

TTAB



08-13-2001

U.S. Patent & TMO/TM Mail Rcpt Dt. #76

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

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In re application of:)
Tickets.com, Inc.)
Serial No.:	75/870,898)
Filed:	December 13, 1999)
For:	TICKETS@HOME)
-----)

01 AUG 19 AM 9:53

APPLICANT'S OPENING APPEAL BRIEF

Hon. Asst. Comm. For Trademarks
United States Patent and Trademark Office
Box: TTAB
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

I. INTRODUCTION

Because Applicant submitted a Request for Reconsideration simultaneously with its Notice of Appeal, the instant appeal should be suspended pending a decision on the Request for Reconsideration. Unfortunately, due to Patent and Trademark Office error, Applicant's appeal has not yet been suspended and Applicant has been informed that its opening appeal brief is still due sixty days from the date it filed its Notice of Appeal. Accordingly, Applicant submits its opening appeal brief, in which it requests that the Examining Attorney's objection to the subject

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mark as descriptive be overturned and that Applicant's mark proceed to registration on the Principal Register. Applicant nonetheless requests that its appeal be suspended and that the Examining Attorney be permitted to render a decision regarding Applicant's Request for Reconsideration.

II. STATEMENT OF FACTS

On December 13, 1999, Applicant filed the subject Application with the Patent and Trademark Office. The Application covers "online ticketing services, namely, online arranging for tickets for shows and other entertainment events via global computer network."

On May 26, 2000, the Examining Attorney issued an Office Action, objecting to Applicant's mark as descriptive of the covered services. Applicant timely responded to the first Office Action by voluntarily disclaiming the prefix portion of its mark, "TICKETS", and by arguing that the suffix portion of the mark – "@HOME" – is non-descriptive of Applicant's services. In so arguing, Applicant cited a number of other "@HOME" marks which have been registered or accepted for registration on the Principal Register and which cover goods or services available online.

Less than one month after Applicant submitted its response, the Examining Attorney issued a second Office Action, maintaining his descriptiveness objection and suggesting that Applicant amend its Application to allege use and thereby seek registration on the Supplemental Register. Applicant responded by filing a Notice of Appeal and simultaneously submitting a Request for Reconsideration.

It is Applicant's understanding that such should have resulted in suspension of the appeal pending a decision by the Examining Attorney on the Request for Reconsideration. Applicant has been communicating with the Trademark Trial and Appeal Board regarding the need for

suspension but, as the appeal has not yet been officially suspended, Applicant submits herewith its opening appeal brief to prevent the subject Application from being abandoned due to failure to file the opening appeal brief.

III. DESCRIPTIVENESS REFUSAL

The Examining Attorney refused registration on the Principal Register on the ground that the proposed mark is descriptive of the covered services. The Examining Attorney indicated, however, that Applicant may amend the subject Application to seek registration on the Supplemental Register. Because Applicant's mark is not descriptive of its services, Applicant requests that the Examining Attorney's Section 2(e) objection be overturned and that Applicant's mark be accepted for registration on the Principal Register.

A. The Suffix Portion of Applicant's Mark – @HOME – Does Not Describe Applicant's Services

A mark is deemed merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods or services. *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986). The Examining Attorney considered Applicant's mark descriptive because he believed that the term TICKETS@HOME immediately informed and merely described the salient feature of ticketing services which afford the user the capability of printing tickets online at home. Applicant will demonstrate, however, that, as applied to its services, the word @HOME is suggestive, rather than descriptive. As such, Applicant's mark is entitled to registration on the Principal Register.

Applicant is seeking to register the mark TICKETS@HOME for use in connection with the following services: "online ticketing services, namely arranging for tickets for shows and other entertainment events via global computer network." Applicant is not seeking to register said mark for services which enable users to print physical tickets to events or shows on their

computer printers. Because Applicant voluntarily disclaimed the word TICKETS apart from the mark as a whole in its response to the first Office Action, only the term @HOME is at issue here. That term does not describe the foregoing services or any aspect of those services.

