

ESTTA Tracking number: **ESTTA392737**

Filing date: **02/10/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Next Realty L.L.C.		
Entity	Limited Liability Company	Citizenship	Illinois
Address	400 Skokie Boulevard Northbrook, IL 60062 UNITED STATES		

Attorney information	Larry L. Saret Michael Best & Friedrich LLP 180 N. Stetson Avenue, Suite 2000 Chicago, IL 60601 UNITED STATES chiipdocket@michaelbest.com, llsaret@michaelbest.com, lwdemarte@michaelbest.com, jwjung@michaelbest.com, dsternig@michaelbest.com Phone:3122220800
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**Applicant Information**

Application No	77932446	Publication date	01/11/2011
Opposition Filing Date	02/10/2011	Opposition Period Ends	02/10/2011
Applicant	NEXTCOMPANY INTERNATIONAL HOLDINGS INC. Mariborough & Queen Streets Winterbotham Place Nassau, BAHAMAS		

**Goods/Services Affected by Opposition**

<p>Class 035. All goods and services in the class are opposed, namely: Consulting services on cost analysis; business management consulting and industrial management advisory services; advisory on business management; business appraisal services; sponsorship search services for businesses; consulting on business organization; professional consulting on business organization and operation; cost analysis services; economic forecasting services; compilation of statistics for business purposes; business management consulting services; providing advisory services in the fields of business and industrial management; conducting business management research surveys; providing business information services; conducting business market research surveys; providing business advisory services in connection with the management of businesses; consulting in the management and organization of businesses; professional consulting in the field of business management; business research on services; business administration services; providing advisory services, consulting services and economic information for the industrial and business sectors of companies, for the purpose of planning, organizing, monitoring and developing business marketing projects; providing online advisory services, online consulting services and online economic information for the industrial and business sectors of companies, for the purpose of planning, organizing, monitoring and developing business marketing projects; audit support services, namely, providing advice, consultation and information in connection with business audits requested by a government body;</p>
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providing advice, consultation and information on business management for industrial or business entities; providing advice, consultation and information on audit investigations, business appraisals and market research on businesses; providing advice, consultation and business information related to the relocation of companies; providing corporate advisory and consulting services in connection therewith, information advisory and consulting in connection therewith and business information all related to planning, analysis, management and organization of business operations for companies; providing advice, consultation and information dealing with new business opportunities; providing advice, consultation and information in connection with business statistics; conducting research studies and issuing written opinions in connection therewith pertaining to macro and micro company advisory services dealing with the management and operation of business entities; conducting market surveys; conducting business organization and business administration services; conducting quality assurance programs for businesses to improve service quality; consulting services, namely, providing expert analysis in the fields of economics and accounting; economic consulting services for the commercial sector for planning and organizing business projects

**Class 036.**

All goods and services in the class are opposed, namely: Financial analysis; financial evaluation; real estate property evaluation; capital investment services; financial consulting; arranging of loans; arranging of long-term loans; Financial management services; providing financial information; financing services; funds investment services; financial guarantee services; mortgage financing services; real estate property appraisal services; providing financial information; financial services, namely, estate settlement services, debt settlement services; monetary exchange operations; securities portfolio management; management of leased portfolios in the field of real estate; investment fund management; financial administration of retirement plans; Advisory, consulting and administration of third parties' financial investments; Advisory, consulting and information on debts management; advisory, consulting and information in the management of equity funds; advisory, consulting and information on financial risks management; Advisory, consulting and information on real estate property appraisal; providing advice, consultation and information in the investment equity and stock funds; providing advice, consultation and information in the field of real estate investment; providing advice, consultation and information on the stock market; providing advice, consultation and information in the field of financial planning; providing advice, consultation and information dealing with public and private equity in the economic and financial markets; providing financial advice, consultation and information for investors; providing advice, consultation and information dealing with insurance actuarial services; providing advice, consultation and information dealing with bank investment; providing advice, consultation and information dealing with the administration of insurance; managing real estate portfolios for foreign investors; establishment and management of real estate investment funds for others; providing financial information to others for the purpose of advising on economic and financial matters

### Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2383949	Application Date	08/10/1998
Registration Date	09/05/2000	Foreign Priority Date	NONE
Word Mark	NEXT		

