The Continuing Saga of STEELBUILDING.COM

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Currently on appeal to the Trademark Trial and Appeal Board is Steelbuilding.com, Inc.'s ("the Applicant") Application, Ser. No. 78680792, for the mark STEELBUILDING.COM for "computerized online retail services in the field of pre-engineered metal buildings and roofing systems." The Examining Attorney has refused registration on the grounds that (1) the mark is generic; (2) the mark is merely descriptive and the evidence of acquired distinctiveness under Section 2(f) insufficient; and (3) the identification of services is indefinite (not addressed here).

If you are experiencing déjà vu, that is because this is the same applicant, the same mark, and the same services that were at issue in both the Federal Circuit's 2005 precedential decision in *In re Steelbuilding.com*, 75 U.S.P.Q.2d 1420 (Fed. Cir. 2005) (*Steelbuilding I*), and the Board's 2007 non-precedential decision in *In re Steelbuilding.com, Inc.*, consolidated Ser. Nos. 76280389 and 76280390 (December 12, 2007) (*Steelbuilding II*) (except that in the latter the identification of services used the word "steel" in place of "metal"). In *Steelbuilding I*, the Federal Circuit found that the Applicant's mark STEELBUILDING.COM was not generic for services identical to those in the present application. Subsequently, in *Steelbuilding II*, the Board reversed a disclaimer requirement for STEELBUILDING.COM for virtually the same services because it found that the term had acquired distinctiveness.

The present appeal has been briefed by both the PTO and the Applicant, and an oral hearing is scheduled for this Wednesday, October 15, 2008. The PTO's unusually-aggressive brief, which largely takes the position that the Federal Circuit's opinion in *Steelbuilding I* was disingenuous, includes a postscript written by the Managing Attorney of the Examining Attorney's law office. The PTO's brief is discussed below, but first some background on the Applicant's previous two cases.

Steelbuilding I

In *Steelbuilding I*, the Federal Circuit vacated the Board's finding that the Applicant's mark STEELBUILDING.COM was generic, but affirmed the Board's finding that the mark was merely descriptive and the evidence of acquired distinctiveness insufficient. Addressing the Board's finding that STEELBUILDING.COM was generic, the court faulted the Board's opinion in four respects.

First, the court disagreed with the Board's approach to defining the genus of Applicant's services, finding the Board's genus too narrow. Although the Applicant's identification of services was "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems," the court found that "the record indicates it provides services beyond mere sales. In other words, the services at issue are far more than an on-line catalogue. . . . The web site features a process that facilitates the customer's design of his building at his own computer

via a complex interactive process." *Steelbuilding I*, 75 U.S.P.Q.2d at 1422. Thus, the court found that the Board "fail[ed] to acknowledge the interactive design feature of the applicant's goods and services" and that "the Board's misunderstanding of the proper genus for 'STEELBUILDING.COM' alone requires this court to vacate its decision on genericness." *Id.*

Second, referring to the Board's conclusion that the compound term STEELBUILDING was generic for "steel buildings," the court found that, alternatively, STEELBUILDING might mean "the building of steel structures," *id.* at 1422, and therefore concluded that "the Board erroneously . . . discounted the ambiguities and multiple meanings in the mark," *id.* at 1423.

Third, the court found that "[i]n any event, the record does not show substantial evidence that 'STEELBUILDING,' in common usage, is a compound word used to mean either 'steel building' or 'steel buildings.'" *Id.* at 1422-23. The court then distinguished its decision in *In re Gould Paper Corp.*, 5 U.S.P.Q.2d 1110 (Fed. Cir. 1987):

> In *Gould*, the applicant attempted to register "SCREENWIPE," but this court held that the applicant's own description of the product as "a . . . wipe . . . for . . . screens" provided adequate evidence that merely combining the words "screen" and "wipe" did not render the mark registerable, and held that "the terms remain as generic in the compound as individually, and the compound thus created is itself generic." [citation omitted] In *Gould*, the applicant admitted that "screenwipe" denoted a "screen wipe." In contrast, the applicant here denies that "STEELBUILDING" describes merely "steel buildings." The record does not contain any examination of dictionary definitions or other sources that might have indicated that joining the separate words "steel" and "building" would create a word that, in context, would be generic. The Board merely cited evidence that showed that when customers or competitors talked about a steel building, they used the phrase "steel building." That evidence shows that "steel building" is generic, but does not address directly the composite term STEELBUILDING.

Steelbuilding I, 75 U.S.P.Q.2d at 1423. The court was thus unimpressed by the extensive record evidence of generic usage of "steel building" and "steel buildings," both by the Applicant and its competitors, including the fact that the Applicant's own website invited one to "Design your *steel building* with our advanced interactive system" (emphasis added). Rather, the court said that "[t]he record shows, however, that the evidence cited by the Board relates to the phrase 'steel building' or 'steel buildings'; none refers to 'steelbuilding' or 'STEELBUILDING.'" *Id.* at 1422.