It is the ultimate consumer reaction which determines whether a mark is merely descriptive. In this technology-driven time, consumers have learned not to interpret the term @HOME literally. Rather, to consumers, the term @HOME connotes goods or services that implicate computers or the Internet. The growing number of @HOME marks on the Principal Register, or approved by the Patent and Trademark Office for registration on the Principal Register, is indicative of this trend. *See, e.g.*, Reg. No. 2,211,491 (@HOME for "providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information"); Reg. No. 2,001,224 (@HOME for "entertainment in the nature of an on-going television program in the field of computer news, education and information."); App. Serial No. 74/654,927 (@HOME for "cable television transmission services" – Notice of Allowance issued for Principal Register); App. Serial No. 75/770,937 (PRINT@HOME for "electronic transmission of printed information to consumers via computer terminals" – Notice of Allowance issued for Principal Register); App. Serial No. 75/774,346 (MEALS@HOME for "ordering services for the purchase of consumer products and services via telephone, facsimile, or online over a global area network" – Notice of Allowance issued for Principal Register); and App. Serial No. 76/176,362 (CONNECTED@HOME for "computers and computer hardware" – approved for publication for Principal Register).¹ Accordingly, consumers might reasonably understand the term @HOME to indicate services that are available over or involve the Internet.

¹ Applicant submits herewith print outs from the Patent and Trademark Office online database reflecting the cited registrations or applications. Duplicate copies of these print outs have been submitted to the Examining Attorney as a supplement to the Request for Reconsideration.

They would not, by contrast, assume that such services are available only or primarily from one's home.

Moreover, the term @HOME does not describe Applicant's services as it is simply incidental that said services may be accessed from one's home. Indeed, Applicant's services are available to consumers at any location from which the Internet may be accessed. Given today's technology, consumers are now able to and do access the Internet, and therefore Applicant's services, from virtually anywhere. Consumers routinely log on to Applicant's web site from the office, school, library, airplane, train, boat and car using desktop computers, laptop computers, cellular telephones, personal digital assistants, and an ever-expanding myriad of other devices.

Neither does the mark describe the manner in which tickets are distributed. Currently, consumers arranging for tickets on Applicant's web site cannot print or otherwise instantly access those tickets from their computer terminals. Rather, the physical tickets must either be picked up by the purchaser at a "Will Call" booth for the relevant event or show or be shipped to the purchaser via a selected shipping method. Thus, tickets are not literally available at one's home, rendering the term @HOME non-descriptive of the relevant services.

Because the average consumer would not readily connect the term @HOME with online services featuring the sale of tickets, the suffix portion of Applicant's mark does not merely describe the indicated services. As such, Applicant's mark is entitled to registration on the Principal Register.

B. Applicant's Mark Clearly is Suggestive of the Identified Services

"A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods [and services]. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [and

services]." J. Thomas McCarthy, *Trademarks and Unfair Competition*, 4th Ed., §11:67, pgs. 110-11 (1996) (citing *Stix Prod. Inc. v. United Merchants and Manufacturers, Inc.*, 295 F.Supp. 479, 160 U.S.P.Q. 777 (SDNY 1968)). Under this test, the suffix portion of Applicant's mark – @HOME – is clearly suggestive of the indicated services.

There is no question that the term @HOME does not readily convey to the relevant consuming public the online ticketing services described above. Rather, thought and imagination are required to determine that Applicant provides online services through which consumers arrange for tickets to shows and other entertainment events and then obtain physical tickets by visiting the "Will Call" booth at the relevant show or event or by having the physical tickets delivered to them. The mark simply suggests that Applicant offers some form of goods or services that implicate computers or computer networks. Accordingly, the suffix portion of Applicant's mark is, at the very least, suggestive of the relevant services.

Finally, it is well settled that any doubt as to descriptiveness should be resolved in favor of the Applicant. *In re Noble Co.*, 225 U.S.P.Q. 749-50 (TTAB 1985). If there is any reservation as to whether Applicant's mark is merely descriptive of the relevant services, the mark should be passed to publication and ultimately registered. Applicant respectfully requests that the Examining Attorney's final refusal of registration on the Principal Register be overruled and that Applicant's mark be accepted for registration on the Principal Register.

IV. CONCLUSION

The dominant portion of Applicant's mark – @HOME – neither describes Applicant's services nor a character or quality of those services. Because the subject mark is not merely

descriptive but is instead suggestive, it is entitled to registration on the Principal Register.

Dated: August 13, 2001

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By



Michelle MacKenzie
Attorneys for Applicant
TICKETS.COM, INC.

