.

In addition, the examining attorney submitted a printout of a Congressional bill (H. R. 808, 107<sup>th</sup> Congress, 1<sup>st</sup> Session, March 1, 2001) entitled "Steel Revitalization Act of 2001." This legislation was enacted "To provide certain safeguards with respect to the domestic steel industry" and it includes provisions for "steelworker" group health plans.

Applicant "does not deny" that steelworkers are members of the labor organization, but argues that its mark is not used to indicate membership in a "steelworkers" organization. (Brief, p. 13.) Applicant argues that STEELWORKERS does not describe "a typical member" of the organization. Applicant states that the organization consists of over 800,000 members "the vast majority of which are not involved in the allied metals industries." According to applicant, its members are "more typically involved in jobs in the chemicals, oil, paper, rubber, transportation,



utilities and private-sector services industries." Req. for Recon, March 26, 2008.

There is no question that the mark STEELWORKERS describes a significant aspect of the membership of applicant's labor organization, namely that the membership includes "steelworkers." Indeed, applicant concedes that the mark is merely descriptive. Response, September 4, 2007;<sup>5</sup> Brief, p. 5.

Further, we find that the mark is highly descriptive of that aspect of the organization. The term "steelworkers" is clear in its meaning. Based on the definition, and other evidence of record, "steelworkers" is a generic term used to identify workers in the steel making industry. Thus, "steelworkers" directly names a class of members of applicant's labor union. Moreover, the term names, not just an incidental or insignificant membership, which might render the term less descriptive, but a principal class of members of the organization. Steelworkers are one of seven groups, or primary groups, of members of the organization as identified by applicant, and also as identified in the name of applicant's organization.<sup>6</sup>

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<sup>5</sup> Unless the question of inherent distinctiveness is clearly reserved, which in this case it was not, a claim of acquired distinctiveness under Section 2(f) is tantamount to a concession that the mark is not inherently distinctive. See *Yamaha International Corp.*, supra at 1005; and *General Foods Corporation v. MGD Partners*, 224 USPQ 479, 485 (TTAB 1984).

<sup>6</sup> There is no information in the record as to how many or what percentage of steelworkers are members of applicant's union. However,

The mark STEELWORKERS is highly descriptive of applicant's labor union which consists in significant part of steelworkers. Marks which identify a key attribute of goods or services have been held unregistrable for the goods or services.<sup>7</sup> See, e.g., *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (CCPA 1969) (PASTEURIZED for applicant's face creams, which have been "'substantially pasteurized'... does not possess the capacity to distinguish applicant's goods."); *J. Kohnstam, Ltd. v. Louis Mark & Co.*, 280 F.2d 437, 126 USPQ 362 (CCPA 1960) (MATCHBOX for toy vehicles generic because that category of toy cars was sold in matchbox-sized boxes); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers used in attics; "The broad general category of goods involved here is sprinklers for fire protection. However, a product may be in more than one category, and here applicant's goods also fall within the narrower category of sprinklers for fire protection of attics").

Further, there is at least one example in the record of use of "steelworkers" by a third-party ([wecansolveit.org](http://wecansolveit.org)) to identify

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we note that the page from the website [citac.info](http://citac.info) submitted by the examining attorney in discussing the impact of the Steel Revitalization Act states, "According to the Bureau of Labor Statistics, in 2000, the steel industry ... employed 175,600 production workers." It is clear that the potential membership is substantial, and these potential users of applicant's collective membership mark must be included as part of the relevant public for applicant's labor union.

<sup>7</sup> Although the cases we have cited all involve genericness, the same general principles apply to marks which are highly descriptive.

another organization of steelworkers.<sup>8</sup> Applicant state that it "believes" that the use of "steelworkers" in this manner "is in reference...to itself or activities in which it was involved." (Brief, p. 7.) However, applicant has submitted no evidence to support this contention. See *Enzo Biochem Inc. v. Gen Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) ("Attorney argument is no substitute for evidence.").