Fourth, the court, interpreting its decision in *In re Oppedahl & Larson LLP*, 71 U.S.P.Q.2d 1370 (Fed. Cir. 2004) (PATENTS.COM held merely descriptive of patent-related software), stated that "[o]nly in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark" but that "[i]n those unusual circumstances, the addition of the TLD can show Internet-related distinctiveness, intimating some 'Internet feature' of the item." *Steelbuilding I*, 75 U.S.P.Q.2d at 1422. Applying these principles to the Applicant's mark STEELBUILDING.COM, the court found that this was just such an "unusual case," and held that:

> the addition of the TLD indicator expanded the meaning of the mark to include goods and services beyond the mere sale of steel buildings. Specifically, the TLD expanded the mark to include internet services that include "building" or designing steel structures on the web site and then calculating an appropriate price before ordering the unique structure.

Id. at 1423.

In my opinion, *Steelbuilding I* was wrongly decided. With respect to the genus of services, the court's emphasis on the "interactive design feature" of the Applicant's website in finding that the Applicant "provides services beyond mere sales" strikes me as much ado about nothing. Don't many retail services, especially those involving complex or customizable products, involve some such interaction with the seller? For example, you can design your own computer at many manufacturers' websites, picking the options you want (memory, display, etc.) while the website recalculates the price, and then place an order for the computer you've configured. Even accepting that the Board's genus was overly narrow, why did the Federal Circuit feel required to vacate the Board's decision when it could have simply proceeded with what it considered the proper genus? For instance, in *In re Reed Elsevier Properties Inc.*, 77 U.S.P.Q.2d 1649 (T.T.A.B. 2005), *aff'd*, 82 U.S.P.Q.2d 1378 (Fed. Cir. 2007), the Examining Attorney and the applicant differed on the proper genus of services. The Board found that "[n]either is quite right," 77 U.S.P.Q.2d at 1653, went on to define the proper genus itself, and ultimately affirmed the refusal.

As for the court's assertion that the compound STEELBUILDING might mean "the building of steel structures," this connotation seems possible but implausible, given the clear, undisputed meaning of "steel building" in the context of the Applicant selling steel buildings (more on this below).

Especially hard to swallow was the Federal Circuit's distinguishing of *Gould*. In *Gould*, the Federal Circuit had affirmed the Board's finding that the proposed mark SCREENWIPE was generic for the applicant's "pre-moistened, anti-static cloth for cleaning computer and television screens." The applicant's specimen of use described its product as "*a* pre-moistened anti-static *wipe* especially designed *for* cleaning computer *screens*" (emphasis added) and the product instructions stated "Open packet, unfold wipe. Wipe screen from top to bottom in even strokes." *Gould*, 5 U.S.P.Q.2d at 1112. The court found that this specimen of use "provided the most damaging evidence" that SCREENWIPE was generic, and held:

> Whether compounded as "screen wipe" – two words – or "screenwipe" – one word – either is ordinary grammatical construction. [dictionary definition omitted] Nothing is left for speculation or conjecture in the alleged trademark. The compound immediately and unequivocally describes the purpose, function and nature of the goods as Gould itself tell [*sic*] us. . . . In this instance, the terms remain as generic in the compound as individually, and the compound thus created is itself generic.

Id.

In *In re American Fertility Society*, 51 U.S.P.Q.2d 1832 (Fed. Cir. 1999), the Federal Circuit characterized its *Gould* decision as follows:

> We held that Gould's own description of the product provided adequate evidence that merely combining the words "screen" and "wipe" did not render the mark registerable. We noted that "Gould's own submissions provided the most damaging evidence [that the word is generic]." Gould's product itself bore the words, "a . . . wipe . . . for . . . screens." [citation to *Gould* omitted] This court thus held that the compound word SCREENWIPE, based both on the dictionary definition of the individual terms and on the applicant's own package advertising and instructions ("Open packet, unfold wipe. Wipe screen . . . .") was as generic as the individual terms themselves. We determined that this combination of two words, even reversed as to order, in the context of the product's package label and intended use as a wipe for computer screens, was sufficient evidence . . .
>
> We, therefore, held that the PTO can satisfy its evidentiary burden by producing "evidence including dictionary definitions that the separate words joined to form a compound have a meaning [to the relevant public] identical to the meaning common usage would ascribe to those words as a compound." [citation to *Gould* omitted] In other words, if the compound word would plainly have no different meaning from its constituent words, and dictionaries, or other evidentiary sources, establish the meaning of those words to be generic, then the compound word too has been proved generic. No additional proof of the genericness of the compound word is required.

Am. Fertility, 51 U.S.P.Q.2d at 1836.

In *Steelbuilding I*, the Board below had based (page 3) its finding of genericness on, among many other pieces of evidence, the fact that Applicant's own website invited one to "Design your *steel building* with our advanced interactive system" (emphasis added), and the Federal Circuit on appeal also took note of this quote from the Applicant's website (but in the portion of the opinion finding the Applicant's mark merely descriptive). The record below also contained many references to "steel building" and "steel buildings" being used in a generic sense, and, further, the Examining Attorney had made of record dictionary definitions of "steel," "building," and ".com" (in the final office action dated 2/5/03).

