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

Proceeding	91221511
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NIKE, INC.,)	
)	
vs.)	Opposition No. 91221511
)	Application No. 86330661
)	
CAPITAL E FINANCE CO, LLC,)	MARK: JUST DID IT
Applicant.)	
)	

**OPPOSER NIKE, INC.'S MEMORANDUM IN SUPPORT OF ENTRY OF
JUDGMENT SUBMITTED PURSUANT TO THE ACCELERATED CASE
RESOLUTION (ACR) STIPULATION**

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TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	STATEMENT OF THE ISSUES.....	2
III.	STATEMENT OF THE RECORD.....	3
IV.	STATEMENT OF FACTS	5
	A. Applicant Stipulated to Dispositive Facts Relevant to this ACR	5
	B. The Fame and Notoriety of the JUST DO IT Mark.....	11
	1. Applicant Admits JUST DO IT is Famous and the TTAB Has Previously Found JUST DO IT Famous.....	11
	2. JUST DO IT Has Been Widely Recognized by Consumers and the Media From Its Earliest Days to the Present	12
	3. JUST DO IT Has Enjoyed Widespread Advertising and Publicity	13
	4. Products Bearing JUST DO IT Have Generated Substantial Sales Throughout the United States	17
	5. JUST DO IT Is the Subject of Widespread Recognition in the Media	19
	6. NIKE Actively Protects JUST DO IT Through Its Trademark Registrations and Consistent Enforcement Efforts.....	21
	C. Applicant and the Opposed Application.....	22
V.	PROCEDURAL HISTORY.....	23
VI.	ARGUMENT.....	24
	A. NIKE Has Standing and Priority.....	24
	B. Applicant’s Registration of “JUST DID IT” is Likely to Dilute the Famous JUST DO IT Mark	25
	1. JUST DO IT Is a Famous Mark and Acquired Fame Well Before the Date of Applicant’s Application	26
	2. Applicant’s Registration of “JUST DID IT” is Likely to Blur the Distinctiveness of the JUST DO IT Mark.....	27
	C. Applicant’s Registration of “JUST DID IT” is Likely to Cause Confusion With the Famous JUST DO IT Mark.....	30
	1. NIKE’s JUST DO IT Mark is Famous for Likelihood of Confusion and Dilution Purposes	31
	2. NIKE’s JUST DO IT Mark and Applicant’s JUST DID IT Mark Are Similar.....	32

3.	The Similarity and Nature of the Goods; the Similarity of Likely-to-Continue Trade Channels and Classes of Consumers Factors Favor NIKE.....	32
VII.	CONCLUSION.....	34

TABLE OF AUTHORITIES

Cases

<i>Am. Throwing Co. v. Famous Bathrobe Co.</i> , 116 U.S.P.Q. 156 (C.C.P.A. 1957)	24
<i>Application of E. I. DuPont DeNemours & Co.</i> , 476 F.2d 1357 (C.C.P.A. 1973)	30, 31, 32
<i>B.V.D. Licensing Corp. v. Body Action Design Inc.</i> , 6 U.S.P.Q.2d 1719 (Fed. Cir. 1988)	24
<i>Bose Corp. v. QSC Audio Prod. 's Inc.</i> , 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002)	32, 34
<i>Genesco Inc. v. Martz</i> , 66 U.S.P.Q.2d 1260 (TTAB 2003)	33
<i>Kenner Parker Toys Inc. v. Rose Art Indus. Inc.</i> , 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992)	34
<i>Lipton Indus., Inc. v. Ralston Purina Co.</i> , 213 U.S.P.Q. 185 (C.C.P.A. 1982)	24
<i>Nat'l Pork Bd. v. Supreme Lobster & Seafood Co.</i> , 96 U.S.P.Q.2d 1479 (TTAB 2010)	30
<i>Nike v. Maher</i> , 100 U.S.P.Q.2d 1018 (TTAB 2011)	passim
<i>Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772</i> , 73 USPQ2d 1689 (Fed. Cir. 2005)	31, 32
<i>Recot Inc. v. Becton</i> , 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000)	32
<i>UMG Recordings Inc. v. O'Rourke</i> , 92 U.S.P.Q.2d 1042 (T.T.A.B. 2009)	33

Statutes

15 U.S.C. §1052(d)	passim
15 U.S.C. § 1125(c)	passim

I. INTRODUCTION

The salient facts of this Opposition are largely undisputed. Opposer NIKE, Inc. (“NIKE”), a leading sport and fitness company, has standing and priority in this proceeding to assert what is perhaps one of the most recognizable trademarks of the last century and this century: JUST DO IT. Launched in 1988, the JUST DO IT mark was developed by NIKE as a means of unifying its mission across its advertisements. NIKE’s JUST DO IT campaign was met with widespread success and recognition among consumers in a way that transcended sports. In the over twenty-five years since then, NIKE has continuously and consistently used the JUST DO IT mark, selling over 50 million units of product bearing JUST DO IT in every state of the United States, including in connection with, for example, shirts, pants, caps, footwear, backpacks, eyewear, etc.; spending billions of dollars on advertisements that include JUST DO IT globally, including on TV, in print; and online; and extending the reach of JUST DO IT through NIKE’s prominent presence in the digital world, including through social media.

Applicant Capital E Finance Co., LLC (“Applicant”) concedes NIKE’s JUST DO IT mark is famous and concedes the Trademark Trial and Appeal Board (“TTAB”) previously found the JUST DO IT mark famous in *Nike v. Maher*, 100 U.S.P.Q.2d 1018 (TTAB 2011), explaining the famous JUST DO IT mark “is entitled to a wide scope of protection.” Nevertheless, Applicant filed Application No. 86/330,661 for “JUST DID IT” on July 8, 2014 (“Application”), citing a bona fide intention to use the mark in Class 25 in connection with goods such as “[w]earable garments and clothing” and “clothing

for athletic use”—the very same types of goods on which NIKE has used the famous JUST DO IT mark for more than twenty-five years.