Four Embarcadero Center
17th Floor
San Francisco, CA 94111
Tel: (415) 434-9100



U.S. Trademark Electronic Search System (TESS)

TESS was last updated on Sat Aug 11 04:24:39 EDT 2001

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM HELP

Logout Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark	@HOME
Goods and Services	IC 042. US 100 101. G & S: providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information. FIRST USE: 19960900. FIRST USE IN COMMERCE: 19961100
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75136537
Filing Date	July 19, 1996
Filed ITU	FILED AS ITU
Published for Opposition	April 1, 1997
Registration Number	2211491
Registration Date	December 15, 1998
Owner	(REGISTRANT) athome.net CORPORATION CALIFORNIA 385 Ravendale Drive Mountain View CALIFORNIA 94043
Attorney of Record	Sally M. Abel
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Typed Drawing

Word Mark	@HOME
Goods and Services	IC 041. US 100 101 107. G & S: entertainment in the nature of an on-going television program in the field of computer news, education and information. FIRST USE: 19940815. FIRST USE IN COMMERCE: 19940815
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74724128
Filing Date	August 28, 1995
Published for Opposition	June 25, 1996
Registration Number	2001224
Registration Date	September 17, 1996
Owner	(REGISTRANT) PCTV, Inc. CORPORATION NEW HAMPSHIRE 322 North Main Street Newport NEW HAMPSHIRE 03773
Attorney of Record	Steven Markiewicz
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Typed Drawing

Word Mark	@HOME
Goods and Services	IC 038. US 100 101 104. G & S: cable television transmission services
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74654927
Filing Date	April 3, 1995
Filed ITU	FILED AS ITU
Published for Opposition	April 2, 1996
Owner	(APPLICANT) athome.net CORPORATION CALIFORNIA 385 Ravendale Drive Mountain View CALIFORNIA 94043
Attorney of Record	Sally M. Abel
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Thank you for your request. Here are the latest results from the TARR web server.

Serial Number: 74654927

Registration Number: (NOT AVAILABLE)

Mark (words only): @HOME

Current Status: A request for the fifth extension of time to file a statement of use has been granted.

Date of Status: 2001-02-13

Filing Date: 1995-04-03

The Notice of Allowance Date is: 1998-07-07

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMEG Law Office 104

CURRENT APPLICANT(S)/OWNER(S)

1. athome.net

GOODS AND/OR SERVICES

cable television transmission services

PROSECUTION HISTORY

2001-02-13 - Extension 5 granted

2001-01-05 - Extension 5 filed

2000-08-28 - Extension 4 granted

2000-07-06 - Extension 4 filed

2000-03-04 - Extension 3 granted

1999-12-30 - Extension 3 filed

1999-08-04 - Extension 2 granted

1999-07-07 - Extension 2 filed

1999-01-28 - Extension 1 granted

1999-01-06 - Extension 1 filed
1998-09-11 - Divisional processing completed
1998-08-24 - Divisional request received
1998-07-07 - Notice of allowance - mailed
1998-05-08 - Opposition terminated for Proceeding
1998-05-08 - Opposition dismissed for Proceeding
1996-06-27 - Opposition instituted for Proceeding
1996-04-15 - Extension of time to oppose - Filed
1996-04-02 - Published for opposition
1996-03-01 - Notice of publication
1996-01-05 - Approved for Pub - Principal Register (Initial exam)
1995-10-17 - Response to office action
1995-09-05 - Non-final action mailed
1995-08-30 - Case file assigned to examining attorney

CONTACT INFORMATION

Attorney of Record: Sally M. Abel

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FENWICK & WEST
TWO PALO ALTO SQUARE
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PRINT@HOME

Word Mark	PRINT@HOME
Goods and Services	IC 038. US 100 101 104. G & S: ELECTRONIC TRANSMISSION OF PRINTED INFORMATION TO CONSUMERS VIA COMPUTER TERMINALS
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	241725
Serial Number	75770937
Filing Date	August 9, 1999
Filed ITU	FILED AS ITU
Published for Opposition	September 12, 2000
Owner	(APPLICANT) HERITAGE PRESERVATION CORPORATION CORPORATION SOUTH CAROLINA 145 N. Church Street Spartanburg SOUTH CAROLINA 29306
Attorney of Record	Ronald B. Coolley
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Serial Number: 75770937

Registration Number: (NOT AVAILABLE)

Mark

PRINT@HOME

(words only): PRINT@HOME

Current Status: A request for the first extension of time to file a statement of use has been granted.

