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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Steelbuilding.com

Serial No. 75934927

Michael M. Zadrozny of Shlesinger, Arkwright & Garvey,
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(Odette Bonnet, Managing Attorney).

Before Walters, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Steelbuilding.com (applicant) applied to register the
mark STEELBUILDING.COM in typed form for services
ultimately identified as "computerized on-line retail
services in the field of pre-engineered metal buildings and
roofing systems" in International Class 35. The
application (Serial No. 75934927) was filed on March 3,
2000, and it was based on an allegation of a bona fide

intention to use the mark in commerce. In an amendment to allege use dated November 15, 2001, applicant asserted a date of first use and a date of first use in commerce of September 29, 2000.

The examining attorney initially refused registration on the ground that the mark STEELBUILDING.COM is merely descriptive of the services. 15 U.S.C. § 1052(e)(1). In the final refusal, the examining attorney also advised applicant "that the proposed mark appears to be generic as applied to the services." Office Action dated May 15, 2001 at 2. In response, applicant argued that its mark was neither generic nor merely descriptive, but it also offered, as an alternative, to amend the application to seek registration under Section 2(f) of the Trademark Act (15 U.S.C. § 1052(f)) and it submitted evidence of acquired distinctiveness. Amendment and Request for Reconsideration dated November 15, 2001. The examining attorney denied the request for reconsideration on the additional grounds of genericness and, in the alternative, even if the mark were found only merely descriptive, lack of acquired distinctiveness.

Applicant filed a notice of appeal and an oral hearing was held on January 22, 2004.

Evidence

We begin our discussion by reviewing the evidence of record both as to the question of whether the mark is merely descriptive or generic for applicant's services, and on the question of whether applicant's mark, if only merely descriptive but not generic, has acquired distinctiveness.

There is no doubt that the metal buildings that applicant provides include "steel buildings." Applicant's own website permits one to "design your **steel building** with our advanced interactive system." An article in *Metal Construction News* featuring an interview with Scott House of applicant starts by noting that applicant describes "itself as 'the first true e-commerce supplier of steel buildings.'" In applicant's advertisement, also in *Metal Construction News* (January 2001), applicant refers to itself as follows: "E-commerce website offers instant pricing and online sales of **steel buildings**, mini storage systems, building accessories, component parts and all-steel homes."

The examining attorney has made of record numerous printouts from the NEXIS database that show that the term "steel building" is a commonly used term to identify buildings made of steel. Some examples are set out below.

They also helped workers at the company - which builds pre-engineered **steel buildings**.

The Sunday Oklahoman, September 23, 2001.

The structure will consist mainly of a prefabricated **steel building**, chosen because it will be relatively inexpensive.

St. Petersburg Times, October 18, 2001.

He attended the North Dakota School of Science in Wahpeton. He owned and operated Quality Design Built Inc., which manufactured pre-engineered **steel buildings**.

Denver Post, October 10, 2001.

Bagley owns Teton West Construction of Rexburg, a company he started in 1974, specializing in **steel building** construction.

Idaho Falls Post Register, October 3, 2001.

He pays about \$25,000 a year in rent for 600 acres, a bit of yard, six grain bins and a small **steel building**.

Star Tribune (Minneapolis, MN), September 16, 2001.

Primarily selling **steel buildings** and buying and selling RVs, other vehicles and boats, Northwest Enterprises has been at the location between Lake City Engineering and Polaris for nearly two years.

Spokesman-Review (Spokane, WA), May 2, 2001.

Missing bolts in the roof assembly of the prefabricated **steel building**, which opened in 1974, were cited as cause for concern.

Union Leader (Manchester, NH), April 18, 2001.

Ganneston Construction designed a pre-engineered **steel building**.

Bangor Daily News, September 25, 1996.

Star Building Systems is a manufacturer of pre-engineered **steel buildings**.

Springfield Business Journal, April 6, 1998.

In addition to applicant's use of the term "steel building" and the publications' use of the term to identify

a type of building, i.e. a steel building, others who appear to be applicant's competitors or at least in the construction industry use the term "steel building(s)" as the name of their products.