The conclusions that the TTAB reached nearly five years ago in *Maher*, when it found that JUST JESU IT was likely to cause confusion with and dilution of NIKE’s famous mark, JUST DO IT, are just as applicable today in this case. Indeed, since the *Maher* decision, JUST DO IT has become even more famous, due to, *inter alia*, (1) NIKE’s ongoing, expanded, and continuous use and promotion of JUST DO IT, (2) widespread public recognition of NIKE’s famous JUST DO IT mark that has continued unabated, and perhaps even increased, after NIKE’s celebration of the 25th Anniversary of JUST DO IT in 2013, and (3) NIKE’s continuous efforts to protect the integrity of its JUST DO IT mark through ongoing enforcement efforts, particularly in proceedings before the TTAB.

For those reasons and the reasons explained below, Applicant’s registration of JUST DID IT is likely to cause dilution by blurring of NIKE’s famous JUST DO IT mark and is likely to cause confusion among consumers under Sections 43(c) and 2(d) of the Trademark Act, 15 U.S.C. §§ 1125(c) and 1052(d). Accordingly, judgment should be granted to NIKE, this Opposition should be sustained on grounds of both dilution and likelihood of confusion, and registration of Applicant’s JUST DID IT mark should be refused.

II. STATEMENT OF THE ISSUES

1. Under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), whether Applicant’s mark, JUST DID IT, is likely to cause dilution by blurring of the distinctive

quality of NIKE's prior registered mark, JUST DO IT, which Applicant has stipulated is famous and became famous long before the July 8, 2014, filing date of Applicant's intent-to-use Application.

2. Under Section 2(d) of the Trademark Act, 15 U.S.C § 1052(d), whether Applicant's mark, JUST DID IT, is likely to cause confusion with NIKE's prior registered mark, JUST DO IT, which is registered and used, *inter alia*, for the same types of goods identified in Applicant's Application.

III. STATEMENT OF THE RECORD

NIKE's Memorandum in Support of Entry of Judgment Submitted Pursuant to the ACR Resolution Stipulation is supported by the following:

- Parties' Stipulation of Facts Not In Dispute Pursuant to the Accelerated Case Resolution (ACR) Stipulation, filed January 4, 2016 ("Stipulation") (Dkt. 12);¹
- NIKE's First Notice of Reliance, which includes numerous newspaper articles and periodical articles referencing NIKE and the JUST DO IT mark and/or advertisements featuring JUST DO IT ("1st Not. of Reliance"), submitted herewith as Exhibit A pursuant to Paragraph 4 of the parties' Stipulation for Use of ACR, filed August 25, 2015, and granted October 5, 2015 (Dkt. 10)²;

¹ "Dkt" citations are to the docket listing viewable through the TTABVUE record for the opposition proceeding.

² Paragraph 4 of the parties' Stipulation to Use ACR provides that "[e]vidence that under normal trial procedures could be submitted by notice of reliance also may be submitted as attachments or exhibits to the parties' briefs."

- NIKE’s Second Notice of Reliance, which includes certified copies showing current status and title of NIKE’s U.S. Trademark Registrations for JUST DO IT at issue in this proceeding (“2d Not. of Reliance”)³, submitted herewith as Exhibit B pursuant to Paragraph 4 of the parties’ Stipulation for Use of ACR;

- Declaration of Jaime Lemons, NIKE’s Global Counsel, Trademark and Copyright, which sets forth facts relating to NIKE’s trademark rights in JUST DO IT, NIKE’s sale of products bearing JUST DO IT, third-party recognition of JUST DO IT, and NIKE’s enforcement of JUST DO IT (“Lemons Decl.”), submitted herewith as Exhibit C (with corresponding Exhibits cited as “C-1,” “C-2,” etc.);⁴

- Declaration of Melanie Sedler, a Trademark Paralegal at NIKE and a NIKE employee since 1979, which sets forth facts relating to the history of JUST DO IT, as well as NIKE’s advertisements and promotions relating to JUST DO IT (“Sedler Decl.”), submitted herewith as Exhibit D (with corresponding Exhibits cited as “D-1,” “D-2,” etc.); and

- Declaration of Nathan Kappes, Litigation Paralegal at Banner & Witcoff, Ltd., which sets forth facts relating to in-store displays featuring JUST DO IT, use of JUST DO IT on products, presence of JUST DO IT on social media, and awards and

³ NIKE’S Registration Nos. 1,875,307, 4,350,316 and 4,704,671 were already made of record with the initial Notice of Opposition (Dkt. 1) pursuant to 37 CFR § 2.122. However, its pleaded pending Application No. 86/444,421 did not mature into Registration No. 4,764,071 until after the proceeding was filed. In accordance with TBMP § 704.03(b)(1)(A), a certified copy of that registration is made of record via the Second Notice of Reliance, along with certified copies of NIKE’s other registrations.

⁴ Ms. Lemons testified in the *Maher* proceeding. At that time, her last name was Schwartz.

recognition for JUST DO IT (“Kappes Decl.”), submitted herewith as Exhibit E (with corresponding Exhibits cited as “E-1,” “E-2,” etc.).

IV. STATEMENT OF FACTS

A. Applicant Stipulated to Dispositive Facts Relevant to this ACR

NIKE and Applicant entered into a Stipulation of Facts Not In Dispute as part of this ACR proceeding. The stipulated facts include case-dispositive facts relevant to NIKE’s opposition to Applicant’s JUST DID IT mark, including:

- NIKE is a leading sport and fitness company and a leading provider of a broad range of clothing, footwear, sporting goods, athletic equipment and related products and services. (Dkt. 12, Stipulation ¶ 1.)
- NIKE has standing to bring this proceeding based on its prior pleaded U.S. Trademark Registration Nos. 1,875,307, 4,350,316 and 4,704,671, and pending Application No. 86/444,421 (which is now Reg. No. 4,764,071) for its trademark JUST DO IT (“NIKE’s Mark” or “JUST DO IT”). (*Id.* ¶ 2.)⁵
- NIKE’s Trademark Registration No. 1,875,307 is incontestable, and Trademark Registration Nos. 1,875,307, 4,350,316 and 4,704,671 all have application filing dates prior to the July 8, 2014, filing date of Applicant’s Application. (*Id.* ¶¶ 3, 4.)
- Over the years, NIKE has owned other registrations for JUST DO IT, including U.S. Trademark Registration Nos. 1,817,919 and 1,931,937. (*Id.* ¶ 5.)