Design Mark	<b>NEXT</b>
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1998/05/13 First Use In Commerce: 1998/05/13 real estate brokerage services, real estate investment consulting, and financial advisory services Class 037. First use: First Use: 1998/05/13 First Use In Commerce: 1998/05/13 real estate development services

U.S. Registration No.	3414957	Application Date	09/22/2006
Registration Date	04/22/2008	Foreign Priority Date	NONE
Word Mark	NEXT DEVELOPMENT		
Design Mark	<b>NEXT DEVELOPMENT</b>		
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 2005/08/15 First Use In Commerce: 2005/08/15 real estate development services		

U.S. Registration No.	3100596	Application Date	06/15/2005
Registration Date	06/06/2006	Foreign Priority Date	NONE
Word Mark	THE NEXT PERSPECTIVE IN REAL ESTATE		

Design Mark	<h1>THE NEXT PERSPECTIVE IN REAL ESTATE</h1>		
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 1998/07/27 First Use In Commerce: 1998/07/27 real estate brokerage services, real estate investment consulting, and financial advisory services</p> <p>Class 037. First use: First Use: 1998/07/27 First Use In Commerce: 1998/07/27 real estate development services</p>		

U.S. Registration No.	3191656	Application Date	07/08/2005
Registration Date	01/02/2007	Foreign Priority Date	NONE

Word Mark	NEXT PARKING		
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Design Mark	<h1>NEXT PARKING</h1>		
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Description of Mark	NONE		
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Goods/Services	<p>Class 036. First use: First Use: 2005/05/22 First Use In Commerce: 2005/05/22 real estate equity sharing, namely, managing and arranging for co-ownership of real estate; real estate investment; real estate management; and real estate syndication</p> <p>Class 037. First use: First Use: 2005/05/22 First Use In Commerce: 2005/05/22 real estate development</p>		
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U.S. Registration No.	3141792	Application Date	09/30/2005
Registration Date	09/12/2006	Foreign Priority Date	NONE

Word Mark	NEXT REALTY MIDWEST		
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Design Mark	<b>NEXT REALTY MIDWEST</b>		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2002/03/08 First Use In Commerce: 2002/03/08 real estate brokerage services; real estate agency services in the nature of assisting tenants with identifying and leasing properties		

U.S. Registration No.	3141788	Application Date	09/30/2005
Registration Date	09/12/2006	Foreign Priority Date	NONE
Word Mark	NEXT REALTY MID-ATLANTIC		
Design Mark	<b>NEXT REALTY MID-ATLANTIC</b>		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1999/07/01 First Use In Commerce: 1999/07/01 real estate brokerage services; real estate agency services in the nature of assisting tenants with identifying and leasing properties		

Attachments	75533590#TMSN.gif ( 1 page )( bytes ) 77005737#TMSN.jpeg ( 1 page )( bytes ) 78650873#TMSN.jpeg ( 1 page )( bytes ) 78666561#TMSN.jpeg ( 1 page )( bytes ) 78724418#TMSN.jpeg ( 1 page )( bytes ) 78724213#TMSN.jpeg ( 1 page )( bytes ) Notice of Opposition.PDF ( 6 pages )(228273 bytes ) Exhibit A.PDF ( 6 pages )(177923 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/larry l. saret/
Name	Larry L. Saret
Date	02/10/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Applicant: )  
NEXTCOMPANY International Holdings )  
Serial No. : 77/932446 )  
Filed : February 10, 2010 )  
Mark: : NEXTCOMPANY )  
)

Published in the Official Gazette dated January 11, 2011

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Next Realty, L.L.C., )  
Opposer, )  
v. ) Opp. No.  
NEXTCOMPANY International Holdings )  
Applicant. )

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**NOTICE OF OPPOSITION**

Next Realty, L.L.C. ("Opposer"), an Illinois limited liability company, believes that it will be damaged by the registration by NEXTCOMPANY International Holdings ("Applicant") of the mark NEXTCOMPANY, shown in Serial No. 77/932446, for, among other services, "real estate property evaluation," "real estate property appraisal services," "management of leased portfolios in the field of real estate," "advisory, consulting and information on real estate property appraisal," "providing advice, consultation and information in the field of real estate investment," "managing real estate portfolios for foreign investors," and "establishment and management of real estate investment funds for others" in International Class 36 (the "Opposed Application"), and hereby opposes said registration.