One of the most interesting examples of the use of the term "steel buildings" is the use of the term in the publication *RentSmart!* that applicant submitted. Applicant's advertisement appears under the heading "**steel buildings.**" In addition to applicant's, two other advertisements appear under the heading "steel buildings." The first is an ad for Express **Steel Building**. The other is for Heritage Building Systems that includes the following language: "Build it Yourself and Save! 10,000 sizes, Bolt-Together **Steel Buildings** & Homes."

In another advertisement, this time in *Metal Construction News* (January 2001) on the same page with applicant's listing, there appears an advertisement for Steelway Buildings Systems that identifies itself as offering "**Steel building** systems and components."

Applicant introduced evidence of a poll regarding its recognition in the metal building manufacturing field. Other names in the poll include BC Steel Buildings, Bigbee Steel Buildings, JRS Pre-Engineered Steel Buildings, Lifetime Steel Buildings, Northern Steel Buildings, Dura-

Steel Buildings, Pioneer Steel Buildings, Premier Steel Buildings, and Southern Steel Buildings.

Applicant also introduced declarations from customers and others associated with the metal building industry. Even these declarations refer to the use of applicant's mark "in the field of pre-engineered **steel buildings**." Ron Holder declaration. See also Ginn Declaration ("I am thoroughly familiar with the marketplace in the field of pre-engineered **steel buildings**"). Key Declaration ("I am employed as Vice President of Operations of Heritage Building Systems, Inc. ('HBS')¹, which is one of the retailers of pre-engineered **steel buildings** in the United States").

Applicant also submitted emails from customers to show that its term has acquired distinctiveness, but even here the customers use the term "steel building(s)" other than as a mark. Bjorneboe email ("I have researched over twenty **steel building** manufacturers"); and Brookbank email ("When I choose to buy a **steel building**, it will be from your company").

¹ The witness went on to explain that HBS and applicant "consider themselves to be 'sister' companies." Key declaration at 2.

Applicant has submitted the declaration of its marketing director, Tom Hockersmith. Mr. Hockersmith declares (¶ 2) that:

The primary products offered by Steelbuilding.com are various types of pre-engineered metal buildings. More specifically, within the overall class of pre-engineered metal buildings, Steelbuilding.com confines itself to simpler and smaller designs, ranging from 900 square feet up to 30,000 square feet and even larger. Some typical uses for our products include agricultural buildings, small warehouses, mini-storage complexes, work shops, auto garages, and various types of utility and storage buildings.

Mr. Hockersmith also declares (¶ 3) that "Steelbuilding.com provides the only method and medium by which potential buyers can get an accurate price quote for a particular building without the aid of trained estimators." Submitted with the declaration of Mr. Hockersmith were the results of various Internet polls taken by MetalBuilding.com, a website applicant's witness identifies as "an Internet-based central information exchange for the industry." Hockersmith, ¶ 11. The declarant (¶ 12) emphasizes that the "current poll lists Steelbuilding.com among the choices along with four of its competitors: Package Industries, Parkline, Steelox, and US Structures. At the time of this declaration, 64% of the respondents had listed Steelbuilding.com as the most recognizable." The printout of the Internet poll does not

indicate how many responses were tallied. The MetalBuilding.com website polls included such questions as "Will Mark McGuire's home run record be broken this season?"; "Is now a good time to invest in the stock market?"; "Timothy McVeigh will be executed..."; "Who will be the first #1 seed to exit the NCAA men's basketball tournament?"; and "Are we headed toward a recession?".

Mr. Hockersmith goes on to explain (¶ 17) that applicant's primary form of advertising is to focus on Internet banner advertising. "For example, each time a person uses Yahoo! to search for information on a term like 'metal building,' a graphical banner advertisement promoting Steelbuilding.com will be displayed at the top and bottom of every page that lists the results of this search."

Finally, Mr. Hockersmith provided information on the number of price quotes (¶ 29) applicant issued in October 2001 (9000) and the number of new (200) and repeat (200) users who enter the interactive pricing system every day (¶ 25).