⁵ U.S. Trademark Registration No. 1,875,307 is for “JUST DO IT.” (with a period). For ease of reference in this Memorandum, NIKE refers to the mark as “JUST DO IT” (without a period).

- NIKE has used the JUST DO IT mark in commerce continuously since January 26, 1989, and began using the JUST DO IT mark in connection with the goods cited in its pleaded registrations prior to the July 8, 2014, filing date of Applicant’s Application. (*Id.* ¶¶ 6, 7.)
- The JUST DO IT mark is famous, and became famous before Applicant filed its application for “JUST DID IT” on July 8, 2014. (*Id.* ¶¶ 8, 9.)
- The Trademark Trial and Appeal Board held NIKE’s JUST DO IT mark famous both for likelihood of confusion and dilution purposes in its precedential decision, *Nike v. Maher*, 100 U.S.P.Q.2d 1018 (TTAB 2011). (*Id.* ¶ 10.)
- In the *Maher* decision, the TTAB also held that the trademark JUST JESU IT for clothing was likely to cause confusion with and dilute NIKE’s famous JUST DO IT mark, and sustained NIKE’s opposition. (*Id.* ¶ 11.) Among other things, the TTAB recognized that NIKE’s “famous mark, JUST DO IT, is entitled to a wide scope of protection.” (*Id.*)
- Since issuance of the *Maher* decision in 2011, NIKE has continued to use and extensively advertise its JUST DO IT mark. (*Id.* ¶ 12.)
- Prior to the *Maher* decision, the following four trademarks had been issued by the USPTO either without opposition or over an opposer’s objections: Just Brew It (April 3, 2011; Registration No. 2439760); Just Be It (October 15, 2002; Registration No. 2634997); Just Grab It (October 23, 2007; Registration No. 3317983); and Just Jew It (December 4, 2007; Registration No. 3349372). (*Id.* ¶ 13.)

- With respect to those four trademarks, the *Maher* decision recognized,

inter alia:

Third-party registrations have little probative value by themselves because they tell us nothing about whether or not the marks are actually being used or the manner of any such use. . . . Applicants have not submitted evidence or testimony to prove that the third-party marks are in use. Without evidence as to how, or whether, the third-party marks have been used, we cannot assess whether any such use has been so widespread as to have had an impact on consumer perceptions.

To the extent the registrations have been offered not to establish use but to indicate that the phrase is a commonly registered expression having a suggestive meaning, we have considered the registrations for this purpose. In this regard, the existence of the four active registrations does not persuade us that the phrase “just ... it” would be considered a commonly registered element such that a mark following this pattern but with a different middle term would thereby be rendered, as a whole, distinguishable from opposer’s famous mark.

(*Id.* ¶ 14 (citations omitted).)

- NIKE has successfully opposed or petitioned to cancel the following trademark applications and registrations of marks including the phrase “JUST...IT” (along with their proceeding number and termination dates):⁶

MARK	PROCEEDING NUMBER	TERMINATION DATE
JUST JUICE IT	Opposition Number: 91090678	October 26, 1993
JUST DO IT LIKE YOU MEAN IT!	Opposition Number: 91159496	October 1, 2004

⁶ On January 14, 2016, shortly after the parties filed the Stipulation of Facts, the Board also entered a judgment sustaining NIKE’s registration of the mark JUST WELD IT! in Opposition No. 91224232. Due to the timing, it was not included in the Stipulation, but it falls into the category of applications that were successfully opposed by NIKE.

MARK	PROCEEDING NUMBER	TERMINATION DATE
JUST DIG IT	Opposition Number: 91159865	November 27, 2004
NOOKIE...JUST DID IT!	Opposition Number: 91163474	April 28, 2005
JUST DOUGH IT	Opposition Number: 91163646	June 18, 2005
JUST KIK-N-IT	Cancellation Number: 92044860	April 5, 2006
JUST SPIN IT	Opposition Number: 91166679	January 20, 2006
JUST DUNE IT	Opposition Number: 91167295	November 3, 2006
JUST STICK IT	Opposition Number: 91169712	July 5, 2006
JUST NAIL IT	Opposition Number: 91169848	November 30, 2006
JUST NON-DO IT	Opposition Number: 91174667	May 18, 2007
DO JUST IT	Opposition Number: 91179431	May 8, 2008
JUST DRINK IT	Opposition Number: 91180569	February 7, 2011
JUST TUBE IT	Opposition Number: 91182260	May 19, 2008
JUST STICK IT	Opposition Number: 91184010	October 2, 2008
JUST HANDLE IT	Opposition Number: 91184207	September 12, 2008
JUST ADD IT	Opposition Number: 91184206	September 11, 2008
JUST O2 IT	Opposition Number: 91185448	November 17, 2008
JUST FLOP IT	Opposition Number: 91187730	March 19, 2009
JUST TASTE IT	Opposition Number: 91188970	June 4, 2009
1 JUST DO ONE and JUST DO ONE	Opposition Number: 91193381	May 11, 2010
JUST JESU IT	Opposition Number: 91188789	October 24, 2011
JUST BUY IT	Opposition Number:	November 4,

MARK	PROCEEDING NUMBER	TERMINATION DATE
	91196082	2010
JUST KITE IT	Opposition Number: 91196301	February 28, 2011
JUST THROW IT	Opposition Number: 91196463	January 4, 2011
JUST WEAR IT	Opposition Number: 91200408	March 6, 2012
JUST SHAVE IT	Opposition Number: 91202503	March 13, 2012
DON'T JUST DO IT DO IT RIGHT	Opposition Number: 91208950	May 28, 2015
JUST FAKE IT	Opposition Number: 91217251	August 21, 2014
DON'T JUST DO IT...DO IT RIGHT. VV & V	Cancellation Number: 92059548	March 9, 2015
JUST MAK'IN IT	Opposition Number: 91217899	August, 29 2014
JUST FIX IT!	Opposition Number: 91218955	January 28, 2015
JUST CHEW IT	Opposition Number: 91219095	January 15, 2015
FRAC-N-HOSE JUST FRAC IT	Opposition Number 91219572	March 27, 2015

(*Id.* ¶ 15.)

