

This Opinion is not a
Precedent of the TTAB

Mailed: September 4, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Douglas Elliman Realty, LLC
—

Serial No. 88640177
—

Stewart J. Bellus of Collard & Roe PC,
for Douglas Elliman Realty, LLC.

Kevin G. Crennan, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

—
Before Zervas, Goodman and Lynch,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Applicant Douglas Elliman Realty, LLC seeks registration of THE NEXT MOVE IS YOURS (in standard characters) for “real estate agency services, real estate brokerage, real estate management, leasing of real estate” in International Class 36.”¹ The Examining Attorney refused registration under Sections 1, 2, 3 and 45 of

¹ Application Serial No. 88640177, filed October 3, 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).

the Trademark Act, 15 U.S.C. §§ 1051-53 and 1127, on the ground that THE NEXT MOVE IS YOURS fails to function as a mark, because it does not indicate the source of Applicant's services, or identify and distinguish them from those of others. More specifically, the Examining Attorney contends that THE NEXT MOVE IS YOURS is a commonplace message or expression widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment. After the refusal became final, Applicant appealed and Applicant and the Examining Attorney filed briefs.²

I. Failure to Function as a Mark

“The Trade-Mark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration.” *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960). Section 45 of the Trademark Act defines a “service mark” as “any word, name, symbol, or device, or any combination thereof--(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this [Act], to identify and distinguish the services of one person,

Page references to the application record refer to the online database page numbers 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 The Examining Attorney has objected to Applicant's general reference in its brief to “NEXT MOVE” registrations registered with the Office that were never made of record during prosecution. Factual assertions must be supported by evidence in the record, and it is well-established that the Board does not take judicial notice of records residing in the Patent and Trademark Office, so we do not take judicial notice here. *See, e.g., In re Duofold Inc.*, 184 USPQ 638 (TTAB 1978).

including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.”

Although advertising phrases and slogans are not per se unregistrable, a phrase or slogan that does not function as a trademark to indicate the source of goods or services to identify and distinguish them from others cannot be registered on either the Principal or the Supplemental register. Trademark Act Sections 1, 2, 3 and 45. For example, “[s]logans and other items that are considered to be merely informational in nature, or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry, are not registrable.” *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (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”).

We must assess whether Applicant’s proposed mark, THE NEXT MOVE IS YOURS, functions as a mark based on whether the relevant public, i.e. purchasers or potential purchasers of Applicant’s services, would perceive THE NEXT MOVE IS YOURS as identifying Applicant’s services and their source or origin. *See e.g. In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *1-2 (TTAB 2019) (“The key question is whether the asserted mark would be perceived as a source indicator for Applicant’s [goods or] services.”); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) (“[T]he critical inquiry is whether the asserted mark would be perceived as a source indicator.”); *In re Volvo Cars of North Am. Inc.*, 46 USPQ2d 1455, 1459

(TTAB 1998) (“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 Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992). In this case, because there are no limitations to the channels of trade or classes of purchasers of the services identified in the application, the relevant consuming public comprises all potential purchasers of real estate agency, brokerage, management and leasing services. *See CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983).

Applicant has filed the application as intent to use, but we consider the evidence of record showing how the designation is actually used by others in the marketplace.³ *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”); *In re Eagle Crest Inc.*, 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 phrased 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.

³ While a failure to function refusal is generally issued after an allegation of use, under some circumstances, a refusal may be issued without considering the specimens. *Cf. In re Right-On Co.*, 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal in a §66(a) application).

Applicant complains in its brief that the Examining Attorney went beyond the USPTO database to search for third-party uses because it was unable to find any registered marks on the register to issue a Section 2(d) refusal and submits that this “double search” is improper. Applicant’s brief 4 TTABVUE 8. However, as indicated by the above cases, it is appropriate for the Examining Attorney to submit marketplace evidence of use of the designation to show consumer perception in the context of a failure to function as a mark refusal.

