UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 88485087

MARK: NEXT MOVE, LLC

88485087

CORRESPONDENT ADDRESS:
DARREN A. HEITNER
HEITNER LEGAL, P.L.L.C.
215 HENDRICKS ISLE
FORT LAUDERDALE, FL 3304

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

APPLICANT:
NEXT MOVE, LLC

Examining Attorney's Name and Law Office Number:
Lyal Fox
Law Office 113

CORRESPONDENT EMAIL ADDRESS:
DARREN@HEITNERLEGAL.COM

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

Filing Date: June 23, 2019
Office Action Date: Sept. 13, 2019

APPLICANT'S RESPONSE TO OFFICE ACTION

In the Office Action dated September 13, 2019, the Examining Attorney refused registration of Applicant's trademark, "NEXT MOVE" ("Mark"), based upon Sections 1, 2, 3, and 45 - Failure to Function. Applicant humbly disagrees with the Examining Attorney's assessment and, in further support of its original application ("Application"), hereby submits this Response and respectfully requests that the Examining Attorney reconsider the prior determination concluding that the Application should be refused.

I. Sections 1, 2, 3, and 45 - Failure to Function

"An applicant may respond to a merely informational failure-to-function refusal by submitting evidence demonstrating that the matter is perceived as indicating a single source for the identified goods or services." *See In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967) (reversing the refusal to register "QUALITY THROUGH CRAFTSMANSHIP" for radio equipment, finding (in part) that the wording functioned as a mark because applicant extensively advertised the slogan, using it in the manner of a trademark on the goods….") TMEP § 1202.04(d). "The amount and nature of evidence that may be sufficient to establish that the matter would be perceived as source indicator rather than merely informational is determined on a case-by-case basis." *Id.* To determine whether matter merely conveys information or an informational message, the "critical inquiry . . . is how the designation would be perceived by the relevant public." *See In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010).

The Examining Attorney stated "[r]egistration is refused because the applied-for mark is a slogan or term that does not function as a service mark to indicate the source of applicant's services and to identify and distinguish them from others." *See* Office Action Outgoing Sept. 13, 2019. However, the Mark clearly functions and is perceived as a source indicator that identifies and distinguishes Applicant's services. Applicant "extensively advertise[s] the slogan, using it in the manner of a trademark on the goods" thereby evidencing the Mark functions as a source indicator. *See In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967). The Application included numerous attachments as evidence of Applicant's extensive successful advertising of the Mark to distinguish its services. Applicant's extensive marketing includes an international demographic in over fifty cities with clientele consisting largely of famous entertainers and athletes including over one hundred professional athletes and coaches across every major sport in the United States such as the NBA, NFL, MLB, NHL, MLS, and UFC. http://tsdr.uspto.gov/documentviewer?caseId=sn88485087&docId=OOA20190913#docIndex=2&page=1&tdrlink=; http://tsdr.uspto.gov/documentviewer?caseId=sn88485087&docId=OOA20190913#docIndex=2&page=1&tdrlink=.

The popularity and viewership of these sports is difficult to understate or undervalue. Clearly, Applicant's extensive marketing led to acquiring these coveted clients. Because Applicant's services focus on and primarily involve popular celebrity athletes, said athletes inherently act as marketing tools themselves, spreading the word about the Mark, thereby further establishing that the Mark functions as a single source indicator of Applicant's services. For example, one of Applicant's most recent celebrity clients, Antonio Brown, NFL wide receiver, is currently one of, if not the most, talked about athletes in the country. https://www.makethenextmove.com/listing-posts/26-n-jackson-way-9wt25; https://www.makethenextmove.com/listing-posts/26-n-jackson-way; https://www.mansionglobal.com/articles/nfl-star-antonio-brown-lists-pittsburgh-mansion-for-2-3m-208490; https://www.tmz.com/2019/10/23/antonio-brown-lists-oakland-home-raiders-3-million/. Mr. Brown retained Applicant's services for two multi-million-dollar estates on either side of the country. Attaching the Mark to multiple celebrity athletes, especially those of such a status as Mr. Brown surely provides countless impressions allowing the Mark to function as a single source indicator.

Additionally, the unique nature, celebrity status, and resounding popularity of Applicant's clients, concretely establishes the Mark as a single source indicator of Applicant's services in that any consumer who interacts with the Mark in connection with Applicant's services would immediately connect the Mark with the services of celebrity athletes making it extremely easy for consumers to recall, distinguish, and identify Applicant's unique services via the Mark due to the public's fanaticism with professional athletes. This is especially true given that the "critical inquiry . . . is how the designation would be perceived by the relevant public" whom's fanaticism towards American sports figures has risen to the level of speculation based on real estate. *See In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); https://www.boston.com/sports/new-england-patriots/2019/10/25/tom-brady-free-agent-2020-rumors. Simply, the international athlete clientele involved in Applicant's services coupled with the extensive marketing, as evidenced by the Attachments, establishes that consumers interacting with the Mark would immediately associate it with Applicant's services, which they are almost guaranteed to remember given the fanaticism involving American sports figures. Therefore, the Mark serves as a single source indicator of Applicant's services and should be granted Registration.

Moreover, given the vagueness of the Mark and its applicability to near countless meanings, as evidenced by the fact that the Examining Attorney was able to handpick the most fitting definitions to their Argument for each word creating the Mark amongst a multitude of definitional choices, the Mark is not a commonly used term or expression and thus it is highly likely that the public will use it to identify only one source and highly likely that it will be recognized by purchasers as a trademark, particularly given

Applicant's clientele's popularity to the public. *See In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013); *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229.

II. Conclusion

Based upon the arguments and evidence presented herein, Applicant strongly believes there appears to be no grounds in which registration of the Mark may be refused. Therefore, in light of the foregoing reasons, Applicant respectfully and humbly requests that the refusal of its Application be overturned.