We find that the term "steelworkers" is a highly descriptive designation which is not registrable in the absence of a sufficient showing of acquired distinctiveness.

We turn then to the sufficiency of applicant's evidence of acquired distinctiveness. The burden is on applicant to show acquired distinctiveness, and, as we noted earlier, the more descriptive the term, the heavier that burden. *Yamaha International Corp. v. Hoshino Gakki Co.*, supra at 1008. Considering the highly descriptive nature of STEELWORKERS we find that applicant has not met this burden.

In support of its Section 2(f) claim, applicant has submitted a declaration of five-years' substantially exclusive and continuous use of the mark in commerce. Applicant also

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<sup>8</sup> The examining attorney's other evidence of purported third-party use of "Steelworkers" is not persuasive. We agree with applicant that use of the term on the website amazon.co.uk, is a descriptive reference to the occupation and not a reference to a labor union. The Congressional bill refers to steelworker participants in a "group health plan" and not to more than one "group" of steelworkers. The yale.edu website refers to "steelworker groups" generically, and not to a particular organization.

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refers to its "50 plus years of exclusive and continuous use of the mark to indicate membership in a labor organization," presumably relying on the date of first use stated in the amendment to allege use.

First, an allegation of first use in an application is not proof of substantially exclusive and continuous use of the mark as of the date alleged therein. Applicant has never verified that the use during that period was "substantially exclusive" or "continuous," that is, without a period of nonuse, as required under Trademark Rule 2.41(b).

Further, it has been consistently held that a declaration or affidavit of continuous and exclusive use as a mark for five years, without specific evidence of the extent of use and exposure of the mark to the relevant public and of the public's perception of the mark, is insufficient in and of itself to support registration under Section 2(f) where the term sought to be registered is highly descriptive in character. See *In re Synergistics Research Corporation*, 218 USPQ 165, 167 (TTAB 1983) and cases cited therein. See also *In re Kalmbach Publishing Co.*, 14 USPQ2d 1490, 1492 (TTAB 1989) (statement in the application that the mark has been used since 1975 held insufficient to show that "the highly descriptive term 'RADIO CONTROL BUYERS GUIDE' has become distinctive of applicant's magazines"); and *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987) (PROTECTIVE EQUIPMENT is

highly descriptive of burglar and fire alarms "a showing considerably stronger than a prima facie statement of five years' substantially exclusive use is required.").

There is little evidence in the record from which we can ascertain the extent of use and perception of STEELWORKERS. Applicant's specimens include a photograph of a hat displaying STEELWORKERS and 24 political campaign buttons, some of which have dates and/or references to certain candidates. Applicant argues that the political buttons show that STEELWORKERS "has been used for decades" by the members of its organization to show the union's support for certain candidates; that the span of years indicated by the buttons combined with the purpose of making and wearing them "shows an extensive amount of use" of the mark "by members in the aggregate." Applicant maintains that "[i]t is unreasonable to suggest that Applicant should have to provide exhaustive evidence showing how many of each button were made, how many members wore each button, and where each button was worn." (Reply Brief, pp. 6-7.)

Applicant, of course, is not required to provide "exhaustive" evidence as to the use of the political buttons. The problem here is that applicant has not provided any evidence regarding the extent of use of these items, only unsupported attorney argument. We cannot assume from the dates shown on the buttons that they were actually distributed during that time. We

certainly cannot assume that these items were widely distributed by applicant or widely displayed by its members.

Applicant has also submitted two articles mentioning "STEELWORKERS," both from the same publication, the *Pittsburgh Business Times*. One article, dated April 18, 2007, has the headline "Steelworkers seeking to merge with international unions" and states, "The Pittsburgh-based Steelworkers represent 850,000 workers in the United States and Canada." The other article, dated September 2, 2007, states, "Steelworkers President Leo W. Gerard issued a Labor Day call to spend more in America and less in Iraq." Applicant argues that these are examples of "frequent reference by the press and others of Applicant's members as STEELWORKERS" and "unsolicited, regular coverage in the press." (Response, September 4, 2007.) Applicant claims such articles have given widespread, unsolicited exposure to its mark. (Brief, p. 15.)