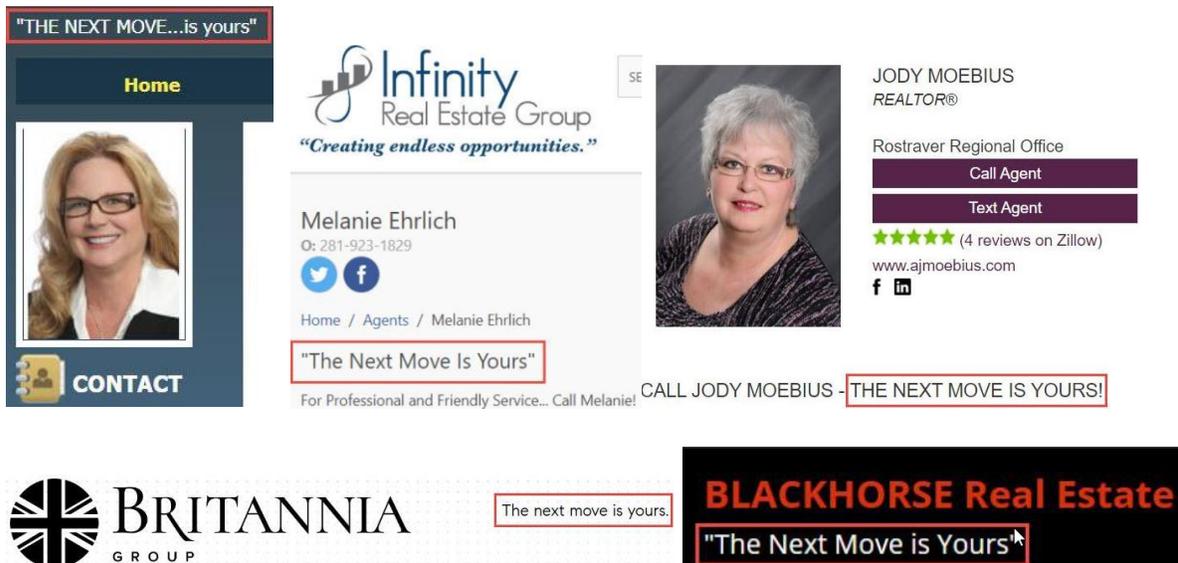
A. Evidence

The Examining Attorney's evidence includes dictionary definitions for "move":

- 1. f. To go from one residence or location to another; relocate
- 5. b. To initiate an action; act

American Heritage Dictionary, ahdictionary.com February 19, 2020 Office Action at TSDR 40.

The Examining Attorney also provided evidence of third-party uses of THE NEXT MOVE IS YOURS. January 13, 2020 Office Action at TSDR 2-11; February 19, 2020 Office Action at TSDR 2-14. Examples of this third-party use in connection with real estate services are shown below, with emphasis added. January 13, 2020 Office Action at TSDR 3, 2, 6, 8, 9, 11; February 19, 2020 Office Action at TSDR 3, 5, 7, 9, 10, 12, 14, 16, 18, 19, 21, 22, 23, 24, 25.





It's a cute space in a great place.

THE NEXT MOVE IS YOURS.

Virtual Tour

Listed by First Weber Realtors

Description

Just minutes from Verona and Madison, this 2 bedroom/2 bath condo has 2 car attached garage and private patio. Located in a calm setting adjacent to a nature reserve and a short walk to Blaser Park and Lake Belle View. This condo comes with all kitchen appliances including washer and dryer. The master bedroom features a full bath and walk-in closet. Private entry thru the large 2 car garage and no stairs to navigate. The next move is yours!

Realtors



Phil Caruso
Mobile: 608-712-5930
Mobile: 6087125930
carusop@firstweber.com



Print This Listing



Rusty Wafer
Office: 505.982.4466
Cell: 505.690.1919

the Plaza on a paved road. The classic Santa Fe style is a 3BD 2BA 2CAR 1839 heated sq ft PLUS an attached sunroom sited on .66 ac lot with SunMountain view and NO homeowners association. The early Santa Fe floor plan centers around the entry great living/dining rooms with two kiva wood-burning fireplaces. The home has been transformed with custom ceramic tile and painting throughout, newer stucco, refrigerated AC and new roof with warranty to 2031! Large walled patio flagstone/courtyard adds space for entertaining, cook-outs, sipping a latte or just daydreaming. The attached sunroom welcomes your imagination and everything green. The backyard is completely fenced and ready for your garden, pets and outdoor fun. There is room for your RV and to add guest house or studio. The next move is yours.