- Applicant is a company primarily engaged in the business of financing or arranging financing for energy and environmental related projects and businesses. (*Id.* ¶ 16.)

- Applicant filed its Application No. 86/330,661 for JUST DID IT pursuant to Section 1(b) of the Trademark Act on July 8, 2014, asserting its bona fide intention to

use the mark JUST DID IT in commerce in connection with all of the goods identified in its Application No. 86/330,661. (*Id.* ¶ 17.)

- The goods identified in Applicant's Application No. 86/330,661 are:

Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; *Athletic apparel*, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic shirts; Button down shirts; Button-front aloha shirts; *Clothing for athletic use*, namely, padded shirts; Collared shirts; Golf shirts; Graphic T-shirts; Hooded sweat shirts; Knit shirts; Long-sleeved shirts; Maternity clothing, namely, shirts; Night shirts; Open-necked shirts; Polo shirts; Rugby shirts; Shirts and short-sleeved shirts; Shirts for infants, babies, toddlers and children; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sleeves worn separate and apart from blouses, shirts and other tops; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sun protective clothing, namely, shirts; Sweat shirts; T-shirts; Tee shirts; *Triathlon clothing*, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits; Turtle neck shirts; *Wearable garments and clothing, namely, shirts*; Yoga shirts

(*Id.* ¶ 18 (emphasis added).)

- Applicant did not use JUST DID IT as a trademark in connection with any of the goods set forth in its Application prior to the July 8, 2014, filing date, and does not claim rights to JUST DID IT as a trademark in connection with any of the goods set forth in its application prior to the July 8, 2014, filing date. (*Id.* ¶¶ 19, 20.)

- Since filing its Application, Applicant has not made use, or use in commerce, of its mark JUST DID IT as a trademark in connection with the goods set forth in its Application. (*Id.* ¶ 21.)

- NIKE has never given Applicant any consent or permission or otherwise authorized Applicant to use or register the mark JUST DID IT in connection with any goods or services, nor has Applicant requested the same. (*Id.* ¶ 22.)
- There is no connection or affiliation between NIKE and Applicant or Applicant’s goods or services. (*Id.* ¶ 23.)

B. The Fame and Notoriety of the JUST DO IT Mark

1. Applicant Admits JUST DO IT is Famous and the TTAB Has Previously Found JUST DO IT Famous

Applicant admits the JUST DO IT mark is famous, and became famous before it filed its application for “JUST DID IT” on July 8, 2014. (Stipulation ¶¶ 8, 9.) The TTAB has likewise held the JUST DO IT mark famous both for likelihood of confusion and likelihood of dilution purposes. (*Id.* ¶ 10.) *See Nike v. Maher*, 100 U.S.P.Q.2d 1018.⁷ As described below, since the TTAB’s finding of fame in *Maher*, NIKE has continued to use and extensively advertise its JUST DO IT mark and its fame has continued to grow. (Stipulation ¶ 12; Sedler Decl. ¶¶ 13, 14, 21–32; Lemons Decl. ¶¶ 9–12, 19.)⁸

⁷ In the *Maher* case, the Board used, *inter alia*, quotes from Applicant Maher’s discovery responses to illustrate the fame of the NIKE mark, including Applicant’s response to Interrogatory No. 13: “Who isn’t aware of Opposer’s Mark? At least in the free world.” And its response to a request for production of documents regarding when it first learned of NIKE’s Mark: “No such documents. Applicants don’t live under a rock.” *Nike v. Maher*, 100 USPQ2d at 1024.

⁸ For the sake of completeness, Section IV.B also sets forth the facts confirming what the Applicant concedes: the JUST DO IT mark is famous and became famous before the July 8, 2014, filing date of Applicant’s Application.

2. JUST DO IT Has Been Widely Recognized by Consumers and the Media From Its Earliest Days to the Present

The genesis of the JUST DO IT mark in the late 1980s is recounted in detail in the Declaration of Melanie Sedler. (Sedler Decl. ¶¶ 8–14.) From its inception, the JUST DO IT campaign distinguished itself from other advertising campaigns of the day. For example, rather than rely exclusively on commercials featuring world-class athletes, NIKE introduced a series of commercials featuring ordinary people that embodied the spirit of JUST DO IT. (*Id.* ¶¶ 11, 12, Exs. D-2, D-3.) One of the earliest JUST DO IT commercials featured a man in his eighties who ran across the Bay Bridge each morning. (*Id.* ¶ 11, Ex. D-2.) The man explains that he keeps his teeth from chattering on cold mornings by removing them before he runs. (*Id.*) Images of the commercial are below and available on YouTube at https://www.youtube.com/watch?v=p_xozTo6wrU.

Figure 1: Walt Stack JUST DO IT Commercial



The JUST DO IT campaign resonated with consumers. (*Id.* ¶¶ 10, 13, 14.) To harness the success of JUST DO IT, NIKE extended JUST DO IT “to all levels of the company, creating excitement at the corporate, retail, and consumer level” and to have “all facets of NIKE, echo and support the same message. (*Id.* ¶ 9, 10, Ex. D-1.) That

message: ‘Just Do It.’” (*Id.* ¶ 10; Ex. D-1.) The JUST DO IT campaign was a contributing factor to NIKE’s success in the late 1980s and early 1990s such that the campaign has remained a central part of NIKE’s overall strategy for more than twenty-five years. (*Id.* ¶ 13.)