Genericness

We begin by addressing the issue of whether the term STEELBUILDING.COM is generic for applicant's services. The Court of Appeals for the Federal Circuit has held that:

"The 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 Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Ginn goes on to explain that:

Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

Id.

A term that is the generic name of a particular product or category of goods is likewise generic for any services that are directed to or focused on that product or class of goods. See In re Log Cabin Homes Ltd., 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES, which is generic for a particular type of building, is also generic for architectural design services directed to that type of building and for retail outlets featuring kits for construction of that type of building); In re A La Vielle Russie Inc., 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for particular field or type of art and also for dealership services directed to that field).

The evidence in this case convinces us that the term STEELBUILDING.COM is generic for applicant's computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems. A significant, if not primary feature, of applicant's services is the sale of steel buildings. Applicant identifies itself as providing steel buildings, applicant's website invites customers to "design your steel building," and applicant lists its services under a generic heading "steel buildings." Furthermore, applicant's competitors use the term "steel buildings" generically, see, e.g., "Bolt-Together Steel Buildings & Homes" and "Express Steel Building." Others in the trade use the term generically. See Metal Building Today (October 2001) at 4 ("R & M Steel Company ... Steel Building Excellence - Since 1969") and 8 ("The company also placed the concrete floors before erecting the steel building"). A poll at MetalBuilding.com identifies several other metal building manufacturers that use the term "Steel Buildings" in their name. As discussed previously, applicant's declarants and customers use the term "steel building" generically, e.g., "one of the retailers of pre-engineered steel buildings in the United States" and "[w]hen I choose to buy a steel building." Finally,

numerous publications discussed earlier provide abundant examples of the generic use of the term.

Next, we address the ".com" part of applicant's mark. This issue is not a case of first impression. The term ".com" is a "domain name suffix denoting commercial entities such as corporations and companies." *Official Internet Dictionary* (1998). The addition of ".com" to a generic term does not convert the term into a non-generic term. See In re Martin Container Inc., 65 USPQ2d 1058, 1060-61 (TTAB 2002) ("A top level domain indicator like '.com' does not turn an otherwise unregistrable designation into a distinctive, registrable trademark" (internal quotation marks and punctuation omitted)). See also In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1792 (TTAB 2002) (The TLD (top level domain) .com "has no source-identifying significance"). As the board explained at length in CyberFinancial.Net Inc., 65 USPQ2d at 1791 (footnote omitted), a case involving the mark BONDS.COM:

The term ".com" is defined in the following ways: "a domain type used for Internet locations that are part of a business or commercial enterprise" *CNET Glossary* (1998); "abbreviation of commercial organization (in Internet addresses)" *The American Heritage Dictionary of the English Language* (4th ed. 2000); and "Internet abbreviation for company: used to show that an Internet address belongs to a company or business" *Cambridge Dictionaries Online* (2001). The record also includes definitions of "Dot Com Company" as "[a] company which operates its business mainly on the

Internet, using '.com' URLs," *Newton's Telecom Dictionary* (2001); and "dot-com company" as "[a]n organization that offers its services or products exclusively on the Internet." *The Computer Glossary* (9th ed. 2001).

The issue presently before us was squarely addressed by the Board in the recent decision of In re Martin Container, Inc., 65 USPQ2d 1058 (TTAB June 11, 2002) (application Serial No. 75/553,426). In that case, the Board found the designation CONTAINER.COM to be generic and incapable of registration on the Supplemental Register when used in connection with "retail store services and retail services offered via telephone featuring metal shipping containers" (Class 35) and "rental of metal shipping containers" (Class 39). The Board concluded that:

what applicant seeks to register is simply a generic term ["container"], which has no source-identifying significance in connection with applicant's services, in combination with the top level domain indicator [".com"], which also has no source-identifying significance, and that combining the two does not create a term which has somehow acquired the capability of identifying and distinguishing applicant's services.