Because the evidence demonstrated that the term "steel building" *as a whole* was a clearly-defined term that had been used in a generic manner by the Applicant, by competitors, and by others familiar with the trade, the case for finding the compound STEELBUILDING generic was actually *better* than that for finding SCREENWIPE generic. That is, unlike the term SCREENWIPE, since "steel building" as a whole had an admittedly generic meaning, analysis of the individual terms "steel" and "building" should not logically have been necessary, or even particularly relevant. *See, e.g.*, *Remington Prods. Inc. v. North Am. Philips Corp.*, 13 U.S.P.Q.2d 1444, 1448 (Fed. Cir. 1990) (analyzing the mark TRAVEL CARE and "entirely disagree[ing]" with the Board's analysis of the individual words "travel" and "care" because the Board had previously stated that it had no doubt that the term "travel care" had been used in a generic manner).

While analysis of the individual terms "screen" and "wipe" was necessary in *Gould*, in the absence of evidence that "screen wipe" had ever been used, in order to determine the meaning of SCREENWIPE, that added step should have been irrelevant here. In short, it's a longer path from "a . . . wipe . . . for . . . screens" to SCREENWIPE than it is from "steel building" to STEELBUILDING, so it is difficult to understand how the Federal Circuit could consider it relevant in *Steelbuilding I* that the "evidence shows that 'steel building' is generic, but does not address directly the composite term STEELBUILDING." 75 U.S.P.Q.2d at 1423.

Lastly, as to the Federal Circuit's finding that this was an unusual case where "the TLD expanded the mark to include internet services that include 'building' or designing steel structures on the web site" and that "the Board erroneously . . . dismissed the addition of the TLD indicator despite its expansion of the meaning of 'STEELBUILDING.COM,'" I simply do not understand how .COM "expands" the meaning of the mark, or even what exactly that is supposed to mean.

To my mind, STEELBUILDING.COM is comprised of the generic compound STEELBUILDING and a top-level domain shared by millions of other websites, and, unlike the *Oppedahl* hypothetical mark TENNIS.NET for a store that sells tennis nets, viewing STEELBUILDING.COM as a whole I see nothing that renders the whole more than the sum of its parts. Nonetheless, the Federal Circuit held as it did in *Steelbuilding I* and it is a precedential decision. The PTO's brief in the pending appeal before the Board struggles to get away from the Federal Circuit's unfortunate opinion.

Steelbuilding II

In *In re Steelbuilding.com, Inc.*, consolidated Ser. Nos. 76280389 and 76280390 (December 12, 2007) (not precedential), the issue in both applications was a disclaimer requirement for the term STEELBUILDING.COM. The Examining Attorney handling these two applications was the same Examining Attorney who handled the application in *Steelbuilding I*. The Examining Attorney initially took the position that STEELBUILDING.COM was generic, but she suspended the two applications pending the Applicant's appeal of the Board's adverse decision to the Federal Circuit. After the Federal Circuit issued its decision in *Steelbuilding I*, she withdrew her position that the term STEELBUILDING.COM was generic and asserted only that the term was merely descriptive and lacked acquired distinctiveness under Section 2(f).

Asserting that the term STEELBUILDING.COM in its two marks had acquired distinctiveness, the Applicant utilized the statutory suggestion of "substantially exclusive and continuous use" of the term for at least the preceding five years and, additionally, submitted various forms of actual evidence. This persuaded the Board that the term STEELBUILDING.COM had acquired distinctiveness, so it reversed the requirements for a disclaimer in both applications. What is notable here, because it bears on the present appeal discussed below, is the evidence that the Examining Attorney used in unsuccessfully arguing that the term STEELBUILDING.COM had not acquired distinctiveness.

Among other types of evidence, the Examining Attorney produced examples of other entities using variations of "steelbuilding.com" in domain names, namely

<unitedsteelbuilding.com>, <metal-buildings.best-steel-building.com>, and <steelbuilding.net>. The Examining Attorney's evidence also included references to <curvco-steel-building.com>, <surplus-steel-building.com>, and <premier-steel-building.com>, but they appeared in Google® search results with little context, so the Board gave them little weight. Lastly, the Applicant's own evidence included one third-party usage of a similar domain name: <steelbuildings.com>.

The Board, however, was not convinced that these third-party domain names defeated the Applicant's claim of acquired distinctiveness for STEELBUILDING.COM, stating (page 21):

> The few scattered uses of steel-building.com with other material for different websites does not demonstrate that in light of the evidence of record that the term STEELBUILDING.COM has not acquired distinctiveness in relation to applicant's identified services. The fact that the term may be used descriptively in these web addresses does not necessarily prohibit applicant's descriptive term from acquiring distinctiveness.