NIKE has evolved how it engages with consumers with respect to JUST DO IT, particularly in the digital era. (*Id.*) For example, NIKE now engages with consumers through different online platforms, such as through social media, to find ways to deliver JUST DO IT in an interactive way. (*Id.*) An example of NIKE’s use of JUST DO IT on Facebook is shown below. (Sedler Decl. ¶ 25; *see also* Kappes Decl. ¶¶ 4–6, Exs. E-3–E-5.)

Figure 2: NIKE’s Use of JUST DO IT on Social Media



3. JUST DO IT Has Enjoyed Widespread Advertising and Publicity

NIKE supported the initial launch of the JUST DO IT campaign with over \$5.6 million in TV and print advertisements over a three month period. (Sedler Decl. ¶¶ 9, 10,

Ex. D-1.) Nearly every department at NIKE became involved in promoting the JUST DO IT theme, including Administrative Services to maintain JUST DO IT displays in the lobby of NIKE buildings, to update the phone greeting to “NIKE – JUST DO IT,” and to use JUST DO IT advertising dye for postal machines in all facilities; Consumer Services to update the phone greetings and recorded messages to convey JUST DO IT; Credit Department to include JUST DO IT on customer invoices; Distribution and Operations to include JUST DO IT on shipping cartons and on outgoing correspondence; Internal Relations to order employee t-shirts and coordinate stage presentation and visuals; Retail Stores to feature JUST DO IT in display windows and the store interior; Public Relations to develop a JUST DO IT press kit, among other departments. (*Id.*)

Since that launch, for more than twenty-five years, NIKE has continued to advertise and promote the JUST DO IT mark. (*Id.* ¶¶ 13 – 27, Exs. D-4–D12.) An example of an in-store retail display promoting JUST DO IT from only a week ago in January 2016 is shown below. (Kappes Decl. ¶ 2, Ex. E-1.)

Figure 3: JUST DO IT Retail Display



NIKE’s decision to feature ordinary people, as well as world class athletes, in its JUST DO IT advertisements has likewise continued through today. (Sedler Decl. ¶¶ 11,

19, 20) Examples of NIKE's advertisements for JUST DO IT from 1988 through 2015 are attached as Exhibits D-4 through D-11 to the Declaration of Melanie Sedler. Many of those TV advertisements have withstood the test of time as evidenced by their popularity on YouTube.com, with some ads approaching nearly 1 million views. (Sedler Decl. ¶¶ 17, 20, Ex. D-6.) Additionally, many of the advertisements featured, and continue to feature, renowned athletes including, for example, Olympian, Carl Lewis; professional baseball and football player, Bo Jackson; professional basketball player, Michael Jordan; professional football player, Howie Long; professional tennis player, Pete Sampras; professional basketball player, Charles Barkley; professional golfer, Tiger Woods; professional tennis player, Maria Sharapova; professional basketball player, LeBron James; professional tennis player, Serena Williams; and professional boxer Manny Pacquiao, among others. (*Id.* ¶ 19.)

NIKE's use of the JUST DO IT mark in connection with its sponsorship of numerous athletes, teams, and events has continued to today, while also furthering its presence on social media. (*Id.* ¶¶ 18, 25, Ex. D-7.) For example, #JUSTDOIT was prominently displayed in the ring during a boxing match between Manny Pacquiao and Floyd Mayweather in 2015 as shown below. (*Id.*)



NIKE celebrated the 20th Anniversary of the JUST DO IT mark in 2008—prior to the *Maher* proceeding. (*Id.* ¶ 21.) At that time, JUST DO IT received a substantial amount of publicity, including a worldwide television campaign. (*Id.*; see also 1st Not. of Reliance Exs. A-74–A80.) For example, NIKE aired a JUST DO IT commercial during the 2008 Olympics that featured Carl Lewis. (Sedler Decl. ¶ 21.) YouTube views for that video have exceeded one million. (*Id.*)

Since the *Maher* proceeding, NIKE also celebrated the 25th Anniversary of the JUST DO IT mark. (*Id.* ¶ 22.) Again, JUST DO IT received a substantial amount of unsolicited and solicited publicity. (*Id.*; Kappes Decl. ¶¶ 7–11, 22–26, Exs. E-6–E-10, E-21–E-26; 1st Not. of Reliance Exs. A-88–A91.) To that end, NIKE promoted the 25th Anniversary by, *inter alia*, releasing videos of interviews of NIKE employees celebrating the JUST DO IT mark over the years. (Sedler Decl. ¶ 22, Ex. D-9.)

NIKE’s commitment to JUST DO IT, and the substantial amount of publicity it has received through the years, is further reflected in NIKE’s advertising expenditures for JUST DO IT. Since 1989, NIKE’s overall advertising expenditures have exceeded \$19

billion globally. (*Id.* ¶ 26.) NIKE estimates that approximately 30% of that amount was dedicated to advertising that included JUST DO IT (*id.*), or approximately \$6 billion total. Since 2008, NIKE estimates it spent two hundred million dollars in the United States alone on advertisements and promotions featuring JUST DO IT. (*Id.*)

