



NEXT GROUP PLC,
Opposer,

-versus-

NATASHA (SHOECAT, INC.),
Respondent- Applicant.

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} IPC No. 14-2008-00280
} Opposition to:
} Appln. Serial No. 4-2005-00617
} Date Filed: 21 January 2005
} TM: "NSX & DEVICE "
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}
}
}

NOTICE OF DECISION

BUCOY POBLADOR & ASSOCIATES

Counsel for the Opposer
21st Floor Chatham House
Valero corner Rufino Street
Salcedo Village Makati City

HECHANOVA BUGAY & VILCHEZ

Counsel for the Respondent-Applicant
G/F Chemphil Building
851 Antonio Arnaiz Avenue
Makati City

GREETINGS:

Please be informed that Decision No. 2014 - 127 dated May 09, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 09, 2014.

For the Director:

Edwin Q. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



NEXT GROUP PLC,
Opposer,

-versus-

IPC No. 14-2008-00280
Opposition to Trademark
Application No. 4-2005-00617
Date Filed: 21 January 2005

NATASHA (SHOECAT, INC.),
Respondent-Applicant.

x ----- x

Trademark: **"NSX & DEVICE"**

Decision No. 2014- 127

DECISION

Next Group PLC¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2005-00617. The contested application, filed by Natasha (Shoecat, Inc.)² ("Respondent-Applicant"), covers the mark "NSX & DEVICE" for use on *"footwear namely, shoes, boots, sandals, slippers, sports shoes for men, women and children; clothing namely, jackets, shirts, blouses, pants, shorts, skirts, beach clothes, and underwear for adults and children; headgear; headgears namely, caps, hats, scarves, sun vicors, and turbans; handkerchiefs, socks"* under Class 25 of the International Classification of Goods³.

The Opposer contends that the mark "NSX & DEVICE" is likely to cause confusion, mistake and deception to the public as to the source or origin of the Respondent-Applicant's goods. It claims to be the registered owner of the trademark "NEXT" in various jurisdictions. In the Philippines, it allegedly filed its trademark application for the mark "NEXT" covering Classes 14, 18 and 25 on 08 November 2005. It asserts that it has adopted and continuously used the mark "NEXT" in international trade and commerce long before the Respondent-Applicant filed its application. It also avers that its goods bearing the "NEXT" mark are widely known in the Philippines and has gained tremendous popularity among local followers.

In support of its Opposition, the Opposer submitted the following as evidence:

1. certified copy of the affidavit of Andrew John Robert Mckinlay;
2. certified copy of Application No. 4-2005-010992;
3. printout of Opposer's website;

¹ A company of the United Kingdom with business address at Desford Road, Enderby, Leicester, United Kingdom.

² With known address at #1610 Amang Rodriguez Avenue, Barangay Dela Paz, Pasig City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

Republic of the Philippines

INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center

Fort Bonifacio, Taguig City 1634 Philippines

T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

1

4. printout showing its total dispatches from the Philippines from 2000 to 2004;
5. copies of its magazine advertisements;
6. list of Opposer's applications and/or registrations in various jurisdictions; and,
7. copies of its certificates of registration in different jurisdictions.⁴

A Notice to Answer was issued and served upon the Respondent-Applicant on 02 December 2008. However, the latter did not file its Answer. Thus, the Hearing Officer issued Order No. 2013-800 on 30 May 2013 declaring Respondent-Applicant in default and the case submitted for resolution.

The issue to be resolved in this case is whether Respondent-Applicant's mark "NSX & DEVICE" should be allowed registration.

The Opposer anchors its argument on the provisions of Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that:

**"Section 123. Registrability. -
123.1. A mark cannot be registered if it:**

x x x

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or**
- (ii) Closely related goods or services, or**
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x"**

This Bureau, in an opposition case, can take cognizance via judicial notice of the contents of the Trademark Registry and other official records and document in connection to the opposed trademark application. In this regard, the Opposer cites its Trademark Application Serial No. 4-2005-010992 for the mark "NEXT" which was filed on 08 November 2005.

This application, however, was refused by the Bureau of Trademark (BOT) Examiner Marvin P. Malaluan on the ground that its mark "NEXT" is identical with another registered mark "NEXT" used for identical and closely related goods. The refusal was upheld by BOT Director Leny B. Raz in her decision rendered on 23 May 2011, reasoning thus:

⁴ Exhibits "B" to "J", inclusive.

"In the instant case, it is apparent that the subject mark and the cited mark show the same dominant feature, the word 'NEXT'. The prior registered marks consist of 'NEXT'. The prior registered marks consist of 'NEXT' used for identical and closely related goods under Class 14, 18 and 25. On the other hand, the applicant's mark consists of the word mark, 'NEXT' also for goods under Class 14, 18 and 25."

As no appeal or motion for reconsideration was timely filed, the refusal or rejection of Trademark Application Serial No. 4-2005-010992 became final and executory. Corollarily, the instant opposition has no more leg to stand on.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2005-000617 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 May 2014.


ATTY. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs