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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re XM Satellite Radio Inc., assignee of XM Satellite
Radio Holdings, Inc.

Serial No. 76/002,802

Cynthia D. Greer and Nancy S. Lapidus of Shaw Pitman LLP
for XM Satellite Radio Inc.

Chrisie Brightmire King, Trademark Examining Attorney, Law
Office 103 (Mike Hamilton, Managing Attorney).

Before Seeherman, Hanak and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

SM Satellite Radio Inc., assignee of SM Satellite
Radio Holdings, Inc., the original applicant, has appealed
from the final refusal of the Trademark Examining Attorney
to register REAL JAZZ for "entertainment services, namely,
providing audio programs featuring music, sports, talk,
news and data via satellite and via a global communication

network."¹ Although applicant has offered a disclaimer of JAZZ, registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services.

Applicant and the Examining Attorney filed appeal briefs;² applicant did not request an oral hearing.

The Examining Attorney asserts that REAL JAZZ is merely descriptive of applicant's services because it describes a significant feature of them, specifically, the type of music being transmitted.

In support of her position, the Examining Attorney has submitted excerpts from a large number of articles taken from the NEXIS database, including the following:³

¹ Application Serial No. 76/002,802, filed March 17, 2000. The application was based on an asserted intention to use the mark in commerce; during the course of prosecution, applicant submitted an Amendment to Allege Use claiming first use and first use in commerce as of September 25, 2001.

² With its brief applicant submitted an updated version of a web site that was made of record by the Examining Attorney in her action denying applicant's request for reconsideration, to show that Net Radio Live ceased business on December 31, 2002. Although the proper procedure to make this evidence of record would have been to file a request for remand, given that this is just an updated version of the Examining Attorney's evidence, and that the Examining Attorney has raised no objection thereto, we have considered this material.

³ With the first Office action, the Examining Attorney submitted Stories No. 1-10, 100-110 and 200-210 of the 375 retrieved from her search. Applicant points out that many of these articles do not show descriptiveness of REAL JAZZ. We agree. However, it is clear that the Examining Attorney did not submit all the articles because she believed they evidenced descriptiveness; rather, she

...1938 than it is today, at least one conceit in the music's history was already in place. It was the notion that real jazz was something apart from mass bourgeois culture and that its audience was a smaller but higher community of true believers....

...They became the first generation of jazz critics, theoreticians and intellectuals. Among their missions was to distinguish between "real" jazz and the knock-off variety. The basic assumption that there was a "real" jazz served a couple of solidifying purposes....

...But in 1938 what was real jazz, whose recorded history was only 21 years old? The future was still vague, so many decided that real jazz was what it had been before the concessions to swing....

"Down Beat," October 1, 2001

...decision to provide listeners in the KUOR area with straight-ahead jazz—real jazz—and blues on a 24-7 basis....

"The Press-Enterprise," August 31, 2001

Fans of "real jazz," as its devotees might term it, were treated to two consecutive displays of the top-shelf stuff Saturday....

"St. Petersburg Times," October 22, 2001

Mr. Marsalis held up bebop—then a 40-year-old genre—as real jazz.

"The Dallas Morning News," May 5, 2000

was attempting to show that she had not cherry-picked only the articles that were favorable to her position. In the future, it would be acceptable for the Examining Attorney to eliminate the "noise" articles, those from foreign publications, and those which are for different goods or services (in this case, the articles relating to the Utah Jazz basketball team) and still state that the articles which are submitted are representative of those which were retrieved.

Real jazz, according to Sherrell,
represents the classics. It's swinging
be-bop, blues-based main-stream,
straight-ahead jazz music....
"Chicago Defender," October 8, 2001

"(Ellington's suite) is written in a
real jazz style, and it gives the
instruments a chance for improvisation,
but you still feel the flavor...
"The Deseret News," December 2, 2001

"His efforts are one reason we've been
able to keep real jazz happening in
Tampa."
"St. Petersburg Times," May 11, 2001

Real jazz fans tend to be
understandably vexed by the huge,
misleading phenomenon known as "smooth
jazz."
"Los Angeles Times," December 15, 2000

Reading metropolitan newspapers and
periodicals and engaging in comparison,
my conclusion is that this masterful
critic, a proponent of the real jazz,
has few, if any, peers.
"The Columbus Dispatch," May 4, 2000

The remainder of the program consists
of "real" jazz, pieces written for
late-night bar improvs; blues, rags,
and mood pieces with echoes of Joplin,
Ellington, Ravel, and...
"American Record Guide," May 1, 2000

In recent years, WNOP-AM returned to
its roots as "Real Jazz 740" under
General Manager Mark Stevens....
"The Cincinnati Enquirer," December 20,
2000

...Armstrong, Charlie Parker, Dizzie Gillespie and Coleman Hawkins in a big band format."

Says Plumleigh, "it's the real jazz that musicians really appreciate."

"The Recorder," April 27, 2000

Headline: Pop Music Review; St. Germain Shows Range in L.A. Debut

Maybe it will steer fans toward some real jazz shows.

"Los Angeles Times," December 15, 2000

...irony they ignored, they chose Armstrong—the very soloist who blew apart old-style New Orleans polyphony, their idea of "pure" or "real" jazz. By 1947 Satchmo reluctantly abandoned his eighteen-piece outfit for the All Stars, a New Orleans-style....

