

ESTTA Tracking number: **ESTTA494152**

Filing date: **09/12/2012**

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.
Granted to Date of previous extension	09/12/2012
Address	400 Skokie Blvd. Northbrook, IL 60062 UNITED STATES

Correspondence information	Larry L. Saret Michael Best & Friedrich LLP 180 N. Stetson Avenue Suite 2000 Chicago, IL 60601 UNITED STATES chiipdocket@michaelbest.com Phone:312.222.0800
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Applicant Information

Application No	79107031	Publication date	05/15/2012
Opposition Filing Date	09/12/2012	Opposition Period Ends	09/12/2012
International Registration No.	1101290	International Registration Date	10/07/2011
Applicant	Silverneedle Hospitality Pte Ltd 238A THOMSON ROAD #25-07/10 NOVENA SQUARE (TOWER A); SINGAPORE 307684 SINGAPORE		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Business management of hotels
Class 036. All goods and services in the class are opposed, namely: Real estate rental and leasing services

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	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	2383949	Application Date	08/10/1998
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No.			
Registration Date	09/05/2000	Foreign Priority Date	NONE
Word Mark	NEXT		
Design Mark	NEXT		
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.	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	THE NEXT PERSPECTIVE IN REAL ESTATE		
Description of Mark	NONE		
Goods/Services	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 Class 037. First use: First Use: 1998/07/27 First Use In Commerce: 1998/07/27 real estate development services		

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	NEXT REALTY MID-ATLANTIC		
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		

U.S. Registration No.	3141792	Application Date	09/30/2005
Registration Date	09/12/2006	Foreign Priority Date	NONE
Word Mark	NEXT REALTY MIDWEST		
Design Mark	NEXT REALTY MIDWEST		
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.	3191656	Application Date	07/08/2005
Registration Date	01/02/2007	Foreign Priority Date	NONE
Word Mark	NEXT PARKING		

Design Mark	<h1>NEXT PARKING</h1>		
Description of Mark	NONE		
Goods/Services	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 Class 037. First use: First Use: 2005/05/22 First Use In Commerce: 2005/05/22 real estate development		

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	<h1>NEXT DEVELOPMENT</h1>		
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		

Attachments	75533590#TMSN.gif (1 page)(bytes) 78650873#TMSN.jpeg (1 page)(bytes) 78724213#TMSN.jpeg (1 page)(bytes) 78724418#TMSN.jpeg (1 page)(bytes) 78666561#TMSN.jpeg (1 page)(bytes) 77005737#TMSN.jpeg (1 page)(bytes) Notice of Opposition - # 11872333 v 1 - # 11872863 v 1.PDF (5 pages)(108113 bytes) Exhibit A - # 11869252 v 1.PDF (7 pages)(181393 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	09/12/2012

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

NEXT REALTY LLC,

Opposer,

v.


SILVERNEEDLE HOSPITALITY PTE LTD,

Applicant.

Opposition No. _____

Serial No.: 79/107031

Mark:

N E X T 

NOTICE OF OPPOSITION

Next Realty, L.L.C. (“Opposer”), an Illinois limited liability company, believes that it will be damaged by the registration by Silverneedle Hospitality Pte Ltd (“Applicant”) of the mark NEXT and Design, shown in Serial No. 79/107031, for “business management of hotels “ in International Class 35 and “real estate rental and leasing services” 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 corporation with an address at 238A Thomson Road #25-07/10 Novena Square (Tower A), Singapore 307684.
2. On May 15, 2012, the Opposed Application was published in the Official Gazette of the United States Patent and Trademark Office. Thereafter, Opposer sought and obtained an extension of time to file this Notice of Opposition.
3. On June 26, 2012, prior to filing this opposition, Opposer wrote to Applicant objecting to the Opposed Application and proposing a resolution. To date, Opposer has not received a response.

4. Opposer has been engaged for many years in the business of real estate services, including, but not limited to, real estate brokerage services, buying real estate assets, advising retail and institutional owners, property management and leasing services, sale/leaseback financing, real estate investment consulting, financial advisory services, real estate development services, real estate management services, and acquisition, development and redevelopment of parking facilities and property.

5. Opposer is the owner of the U.S. service mark registrations set forth below (collectively, the “NEXT Marks”), copies of which are attached as Exhibit A:

<u>Mark</u>	<u>Registration / Serial No.</u>	<u>Services</u>
NEXT	2,383,949	real estate brokerage services, real estate investment consulting, and financial advisory services; 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 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
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 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 DEVELOPMENT	3,414,957	real estate development services

6. Opposer’s registrations for NEXT and THE NEXT PERSPECTIVE IN REAL ESTATE, Reg. Nos. 2,383,949 and 3,100,596, have become incontestable and constitute “conclusive

evidence of ... the registrant's exclusive right to use the registered mark[s] ..." under the Lanham Act, 15 U.S.C. § 1115(b) (underline added).

7. 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.

8. The mark NEXT and Design set forth in the Opposed Application is confusingly similar to Opposer's well known NEXT Marks.

9. The "real estate rental and leasing services" set forth in the Opposed Application are identical or highly related to those services provided by Opposer under its NEXT Marks.

10. Opposer's rights in its NEXT Marks predate any rights Applicant has in the Opposed Application or the mark shown therein.

11. If Applicant is permitted to use and register the mark set forth in the Opposed Application in connection with the services in International Class 36 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.

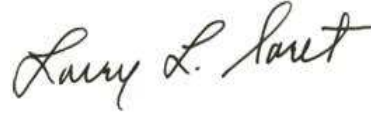
12. If Applicant were granted the registration herein opposed in connection with services in International Class 36, it would thereby obtain at least a *prima facie* exclusive right to use the mark set forth in the Opposed Application. Such registration by Applicant would be a source of irreparable damage and injury to Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of Applicant's application, Serial No. 79/107031, insofar as it pertains to services in International Class 36, be denied and refused.

Dated: September 12, 2012

Respectfully submitted,

Next Realty, L.L.C.

A handwritten signature in cursive script that reads "Larry L. Saret".

By: _____
One of its Attorneys

Larry L Saret
Luke W. DeMarte
Michael Best & Friedrich LLP
Two Prudential Plaza
180 N. Stetson Ave., Suite 2000
Chicago, Illinois 60601
(312) 222-0800

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 September 12, 2012 via first class mail, postage prepaid, to:

238A Thomson Road #25-07/10
Novena Square (Tower A)
Singapore 307684



Larry L. Saret

EXHIBIT A

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

Int. Cls.: 36 and 37

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

United States Patent and Trademark Office

Reg. No. 3,100,596

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. 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 NATURE
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

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 IDENTIFY-
ING 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 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 MIDWEST", APART
FROM THE MARK AS SHOWN.

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

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.: 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

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

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

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

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

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

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

ELIZABETH BEYER, EXAMINING ATTORNEY