Date of Status: 2001-06-11

Filing Date: 1999-08-09

The Notice of Allowance Date is: 2000-12-05

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMO Law Office 110

CURRENT APPLICANT(S)/OWNER(S)

1. HERITAGE PRESERVATION CORPORATION

GOODS AND/OR SERVICES

ELECTRONIC TRANSMISSION OF PRINTED INFORMATION TO CONSUMERS VIA
COMPUTER TERMINALS

PROSECUTION HISTORY

2001-06-11 - Extension 1 granted

2001-05-24 - Extension 1 filed

2000-12-05 - Notice of allowance - mailed

2000-09-12 - Published for opposition

2000-08-11 - Notice of publication

2000-07-11 - Approved for Pub - Principal Register (Initial exam)

2000-05-30 - Response to office action

1999-12-23 - Non-final action mailed

1999-12-17 - Case file assigned to examining attorney

CONTACT INFORMATION

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Typed Drawing

Word Mark	MEALS@HOME
Goods and Services	IC 035. US 100 101 102. G & S: ordering services for the purchase of consumer products and services via telephone, facsimile, or online over a global computer network
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75774346
Filing Date	August 12, 1999
Filed ITU	FILED AS ITU
Published for Opposition	January 23, 2001
Owner	(APPLICANT) E2 Partners W.R. Smith II and James Brimhall, both U.S. citizens GENERAL PARTNERSHIP TEXAS 3020 Issaquah-Pine Lake Road Suite 484 Issaquah WASHINGTON 98029
Attorney of Record	Jeffrey M. Becker
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Serial Number: 75774346

Registration Number: (NOT AVAILABLE)

Mark (words only): MEALS@HOME

Current Status: Opposition period completed, a Notice of Allowance has been issued.

Date of Status: 2001-04-17

Filing Date: 1999-08-12

The Notice of Allowance Date is: 2001-04-17

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMO Law Office 111

CURRENT APPLICANT(S)/OWNER(S)

1. E2 Partners

GOODS AND/OR SERVICES

ordering services for the purchase of consumer products and services via telephone, facsimile, or online over a global computer network

PROSECUTION HISTORY

2001-04-17 - Notice of allowance - mailed

2001-01-23 - Published for opposition

2000-12-22 - Notice of publication

2000-09-30 - Approved for Pub - Principal Register (Initial exam)

2000-07-12 - Response to office action

2000-01-11 - Non-final action mailed

2000-01-10 - Case file assigned to examining attorney

1999-12-28 - Case file assigned to examining attorney

1999-12-28 - Case file assigned to examining attorney

CONTACT INFORMATION

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Word Mark CONNECTED@HOME
Goods and Services IC 009. US 021 023 026 036 038. G & S: computers and computer hardware
Mark Drawing Code (1) TYPED DRAWING
Serial Number 76176362
Filing Date December 5, 2000
Filed ITU FILED AS ITU
Owner (APPLICANT) PeoplePC, Inc. CORPORATION DELAWARE 100 Pine Street, Suite 1100 San Francisco CALIFORNIA 94111
Attorney of Record JOANNA L SACAVICTH
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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Serial Number: 76176362

Registration Number: (NOT AVAILABLE)

Mark (words only): CONNECTED@HOME

Current Status: Final review prior to publication has been completed, application will be published for opposition.

Date of Status: 2001-07-03

Filing Date: 2000-12-05

The Information will be/was published in the Official Gazette on 2001-08-14

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMEG Law Office 106

CURRENT APPLICANT(S)/OWNER(S)

1. PeoplePC, Inc.

GOODS AND/OR SERVICES

computers and computer hardware

PROSECUTION HISTORY

2001-07-25 - Notice of publication

2001-04-20 - Approved for Pub - Principal Register (Initial exam)

2001-04-17 - Case file assigned to examining attorney

CONTACT INFORMATION

Attorney of Record: JOANNA L SACAVICTH

Address:

JOANNA L SACAVICTH
GRAY CARY WARE & FREIDENRICH LLP
400 HAMILTON AVE
PALO ALTO CA 94301-1825
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Maria Mares