NEXT JEANS, INC., Opposer, **-versus-** **SBJ MARIKINA SHOE EXCHANGE CORP.,** Respondent-Applicant.	} } } } } } } } }	**IPC No. 14-2009-00126** Opposition to: Appln. Serial No. 4-2008-012245 (Filing Date: 07 October 2008) TM: **"NXT"**

x----------x

NOTICE OF DECISION

SIOSON SIOSON & ASSOCIATES
Counsel for Opposer
Unit 903-AIC-Burgundy Empire Tower Roads
Ortigas Center, Pasig City

HECHANOVA BUGAY & VILCHEZ
Counsel for Respondent-Applicant
G/F Chemphil Building
851 Antonio Arnaiz Avenue
Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 32 dated February 13, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 13, 2013.

For the Director:

Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs

CERTIFIED TRUE COPY
MARILYN F. RETUTAL

NEXT JEANS, INC.,
Opposer,

- versus -

SBJ MARIKINA SHOE EXCHANGE CORP.,
Respondent-Applicant.
x----------x

IPC No. 14-2009-00126
Opposition to:

Appln. Serial No. 4-2008-012245
(Filing Date: 07 October 2008)
TM: "NXT"

Decision No. 2013- 32

DECISION

NEXT JEANS, INC. ("Opposer")[1] filed on 29 April 2009 an opposition to Trademark Application Serial No. 4-2008-012245. The application, filed by SBJ MARIKINA SHOE EXCHANGE CORP. ("Respondent-Applicant")[2], covers the mark "~~NXT~~" for use on "*wallets, bags and all kinds of articles of outer and underwear for men, women, teenagers and children, namely shirts, blouses, skirts, suits, pants, trousers, jeans, vests, dresses, ties, coats, stockings, lingeries, panties, slips, camisoles, belts, bras, girdles, sandos, robes, bathing suits, socks, gloves, scarves, shoes, slippers, sandals, headwear, namely hats, and caps"* which fall under classes 18 and 25 of the International Classification of goods[3].

The Opposer alleges, among other things, that ~~NXT~~ is confusingly similar to its registered trademark NEXT. To support its opposition, the Opposer submitted as evidence certified copy each of its Amended Articles of Incorporation, and certificates of registration No. 447510 (issued on 05 March 1990) and No. 55791 (issued on 18 Aug. 1993) for the mark NEXT; duplicate originals of the accepted Affidavits of Use in connection with trademark registration No. 47510 and No. 55791; representatives sales invoices, photographs of goods and advertising contracts of NEXT products; certificates of registration of the business name "NEXT JEANS, INC." in the Department of Trade and Industry and in the Bureau of Internal Revenue; print-out of Respondent-Applicant's mark ~~NXT~~ as published in the "e-Gazette" on 06 March 2009; and the duly notarized affidavit of Elizabeth Munoz Ang.[4]

On 09 September 2009, the Respondent-Applicant filed its Answer alleging, among other things, that there is no confusing similarity as the competing marks are not identical. The Respondent-Applicant's evidence consists of the affidavits of Victoria B. Jiardolin and Sebastian Jiardolin and various products brochures.[5]

The Opposer filed on 05 October 2009 a Reply, in essence, reiterating its allegation that the mark ~~NXT~~ is confusingly similar to NEXT. This prompted the Respondent-Applicant to file a Rejoinder on 15 October 2009. The Bureau proceeded to conduct the preliminary conference which was terminated on 17 February 2010. Then after, the parties filed their respective position papers.

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1 With business address at 1026 C.R. Square Building, Roman Street, Binondo, Manila.
2 With business address at No. 1610 Amang Rodriguez Avenue, Brgy. 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.
4 Marked as Exhibits "A" to "P", inclusive.
5 Marked as Exhibits "2" to "3", inclusive.

Should the Respondent-Applicant be allowed to register the mark ~~NXT~~?

It is emphasized that the essence of the trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; to secure to him who has been instrumental in bringing into the market a superior article of merchandise; the fruit of hi, 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 article as his product[6].Sec. 123.1 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 is nearly resembles such a mark as to be likely to deceive or cause confusion

Records show that at the time the Respondent-Applicant filed its trademark application on 07 October 2008, the Opposer has existing registrations for the mark NEXT - Reg. No. 47510 issued on 05 March 1990, for use on "*pants, jeans, shirts, skirts, blouses, shoes, sandals, slippers, dresses*" under Class 25, and Reg. No. 55791 issued on 18 August 1993 covering "*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*" under Classes 14, 18 and 25. There is no doubt that the goods covered by these trademark registrations are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application.

But, are the competing marks, as shown below, resemble each other such that confusion, or even deception, is likely to occur?

Opposer's mark

Respondent-Applicant's mark

Notwithstanding that the Opposer's mark is in the lower case, the use of the Respondent-Applicant's mark as indicated in the trademark application, is likely to cause confusion among the consumers. Even if the letter "E" was removed, the mark applied for registration by the Respondent-Applicant still looks and sounds like the word "next". The mid-horizontal line or bar across the letters "N", "X", and "T" in fact produces an optical illusion of the presence of a letter "E" between "N" and "X".

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other[7]. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article[8].

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6 *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No.114508, 19 Nov. 1999.

7 *Societe Des Produits Nestle , S.A v. Court of Appeals*, G.R. No.112012, 4 April 2001, 356 SCRA 207, 217.

8 *Emerald Garment Manufacturing Corp. v. Court of Appeals.* G.R. No. 100098, 29 Dec. 1995.

NEXT is a unique and distinctive trademark for goods falling under classes 14, 18 and 25. Succinctly, because the Respondent-Applicant will use or uses the mark it applied for registration on goods that are similar and/or closely related to those covered by the Opposer's registered mark, the changes in the spelling did not diminish the likelihood of the occurrence of mistake, confusion, or even deception. Since the Respondent-Applicant's mark looks like the word "next" or a abbreviated/fanciful form thereof, it becomes difficult for one to distinguish it from the Opposer's. Significantly, trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. There is therefore the likelihood that information, assessment, perception or impression about Respondent-Applicant's products may be unfairly cast upon or attributed to the NEXT products and the Opposer, and *vice-versa*.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.[9] The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[10]

> Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2008-012245 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 13 February 2013.

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

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[9] *American Wire and Cable Co. v. Director of Patents et al.*, (31 SCRA 544) G.R. No. L-26557, 18 Feb. 1970.
[10] *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.