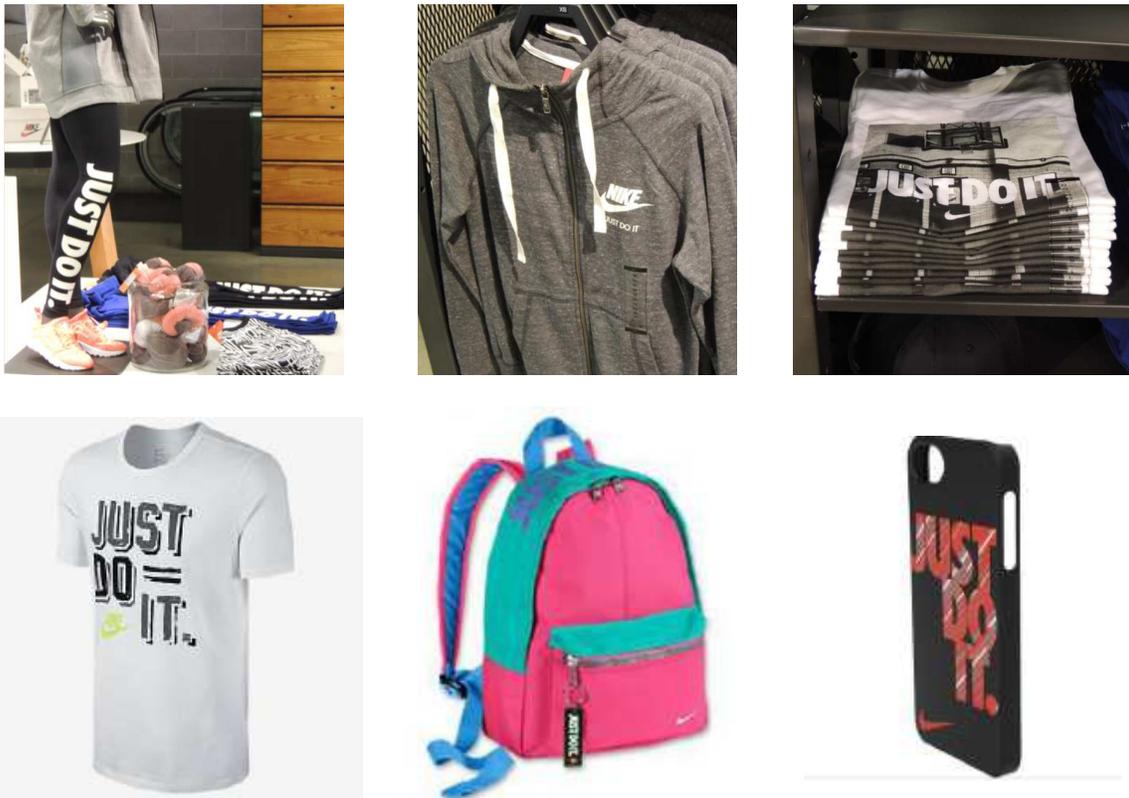
4. Products Bearing JUST DO IT Have Generated Substantial Sales Throughout the United States

As noted in the *Maher* proceeding, 100 U.S.P.Q.2d at 1027, NIKE conservatively estimates that it has distributed more than 10,000 different product types in the United States featuring JUST DO IT, totaling over 27.5 million units of JUST DO IT products sold in every state of the United States between 1989 and 2009. (Lemons Decl. ¶¶ 9–12.) Representative examples of those products include for example, footwear, many different types of apparel, such as t-shirts, sweatshirts, tank tops, polo shirts, jackets, capris, shorts, pants, caps, socks, as well as backpacks, duffle bags, sunglasses, cell phone covers, bumper stickers, lanyards, and wristbands. (*Id.* ¶ 13; Kappes Decl. ¶ 2, 3, Exs. E-1–E-2; Sedler Decl. ¶¶ 27–33, Exs. D-12–D-18.)

After the TTAB’s finding of fame in *Maher*, NIKE continued to distribute numerous products bearing JUST DO IT throughout the United States. (Lemons Decl. ¶¶ 10, 12.) Indeed, in the last five years alone (*i.e.*, since 2010) NIKE’s sales of products bearing JUST DO IT or “JDI” in the style name (which refers to a JUST DO IT product) have exceeded 30 million units. (*Id.* ¶ 12.) Examples of those products were submitted to the USPTO as specimens in connection with NIKE’s trademark registrations for JUST DO IT, including U.S. Trademark Registration Nos. 1,875,307; 4,350,316; 4,704,671, and 4,764,071, exemplary images of which are shown below. (Sedler Decl. ¶¶ 28–32,

Exs. D-13–D-17.) Additional examples of NIKE products bearing JUST DO IT as displayed in a NIKE retail store in January 2016 and on NIKE’s website are identified in the Declaration of Nathan Kappes, exemplary images of which are also shown below. (Kappes Decl. ¶ 2, 3, Exs. E-1–E-2.)

Figure 4: Examples of NIKE’s Products Bearing JUST DO IT Since *Mahe*



Additionally, NIKE uses and promotes the JUST DO IT mark on its product packaging. For example, since 2006, NIKE has also placed the JUST DO IT mark on its corporate shoe boxes. (Sedler Decl. ¶ 33, Ex. D-18.) As the TTAB in *Mahe* recognized, between 2006 and 2010, NIKE distributed approximately 900 million shoe boxes bearing JUST DO IT. 100 U.S.P.Q. at 1026. (*Id.*) Since the *Mahe* decision, NIKE has

distributed over 1.5 billion shoe boxes displaying JUST DO IT. (*Id.*) An image of the JUST DO IT mark as it appears on NIKE's shoe boxes is show below.



5. JUST DO IT Is the Subject of Widespread Recognition in the Media

As a result of its widespread appeal over the last twenty-five-plus years, JUST DO IT has received a pervasive amount of unsolicited publicity and recognition, including in newspaper articles, periodicals, and books. (*See* 1st Not. of Reliance.) As recognized in the *Maier* proceeding, the “slogan has made its way into the popular culture at all levels,” 100 U.S.P.Q. 2d 1018. The Board’s opinion included a long list of articles and references, *id.* at 1024–26, which are included in NIKE’s 1st Notice of Reliance (Exs. A1–A91). Since the TTAB’s finding of fame in the *Maier* proceeding, JUST DO IT has continued to receive widespread recognition in the media, including in recognition of its 25th Anniversary. For example:

- “Nike’s ‘Just Do It’ slogan, unveiled 25 years ago this month by Wieden + Kennedy, might be the last great tagline in advertising history.” Gianatasio, David, *Happy 25th Birthday to Nike’s ‘Just Do It,’ the Last Great Advertising Slogan*, *AdWeek*, July 2, 2013. (Kappes Decl. ¶ 22, Ex. E-21.)
- “Nike’s ‘Just Do It’ is arguably the best tagline of the 20th century. It cut across age and class barriers, linked Nike with success – and made consumers believe

they could be successful too just by wearing its products.” *History of Advertising: No 118: Nike’s ‘Just Do It’ tagline*, Campaign Live, January 22, 2015. (Kappes Decl. ¶ 23, Ex. E-22.)