The grounds for opposition are as follows:

1. On information and belief, Applicant is a company with an address at Nassau, Bahamas.
2. On January 11, 2011, the Opposed Application was published in the Official Gazette of the United States Patent and Trademark Office.
3. Opposer has been engaged for many years in the business of real estate services, including, but not limited to, real estate investment consulting and financial advisory services, real estate equity sharing, namely, managing and arranging for co-ownership of real estate, and real estate management.
4. Opposer is the owner of the U.S. service mark registrations covering the marks and services set forth below (collectively, the "NEXT Marks"), copies of which are attached as Exhibit A:

<u>Mark</u>	<u>Registration / Serial Number</u>	<u>Services</u>
NEXT	2,383,949	real estate brokerage services, real estate investment consulting, and financial advisory services; real estate development services
NEXT DEVELOPMENT	3,414,957	real estate development services
THE NEXT PERSPECTIVE IN REAL ESTATE	3,100,596	real estate brokerage services, real estate investment consulting, and financial advisory services; real estate development services
NEXT PARKING	3,191,656	real estate equity sharing, namely, managing and arranging for co-ownership of real estate; real estate investment; real estate management; and real estate syndication; real estate development
NEXT REALTY MIDWEST	3,141,792	real estate brokerage services; real estate agency services in the nature of assisting tenants with identifying and leasing properties
NEXT REALTY MID- ATLANTIC	3,141,788	real estate brokerage services; real estate agency services in the nature of assisting tenants with identifying and leasing properties



5. Opposer's NEXT registration, Reg. No. 2,383,949, has become incontestable and constitutes "conclusive evidence of ... the registrant's exclusive right to use the registered mark ..." under the Lanham Act, 15 U.S.C. § 1115(b) (underline added).

6. For many years, and long before the filing date of the Opposed Application, Opposer has continuously used, and presently uses, the NEXT Marks in interstate commerce in the United States in connection with real estate services.

7. For many years, Opposer has, at great expense, continuously engaged in the sale, advertising and promotion of its real estate services under its NEXT Marks. Opposer has, at great expense, extensively and continuously offered to the public high quality real estate services under its NEXT Marks. By reason of its efforts, and the expenditure of considerable sums for promotion, and by virtue of the excellence of its services offered under the NEXT Marks, the public and trade have come to recognize the NEXT Marks as signifying Opposer and its services, and Opposer has built up exceedingly valuable goodwill in connection with its real estate services offered under its NEXT Marks.

8. The NEXTCOMPANY mark set forth in the Opposed Application by Applicant is confusingly similar to Opposer's well known NEXT Marks. At least some of the services set forth in the Opposed Application are identical or highly related to those services provided by Opposer under its NEXT Marks, and those services of Applicant are likely to be encountered by the same persons who use Opposer's services and under circumstances that would give rise to the mistaken belief that Applicant's and Opposer's services originate from the same source.

9. The differences between Opposer's NEXT Marks and Applicant's mark NEXTCOMPANY are likely to increase, rather than reduce, the likelihood of confusion between the marks because Applicant's mark merely adds the word "COMPANY" that is descriptive. The dominant portion of both parties' marks is the same, and the parties' marks in their entireties convey substantially similar commercial impressions.

10. If Applicant is permitted to use and register the mark set forth in the Opposed Application, such registration and use by Applicant are likely to cause confusion, deception and mistake, and will seriously damage Opposer, all in violation of 15 U.S.C. §§ 1052(a) and (d). Persons familiar with Opposer's marks would be likely to mistakenly believe that Opposer is the source of, affiliated with, or has authorized the services offered under the mark NEXTCOMPANY. Any such confusion in the public or trade inevitably would result in loss of sales, harm to reputation, and other damage to Opposer.

11. If Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to use the mark set forth in the Opposed Application. Such registration by Applicant would be a source of irreparable damage and injury to Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of Applicant's application, Serial No. 77/932446, be denied and refused.

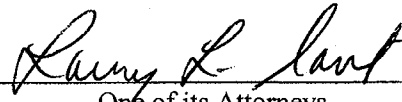
Opposer hereby consents and appoints Larry L. Saret, Luke W. DeMarte, and Jin-Won Jung, members of the bar of the State of Illinois, whose address is Michael Best & Friedrich LLP, 180 North Stetson Avenue, Suite 2000, Chicago, Illinois 60601, as its duly authorized agents and attorneys in the matter of the opposition above-identified to prosecute said opposition; to transact all business in the Patent and Trademark Office and in the United States courts in connection with this opposition, to sign its name to all papers which may hereafter be filed in connection therewith, and to receive all communications related to the same.