Applicant's arguments are conclusory and lack any detail as to the extent of media recognition and exposure. We simply cannot agree with applicant that the use of the mark on just two occasions in a single publication is sufficient to establish or even from which we can infer that the mark appears "regularly" in the press or that the mark has received wide public exposure. In addition, there is no evidence that this publication is nationally or at least widely circulated. In fact, it appears to

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be a local newspaper with very limited circulation and we cannot infer that this limited exposure significantly increased awareness of the mark.

Applicant also points to the reference to "Steelworkers" in a Supreme Court decision, National Labor Relations Board v. United Steelworkers of America, C.I.O., 357 U.S. 359, 360 (1958). However, the use of "Steelworkers" in that case was a shorthand reference to applicant as a party in the case, not an acknowledgement or recognition of the term as a mark. Further, the fact that the Court's opinion is publicly available does not mean that the opinion has received widespread public exposure.

Applicant argues that the examining attorney's acceptance of its claim of acquired distinctiveness in its related applications cannot be reconciled with the refusal in the present case.

(Brief, pp. 9-10.) Applicant is referring to its applications for STEELWORKERS (Serial No. 78816222) and UNITED STEELWORKERS (Serial No. 78816205), both for clothing (Class 25) and for retirement/pension plans (Class 36) with a Section 2(f) claim in each application as to Class 36.

These applications are for different marks and/or types of marks than the collective membership mark herein and they have no bearing on whether the mark in this case is descriptive, or whether the evidence of acquired distinctiveness in this case is sufficient. It is well settled that each case must be decided on

its own facts, based on the particular mark, the particular goods or services, and the particular record in each application. See *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits").

Although we have found that STEELWORKERS is a highly descriptive designation, we do not agree, as the examining attorney seems to suggest, that the term is so highly descriptive that it is unregistrable under Section 2(f) regardless of the evidence submitted. Applicant has simply failed to carry its burden of proving acquired distinctiveness in this case. The evidence is insufficient on this record to show that STEELWORKERS has become distinctive as a collective membership mark.

**Decision:** The refusal to register on the ground that applicant's mark is merely descriptive under Section 2(e)(1) and that applicant's evidence of acquired distinctiveness is insufficient is affirmed.



Bucher, Administrative Trademark Judge, concurring in part and dissenting in part:

Although I agree with the majority that United Steel, Paper and Forestry, Rubber, Manufacturing, Energy, Allied Industrial and Service Workers International Union AFL-CIO-CLC (hereinafter "USW" or "Steelworkers") has provided scant evidence in support of registration, I respectfully dissent from the majority decision to affirm the position of the Trademark Examining Attorney based upon the insufficiency of applicant's evidence of acquired distinctiveness.

While the Trademark Examining Attorney and applicant agree that the term **STEELWORKERS** falls within the prohibition of Section 2(e)(1) of the Act when used as a collective membership mark indicating membership in a labor organization, they disagree about the degree of descriptiveness involved. On the "spectrum of distinctiveness" (i.e., generic-descriptive-suggestive-arbitrary-fanciful),<sup>9</sup> the majority herein, like the Trademark Examining Attorney, places this merely descriptive mark close to the line with generic matter. By contrast, I agree with applicant that it should be placed closer to the opposite sideline of mere descriptiveness, not too far from the legally-

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<sup>9</sup> See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9, 189 USPQ 759, 764 (2d Cir. 1976).

significant line of demarcation separating merely-descriptive terms from highly-suggestive marks.

The involved application deals with a collective mark indicating membership in a labor union. During the relevant period of 2006 - 2008, the majority of applicant's members were involved in occupations in the chemicals, oil, paper, rubber, transportation, utilities and private-sector services industries. Admittedly, some small minority of the union's membership is involved in occupations of the allied metals industries, including steel-making.<sup>10</sup> For this very reason, applicant has conceded that the mark is barred from registration by Section 2(e)(1) of the Act. However, irrespective of minor fluctuations in the percentage of applicant's membership involved in making steel, applicant's focus remains the same, namely providing for its membership - a wide range of industrial and service workers - the benefits of collective bargaining.

