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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nucor Corporation

Serial No. 74/499,516

Richard S. Shenier of Shenier & O'Connor for Nucor Corporation.

Angela M. Micheli, Trademark Examining Attorney,
Law Office 108 (David E. Shallant, Managing Attorney)

Before Sams, Seeherman and Hanak, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

On March 14, 1994 Nucor Corporation (applicant) filed an application seeking to register HI-TEC in typed capital letters for "steel sheet and strip, and lengths of steel sheet and strip formed into rolls and coils." Applicant claimed that it first used the mark on February 18, 1994.

In her first Office Action, the Examining Attorney refused registration "because the proposed mark merely

describes [applicant's] goods." The Examining Attorney attached approximately ten excerpts of stories from the NEXIS database which purportedly supported her position.

In response, applicant noted that the Examining Attorney had demonstrated "confusion between a product and a process for making the product." Continuing, the applicant explained that "any given grade of steel is the same whether made by old steel mills ... or by modern steel mills employing continuous casting. ... Modern steel mills employ 'high tech' equipment; but the steel produced is identical to and meets the same specifications as that made by old 'low tech' equipment." A review of the Examining Attorney's NEXIS evidence demonstrates that the term "high-tech" does indeed refer to a process for making steel, and not to the steel itself. As applicant explained, "the term 'high-tech' may be descriptive as applied to processes, processing equipment and mills; but as applied to the steel product, it is merely suggestive." Applicant concluded its response by making reference to eight registrations of marks containing the term HI-TEC (or variations thereof) wherein the goods were various steel or metal products and wherein the term HI-TEC was not disclaimed.

In her second and "final" Office Action, the Examining Attorney maintained her refusal on the basis that applicant's mark was merely descriptive of applicant's goods. In so doing, she noted that applicant itself stated that "the term HI-TEC refers to the way the steel is

processed." In addition, the Examining Attorney discussed the merits of applicant's list of eight third-party registrations and noted that "third-party registrations are not conclusive on the question of descriptiveness." The Examining Attorney never objected to the fact that applicant simply listed the registrations and did not make of record copies of the registrations.

Applicant then submitted a request for reconsideration and a proposed amendment to its description of goods which reads as follows: "steel sheet and strip and lengths thereof formed into rolls and coils, all of standard industrial quality." Attached to applicant's request for reconsideration was the declaration of LeRoy C. Prichard, a Vice President of applicant. In his declaration, Mr. Prichard made the following statement: "The term 'high tech' as applied to steels might include such specialty steels as stainless steels, electrical steels, tool steels, and special alloy steels; but it is not descriptive of any particular one." (Emphasis added). Applicant again emphasized that the Examining Attorney was confusing a process for making steel and steel itself. Applicant explained that with regard to the latter, the term HI-TEC was not descriptive of any type of steel, but that to eliminate any doubt whatsoever on this point, applicant was limiting its identification of goods by including the words "all of standard industrial quality." Applicant noted that while certain specialty steels might have the term "high

tech" applied to them, standard industrial quality steel would certainly not have that term applied to it.

In her third office action, the Examining Attorney noted that "applicant states that the goods it manufactures are not of the high-tech variety ... [and thus] the term [HI-TEC], as used by the applicant, is deceptively misdescriptive and unregistrable under Section 2(e)(1)."

Applicant then took an appeal to this Board and filed its appeal brief.

Subsequently, the Examining Attorney requested that the case be remanded to her. The Examining Attorney explained that in her third office action, she raised a new ground of refusal and yet made the refusal to register final. The Examining Attorney stated that she "should have issued a non-final action formally refusing registration on the basis that the mark was deceptively misdescriptive of applicant's goods. This Board granted the Examining Attorney's request for remand.

The Examining Attorney then issued a fourth and final office action refusing registration pursuant to Section 2(e)(1) of the Lanham Trademark Act on the basis that applicant's mark "is deceptively misdescriptive of [applicant's] goods." The Examining Attorney attached additional NEXIS evidence of the same type attached to her first office action, namely, evidence demonstrating that the words "high-tech" and "high-technology" describe a type of process for the manufacture of steel.

Applicant then filed a supplemental brief. The Examining Attorney filed her brief. Finally, applicant filed a reply brief.

The only issue before this Board is whether applicant's mark, as applied to the goods set forth in applicant's amended identification, is deceptively misdescriptive pursuant to Section 2(e)(1) of the Lanham Trademark Act. What is not before this Board is the issue of whether applicant's mark, as applied to the goods set forth in applicant's amended identification, is merely descriptive of said goods. The Examining Attorney explicitly withdrew her refusal to register on the basis of mere descriptiveness. Moreover, because the issue of mere descriptiveness was considered by the Examining Attorney and then the refusal based on this ground was withdrawn, this Board cannot remand the case to the Examining Attorney for reconsideration of her decision to withdraw this ground of refusal.

As the Examining Attorney correctly notes, "the test for deceptive misdescriptiveness has two parts: (1) does the mark misdescribe the goods, and (2) are consumers likely to believe the misrepresentation." (Examining Attorney's brief page 2 citing In re Quady Winery, Inc., 221 USPQ 1213, 1214 (TTAB 1984). The Examining Attorney notes that applicant's own vice-president (Mr. Prichard) stated that "the term 'high-tech' as applied to steels might include such specialty steels as stainless steels, electrical steels, tool steels, and special alloy steels; but it is not

descriptive of any particular one." (Examining Attorney's brief page 4, emphasis added). The Examining Attorney then continues by stating as follows: "The use of the proposed mark on steel products conveys to the relevant purchasing public that applicant's goods are of the variety of steel called high tech. Since the term high tech is used in connection with steel, it is a reasonable step to say purchasers would believe the goods are what they say there are, that is, high tech steel." (Examining Attorney's brief page 5).

We have two problems with the Examining Attorney's approach. First, the only evidence of record which indicates that certain types of steel (as opposed to processes for making steel) might be referred to as "high tech" is the aforementioned statement of Mr. Prichard. However, Mr. Prichard's statement should not be interpreted to mean that the term "high tech" does indeed specify a particular type of steel. Mr. Prichard clearly qualified his comments by noting "that the term 'high tech' ... is not descriptive any particular [type of steel]." Thus, on this particular record, it is debatable as to whether the mark HIGH-TEC is misdescriptive of applicant's "steel sheet and strip and lengths thereof formed into rolls and coils, all of standard industrial quality."

However, even if we assume that the mark HIGH-TEC is misdescriptive of applicant's goods, there is no evidence in the record to support the Examining Attorney's belief that

"it is a reasonable step to say purchasers would believe the goods are what they say they are, that is, high tech steel." (Examining Attorney's brief page 5). Applicant's goods are, obviously, not consumer products. There is no dispute that applicant's goods are purchased only by sophisticated professionals. Even if we assume there is a particular type of steel known as "high tech," there is no evidence that such sophisticated professional purchasers -- upon seeing the mark HIGH-TEC on steel of standard industrial quality -- would actually believe that said steel is "high tech." Rather, it is more likely that such sophisticated professional purchasers would view the use of the mark HI-TEC on standard industrial quality steel to be but mere puffery.

Decision: The refusal to register on the basis that applicant's mark is deceptively misdescriptive when applied to the goods as set forth in applicant's amended identification of goods is reversed.

J. D. Sams

E. J. Seeherman

E. W. Hanak
Administrative Trademark
Judges, Trademark Trial
and Appeal Board