Dated: February 10, 2011

Respectfully submitted,

Next Realty, L.L.C.

By: \_\_\_\_\_



One of its Attorneys

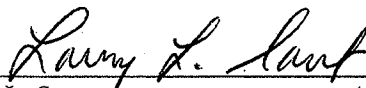
Larry L Saret  
Luke W. DeMarte  
Jin-Won Jung  
Michael Best & Friedrich LLP  
180 North Stetson Avenue  
Suite 2000  
Chicago, Illinois 60601  
Tel: (312) 222-0800  
Fax: (312) 222-0818

Attorneys for Next Realty, L.L.C.

**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and complete copy of the foregoing Notice of Opposition has been served upon Applicant by mailing said copy on February 10, 2011 via first class mail, postage prepaid, to:

Arturo Perez-Guerrero  
Law Offices of Arturo Perez-Guerrero  
P.O. Box 9024163  
San Juan, PR 00902-4163



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Larry L. Saret  
Jin-Won Jung  
MICHAEL BEST & FRIEDRICH LLP  
180 North Stetson Avenue  
Suite 2000  
Chicago, IL 60601  
Tel: (312) 222-0800  
Fax: (312) 222-0818

Attorneys for Opposer

Int. Cls.: 36 and 37

Prior U.S. Cls.: 100, 101, 102, 103, and 106

Reg. No. 2,383,949

**United States Patent and Trademark Office**

Registered Sep. 5, 2000

**SERVICE MARK  
PRINCIPAL REGISTER**

**NEXT**

NEXT REALTY, L.L.C. (ILLINOIS LIMITED LIABILITY COMPANY)  
ONE NORTHFIELD PLAZA  
SUITE 210  
NORTHFIELD, IL 60093

FOR: REAL ESTATE BROKERAGE SERVICES,  
REAL ESTATE INVESTMENT CONSULTING, AND  
FINANCIAL ADVISORY SERVICES, IN CLASS 36  
(U.S. CLS. 100, 101 AND 102).

FIRST USE 5-13-1998; IN COMMERCE 5-13-1998.  
FOR: REAL ESTATE DEVELOPMENT SERVICES,  
IN CLASS 37 (U.S. CLS. 100, 103 AND 106).

FIRST USE 5-13-1998; IN COMMERCE 5-13-1998.

SN 75-533,590, FILED 8-10-1998.

MARGERY A. TIERNEY, EXAMINING ATTORNEY

**EXHIBIT**

**A**

**Int. Cl.: 37**

**Prior U.S. Cls.: 100, 103, and 106**

**United States Patent and Trademark Office**

**Reg. No. 3,414,957**

**Registered Apr. 22, 2008**

**SERVICE MARK  
PRINCIPAL REGISTER**

**NEXT DEVELOPMENT**

**NEXT REALTY, L.L.C. (ILLINOIS LTD LIAB CO)  
400 SKOKIE BOULEVARD  
SUITE 800  
NORTHBROOK, IL 60062**

**OWNER OF U.S. REG. NOS. 2,383,949, 3,191,656,  
AND OTHERS.**

**FOR: REAL ESTATE DEVELOPMENT SERVICES,  
IN CLASS 37 (U.S. CLS. 100, 103 AND 106).**

**NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "DEVELOPMENT", APART FROM  
THE MARK AS SHOWN.**

**FIRST USE 8-15-2005; IN COMMERCE 8-15-2005.**

**SN 77-005,737, FILED 9-22-2006.**

**THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.**

**ELIZABETH BEYER, EXAMINING ATTORNEY**

Int. Cls.: 36 and 37

Prior U.S. Cls.: 100, 101, 102, 103 and 106

Reg. No. 3,100,596

United States Patent and Trademark Office

Registered June 6, 2006

**SERVICE MARK  
PRINCIPAL REGISTER**

**THE NEXT PERSPECTIVE IN  
REAL ESTATE**

NEXT REALTY, L.L.C. (ILLINOIS LTD LIAB CO)  
SUITE 210  
ONE NORTHFIELD PLAZA  
NORTHFIELD, IL 60093

FOR: REAL ESTATE BROKERAGE SERVICES,  
REAL ESTATE INVESTMENT CONSULTING, AND  
FINANCIAL ADVISORY SERVICES, IN CLASS 36  
(U.S. CLS. 100, 101 AND 102).