The Board viewed CONTAINER.COM more like a compound term than a phrase, and cited to In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) in finding it generic. The Board stated that "to the average customer seeking to buy or rent containers, 'CONTAINER.COM' would immediately indicate a commercial web site on the Internet which provides containers." In making its determination, the Board analogized to the cases of In re Paint Products Co., 8 USPQ2d 1863 (TTAB 1988) [PAINT PRODUCTS CO. held incapable of identifying and distinguishing paints], and In re E.I. Kane, Inc., 221 USPQ 1203 (TTAB 1984) [OFFICE MOVERS, INC. held incapable of identifying and distinguishing office facilities moving services]. The Board also cited to the views espoused by Professor McCarthy:

a top level domain ["TLD"] indicator [such as ".com"] has no source indicating significance and cannot serve any trademark [or service mark] purpose. The same is true of other non-distinctive modifiers used in domain names, such as <http://www> and "html"... [because] the TLD ".com" functions in the world of cyberspace much like the generic indicators "Inc.," "Co.," or "Ltd." placed after the name of a company.

A top level domain indicator like ".com" does not turn an otherwise unregistrable designation into a distinctive, registrable trademark [or service mark]. Thus, for example, adding a ".com" to a generic term, such as <bankingnews.com> would not change the basic generic nature and the composite will probably be found generic and unregistrable for the service of providing information in the field of banking. 1 J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 7:17.1 at pp. 7-28.1 to 7-29 (4th ed. 2002).

Therefore, the addition of the term ".com" to applicant's generic term is not significant. We add that while applicant's mark is an Internet domain name,² "[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

² Applicant's website is www.steelbuilding.com. There is no practical difference between steelbuilding.com and www.steelbuilding.com. *1-800 Contacts Inc. v. WhenU.com*, 69 USPQ2d 1337, 1359 (S.D.N.Y. 2003) (Defendant's mark "differs from Plaintiff's trademark only in the omission of spaces and grammatical marks, and in the addition of the "www" and ".com." These distinctions are not significant'). We also note that "a misspelling of a generic name which does not change the generic significance to the buyer, is still generic." 2 *McCarthy on Trademarks and Unfair Competition*, § 12.38 (4th ed. 2003).

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 USPQ2d 1969, 1980 (2d Cir. 2001).

Furthermore, the term ".com" is a designation for a commercial entity on the Internet much like the older expression "company" or its abbreviation "co." The Supreme Court held more than 100 years ago that adding a term such as "company" to a generic term did not magically change an unregistrable term to a registrable term:

[P]arties united to produce or sell wine, or to raise cotton or grain, might style themselves Wine Company, Cotton Company, or Grain Company; but by such description they would in no respect impair the equal right of others engaged in similar business to use similar designations, for the obvious reason that all persons have a right to deal in such articles, and to publish that fact to the world. Names of such articles cannot be adopted as trade-marks, and be thereby appropriated to the exclusive right of any one; nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to use of the name.

Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 US 598, 602-03 (1888).

We find that the evidence, including applicant's own evidence, shows that the genus for its services would be the sale of pre-engineered "steel buildings" on the Internet. The addition of non-distinctive matter such as

"[t]he top level domain indicator [".com"], which also has no source-identifying significance, and combining the two does not create a term which somehow has acquired the capability of identifying and distinguishing applicant's services." CyberFinancial.Net, 65 USPQ2d at 1791.

Next, we look at whether the term is understood by the relevant public to refer to the product included in the genus of the services. Ginn, 228 USPQ at 530. "Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications." In re Merrill Lynch, Fenner and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). "The 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." Ginn, 228 USPQ at 530. Here, the relevant public would understand that the term "steelbuilding.com" refers to the genus of the services. Combining generic words can result in the combined term also being generic. See In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE generic for a wipe for cleaning television and computer screens); In re Abcor Dev. Corp., 588 F.2d 811,

200 USPQ 215 (CCPA 1978) (GASBADGE at least descriptive for gas monitoring badges; three judges concurred in finding that term was the name of the goods); In re American Institute of Certified Public Accountants, 65 USPQ2d 1972 (TTAB 2003) (CPA EXAMINATION found generic).