This passage is relevant because the Examining Attorney handling the present appeal has made the same argument. It should be noted that this decision is designated "not precedential," so it is not binding on the Board. However, pursuant to the Board's position on such decisions, it may be cited for whatever persuasive value it might have.

The Current Appeal Before the Board

If the PTO's brief in the current appeal is any indication, it appears that the PTO is very unhappy with the Federal Circuit's opinion in *Steelbuilding I*. As noted above, I think the Federal Circuit's opinion was wrong, and it certainly does not mesh well with the Federal Circuit's precedent, so the PTO's unhappiness is understandable. Still though, the PTO's brief is rather remarkable in that at times it is critical of *Steelbuilding I*, at other times argues as if *Steelbuilding I* was never decided, and at bottom seems to suggest that the Board shouldn't let the Federal Circuit get away with a fast one.

Not surprisingly, in this case the Applicant began citing *Steelbuilding I* as soon as the Examining Attorney argued in her second office action that the mark was generic.[1] In her brief, the Examining Attorney explains upfront that "it is the Office's position that the facts in this case are different [from those in *Steelbuilding I*] and based upon the additional evidence provided by the Examining Attorney in this application, the present mark is generic" (unnumbered, page 4). This "additional evidence" will be considered later in the context of the Examining Attorney's specific arguments.

A. Is the Compound STEELBUILDING Generic for Buildings Made of Steel?

I sure think so, as does the Examining Attorney, but the problem is that the Federal Circuit, based upon the record evidence, disagreed in *Steelbuilding I*. Of course, in the present appeal, the Examining Attorney takes the position that the "additional evidence" of record in this appeal should alter the outcome.

In her brief, the Examining Attorney argues that the compound term STEELBUILDING is generic for a building made of steel. She writes (page 6):

> The applicant's specimen clearly and unequivocally states that it retails actual "steel buildings" and the specimen further states that applicant is an "online supplier of pre-engineered steel buildings." Thus, in the specimen, the applicant concedes this generic meaning of "steel building" used in the context of the applicant's services.

This is a perfectly sensible argument and entirely in line with *Gould*, but it ignores the Federal Circuit's criticism of the evidence in *Steelbuilding I*. In its opinion below, the Board had relied on the fact that the Applicant's own specimen of use stated, "Design your steel building with our advanced interactive system" and that the Applicant referred to itself in an industry article as "the first true e-commerce supplier of steel buildings." The record evidence in *Steelbuilding I* also included numerous other generic references – by the Applicant, by competitors, and by others in the trade – to "steel building" and "steel buildings," as well as dictionary definitions of "steel" and "building"[2] (and ".com").

The Examining Attorney's argument here simply does not address the Federal Circuit's above-noted criticism in *Steelbuilding I* that "the record shows, however, that the evidence cited by the Board relates to the phrase 'steel building' or 'steel buildings'; none refers to 'steelbuilding' or 'STEELBUILDING,'" *Steelbuilding I*, 75 U.S.P.Q.2d at 1422, and that the Board's evidence "shows that 'steel building' is generic, but does not address directly the composite term STEELBUILDING," *id.* at 1423.

The Examining Attorney also attempts to apply *Gould* (pages 9-10) to the compound term STEELBUILDING, but in doing so she does not even acknowledge that the Federal Circuit distinguished *Gould* (no matter how unpersuasively) in *Steelbuilding I*. Regardless of the merits of the argument, and I agree that *Gould* logically applies here, this is one of several places where the PTO's brief seems to assume that neither it nor the Board (in deciding this appeal) has to grapple with a precedential decision from the Court of Appeals for the Federal Circuit.

Nonetheless, the Examining Attorney does argue (page 10) that "the applicant's joining of the words 'steel building' into 'steelbuilding' is not an action that can save the mark from being deemed generic simply because the applicant had to place the words together in order to create its domain name." However, in its opinion below in *Steelbuilding I*, the Board made the very same argument (pages 13-14):

> We add that while applicant's mark is an Internet domain name [footnote omitted], "[i]t is necessary in the registration of an internet address to eliminate spaces and possessive punctuation. It is necessary, furthermore, to add a top-level domain at the end of the address. Thus, consumers would see the domain name 'thechildrensplace.com/.net' as employing functionally the same name as 'The Children's Place.' TCPIP Holding Co. v. Haar Communications Inc., 244 F.3d 88, 57 U.S.P.Q.2d 1969, 1980 (2d Cir. 2001).

In reversing the Board's decision, the Federal Circuit did not explicitly comment on the Board's argument. Nonetheless, apparently it did not view this argument as weighty enough such that

evidence of STEELBUILDING as a compound could be dispensed with, and thus implicitly rejected this argument.