When working as a Trademark Examining Attorney here in the United States Patent and Trademark Office in the early '80's, I was a dues-paying member of The National Treasury Employees Union (NTEU). I understood NTEU's mission was to represent the

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<sup>10</sup> Between the astonishing productivity improvements in domestic steel mills and the alleged unfair trade practices of some foreign manufacturers, employment in the U.S. steel industry has dwindled significantly in recent decades. In the event that the percentage of applicant's members involved in making steel continues to decline beyond its current small percentage, the term "Steelworkers" might well some day be deemed to be deceptively misdescriptive for this collective membership mark, or even arbitrary.

interests of my cohorts and other federal employees in dozens of federal agencies and departments. While the name suggests the historical roots of the NTEU in the Internal Revenue Service (IRS), the perception within the relevant marketplace created by this collective membership designation is that of a federal employees' union representing employees throughout the government. This view is unchanged by the fact that this national union still has chapters within IRS and the Department of the Treasury.

Or turning to another union shop with a reputation for being formidable in negotiations, consider the "Teamsters."

"Teamsters" is the designation for a well-known union, and when examined as a collective membership mark, it is a term that should not be refused registration unequivocally, even if it might be shown that this word is still used generically for those who make a living driving a truck (or a team of horses!).

So it is with the USW, or the "Steelworkers" in the Twenty-First Century. When used as a collective membership mark, it readily reflects membership in a labor union - not the more limited occupational setting from which applicant's early members were drawn. Not surprisingly, an overwhelming number of the uses of "Steelworkers" in this record (even where it is used carelessly by writers) clearly refer to applicant and its members. In those very few cases where it is used generically to

refer to the occupation of individuals who are involved with making steel, it does not detract from its highly suggestive/merely descriptive usage in the context of labor management relations.

Hence, while the term is merely descriptive as that term is used in Section 2(e)(1) of the Lanham Act, I find that it cannot correctly be characterized as a "highly descriptive" designation for this collective membership.

The second but inextricably-related issue before us is whether applicant's evidence of acquired distinctiveness is sufficient to overcome the statutory bar of Section 2(e)(1). *See Yamaha Int'l Corp.* 6 USPQ2d at 1004. Having determined that the applied-for term is merely descriptive and not highly-descriptive, I would not require that applicant assume the same heavy burden of proving acquired distinctiveness as does the majority - and certainly would demand less than that required by the Trademark Examining Attorney. Furthermore, in reviewing the prosecution of this application, I fear that the Trademark Examining Operations may well have sandbagged applicant's counsel by repeatedly discouraging submission of such evidence as futile.

Throughout the prosecution of this application, the Office characterized this term as being so highly descriptive as to be incapable of achieving trademark significance. While repeatedly

saying that genericness is not at issue, and never analyzing the applied-for term using the two-step inquiry of *Marvin Ginn*,<sup>11</sup> nonetheless, the Trademark Examining Operations retained the following quotations in its appeal brief:

- ...[I]t might be difficult, if not impossible [for applicant], to demonstrate acquired distinctiveness ...
- ...[T]he applied-for mark appears to be generic in connection with the identified goods and, therefore, incapable of functioning as a source-identifier for applicant's goods ...
- No amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark. Such a designation cannot become a trademark under any circumstances ...
- The applicant was further advised that the mark appeared to be generic, and that it was unlikely that any amount of evidence could overcome the Section 2(e)(1) refusal.

Experienced trademark counsel may have responded with exhaustive evidence supported by a declaration. Applicant's counsel was dissuaded from putting on a strong case by these "advisories" of incapability and impossibility. The majority of this panel has implicitly decided that at this juncture it would set a bad precedent for the Board to remand this case to the Trademark Examining Attorney on this question, giving applicant an opportunity to submit solid evidence demonstrating acquired distinctiveness. After such a submission, I would anticipate that the Trademark Examining

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<sup>11</sup> *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 228 USPQ 528 (TTAB 1986).