However, a failure to provide evidence that the public uses the term to refer to the genus of the goods or services can result in the Office failing to satisfy its burden of proof. In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE held not generic for association services because there was no evidence of generic use of the term); In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001) ("There is no record evidence that the relevant public refers to the class of shop-at-home telephone mattress retailers as '1-888-M-A-T-R-E-S-S'").

We find that the evidence supports a conclusion that the term STEELBUILDING.COM, when viewed in relationship to the services, would be viewed by relevant purchasers as the genus of the goods, i.e. a website that provides computerized on-line retail services in the field of pre-engineered metal buildings including steel buildings. Just as the public would understand that the terms "wine

company," "cattle company," "BONDS.COM," and "CONTAINER.COM" refer to entities that market or provide information on wine, cattle, bonds, and storage containers, applicant's mark is simply the name of a website that sells, inter alia, steel buildings.

We also hold that STEELBUILDING.COM is a compound word. See CyberFinancial.Net, 65 USPQ2d at 1794 ("BONDS.COM is properly considered a compound word in this analysis. The terms 'bond' and '.com' are joined as compound word and appear without any space or separation between them"). The board in that case held that the term BONDS.COM was analogous to the term SCREENWIPE in Gould Paper and, therefore, different from the terms SOCIETY FOR REPRODUCTIVE MEDICINE in American Fertility and 1-888-MATRESS in Dial-A-Mattress. We agree that the result is the same in this case.

In arriving at this conclusion, we have considered all the evidence of record. Regarding the declaration of potential customers and competitors, these declarations contain statements that the declarants associate applicant's term with "retail services in the field of pre-engineered steel buildings" and they are familiar with "several companies offering retail services in the field of

pre-engineered steel buildings." Holder and Ginn declarations.

Obviously, a domain name is a unique address. However, the mere fact that a domain name is registered does not mean that the name is no longer generic. See Martin Container (CONTAINER.COM) and CyberFinancial.Net, 65 USPQ2d at 1793 (The "term BONDS CO. would be generic for services relating to bonds, and competitors should be allowed to freely use marks such as ACME BONDS CO. and UNITED BONDS CO. to identify and distinguish their services. In the same manner, a designation such as BONDS.COM should be freely available for others to adopt so that designations such as ACMEBONDS.COM or UNITEDBONDS.COM could be used by competitors to identify and distinguish their services from others in the field"). The same reasoning should apply here. Applicant has identified numerous competitors or manufactures with names such as the following: Lifetime Steel Buildings, Dura-Steel Buildings, and O'Steel Buildings. Internet users assume that many companies' web address is simply the company's name with a ".com" ending. Lockheed Martin Corp. v. Network Solutions Inc., 985 F. Supp. 949, 44 USPQ2d 1865, 1868 (C.D. Calif. 1997) ("Because most businesses with a presence on the Internet use the ".com" top-level domain, Internet users

intuitively try to find businesses by typing in the corporate or trade name as the second-level domain name, as in "acme.com." Second-level domain names, the name just to the left of ".com," must be exclusive"), aff'd, 193 F.3d 980, 52 USPQ2d 1481 (9th Cir. 1999). Therefore, it would not be unexpected that some of the companies and manufacturers that applicant has identified would use or would have a need to use domain names such as LifetimeSteelBuildings.com, DuraSteelBuildings.com, and OSteelBuildings.com. Indeed, applicant's own evidence points to an even closer use. One of its customers reported the following problem: "I also wanted to let you know that when I typed steelbuilding.com tonight, I inadvertently added an 's' at the end of steelbuilding, and it took me to somebody else's site. Too bad you can't get those close spellings redirected to your site." Chipsoles email. On the Internet, steelbuilding.com and steelbuildings.com are distinguishable. For trademark purposes, the evidence demonstrates that the terms "steel building" and "steel buildings" are equally generic.

On this point, we do not find that applicant's evidence of non-genericness dissuades us from our finding that, under the record before us, the term "steelbuilding.com" is clearly generic.