"The Nation," November 27, 2000

Exline said there are still several formats that aren't available in Owensboro. "We don't have a real jazz station," he said. "No true alternative rock station. And we don't have a good bluegrass station."

"Messenger-Inquirer," May 9, 2000

In addition to the NEXIS evidence, the Examining Attorney submitted excerpts from various websites.⁴ They include the following, taken from the website of WBEE 1570

AM:

What is Real Jazz?

Our Definition:

Real Jazz music is the uncompromised and unmistakened sounds of swinging blues-based music. Real Jazz music

⁴ We have not considered the summary of the first ten results retrieved by the Google search, as they are taken out of context, and too truncated to be of any probative value.

must also embody the simple but most important element improvisation.

www.realjazzmusic.com

The test for determining whether a mark is merely descriptive has been set out in both applicant's and the Examining Attorney's briefs. A mark is merely descriptive if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. It does not have to describe every one of these. It is enough if it describes a single, significant quality, feature, function, etc. Moreover, the question is not decided in a vacuum but in relation to the goods on which, or the services in connection with which, it is used. In re Venture Lending Associates, 226 USPQ 285, 286 (TTAB 1985).

There is no question that the term JAZZ per se is merely descriptive of applicant's services. Applicant has explained that it provides 100 channels of digital programming, including music, which is delivered to cars and homes via satellite on a subscription basis. Applicant uses the mark REAL JAZZ for its "jazz channel 'from the 20s to today.'" Brief, p. 14 Applicant's disclaimer of the word JAZZ in its mark is a further acknowledgement that JAZZ describes a feature of its services.

However, applicant contends that the mark as a whole, REAL JAZZ, is not merely descriptive of its services, asserting that the Examining Attorney has failed to demonstrate that REAL JAZZ identifies a genre of music.

The problem with applicant's position is that the Examining Attorney is not required to demonstrate that REAL JAZZ is the name of a category or genre of music. As the Examining Attorney explained in her brief, she is not asserting that REAL JAZZ is a generic term, only that it is merely descriptive of applicant's services.

Having reviewed the evidence of record, we cannot say with certainty that "real jazz" is used to describe a particular style of jazz music. There is certainly evidence that indicates that this is the case. For example, articles indicate that "real jazz" is a term for what is also known as be-bop, or "straight-ahead" jazz; or "pure" jazz; or jazz music before the influence of swing. It is also not "smooth" jazz. However, because the word "real" has meanings such as "true" and "good," the term REAL JAZZ in the various NEXIS articles may also be considered to have this meaning, rather than referring to a particular style or genre.

We need not decide that question, however, because we find that REAL JAZZ is a merely descriptive term for

applicant's services even if it is not the name of a category or genre of music. As applicant itself acknowledges, "real" has a laudatory significance when paired with "jazz." In its brief, applicant characterizes the use of "real" paired with "jazz" in the articles as "an adjective meaning authentic and genuine, which is used to describe jazz music." Brief, p. 5. When the laudatorily descriptive term meaning "authentic" and "genuine" is combined with the descriptive term "jazz" in the phrase REAL JAZZ, and used in connection with applicant's identified services, it immediately conveys to consumers that they will find authentic and genuine jazz music on applicant's audio programs. Thus, the mark is merely descriptive.

Applicant points to certain third-party registrations for "REAL" marks which were registered on the Principal Register without resort to Section 2(f), e.g., REAL GOSPEL ("gospel" disclaimed), REAL RADIO ("radio" disclaimed), BOSTON'S REAL ALTERNATIVE ("Boston's" and "alternative" disclaimed), REAL ROCK RADIO ("rock radio" disclaimed) and REAL MUSIC FROM REAL ARTISTS, all for radio broadcasting services; and MAI CRAMER'S REAL BLUES ("blues" disclaimed) for production of radio programs featuring blues music. Applicant contends that if these marks were sufficiently

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distinctive for registration, then applicant's mark should be registered as well.

We think there are significant differences in the commercial impressions of several of these marks, in particular, REAL RADIO, REAL MUSIC FROM REAL ARTISTS and the double entendre of BOSTON'S REAL ALTERNATIVE, such that their acceptance on the Principal Register has no bearing on our decision herein. More importantly, the Court of Appeals for the Federal Circuit has made it clear, when a similar argument was raised in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001), even if some prior registrations had some characteristics similar to applicant's mark, the USPTO's allowance of such prior registrations does not bind the Board.

Moreover, in this case we have evidence of a third-party registration, Registration No. 2,454,877, for radio broadcasting services in which the identical term, REAL JAZZ, was disclaimed, thus indicating the descriptive nature of this phrase. There is also evidence in the NEXIS excerpts that third parties use the term REAL JAZZ as a descriptive element in their respective names. See, for example, "The John Scofield 'Real Jazz' Project," used in connection with jazz performances ("SF Weekly," May 16, 2001). If applicant were to obtain a registration for REAL

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JAZZ, that would certainly hinder competitors, and particularly the owner of Registration No. 2,454,877 from using its mark which contains the disclaimed, descriptive term.

Decision: The refusal of registration is affirmed.