Though not specifically addressed to the meaning of the compound STEELBUILDING, the Examining Attorney has introduced two forms of evidence that were not present in *Steelbuilding I* and that may be relevant in determining whether the compound STEELBUILDING standing alone is generic: third-party registrations and third-party domain names. The Examining Attorney made of record eight third-party registrations (and one pending application). One registration is for a mark on the Supplemental Register and it contains a disclaimer of "STEEL BUILDING" (singular); the remaining seven registrations are on the Principal Register and each contains a disclaimer of "STEEL BUILDINGS" (plural). However, these third-party registrations add nothing to the abundant evidence already of record concerning the generic nature of "steel building" and "steel buildings," and do not address the Federal Circuit's concern that there was no evidence regarding the compound term STEELBUILDING. The Examining Attorney argues (page 12) that these registrations "show how others in the 'steel building' industry need to use this term to describe their goods and services," but the registrations do not show that others need to use the compound term STEELBUILDING, let alone the entire mark STEELBUILDING.COM, to describe their goods and services.

The Examining Attorney likewise argues (pages 11-12) that the fact that one of the Applicant's competitors uses the domain name <steelbuilding.net> and another competitor uses the domain name <steelbuilding.cc> shows a competitive need to use "both of the terms comprising the applicant's mark."[3] First, however, these two competitor domain names do not show *generic* use of the compound STEELBUILDING (e.g., "we sell steelbuildings"). Second, they do not demonstrate any competitive need to use the Applicant's mark STEELBUILDING.COM; indeed, the fact that these two competitors are competing without doing so tends to suggest the opposite. Compare *In re Reed Elsevier Properties Inc.*, 77 U.S.P.Q.2d 1649, 1657 (T.T.A.B. 2005), *aff'd*, 82 U.S.P.Q.2d 1378 (Fed. Cir. 2007) (finding LAWYERS.COM generic where "the record in this case evidences use of 'lawyers.com' as part of the domain names of numerous hosts of web sites"). Third, even if there were a competitive need to use the compound STEELBUILDING or STEELBUILDING.COM, as the Board pointed out in *Steelbuilding II* (page 21), protection of a mark's secondary meaning (i.e., as a trademark) does not prevent use of the same words in their primary meaning (i.e., to describe products in a non-trademark sense). Lastly, in finding that STEELBUILDING.COM had acquired distinctiveness in *Steelbuilding II*, the Board also addressed (page 21) third-party domain names, which, incidentally, also included <steelbuilding.net>, one of the two domain names the present Examining Attorney points to:

> The few scattered uses of steel-building.com with other material for different websites does not demonstrate that in light of the evidence of record that the term STEELBUILDING.COM has not acquired distinctiveness in relation to applicant's identified services. The fact that the term may be used descriptively in these web addresses does not necessarily prohibit applicant's descriptive term from acquiring distinctiveness.

While I would have had no problem finding the evidence in both *Steelbuilding I* and the present application more than sufficient to find the compound STEELBUILDING generic, the PTO's brief in the present case does not really address the evidentiary problem that the Federal

Circuit saw in *Steelbuilding I*. In any event, even if the record evidence were sufficient to find the compound STEELBUILDING generic, the Federal Circuit had additional concerns.

B. Could STEELBUILDING Mean "the building of steel structures"?

The Examining Attorney writes (page 6) that the "central issue" of *Steelbuilding I* was "the dual generic meaning of 'steel building,'" and for this reason she requests that the Board take judicial notice of dictionary definitions of "steel" and "building." These definitions are the exact same dictionary definitions for "steel" and "building" that were of record in *Steelbuilding I*.

As for the Federal Circuit's belief that an alternative meaning of STEELBUILDING could be "the building of steel structures" and its resulting holding that "the Board erroneously . . . discounted the ambiguities and multiple meanings in the mark," this is where the PTO's brief really takes issue with the court's holding in *Steelbuilding I*. Citing the absence of any dictionary definition for "steelbuilding" as a compound, the Examining Attorney argues (pages 6-7) that:

> If 'steel building' meant 'building in steel' it would surely appear in the dictionary along with ["steelmaker" and "steelwork"]. The fact that it does not, nor has the applicant or the CAFC shown any common usage of this term to mean 'building with steel,' points to the fact that this second meaning is merely a judicial construct without basis in the real world.

In his postscript, the Managing Attorney likewise criticizes the Federal Circuit's notion that STEELBUILDING could refer to "the building of steel structures" (pages 24-25):

> [I]f there is any possible ambiguity or multiple meaning to the mark, then those are lost on the marketplace in that competitors and customers are clearly going by the ordinary dictionary definitions of the terms, rendering any other meanings as mere academic arguments raised in the vacuum of a court room and not tested in the forge of real commerce. . . . Despite the CAFC's attempts to be creative with language, no one uses "steel building" to mean "building with steel" and no one "builds steel" – they forge it or manufacture it. The CAFC's attempt to pretend that "steel building" is used like "home building" was completely without merit, with no evidence in the record to support it whatsoever.