Descriptiveness

For the sake of completeness, we now address the issue of whether applicant's term STEELBUILDING.COM is merely descriptive, in the event that applicant's term is subsequently determined to not be generic. "As often stated, genericness is the ultimate in descriptiveness." In re Central Sprinkler Co., 49 USPQ2d 1194, 1199 (TTAB 1998). See also Ginn, 228 USPQ at 530. For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980); In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service").

We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 200 USPQ at 218. See also MBNA, 67 USPQ2d at 1783 ("Board correctly found MBNA's emphasis on the regional theme through marketing promotions and picture designs provides circumstantial evidence of how

the relevant public perceives the marks in a commercial environment").

Applicant argues that "[w]hile the words 'steel building' characterize one product sold by Applicant, it is not the primary feature of Applicant's services, nor does it describe all buildings constructed of metal ... nor roofing systems." Applicant's Brief at 11. To be "merely descriptive," a term need only describe a single significant quality or property of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). While we are not sure exactly what applicant means when it says that "steel building" is not the primary feature of applicant's services, applicant's own website lists as its first feature: "Design your steel building with our advanced interactive system." One of applicant's advertisements contains the following information: "E-Commerce website offers instant pricing and online sales of steel buildings, mini storage systems, building accessories, component parts and all-steel homes." An article that applicant submitted contains the following sentence: "Describing itself as 'the first true e-commerce supplier of steel buildings,' Steelbuilding.com promises..." We, frankly, are at a loss to

understand that if the retail sale of steel buildings is not the primary feature of applicant's services, what is. However, whether steel buildings are the "primary feature" of applicant's services is not determinative, because they are at least a significant feature of applicant's services. In re Pencils, Inc., 9 USPQ2d 1410, 1411 (TTAB 1988) ("We agree with applicant that the sale of pencils is not the central characteristic of applicant's services.

Nevertheless, pencils are significant stationery/office supply items that are typically sold in a store of applicant's type, that is, a stationery and office supply store. While applicant's stores may carry a variety of products, pencils are one of those products, and, thus, the term 'pencils' is merely descriptive as applied to retail stationery and office supply services"). Accord In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 (TTAB 2002) ("[I]f applicant's mark BONDS.COM is generic as to part of the services applicant offers under its mark, the mark is unregistrable").

In addition, when we consider the issue of descriptiveness, we must consider not only the term "steel building" but also the ".com" feature and the mark in its entirety. As discussed previously, the addition of a

".com" to an unregistrable term does not convert the term into registrable mark.

When a descriptive term is combined with a top level domain name, the combined term simply means that services associated with the generic term are performed in an online or "e-commerce" environment. Therefore, applicant's combined term is also merely descriptive. In re Microsoft Corp., 68 USPQ2d 1195, 1203 (TTAB 2003) ("The combination of the specific term and TLD at issue, i.e., OFFICE and .NET, does not create any double entendre, incongruity, or any other basis upon which we can find the composite any more registrable than its separate elements. The combination immediately informs prospective purchasers that the software includes 'office suite' type software and is from an Internet business, i.e., a '.net' type business").

We conclude that applicant's term is, at least, merely descriptive for applicant's computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems.

Acquired Distinctiveness

We now address the last issue, acquired distinctiveness. If applicant's mark is generic then evidence of acquired distinctiveness cannot establish the registrability of the term. In re Northland Aluminum

Products, Inc., 777 F.2d 1556, 227 USPQ 961, 964 (Fed. Cir. 1985). If subsequently it should be determined that applicant's term is descriptive but not generic, it is important that we discuss the evidence on this issue. Applicant has the burden of proving that its mark has acquired distinctiveness. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954)("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988).

We begin here with a discussion of applicant's Internet poll. See Hockersmith declaration (¶¶ 12 and 13). This evidence refers to a poll at a website named MetalBuilding.com. Apparently, a regular feature of this website is a poll question normally about current events or sports ("Who will win Election 2000?", "Who will win the Super Bowl?", "Who will win the NBA title"?, and "Is now a good time to invest in the stock market?"). In between these questions, visitors were asked "Which one of the following building manufacturers is the most recognizable?" Mr. Hockersmith points out that when applicant was compared

to "Package Industries," "Parkline," "Steelox," and "US Structures," it was by far "the most recognizable."