2497 S Caliente Drive

Palm Springs, CA 92264



\$1,525,000 STATUS: **ACTIVE** ON SITE: **168 DAYS** MLS #: **19506382**

OPEN HOUSE

UPDATED: **73 min ago**

Description

Incredible Mid Century Gated compound on prestigious Caliente Drive. on Indian Canyon golf course. William Kreisel original home with big mountain views. Totally updated with four bedroom suites all with en suite bathrooms. Cooks kitchen. Butlers pantry. Outside covered living room with electric awning. Swimmers pool with separate spa. Outside shower. Beautiful landscaping surrounds the whole property with numerous patio areas to relax and enjoy the views... The Next Move is yours.

Alex Dethier



Paul Kaplan GROUP
Bennion Deville Homes

See

Overview

Totally updated ready to move into apartment in the exclusive Desert Island. Huge lake and golf course views. large living room with Fireplace. Totally updated Kitchen with custom cabinets and sill stone counter tops with bathroom with large shower and dual vanity sinks. walk in closet. Second spa bathroom with shower. Walk in Views from every room.. A must see ..Easy living at its best... The Next Move is Yours.



From your first visit to move-in, Prudential Connecticut Realty keeps things moving ahead smoothly.

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Title & Settlement services

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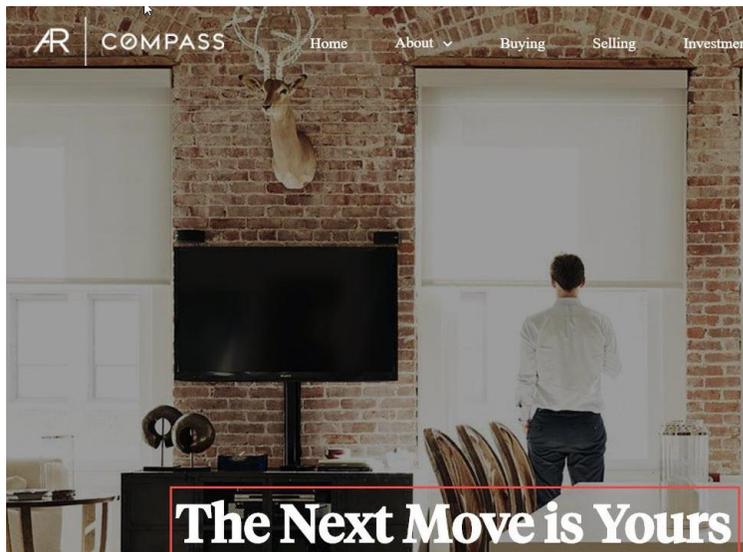
- Utility connection and disconnection
- Phone and Cable hook-ups
- Moving services
- Locksmith
- and more.

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The Next Move Is Yours!
So make the right move. Contact us today, so we can help you with a winning strategy designed for your success! We hope to hear from you soon!

Sell My House

Troy Goins



The "Next Move" is yours. Let me help you get there
REALTOR TN License # 326576
From the Office of: Bender Realty
Bender Realty

Are you ready to learn more? Join the [Valbridge VWC newsletter](#) for more information, or [contact us directly](#). **The next move is yours** – make it a smart one!

The Examining Attorney also included use by third parties in related or other industries (emphasis added):

“The next move is yours! From packing to loading and transporting of regular special items, when it comes to moving, we will deal with it all. Simply call us any time so that we can properly plan your relocation and deal with it in a timely fashion.” Verrazano Moving and Storage (moving services), [verrazanomoving.com](#), February 19, 2020 Office Action at TSDR 32-33.