After arguing that the Federal Circuit's alternative meaning of STEELBUILDING – the building of steel structures – is "merely a judicial construct without basis in the real world," the Examining Attorney adds (page 7) that there is no evidence of record to indicate that the public "would ever use or understand" this alternative meaning. Amazingly, the Examining Attorney then argues (page 7) that this alternative meaning of STEELBUILDING is nevertheless ***generic*** as applied to the services shown on the Applicant's specimen of use, and therefore that "STEEL BUILDING is thus generic in both contexts, for the actual goods being offered on the applicant's web site and for assembling buildings of steel, which is a service that can also be performed via the website."

Given that "[t]he critical issue in genericness cases is whether members of the relevant public primarily *use or understand* the term sought to be protected to refer to the genus of goods

or services in question," *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986) (emphasis added), how can the Examining Attorney argue that the alternative meaning of STEELBUILDING is "merely a judicial construct" that no one "would ever use or understand," and in the next breath argue that this alternative meaning is *generic*? The Examining Attorney cannot have it both ways.

Further, the absence of a dictionary definition for "steelbuilding" indicating that this term means something like "the building of steel structures" cuts *against* the Examining Attorney's position that this alternative meaning is generic (or descriptive), and in favor of the Federal Circuit's apparent belief that there is a double entendre in STEELBUILDING. In a completely unrelated case, the Board addressed the Federal Circuit's reasoning in *Steelbuilding I*:

> While not using the term "double entendre," the Court's reasoning in *Steelbuilding.com* suggests a non-descriptive connotation (perhaps not unlike SUGAR & SPICE for bakery products, THE SOFT PUNCH for noncarbonated soft drink, and NO BONES ABOUT IT for fresh pre-cooked ham). . . . Specifically, given the interactive design feature of that applicant's goods and services, the Court concluded that STEELBUILDING could also refer to "the building of steel structures."

In re DNI Holdings Ltd., 77 U.S.P.Q.2d 1435, 1439 (T.T.A.B. 2005) (internal citations omitted).[4]

Having presented the self-contradictory argument that STEELBUILDING in the sense of "the building of steel structures" is both a figment of the Federal Circuit's imagination *and* generic, and failing to show that this alternative sense of STEELBUILDING is generic for the Applicant's services, that leaves only the Examining Attorney's complaint that the Federal Circuit lacked any evidentiary basis to find an alternative meaning/double entendre.

Did the Federal Circuit *need* any evidence to find that STEELBUILDING creates a double entendre? It's not clear that it did. Compare *In re Boulevard Entm't Inc.*, 67 U.S.P.Q.2d 1475, 1480 (Fed. Cir. 2003) (distinguishing the applicant's mark from the third-party mark JACK OFF JILL, and other marks, because JACK OFF JILL "relates at least in part to the nursery rhyme involving Jack and Jill, and therefore creates a double entendre that is not present in Boulevard's marks. Similar double entendres are present in many of the other marks . . .") and *In re Delaware Punch Co.*, 186 U.S.P.Q. 63, 63 (T.T.A.B. 1975) (agreeing with applicant that THE SOFT PUNCH for soft drinks projects a double entendre that the drink "has an impact like a soft punch or a pleasing hit"), with *In re Wells Fargo & Co.*, 231 U.S.P.Q. 95, 99 (T.T.A.B. 1986) (agreeing that a mark containing a double entendre is suggestive, but finding that "the prerequisite factual inference in the instant case is not supported by the facts in the record before us."). Maybe the reality is simply that if the Board or a court discerns a double entendre based upon its own knowledge and experience, it will find a double entendre; if it does not "get it" on its own, it will require evidence.

Anyway, even if the Board believes that evidence is, or should be, required in order to discern a double entendre in a mark, is it free to simply ignore the Federal Circuit's holding that "the Board erroneously . . . discounted the ambiguities and multiple meanings in the mark"?

C. <u>The Proper Genus for the Applicant's Services</u>

Recall that in defining the genus for the Applicant's services as "the sale of pre-engineered 'steel buildings' on the Internet" and "computerized on-line retail services in the field of pre-engineered metal buildings including steel buildings," the Federal Circuit found in *Steelbuilding I* that the Board had defined the genus too narrowly by "fail[ing] to acknowledge the interactive design feature of the applicant's goods and services" and held that "the Board's misunderstanding of the proper genus for 'STEELBUILDING.COM' alone requires this court to vacate its decision on genericness."

Inexplicably, the Examining Attorney commits the same error in this application. She writes (page 7) that "it should be noted that the present application is solely for 'computerized online retail services in the field of pre-engineered metal buildings and roofing systems' and not for any service where a customer may customize the goods. Thus, those additional services are not relevant to any analysis as to the capability of the mark." She repeats this contention at page 9 of her brief, and at page 13 states that "the genus of services is retail services featuring the ability to purchase a 'steel building.'"