"There is no provision in the Trademark Rules of Practice concerning the applicability of the Federal Rules of Evidence to ex parte appeals before the Board." TBMP § 101.02. However, the fact that the Federal Rules do not apply does not mean that we do not evaluate evidence critically. See In re American Olean Tile Co., 1 USPQ2d 1823, 1824 n.2 (TTAB 1986) ("The third-hand report of a statement made by an unknown representative of registrant is inadmissible hearsay which can be accorded no probative value in our determination of the appeal").

Applicant's evidence of the results of an Internet poll is devoid of any foundation that would convince us of its reliability. We do not know how many people participated, whether any attempt was made to prevent people from voting more than once, whether any attempt was made to prevent interested parties, i.e. representatives, friends, or associates of applicant from participating, or even if the participants were prospective purchasers of retail services involving pre-engineered metal buildings. The Internet poll is not even remotely similar to a trademark survey. It should be taken with the same degree of seriousness as investors would take the responses to the

poll's questions on the economy as a basis for making investment decisions ("Is now a good time to invest?" and "Are we entering a recession?").

Concerning the specific question (Which of the following **metal building** manufacturers is the most recognizable?), it appears that of the five choices (Package Industries, Parkline, Steelox, Steelbuilding.com, and US Structures), applicant's own name "**steelbuilding.com**" uniquely provides all the information a person who was guessing needs to answer the question.

We have also considered the declarations from individuals who describe themselves as being familiar with companies offering "pre-fabricated steel buildings." See Holder and Ginn declarations. We also have considered the emails from customers. Again here, these customers often recognize the genericness of the basic term. Kittler email ("I have researched over twenty other steel building manufacturers"); Fisher email ("When I choose to buy a steel building"). We find that these letters provide some de facto evidence that, occasionally, people may recognize applicant's term as a trademark but much of this evidence may be attributable to domain name recognition.

We also have considered Mr. Hockersmith's declaration concerning how applicant does business, the volume of its

website's hits, and its advertising. This evidence does not show that purchasers recognize applicant's term as a trademark. In re Leatherman Tool Group Inc., 32 USPQ2d 1443, 1450 (TTAB 1994) ("Absent, therefore, anything to link applicant's gross sales of over \$20 million and advertising expenditures of \$200,000, which were generated and spent in connection with its marketing of in excess of one million tools during a nearly ten-year period, with use in contexts which would condition customers to react to or recognize the designation 'POCKET SURVIVAL TOOL' as an indication of source rather than as a description of a category of product, there is no convincing basis for finding that such designation functions other than as a generic name"). Applicant's advertising expenses are at a much smaller level and rely heavily on Internet banner advertisements that directly send potential purchasers searching the terms metal buildings and the like to applicant's site.

In this case, if the terms "steel building" and ".com" are not generic, they are at least highly descriptive. Applicant's burden of demonstrating that its mark has acquired distinctiveness increases as the level of

descriptiveness increases. We find that applicant's evidence falls far short of its burden here.³

CONCLUSION

We agree with the examining attorney that the term STEELBUILDING.COM is merely descriptive and generic for the services recited in the application and that applicant has not demonstrated that it has acquired distinctiveness.

Decision: The refusals to register are affirmed.

³ Applicant has also introduced numerous registrations, which it says "comprise a generic term or word for the identified services or goods together with a '.com' suffix." Supplemental response dated November 14, 2002 at 1. To the extent that applicant is still relying on this evidence, we note that most of these registrations issued or were published prior to the board's precedential decisions in Martin Container and CyberFinancial.Net, which provided some clarification to the examining attorneys on this issue. Furthermore, each trademark case must be decided on its own merits and even "if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). The record in this case provides clear evidence of the genericness of applicant's term.