



NEXT JEANS, INC.,
Opposer,

-versus-

RISHI N. MIRANI,
Respondent-Applicant.

X-----X

} IPC No. 14-2012-00426
}
} Opposition to:
} Appln. Serial No. 4-2010-013398
} Date Filed: 09 Dec. 2010
} TM: "NEXT"
}
}
}
}

NOTICE OF DECISION

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Pasig City

RISHI N. MIRANI
Respondent-Applicant
KAMPRI Building
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Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 171 dated August 15, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 15, 2013.

For the Director:

Edwin A. Daning
Atty. EDWIN DANILO A. DANILO
Director III
Bureau of Legal Affairs



NEXT JEANS, INC.,	}	IPC NO. 14-2012-00426
Opposer,	}	Opposition to:
	}	
-versus-	}	Appln. Ser. No. 4-2010-013398
	}	Date Filed: 9 Dec. 2010
	}	
RISHI N. MIRANI,	}	Trademark: NEXT
Respondent-Applicant.	}	
x-----x	}	Decision No. 2013- 171

DECISION

NEXT JEANS, INC., (Opposer)¹ filed on 29 October 2012 an opposition to Trademark Application Serial No. 4-2010-013398. The application, filed by RISHI N. MIRANI (Respondent-Applicant)², covers the mark “NEXT”, for use on “soaps for body and face, hair lotions, cosmetics preparations for the bath bath salt, bath gels, cotton sticks for cosmetic purposes, skin whitening creams and powders, foundation preparations, hair colorants, hairdressing products, cosmetic preparation for eyelashes, adhesives for false eyelashes, decorative transfers for cosmetic purposes, cosmetic pencils, cosmetic creams, paper guides for eye make-up, blush essential oils for personal use, milk for cosmetic purposes, nail varnishes, lotions for cosmetic purposes, make-up preparations, beauty masks, cosmetic kits, nail care preparation, false nails, cotton wool for cosmetic purposes, perfumery, namely: perfumes, toilet oil, scented water, eau de cologne, pomades for cosmetic purposes, make-up powder, lipsticks, cosmetic preparations for skin care, eyebrow cosmetics, eyebrow pencils, cosmetics, dyes, toilet water oils for toilet purposes, toiletries, varnish-removing preparations, make-up brushes and make-up kit” under Class 03 and “hair accessories, specifically head band, ribbon, hair pins, hair clips, ponytail, hair stick, hair claw, barrette, 3 pong hair forks, hair clamps, bobby pins, banana pins, bun holder, ponytail holder, and pint pins” under Class 26 of the International Classification of Goods³.

The Opposer anchors its opposition on the ground that the approval of Application SN 4-2010-013398 is contrary to Sections 123.1(d), 138, 147 and 165 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”). The Opposer alleges the following:

¹ A corporation organized and existing under the laws of the Philippines with office address at 55-B Lincoln Street, Barangay San Antonio, Quezon City
² With address at Kampri Building, 2254 Don Chino Roces Avenue, Makati City
³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"1. The Opposer is the registered owner of the trademark 'NEXT' under Registration No. 47510 originally issued on 5 March 1990 and renewed on 5 March 2010, for use on pants, jeans, shirts, blouses, shoes, sandals, slippers falling under Class 25.

"2. The trademark 'NEXT' is also registered in favor of Opposer under Registration No. 55791 issued on August 18, 1993 for use on leather goods namely, shoes, sandals, wallets, handbags; children's clothing namely: dresses, panty, shorts, t-shirts, blouses, fashion accessories namely, sunglasses, buckets, watches, belts, umbrella, hankies falling under Classes 14, 18 & 25.

"3. Opposer first used the trademark 'NEXT' on January 15, 1987 on goods falling under Class 25, on January 15, 1990 on goods falling under Classes 14, 18 and 25.

"4. Opposer has not abandoned the use of its registered trademark 'NEXT' but continues its use since 1987 up to the present. In fact, in 2004, Opposer extended the use of its trademark NEXT on goods falling under Classes 3, 9, 21, 24 and 26 and now the subject of Application SN 4-2012-012899.

"5. As further proof of its continuous use of its registered trademark 'NEXT', as well as extension of its use on other classes of goods, Opposer submits herewith representative sales invoices, as well as photographs of representative products bearing the trademark 'NEXT'.