“Moving to another country is a big decision, but choosing how to finance your new Audi vehicle shouldn’t be. Whether you decide to lease or purchase, Audi Financial services can guide you along the way. **The next move is yours.**” Audi Financial Services (vehicle financing services), [mydigimag.rrd.com](#), February 19, 2020 Office Action at TSDR 25.

“The next move is yours. Ready to take your digital marketing to the next level? ... Check out the marketer’s toolkit here to learn more and get started today.” AWeber Digital Marketing, (digital marketing), [blog.aweber.com](#), February 19, 2020 Office Action at TSDR 28-29.

“Let’s discuss your marketing automation needs. ... It all begins with a discussion between you and us. **The next move is yours.**” Walker Sands, (marketing automation consulting), [walkersands.com](#), February 19, 2020 Office Action at TSDR 30-31.

“The next move is yours. Like most serious investors you probably have some specific questions about how we are able to put an entire team of institutional-class investment experts to work managing your investments. We’d love to sit down with you and answer those questions, one at a time. All you have to do is contact us and schedule an appointment.” Union Advantage Financial, (financial planning and investment advice services), [unionadvantagefinancial.com](#), February 19, 2020 Office Action at TSDR 26-27.

“The next move is yours. When a commercial dispute arises it’s best to seek the services of a skilled litigator as soon as possible.” Law Office of Corbet H. Williams. (legal services), [chwilliamslaw.com](#), February 19, 2020 Office Action at TSDR 36-37.

“The next move is yours. Don’t put it off today. Contact us to get started.” Frugal Web Designs, (web design services), [frugalwebdesigns.com](#), February 19, 2020 Office Action at TSDR 38-39.

Applicant submitted evidence of third-party registrations of other slogans and taglines (e.g., WHERE'S THE BEEF, JUST DO IT, FINGER LICKIN' GOOD, EAT FRESH), as examples of the registrability of slogans and taglines.⁴ January 28, 2020 Response to Office Action at TSDR 2-24. Whether a slogan or tagline is used as trademark is a fact-based inquiry that differs in every case. In any event, the question of registrability of other taglines or slogans identified by Applicant is not before us, and has no bearing on the question of whether the designation THE NEXT MOVE IS YOURS is registrable.⁵

B. Arguments and Analysis

The Examining Attorney argues that the designation THE NEXT MOVE IS YOURS is a commonplace message or widely used expression in many different industries that “conveys an ordinary, familiar, well-recognized concept or sentiment.” Examining Attorney’s brief, 6 TTABVue 4, 5. The Examining Attorney submits that “consumers are likely to perceive the mark as a double entendre informing them that it is their turn to physically move, e.g., move homes, and to proverbially move, e.g.,

⁴ The TMEP acknowledges that slogans can be registrable if they are “used in a trademark sense and function[] as a trademark or service mark,” but that “if a mark consists entirely of a slogan that is generic, merely descriptive, merely informational, or that is otherwise not being used as a mark, registration must be refused.” TMEP § 1213.05(b)(i) (Oct. 2018).

⁵ Applicant also stated in this response that it intended to use THE NEXT MOVE IS YOURS with its house mark DOUGLAS ELLIMAN and provided an example of intended use. However, since we must consider the mark for which Applicant has applied, and further note that no allegation of use has been filed, we do not consider it. “It need hardly be said that ‘in determining the applicant’s right to registration, only the mark as set forth in the application may be considered; whether or not the mark is used with an associated house mark is not controlling.’” *Blue Cross and Blue Shield Association v. Harvard Community Health Plan Inc.*, 17 USPQ2d 1075, 1077 (TTAB 1990).

contact the Applicant to procure their services.” *Id.* at 5. The Examining Attorney argues that because of widespread use of THE NEXT MOVE IS YOURS by third-parties, consumers will perceive it to be an informational slogan and not a source indicator. *Id.* at 7.