Of course, this narrow understanding of the genus for the Applicant's services is precisely what the Federal Circuit held to be error in *Steelbuilding I*, and sufficient enough reason by itself to vacate the Board's finding of genericness. *See also DNI Holdings*, 77 U.S.P.Q.2d at 1438 (Board noting that the Federal Circuit in *Steelbuilding I* had first looked at the identification of services to determine the genus, and "then went on to look at the actual website and other evidence of record"); *Reed Elsevier*, 77 U.S.P.Q.2d at 1655 (following *Steelbuilding I* and interpreting the applicant's identification of services "in light of what the record shows the database to include"), *aff'd*, 82 U.S.P.Q.2d at 1380 ("the board appropriately reviewed the [applicant's] website for context, to inform its understanding of the term").

Strangely, although the Examining Attorney improperly defines the genus too narrowly by refusing to consider "any service where a customer may customize the goods," insisting that such "additional services are not relevant to any analysis as to the capability of the mark," the Examining Attorney *does* look to the Applicant's specimen of use in trying to argue that the Federal Circuit's alternative meaning of STEELBUILDING ("the building of steel structures") is generic. For instance, she writes that "the applicant's specimen nonetheless indicates that it offers services to build steel buildings to the specifications of its customers" and that building "is exactly the activity that the consumer engages in when utilizing the applicant's custom design and manufacturing services" (page 7).

The Examining Attorney's vacillation on this point – the interactive design feature of the Applicant's services shown on the Applicant's specimen of use is supposedly "not relevant to any analysis as to the capability of the mark" but *is* relevant in determining whether the alternative meaning of STEELBUILDING is generic – results in the bizarre sentence that "the applicant's specimen shows use of STEELBUILDING generically regarding both potential meanings when used in context of the services indicated on the specimen, even though only the retail services featuring the goods and not the customized manufacturing services are applicable in the present application" (page 7). This is another situation in which the Examining Attorney tries to have her cake and eat it too.

Suffice it to say, in *Steelbuilding I* the Federal Circuit repeatedly emphasized the interactive design feature of the Applicant's services and concluded that the Board had "fail[ed] to acknowledge the interactive design feature," and the Examining Attorney inexplicably ignores this.

D. .COM And Its "Expansion" of the Mark STEELBUILDING.COM

After citing *Oppedahl* and arguing that the addition of a TLD to an otherwise descriptive term will only result in a distinctive, registrable mark in unusual circumstances, the Examining Attorney argues (page 9):

> In this case, no such exceptional circumstances exist. The non-TLD portion of the mark is unregistrable, and the addition of the TLD does not create a witty double entendre or add any other significance capable of identifying source or acquiring distinctiveness. When combined, the wording and the TLD retain their common meaning.
>
> Contrary to the applicant's assertion regarding the Federal Circuit's previous STEELBUILDING.COM holding, the addition of .COM does not expand the meaning of the mark in the present application to include internet services that include "building" or designing steel structures on the website.

The Managing Attorney likewise argues (page 24-25) that "based on the PATENTS.COM case [i.e., *Oppedahl*], the addition of the TLD .COM to a generic term in no way expands the real world meaning of the generic term, except again perhaps in the purely academic atmosphere of the Court of Appeals for the Federal Circuit."

As an initial matter, in *Oppedahl* the Federal Circuit held the proposed mark PATENTS.COM to be merely descriptive, not generic. The court even stated that "the Board properly recognized . . . that TLD marks may obtain registration upon a showing of distinctiveness. . . . The Board properly left that door open for this patents.com mark as well." *Oppedahl*, 71 U.S.P.Q.2d at 1373.

More importantly, though I agree with the PTO here on the underlying merits regarding this particular mark STEELBUILDING.COM, I am simply at a loss why the Examining Attorney and the Managing Attorney do not consider themselves – or, apparently, the Board – bound by *Steelbuilding I*, whose holding is indisputably contrary to their argument here. The Federal Circuit held as follows:

> In fact, in rare circumstances, as noted before, "a TLD may render an otherwise descriptive term sufficiently distinctive for trademark registration." *Oppedahl*, 373 F.3d at 1177. In this unusual case, the addition of the TLD indicator expanded the meaning of the mark to include goods and services beyond the mere sale of steel buildings. Specifically, the TLD expanded the mark to include internet services that include "building" or designing steel structures on the web site and then calculating an appropriate price before ordering the unique structure.

Steelbuilding I, 75 U.S.P.Q.2d at 1423.

E. Acquired Distinctiveness

The PTO's brief takes the position that the Applicant's Section 2(f) claim is unacceptable because (1) the mark is generic, so no amount of evidence would be acceptable, and (2) the evidence is insufficient to carry the Applicant's burden of proving acquired distinctiveness. I won't get into this issue too much because this is already far too long, but I do want to address one point made by the Examining Attorney. She writes (page 17):

> Of special importance, the evidence of record that STEELBUILDING.NET and STEELBUILDING.CC offer the same services as the applicant clearly shows that the applicant's use of STEELBUILDING plus a TLD is neither exclusive nor continuous. The evidence thus falls short on the most basic level necessary to show acquired distinctiveness – that the applicant has been the exclusive source for the services rendered in conjunction with the mark for a continuous period of time. The applicant simply cannot surpass this hurdle so long as competitors operate web sites using STEELBUILDING plus a TLD.