To support its opposition, the Opposer submitted as evidence the following:

1. Certified copy of Certificate of Registration No. 47510 issued on 5 March 1990 for the trademark NEXT under Class 25 and Certificate of Renewal of Registration (Exhibit "A" to "A-3");
2. Certified copy of Certificate of Registration No. 55791 issued on 18 August 1993 for the trademark NEXT under Classes 14, 18 & 25. (Exhibit "B");
3. Duplicate original application for registration of the mark NEXT for goods falling under Classes 3, 9, 21, 24 and 26. (Exhibit "C");
4. Certified copies of Affidavits/Declarations of Actual Use (Exhibits "D" to "D-3" and "E" to "E-2");
5. Copies of representative sales invoices and photographs of products bearing the mark NEXT. (Exhibit "F"- "F-35");
6. Copies of sales invoices, delivery acknowledgement, quotation, receipts for bottles, labels, stickers for NEXT cosmetic products (Exhibit "G" to "G"-4");

7. Samples of advertisements. (Exhibit "H"- "H-7");
8. Certified copies of Opposer's Amended Articles of Incorporation issued by the Securities and Exchange Commission, Business Name Registrations issued by Department of Trade and Industry and Certificates of Registration issued by the Bureau of Internal Revenue for NEXT Jeans Inc. and The Next Fashion . (Exhibit "I"- "I-5");
9. Print -out of Respondent- Applicant's trademark application (Exhibit "J");
10. Copy of Respondent-Applicant's Trademark Application Form (Exhibit "K");
11. Copy of Reply to Action Paper No. 03 (Exhibit "L"); and
12. Duly notarized affidavit of Elizabeth Munoz Ang, President of Next Jeans, Inc. (Exhibit "M").

This Bureau served upon Respondent-Applicant a "Notice to Answer" on 19 November 2012. The Respondent-Applicant, however did not file an Answer and was declared to have waived its right to file an Answer in Order No. 2013-377 issued by the Hearing Officer on 5 March 2013.

Should the Respondent-Applicant be allowed to register the trademark NEXT?

The essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁴ Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The competing marks, as depicted below, are practically identical:

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G. R. No. 114508, 19 November 1999.



Opposer's mark

Respondent-Applicant's mark

In this regard, the records show that at the time Respondent-Applicant filed its trademark application on 9 December 2010, the Opposer already has an existing registration for the mark "NEXT" on goods under Classes 25, 14 and 18, namely: pants, jeans, shirts, blouses, shoes, sandals, slippers, dresses, leather goods, namely: shoes, sandals wallets, handbags, children's clothing, namely dresses, panty, shorts, t-shirts, blouses, fashion accessories, namely: buckets, watches, belts, umbrella, hankies. In addition, the Opposer applied for registration of its mark on 19 October 2012 for goods under Class 3, namely: lotions, perfumes, hand sanitizers, hand wash, body wash, shampoos, colognes, conditioners, hairsprays, hair gels, make-up, nail polish, powders, deodorants, soaps, liquid soaps, facial wash; Class 9, namely: eyewear, eyeglass, sunglasses; Class 21, namely: comb, brush, tumblers, coffee mugs; Class 24, namely: towels, handkerchiefs; Class 26, namely: pins, rubberbands, headbands.

The Supreme Court in *Mighty Corporation and La Campana Fabrica de Tabaco, Inc. v. E.J. Gallo Winery and Andresons Group, Inc.*⁵ held, that in resolving whether goods are related, several factors come into play:

- (a) the business (and its location) to which the goods belong
- (b) the class of product to which the goods belong
- (c) the product's quality, quantity, or size, including the nature of the package, wrapper or container
- (d) the nature and cost of the articles
- (e) the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality
- (f) the purpose of the goods
- (g) whether the article is bought for immediate consumption, that is, day-to-day household items
- (h) the fields of manufacture
- (i) the conditions under which the article is usually purchased and
- (j) the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold.

⁵ G.R. No. 154342, 14 July 2004.

The goods indicated in the Respondent-Applicant's trademark application may be considered related to those covered by the Opposer's trademark registration. These goods are sold in the same channels of trade. Nowadays, soaps, lotions, cosmetic preparations, hair accessories and clothes and shoes are sold in one department store. The Opposer also attached copies of certificates registration, renewal of registrations and Declaration of Actual Use⁶ issued prior to the filing of Respondent-Applicant's application, the earliest of which was issued as early as 1990.

Moreover, Sec. 123.1 (d) of the IP Code also proscribes registration if the mark resembles an earlier registered mark as to be likely to deceive, or cause confusion. Significantly, the Opposer has proven that it has expanded its business to goods indicated in the Respondent-Applicant's trademark application. The Opposer presented evidence of its application for registration under Classes 3 and 26⁷ and sales invoices, labels and packages showing sales of cosmetic products and fashion accessories.⁸ Hence, even if the goods indicated in the Respondent-Applicant's trademark application are not directly in actual competition, with the goods covered by the Opposer's existing trademark registration, confusion or even deception is still likely to occur.

The ruling of the Supreme Court in *Sta. Ana v. Maliwat*⁹ is instructive, to wit:

Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trademark or tradename is likely to lead to a confusion of source, as where the prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR et seq. 52 Am Jur 576) or is it any way connected with the activities of the infringer; or when it forestalls the normal expansion of his business (v. 148 ALR, 77; 84 52 Am Jur 576, 577).

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-013398 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 August 2013.


Atty. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁶ Exhibits "A", "B" and "D"

⁷ Exhibit "C"

⁸ Exhibits "F", "H" and "G"

⁹ G.R. No. L- 23023, 31 August 1968