- “‘Just Do It’ has become the call to action for generations looking for inner motivation. It is one of the most successful catch phrases of the twentieth century but those three words ‘Just do it’ started as a campaign to rescue Nike.” Cinquina, John, *Just do it – the campaign that rescued Nike*, Blog Red Meets Blue, November 3, 2015. (Kappes Decl. ¶ 24, Ex. E-23.)
- “*Just Do It*. Those three little words have inspired a whole host of people the world over to do just that. They compete. They work. They hustle. They just *do* it. That phrase, which has come to be synonymous with success, with strength, with perseverance, *is* Nike’s brand.” Wright, Meghan, *Just Do It: Nike’s Marketing Strategy and How They’re Getting it Done*, Advat, May 28, 2015. (Kappes Decl. ¶ 25, Ex. E-24.)
- “Nike’s ‘Just Do It’ phrase is one of the most globally recognized slogans and a powerful distillation of the brand’s core values.” Dunne, Brendan, *How ‘Just Do It’ Saved Nike*, Sole Collector, August 17, 2015. (Kappes Decl. ¶ 26, Ex. E-25.)

JUST DO IT is also repeatedly honored as one of the best advertising slogans of all time, examples of which—both before and after the *Maier* decision—are included in the Declaration of Nathan Kappes. For example, since the *Maier* decision:

- In June 2016, JUST DO IT was identified as one of the “12 of the Best Marketing and Advertising Campaigns of All Time.” (Kappes Decl. ¶ 8, Ex. E-7.)
- In November 2014, JUST DO IT was identified as one of the “10 Best Corporate Taglines and Slogans of All Time.” (*Id.* ¶ 7, Ex. E-6.)
- In February 2014, JUST DO IT was identified as among the “Most Famous Advertising Slogans of All Time.” (*Id.* ¶ 11, Ex. E-10.)

As recounted in the Declaration of Jaime Lemons, JUST DO IT was also the subject of unsolicited case studies and surveys that recognized the strength and impact of

JUST DO IT. One described it as “one of the most famous and easily recognized slogans in advertising history.” (Lemons Decl. ¶ 17, Ex. C-3.) In another unsolicited survey conducted in 1999, the survey questioned 1,000 respondents, and asked, among other things, which company “uses the advertising slogan ‘Just Do It’?” (*Id.* ¶ 18, Ex. C-4.) The total percentage of respondents correctly identifying NIKE was 79%. (*Id.*)

6. NIKE Actively Protects JUST DO IT Through Its Trademark Registrations and Consistent Enforcement Efforts

As a result of its fame, notoriety, and substantial goodwill, the JUST DO IT mark has been the subject of unauthorized copying. (Lemons Decl. ¶ 20.) Accordingly, for over twenty-five years, NIKE has monitored and taken action against those who use JUST DO IT, or variations thereof, in violation of NIKE’s rights. (*Id.* ¶ 22.) To protect its trademarks, NIKE has generally not permitted others to use or modify its trademarks, including JUST DO IT. (*Id.* ¶ 21.) As a result, when third-parties ask for permission to use JUST DO IT or variations thereof, such as “JUST ___ IT,” NIKE has typically declined their requests. (*Id.*)

When she testified in the *Maher* proceeding, Ms. Lemons noted that since at least as early as 1989, NIKE had sent dozens of cease and desist letters to third-parties using JUST DO IT, or variations thereof, in violation of NIKE’s rights. (*Id.* ¶ 22, Ex. C-5.) In the years since the *Maher* proceeding, NIKE has continued that practice, sending numerous cease and desist letters to enforce its rights to the JUST DO IT mark. (*Id.*)

In addition to sending cease and desist letters, NIKE also opposes or seeks to cancel marks that it believes violate its rights in JUST DO IT. (*Id.* ¶¶ 23–25.) Because many of NIKE’s products fall in Class 25, which includes footwear, apparel and

headwear, many of the opposition and cancellation proceedings filed by NIKE were brought against marks with respect to goods in Class 25, including, for example, “NOOKIE . . . JUST DID IT,” “JUST JESU IT,” “JUST FLOP IT,” “JUST DO IT LIKE YOU MEAN IT!,” “JUST SHAVE IT,” “DON’T JUST DO IT . . . DO IT RIGHT VV & V,” and “JUST FAKE IT,” among many others. (*Id.* ¶ 25.) Of course, NIKE’s use and registration of the JUST DO IT mark is not limited to goods in Class 25, and NIKE has also successfully enforced JUST DO IT against marks used in connection with goods and services besides apparel and footwear in Class 25, including, for example, goods and services in Classes 5, 9, 14, 16, 21, 24, 25, 28, 30, 32, 35, and 41. (*Id.*) A list of NIKE’s successful opposition and cancellation proceedings are identified in paragraph 15 of the Stipulation. As detailed in the Lemons Declaration, NIKE also has also enforced its rights to JUST DO IT in court proceedings, including proceedings in which it obtained judgments against infringers and those offering counterfeit goods. (*Id.* ¶ 23, Ex. C-6.)

