

This Opinion is not a
Precedent of the TTAB

Mailed: February 12, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Lori Allen Enterprises, LLC
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Serial No. 88546889
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Francis John Ciaramella of Francis John Ciaramella PLLC,
for Lori Allen Enterprises, LLC.

David A. Brookshire, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

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Before Lykos, Shaw and Goodman,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Lori Allen Enterprises, LLC (“Applicant”) seeks registration on the Principal Register of the mark SAY YES TO WHAT’S NEXT (in standard characters) for the following goods and services:

Religious books in International Class 16;

Pants; Shirts; Shorts; T-shirts; Tee shirts; Women’s clothing, namely, shirts, dresses, skirts, blouses in International Class 25; and

Entertainment and educational services, namely, the presentation of seminars, workshops and panel discussions, and ongoing television and radio shows all in the field of women aging and how to improve quality of life in the last quarter of life in International Class 41.¹

The Trademark Examining Attorney has refused registration of Applicant's mark under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§ 1051-1053, and 1127 for failure to function as a mark because the applied-for mark "is a commonplace message or expression" "that merely conveys an ordinary, familiar, well-recognized sentiment."²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

I. Failure to Function as a Mark

"Not every designation adopted with the intention that it perform a trademark function necessarily accomplishes that purpose." *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010). Slogans and other terms that are considered to be merely informational in nature, or to be common laudatory phrases or commonly expressed concepts or sentiments that would ordinarily be used in business or in the particular

¹ Application Serial No. 88546889 was filed on July 29, 2019, based upon Applicant's assertion of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Page references to the application record refer to the online database pages of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system.

² Examining Attorney's brief, 8 TTABVUE 4.

trade or industry, are not registrable. *In re Texas With Love, LLC*, 2020 USPQ2d 11290, at *3 (TTAB 2020) (affirming refusal to register TEXAS LOVE for hats and shirts because “it would be perceived not as a source identifier, but instead as a widely-used phrase that merely conveys a well-recognized and commonly expressed concept or sentiment”); *Eagle Crest*, 96 USPQ2d at 1229 (affirming refusal to register “Once a Marine, Always a Marine” for clothing because it would be perceived as an informational slogan “to express support, admiration or affiliation with the Marines”). Derivatives or variations of widely used messages also fail to function as marks if they convey the same or similar type of information or sentiment as the original wording. *In re Melville Corp.*, 228 USPQ 970, 971 (TTAB 1986) (finding BRAND NAMES FOR LESS failed to function as a mark based on evidence of widespread use of similar marketing phrases, noting that “[t]he fact that applicant may convey similar information in a slightly different way than others is not determinative.”).

“A critical element in determining whether a term or phrase is a trademark is the impression the term or phrase makes on the relevant public.” *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998). “[E]vidence of the public’s perception may be obtained from ‘any competent source, such as consumer surveys, dictionaries, newspapers and other publications.’” *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1833 (Fed. Cir. 2015) (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985)). Internet evidence is relevant to show consumer perception. *In re Bayer AG*, 488 F.3d 960, 82

USPQ2d 1828, 1833 (Fed. Cir. 2007). Because there are no limitations to the channels of trade or classes of purchasers of the goods and services identified in the application, the relevant consuming public comprises all potential purchasers of the identified Class 16 and 25 goods and Class 41 services. *See CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983).

“Generally, the failure-to-function refusal is a specimen-based refusal.” Trademark Manual of Examining Procedure (TMEP) § 1202 (October 2018). Applicant filed the application under Section 1(b) as intent-to-use and there are no specimens of use. However, “the examining attorney may issue a failure-to-function refusal for applications based on §1(b), §44, or §66(a) if information in the application record or other available evidence is dispositive of the failure of the relevant matter to function as a mark.” TMEP § 1202.17(c)(ii)(A).

As there is no evidence in the record of Applicant’s actual use, we consider the evidence of record showing how the designation is actually used by others in the marketplace. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (failure to function found where “the marketplace is awash in products that display the term”); *Eagle Crest*, 96 USPQ2d at 1229 (considering specimens and evidence in the record showing how the designation is actually used in the marketplace). “The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark.” *Eagle Crest*, 96 USPQ2d at 1229.

A. Arguments

The Examining Attorney argues that “the applied-for mark SAY YES TO WHAT’S NEXT will not be perceived by the public as a unique source identifying mark because this phrase is widely used by the general public as an affirmation encouraging perseverance and positivity in the face of change.”³ The Examining Attorney submits that “multiple third parties” in a “variety of industries and businesses” use this term or expression as “an affirmation of encouragement to overcome obstacles and embrace change.”⁴

Applicant criticizes the Examining Attorney’s evidence, and points out that the evidence must be overwhelming to support a failure to function as a mark refusal.⁵ Applicant submits that the Examining Attorney has not met his burden.⁶

B. Evidence

The Examining Attorney submitted 12 examples of use of the phrase “say yes to what’s next.”⁷

Three of those examples are from the same parenting coach’s women/tween group that assists women in “growing, expanding her vision, digging in, and taking life to

³ Examining Attorney’s brief, 8 TTABVUE 5.

⁴ *Id.*

⁵ Applicant’s brief, 6 TTABVUE 5.

⁶ *Id.*

⁷ October 23, 2019 Office Action at TSDR 2-9; January 11, 2020 Office Action at TSDR 2-6. (emphasis supplied).

the next level ... [and] [i]s ready to explore, try new things, set goals and go after them.”