FIRST USE 7-27-1998; IN COMMERCE 7-27-1998.

FOR: REAL ESTATE DEVELOPMENT SERVICES,  
IN CLASS 37 (U.S. CLS. 100, 103 AND 106).

FIRST USE 7-27-1998; IN COMMERCE 7-27-1998.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,383,949.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "REAL ESTATE", APART FROM  
THE MARK AS SHOWN.

SER. NO. 78-650,873, FILED 6-15-2005.

RAUL CORDOVA, EXAMINING ATTORNEY

Int. Cls.: 36 and 37

Prior U.S. Cls.: 100, 101, 102, 103 and 106

**United States Patent and Trademark Office**

Reg. No. 3,191,656

Registered Jan. 2, 2007

**SERVICE MARK  
PRINCIPAL REGISTER**

**NEXT PARKING**

NEXT REALTY, L.L.C. (ILLINOIS LTD LIAB CO)  
SUITE 320  
TWO NORTHFIELD PLAZA  
NORTHFIELD, IL 60093

FOR: REAL ESTATE EQUITY SHARING, NAME-  
LY, MANAGING AND ARRANGING FOR CO-  
OWNERSHIP OF REAL ESTATE; REAL ESTATE  
INVESTMENT; REAL ESTATE MANAGEMENT;  
AND REAL ESTATE SYNDICATION, IN CLASS 36  
(U.S. CLS. 100, 101 AND 102).

FIRST USE 5-22-2005; IN COMMERCE 5-22-2005.

FOR: REAL ESTATE DEVELOPMENT, IN CLASS  
37 (U.S. CLS. 100, 103 AND 106).

FIRST USE 5-22-2005; IN COMMERCE 5-22-2005.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "PARKING", APART FROM THE  
MARK AS SHOWN.

SER. NO. 78-666,561, FILED 7-8-2005.

RAUL CORDOVA, EXAMINING ATTORNEY



Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

**United States Patent and Trademark Office**

**Reg. No. 3,141,792**

Registered Sep. 12, 2006

**SERVICE MARK  
PRINCIPAL REGISTER**

**NEXT REALTY MIDWEST**

NEXT REALTY L.L.C. (ILLINOIS LTD LIAB CO)  
SUITE 320  
TWO NORTHFIELD PLAZA  
NORTHFIELD, IL 60093

FOR: REAL ESTATE BROKERAGE SERVICES;  
REAL ESTATE AGENCY SERVICES IN THE NATURE  
OF ASSISTING TENANTS WITH IDENTIFYING  
AND LEASING PROPERTIES, IN CLASS 36  
(U.S. CLS. 100, 101 AND 102).

FIRST USE 3-8-2002; IN COMMERCE 3-8-2002.

THE MARK CONSISTS OF STANDARD CHARACTERS  
WITHOUT CLAIM TO ANY PARTICULAR FONT,  
STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,383,949.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "REALTY MIDWEST", APART  
FROM THE MARK AS SHOWN.

SER. NO. 78-724,418, FILED 9-30-2005.

RAUL CORDOVA, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

**United States Patent and Trademark Office**

Reg. No. 3,141,788

Registered Sep. 12, 2006

**SERVICE MARK  
PRINCIPAL REGISTER**

**NEXT REALTY MID-ATLANTIC**

NEXT REALTY L.L.C. (ILLINOIS LTD LIAB CO)  
SUITE 320  
TWO NORTHFIELD PLAZA  
NORTHFIELD, IL 60093

FOR: REAL ESTATE BROKERAGE SERVICES;  
REAL ESTATE AGENCY SERVICES IN THE NAT-  
URE OF ASSISTING TENANTS WITH IDENTIFY-  
ING AND LEASING PROPERTIES , IN CLASS 36  
(U.S. CLS. 100, 101 AND 102).

FIRST USE 7-1-1999; IN COMMERCE 7-1-1999.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,383,949.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "REALTY MID-ATLANTIC",  
APART FROM THE MARK AS SHOWN.

SER. NO. 78-724,213, FILED 9-30-2005.

RAUL CORDOVA, EXAMINING ATTORNEY