Attorney would evaluate this evidence, and return the case to us for an immediate decision in the event that this showing is still deemed to be inadequate.

Without the possibility for a remand, I am faced with a difficult decision. As an agency, we have been criticized in the past for misapprehending our role. To the extent that the members of this tribunal seek always to keep our eyes on the correct rat hole,<sup>12</sup> I would reverse this refusal despite counsel's failure during examination to secure for applicant a registration, for example, by doing something as simple as submitting a one-page declaration.

Analogizing to our Section 2(f) standards for surnames, secondary source, etc., where the public policy proscriptions against registering a mark are not that strong, the Office can choose to register under Section 2(f) relying upon Rule 2.41(b).<sup>13</sup>

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<sup>12</sup> " ... [The United States Patent and Trademark Office behaves] at times, like a cat watching the wrong rat hole."

*In re Nat'l Distillers & Chem. Corp.*, 297 F.2d 941, 948, 132 USPQ 271, 277 (CCPA 1962) (Rich, J., concurring), cited in *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071, 1071-72 (Fed. Cir. 1993).

<sup>13</sup> (b) In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with § 2.20, in the application may, in

Even if the same level of "proof" of acquired distinctiveness placed into the instant record may be found unacceptable, where an upstart vendor is trying to claim a merely descriptive term as its product mark, for example, I would argue that the modicum of evidence that emerges from this record should be deemed sufficient to establish acquired distinctiveness under the circumstances of this case.

Moreover, when the Trademark Examining Attorney's own evidence points to "a labor law lecture given by Thomas Geoghegan [currently running for the House seat in Chicago just vacated by Rahm Emanuel] who 'has represented steelworker groups in plant closings ...'," the inartfully-worded term "steelworker groups" is unmistakably a reference to applicant. From other, undisputed stories in this record, we learn that applicant is the largest industrial labor union in North America. There is no compelling public policy reason why the term "Steelworkers" should be kept available for other labor organizations to use to identify their membership. I would argue that the Office has the latitude on this record to accept as true applicant's

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appropriate cases, be accepted as prima facie evidence of distinctiveness...  
37 C.F.R. § 2.41(b) "Proof of distinctiveness under section 2(f)"

Unfortunately, as the majority points out, applicant also failed to verify that the use during the relevant period was "substantially exclusive" and "continuous," as required under this rule. In any case the Trademark Examining Attorney rejected on its face the approach of five-years use without reference to this defect.

decades of nation-wide usage, crediting skimpy evidence (yes, admittedly hearsay evidence of applicant's history for almost seventy years<sup>14</sup> and its approximately 800,000 union members, references to applicant as "Steelworkers" in a Supreme Court case way back in the 1950's, political buttons depicting the names and/or images of candidates for many national presidential elections, etc.) as being sufficient to match a lowered level of descriptiveness.



**Reproduction of  
Steelworkers  
Clinton-Gore '92  
button that  
applicant placed  
into the record**

Would applicant have been better served if counsel had submitted a correctly-worded declaration under Section 2(f) of the Act, chock-full of statistics on the numbers and diversity of USW's membership, while briefly laying out the storied history that counsel extolled in his briefs and communicated so emphatically at the time of oral argument? Of course. Are we watching the wrong rat hole with this decision? Probably.

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<sup>14</sup> With their review of the unsolicited press coverage applicant has submitted, I am sure the majority would surprise many folks from western Pennsylvania with their inadvertent diminution of *The Pittsburgh Post-Gazette*. Unlike the *Pittsburgh Business Times*, *The Pittsburgh Post-Gazette* is that region's largest newspaper, published continuously for more than two-hundred-twenty years. The article in an edition of the Sunday paper ("Nation building is needed at home," September 2, 2007) may well have been seen by almost one million readers.