Say Yes to What’s Next, Create the Life You Want.⁸

**

It’s Your Turn Moms
Say Yes to What’s Next!⁹

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Create Your Best Life
Moms, **Say “Yes” to What’s Next.**
It’s Your Turn Now!¹⁰

A web page from a career coach website:

Does Your Career Have a Death Grip On Your Soul?
Escape your Boring Job and **Say Yes to What’s Next.**¹¹

A post about virtual small business coaching for women entrepreneurs titled

“What to do when yo[u] want to Give Up on Coaching:”

It WILL get tough, but KEEP pushing.
It will all be WORTH it.
Stay encouraged. Stay motivated.
This is setting you up for GREATNESS.
Always **Say “Yes!” to what’s next.**¹²

⁸ October 23, 2019 Office Action at TSDR 3, allevents.in Lake Forest (event listing for women’s group at Gorton community center).

⁹ October 23, 2019 Office Action at TSDR 7, momsoftweensandteens.com (women’s group event at Gorton Community Center).

¹⁰ January 11, 2020 Office Action at TSDR 2, facebook.com/events/gorton-community-center (event listing for women’s group at Gorton Community Center).

¹¹ October 23, 2019 Office Action at TSDR 2, wishingwellcoach.com (career coaching).

¹² January 11, 2020 Office Action at TSDR 5, thebossof.me.com (small business coaching).

A website from a ministry discussing John Wesley with a post titled “**Say ‘yes’ to what’s next**” ... that states “What I love about John Wesley is that no matter what, he said YES.”¹³

A webpage at the website theorchardcommunity.com, a faith-based community, titled “Wholeness”:

What’s right for us yesterday, may not be right for us today. The best thing we can do is keep our ear to the ground, our hearts open and courageously ready to **say YES to what’s next**.¹⁴

A blog post from the Leadership blog of the Leadership Now (“Building a Community of Leaders”) website titled “Wakeman Presents the Five Reality-Based Rules of the Workplace”:

4. **Say “yes” to what’s next.** Your success will not be dependent on everything staying the same, but on your readiness for what’s next.¹⁵

A student profile from Rutgers University of a student named Catalina Guzman states:

¹³ October 23, 2019 Office Action at TSDR 4, isoughtout.com (ministry).

¹⁴ October 23, 2019 Office Action at TSDR 9, theorchardcommunity.com (faith community).

¹⁵ October 23, 2019 Office Action at TSDR 6, leadershipnow.com (leadership blog).

Her undergraduate career was full of rewarding experiences and professional growth that gave her the confidence to **say yes to what's next**.¹⁶

An article discussing a women's retreat that will empower women and transform their everyday life into success, fulfillment and love:

The retreat is ideal for anyone who is ready to:

Learn what's been holding them back and let it go.
Recharge and have access to their best self.
Define their "Brave and Beautiful" Life
Experience themselves as ENOUGH just as they are
Create a community of empowered women
Say YES to what's next on their journey.¹⁷

An article on the Breaking Tales website titled "Three Reflective Ways to Refocus Your Thinking for Success":

Our value is distinguished by how quickly we can accept the reality of our situation and **say yes to what's next** and contribute amazing results in less than perfect circumstances.¹⁸

Starbucks Frappuccinno Happy Hour TV advertisement titled "**Say Yes to What's Next**."¹⁹

¹⁶ January 11, 2020 Office Action at TSDR 4, whatsnext.rutgers.edu (student profile).

¹⁷ January 11, 2020 Office Action at TSDR 3, whatcomtalk.com (Whatcom county website that provides, among other things, information about local activities and events).

¹⁸ January 11, 2020 Office Action at TSDR 6, breakingtales.com (website offering content on a variety of topics).

¹⁹ October 23, 2019 Office Action at TSDR 8, ispot.tv.ad (website for viewing TV ads).

The Examining Attorney's evidence shows use of "say yes to what's next" in the context of career, personal, and parenting coaching (3), faith/ministry (2) information about leadership, success, and personal growth (4), and an advertisement about a beverage (1).

Evidence of use by media and businesses in a variety of industries may be probative, and it is not necessary that the evidence show use by competitors of Applicant. *See In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992) (evidence of use by media and businesses in a variety of industries established that the slogan THINK GREEN for mailing and shipping items and weather-stripping does not function as a trademark). However, the evidence must be sufficiently widespread to show that the public would not perceive it as a trademark. *DataNational Corp. v. BellSouth Corp.*, 18 USPQ2d 1862, 1865 (TTAB 1991) ("That is, because the public is accustomed to seeing the walking fingers logo on all classified telephone directories, wherever it may encounter them, it will not regard the logo as a trademark but merely as an informational symbol which denotes yellow pages").

The record evidence does not show use in connection with any of the type of goods (religious books and women's clothing) or services (workshops, seminars, panels, radio and television shows related to women's aging and improving quality of life) identified by Applicant, although it does show de minimis use in connection with ministry/faith groups and programs related to women's growth and success. In this case, the Examining Attorney's evidence does not rise to the level of demonstrating that use of "say yes to what's next" is so common or widespread that the consuming

public would view it as a common place expression or sentiment. *See Eagle Crest*, 96 USPQ2d at 1230 (voluminous evidence of third-party use). Therefore, based on the present record, the Examining Attorney has not met his burden to establish that Applicant's applied-for mark, SAY YES TO WHAT'S NEXT, fails to function as a mark.

II. Conclusion

The present record as a whole does not establish that the applied-for-mark is a common or familiar expression or message in such widespread use that it is inherently incapable of functioning as a mark.²⁰

Decision: The refusal to register Applicant's mark SAY YES TO WHAT'S NEXT is reversed.

²⁰ This does not mean that a failure to function refusal cannot issue at the statement of use stage once a specimen is provided. The Examining Attorney may, if appropriate, issue such a refusal based on the evidence of record after examining the statement of use. TMEP § 1109.08.