I assume that when the Examining Attorney speaks of "the exclusive source for the services rendered in conjunction with the mark," she intends to refer to whether the Applicant's use *of its mark* has been exclusive, and not whether the Applicant has been the only entity to provide services of the type it provides (however they are defined).

The Examining Attorney's argument here is misguided for two reasons. First, competitors' use of the domain names <steelbuilding.net> and <steelbuilding.cc> has no logical bearing on whether the Applicant has continuously used its mark STEELBUILDING.COM. Second, as to exclusivity of use, the Examining Attorney's position that the Applicant cannot prove acquired distinctiveness "so long as competitors operate web sites using STEELBUILDING plus a TLD" is simply wrong as a matter of law. The Applicant's use of its mark STEELBUILDING.COM does not need to be exclusive as a prerequisite to acquired distinctiveness. *See, e.g.*, *L.D. Kichler Co. v. Davoil Inc.*, 52 U.S.P.Q.2d 1307, 1309 (Fed. Cir. 1999) (Section 2(f) refers to "proof of *substantially* exclusive and continuous use"; district court "erred in suggesting that *any* use by others is sufficient to preclude an applicant's declaration of 'substantially exclusive' use"); *In re EBSCO Indus. Inc.*, 41 U.S.P.Q.2d 1917, 1924 (T.T.A.B. 1997) ("we find that the exhibits showing some third-party use of applicant's lure configuration, without any evidence of the length of time or extent to which such lures have been marketed, do not outweigh the substantial evidence submitted by applicant that its configuration serves as a source-identifier of applicant's lures").

Here, there are only two similar third-party domain names – not even used as service marks – which don't seem like enough to defeat the Applicant's claim of acquired distinctiveness. The Board made pretty much the same point in *Steelbuilding II*, as noted above.

Conclusion

This appeal reminds me of Demi Moore's character in *A Few Good Men*. At trial, her character makes an objection, is overruled by the judge, so then she *strenuously* objects. The

PTO quite understandably disagrees with the Federal Circuit's holding that the Applicant's mark STEELBUILDING.COM is not generic, but the "additional evidence" upon which the PTO ostensibly relies in this appeal – third-party registrations that add nothing to the evidence already of record and two similar third-party domain names – does not really address the evidentiary problems the Federal Circuit perceived in *Steelbuilding I*. As to the Federal Circuit's alternative meaning "the building of steel structures" and its belief that this was an unusual case in which the .COM "expanded" the Applicant's mark, the PTO's brief is self-contradictory and in the end simply disagrees with the Court of Appeals for the Federal Circuit. Moreover, the PTO bewilderingly mis-defines the Applicant's genus for its services too narrowly, contrary to *Steelbuilding I* and subsequent case law. Lastly, the PTO's position on acquired distinctiveness is wrong in its insistence that the Applicant's use of its mark STEELBUILDING.COM must be exclusive, and the existence of two similar domain names used only as domain names hardly seems sufficient to defeat its claim of acquired distinctiveness.

In short, the PTO is, for all intents and purposes, now asking the Board to "reverse" its primary reviewing court. It will be interesting to see what the Board does with this appeal.

Notes

[1] It was actually the Examining Attorney who first brought up *Steelbuilding I* when, in the first office action holding the mark merely descriptive, she stated: "Applicant may also wish to again review the findings of the U.S. Court of Appeals Federal Circuit's findings in *In re Steelbuilding.com*, 75 USPQ2d 1420 (CA FC 2005), where the court reviewed the proposed mark, which was previously submitted to this office for registration on March 3, 2000."

[2] It's not clear whether the Federal Circuit saw these dictionary definitions, because at one point it stated that, "The record does not contain any examination of dictionary definitions or other sources that might have indicated that joining the separate words 'steel' and 'building' would create a word that, in context, would be generic." *Steelbuilding I*, 75 U.S.P.Q.2d at 1423. The record did include dictionary definitions of "steel" and "building," but perhaps the court simply meant that there was no *analysis* of what those terms might mean when combined into STEELBUILDING.

[3] The Examining Attorney also argues (page 11) that eleven domain names – nine aside from the Applicant's <steelbuilding.com> and the noted third-party one <steelbuilding.net> – consisting of "steelbuilding" plus a popular TLD have been reserved. However, presumably none of these domain names are being used, as domain names or as trademarks, since the Examining Attorney did not make such evidence of record.

[4] Although distinguishing *Steelbuilding I* factually in *DNI Holdings*, the Board also made several comments that are difficult to reconcile with *Steelbuilding I*. For instance, citing *Gould*, it stated that, "As a matter of trademark law, 'sports betting' is equivalent to 'sportsbetting,' which in its combined or collapsed form is not greater than the sum of its parts." 77 U.S.P.Q.2d at 1440. It also again made the point that domain names cannot have spaces. *Id.*