Although Applicant acknowledges that the likely interpretation of consumers must be considered, it submits that “common use alone is not the determinative factor.” Applicant’s brief, 4 TTABVUE 7. Applicant contends that THE NEXT MOVE IS YOURS has similar characteristics to registered taglines or slogan marks (such as EAT FRESH) in that it is used by others often, it conveys information, it suggests an action, and it functions as a trademark. *Id.* at 4-5. Applicant argues that while a slogan or tagline may be informational, it can also function as a trademark and that the cases cited by the Examining Attorney are inapplicable because “the designation [in those cases] conveyed information and nothing else” while THE NEXT MOVE IS YOURS requires several mental steps to discern the meaning of the phrase and does not immediately and merely provide an informational message or idea.⁶ *Id.* at 5-6.

In this case, the numerous uses by third parties of THE NEXT MOVE IS YOURS are strong support for the Examining Attorney’s position. Here, the third-party Internet evidence in the record demonstrates general use of THE NEXT MOVE IS YOURS in advertising to consumers and to businesses in a variety of industries. This evidence shows that THE NEXT MOVE IS YOURS would be perceived not as a source

⁶ Applicant states that the refusal is unclear as to what factual information the Examiner believes THE NEXT MOVE IS YOURS immediately conveys to consumers. Applicant’s brief, 4 TTABVUE 7.

identifier, but instead as a widely-used phrase, specifically, a call to action or directive that the consumer or business contact the entity that is advertising the particular service. *See e.g., D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (sustaining opposition to registration of **I ♥ DC** for clothing because it would be perceived as “an expression of enthusiasm, affection or affiliation with respect to the city of Washington, D.C.”); *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013) (commonly used political slogan NO MORE RINOS fails to function as a mark); *Volvo Cars*, 46 USPQ2d 1460-61 (DRIVE SAFELY fails to function as a mark because it would be perceived as an everyday, commonplace safety admonition); *In re European-American Bank & Trust Co.*, 201 USPQ 788, 790 (TTAB 1979) (THINK ABOUT IT is a familiar expression and fails to function as a mark).

In the context of real estate services, THE NEXT MOVE IS YOURS, in addition to being a call to action or directive, also conveys information to consumers by suggesting that if they take action by contacting the realtor, they can move to a new property. However, we find that THE NEXT MOVE IS YOURS does not create a significant double entendre, as both meanings are informational. *See In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1460 (TTAB 1998) (“We hasten to add that to the extent that applicant’s designation DRIVE SAFELY engenders some minor double entendre, this should not result in registration inasmuch as the primary significance of the phrase remains that of a commonplace safety admonition.”). Although Applicant argues otherwise, the evidence reflects that this phrase is in common use in connection with real estate services, and therefore, consumers would

not perceive of THE NEXT MOVE IS YOURS as a source indicator. Thus, the primary significance of THE NEXT MOVE IS YOURS remains a commonly used call to action by advertisers to consumers and businesses as well as an informational slogan used by realtors and moving companies.

Lastly, although Applicant argues that THE NEXT MOVE IS YOURS is registrable as a service mark, it has not submitted any evidence to rebut the Examining Attorney's evidence and establish that consumers would perceive THE NEXT MOVE IS YOURS as a service mark. *See In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984) (noting that applicant did not submit any evidence to show that WATCH THAT CHILD functioned as a trademark to rebut the Examining Attorney's contention). We find the third-party use evidence is sufficient to demonstrate that THE NEXT MOVE IS YOURS fails to function as a mark in connection with Applicant's services.

II. Conclusion

The record evidence shows that consumers are accustomed to seeing the phrase THE NEXT MOVE IS YOURS used in an informational manner as a call to action or directive to contact the particular business. As a result, consumers will not perceive this wording as applied to Applicant's services as a source indicator pointing uniquely to Applicant. Rather, consumers purchasing Applicant's services will perceive the designation THE NEXT MOVE IS YOURS as a commonly used informational slogan by multiple entities rather than a sole source of services.

Decision: The refusal to register THE NEXT MOVE IS YOURS under Sections 1, 2, 3 and 45 of the Trademark Act is affirmed.