

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB NOV. 10, 98
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Roger Nierenberg

Serial No. 75/152,511

Ira C. Edell of Epstein, Edell & Retzer for Roger
Nierenberg

Steven R. Foster, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney)

Before Seeherman, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Roger Nierenberg has applied to register THE MUSIC
PARADIGM as a service mark for "educational services,
namely, conducting classes, seminars, and workshops for
training executives, employees, and the like to improve

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productivity and efficiency."¹ Registration has been refused by the Trademark Examining Attorney 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 has appealed. Both applicant and the Examining Attorney filed briefs, and applicant filed a reply brief. An oral hearing was not requested.

It is the Examining Attorney's position that THE MUSIC PARADIGM describes a significant aspect of applicant's services, in that it "describes the manner in which the services are provided, i.e., through the use of music as a paradigm." Brief, p. 2. In support of his position the Examining Attorney has made of record dictionary definitions showing "paradigm" as meaning "example, pattern; esp: an outstandingly clear or typical example or archetype"² and "an example serving as a model; pattern."³ He has also submitted the following three excerpts taken from the NEXIS database:

...classical music concerts are perfect business paradigms: "The CEO, as the conductor, is in constant danger of

¹ Application Serial No. 75/152,511, filed August 19, 1996 and asserting first use on June 4, 1995 and first use in commerce on July 26, 1995.

² Webster's New Collegiate Dictionary, © 1979.

³ Random House Unabridged Dictionary, 2d ed., © 1987.

being too authoritative, of forcing his will on the players and sapping them of creativity..."

"The Financial Times Limited,"
November 2, 1996;⁴

Body Play combines innovative touch techniques and music and movement to create a paradigm for social interaction.

"The Tennessean," September 2, 1995;
and

Headline: The paradigm of jazz;
improvising for customer satisfaction
in technical communication industry;
Customer Satisfaction: The Quest for
Quality

Body: Taking advantage of Professor
Rowland's expertise in music, let's
consider how the paradigm of a jazz
band can help with creating
communications that respond in the best
possible way to our customers."

"Technical Communication," May 1993.

The Examining Attorney also points to applicant's own specimens in an effort to show that applicant uses music as a paradigm in connection with its educational services.

The specimen, which appears to be a promotional flyer,

includes the following statements:

The Music Paradigm is a powerful interactive learning environment that dramatizes issues of communication, team work and leadership skills. Participants are seated right in the middle of a symphony orchestra, where they not only see and hear, but also

⁴ The Examining Attorney has recognized that this article is from a foreign publication, and thus its evidentiary value is limited in terms of showing that the public has been exposed to it.

feel the group dynamics of making music together.

The Music Paradigm is a group experience; your people participate all together. They feel the energy and power of the music. They watch the musicians at close range, and understand how effectively and quickly musicians communicate.

It is well-established that a term is merely descriptive if, as applied to the goods or services in question, it describes an ingredient, quality, characteristic, function, feature, composition, purpose, attribute, use, etc. of such goods or services. See **In re Engineering Systems Corp.**, 2 USPQ2d 1075 (TTAB 1986) and cases cited therein. Applicant asserts that a test for determining whether a mark is merely descriptive is an "imagination" test, by which "a consumer of the goods/services, if confronted with the mark in question out of context, must have at least some general recognition of the nature of the goods/services without substantial imagination, thought or perception." Brief, p. 3. Applicant has provided no case support for this assertion, and his position is contradicted by the case law. As the Board stated in **In re Engineering Systems Corp.**, supra at 1076, "the question of whether a particular term is merely descriptive must be determined not in the abstract, but in

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relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters goods bearing the mark in the marketplace." See also, **In re Abcor Development Corporation**, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Applicant has acknowledged that his services include "immersing clients in an orchestral setting to permit observation of the cooperation and leadership therein and how it enhances productivity and efficiency." Brief, p. 2. We have no doubt that "orchestra paradigm" would be descriptive of a characteristic of applicant's services. However, after carefully reviewing all the evidence which is of record, we cannot say that THE MUSIC PARADIGM is merely descriptive of applicant's educational services which include immersion in an orchestra to observe how an orchestra makes music. The paradigm involved is that of an orchestra working together to make music, not the making of music per se. As applicant's promotional material explains, "The prototype of the modern organization is the symphony orchestra. Each of the musicians in the orchestra is a specialist, and a high-grade one. Yet by itself the tuba doesn't make music; only the orchestra can do that."

Similarly, the relevant NEXIS excerpts relate to the concept of a group of musicians, whether it be in a classical music concert or a jazz band, being the paradigm, not the music per se.⁵

There is a difference between an orchestra and music, and although an orchestra makes music, we think the steps that are required to reason from applicant's THE MUSIC PARADIGM to the characteristic of his services as involving the example of an orchestra working together results in the mark being suggestive and not merely descriptive. As has often been recognized, there is but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness. **In re Recovery, Inc.**, 196 USPQ 830 (TTAB 1977). In this case, we find that applicant's mark falls on the suggestive side of that line.

⁵ We do not agree with the Examining Attorney that the use of the phrase "The paradigm of jazz" as a headline in the third NEXIS excerpt, quoted above, shows that a particular style of music, i.e., the music itself, can be a paradigm. By the very nature of a headline, it may omit words and phrases; it is clear from the text of the article submitted that the paradigm to which the headline refers is that of a jazz band, not jazz music per se.

Similarly, we do not find the second NEXIS article to be persuasive that there is such a concept as a music paradigm. That article only states that music is combined with touch techniques and movement to create a paradigm for social

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interaction. It is not evidence of the descriptiveness of THE MUSIC PARADIGM for applicant's identified services.

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Decision: The refusal of registration is reversed.

E. J. Seeherman

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board