C. Applicant and the Opposed Application

Applicant applied to register “JUST DID IT” in Class 25, asserting its bona fide intention to use the mark in commerce in connection with various types of apparel, including, *inter alia*, “wearable garments and clothing” and “athletic apparel.” (Stipulation ¶¶ 17, 18.) In particular, the goods identified in Applicant’s Application include apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic shirts; Button down shirts; Button-front aloha shirts; Clothing for athletic use, namely, padded shirts; Collared shirts; Golf shirts; Graphic T-shirts; Hooded

sweat shirts; Knit shirts; Long-sleeved shirts; Maternity clothing, namely, shirts; Night shirts; Open-necked shirts; Polo shirts; Rugby shirts; Shirts and short-sleeved shirts; Shirts for infants, babies, toddlers and children; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sleeves worn separate and apart from blouses, shirts and other tops; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sun protective clothing, namely, shirts; Sweat shirts; T-shirts; Tee shirts; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits; Turtle neck shirts; Wearable garments and clothing, namely, shirts; Yoga shirts. (*Id.* ¶ 18.)

Applicant did not use, and does not claim rights to, JUST DID IT as a trademark in connection with any of the goods set forth in its Application prior to the July 8, 2014, filing date of its Application. (*Id.* ¶¶ 19, 20.) Since filing its Application, Applicant has not made use of, or used in commerce, JUST DID IT as a trademark in connection with any of the goods set forth in its Application. (*Id.* ¶ 21.)

V. PROCEDURAL HISTORY

NIKE timely-filed its Notice of Opposition on April 15, 2015, against Applicant's JUST DID IT mark, asserting a likelihood of confusion and dilution based on U.S. Trademark Registration Nos. 1,875,307; 4,350,316; 4,704,671, as well as Application Serial No. 86/444,421, which has since issued as U.S. Trademark Registration No. 4,764,071.

Applicant filed an Answer on May 25, 2015. The parties filed a Stipulation for Use of Accelerated Case Resolution (ACR) Procedure on August 25, 2015 ("ACR

Stipulation”) (Dkt. 10), which the TTAB granted. The parties filed the Stipulation of Facts Not in Dispute on January 4, 2016. (Dkt. 12.)

VI. ARGUMENT

A. NIKE Has Standing and Priority

Applicant admits NIKE has standing to bring this proceeding based on NIKE’s prior pleaded trademark Registration Nos. 1,875,307, 4,350,316, and 4,704,671, as well as pending Application No. 86/444,421 (now U.S. Trademark Registration No. 4,764,071) for JUST DO IT. (Stipulation ¶ 2.) Additionally, as set forth in Section II, above, the evidence shows NIKE’s use of JUST DO IT since at least as early as 1989, which significantly predates the earliest date upon which Applicant may rely—July 8, 2014, the filing date of its Application—because Applicant has not commenced actual use of the applied-for mark (*Id.* ¶¶ 19–21). See *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 U.S.P.Q. 185,189-90 (C.C.P.A. 1982); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 6 U.S.P.Q.2d 1719,1720 (Fed. Cir. 1988). In view of NIKE’s pleaded registrations and the Stipulation, priority is not an issue. *Am. Throwing Co. v. Famous Bathrobe Co.*, 250 F.2d 377, 379-80, 116 U.S.P.Q. 156 (C.C.P.A. 1957).

B. Applicant’s Registration of “JUST DID IT” is Likely to Dilute the Famous JUST DO IT Mark

Applicant’s registration of JUST DID IT is likely to dilute NIKE’s famous JUST DO IT mark by creating unauthorized and unwanted associations in consumers’ minds between JUST DID IT and NIKE or JUST DO IT. Those unwanted associations will whittle away the unique association in consumers’ minds between NIKE and its famous JUST DO IT mark.

Federal law prohibits dilution of famous marks, such as JUST DO IT. Specifically, section 43(c) of the Lanham Act provides relief for the owner of a famous mark when another person “commences use of a mark or trade name . . . that is likely to cause dilution by blurring . . . of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” 15 U.S.C. § 1125(c)(1). Dilution by blurring consists of an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” *Id.* § 1125(c)(2)(B).

The threshold question for federal dilution claims is whether the mark at issue is “famous,” *i.e.*, whether it is “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” *Id.* § 1125(c)(2)(A). Once a mark is deemed famous—as is the case with JUST DO IT—the test for evaluating trademark dilution is a likelihood of dilution. *Id.* § 1125(c)(2)(B). Actual dilution is not required. *Id.* The evidence presented herein demonstrates that the fame and recognition of JUST DO IT was already established during *Maher*, and that fame has only increased with the passage of time. The Board should again find that the

opposed mark in this case, JUST DID IT, is likely to cause dilution by blurring of NIKE's famous mark, JUST DO IT.

1. JUST DO IT Is a Famous Mark and Acquired Fame Well Before the Date of Applicant's Application

As a threshold matter, Applicant *admits* JUST DO IT is a famous mark that became famous before Applicant filed its Application for JUST DID IT on July 8, 2014 (Stipulation ¶¶ 8, 9), and the TTAB has likewise found JUST DO IT famous for purposes of likelihood of dilution and likelihood of confusion. *Maier*, 100 U.S.P.Q.2d at 1021. Even without the stipulation of Applicant and the decision in *Nike v. Maier*, an analysis of the factors set forth in the Lanham Act for assessing fame further confirms that JUST DO IT is famous, and became famous well before the filing date of Applicant's Application. Those four factors include:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A).

NIKE has presented an extensive amount of evidence supporting each of these factors, covering a period from when the mark was first adopted by NIKE to the present day. (*See* Section II.) JUST DO IT is the subject of multiple trademark registrations, including the four cited as a basis for this Opposition, one of which is incontestable.

NIKE has advertised and promoted the mark in a variety of media through the United States for over twenty-five years, spending approximately \$6 billion globally on JUST DO IT promotions since 1988, and over one hundred million dollars in the United States since 2008. NIKE has distributed over 10,000 different products bearing JUST DO IT, amounting to nearly 50 million units of product bearing JUST DO IT in every single state of the United States since 1989, and over 30 million units in the last six years alone. Those products include apparel, such as t-shirts, sweatshirts, polo shirts, and pants, as well as backpacks, duffel bags, cell phone cases, and lanyards.

But “perhaps the most significant” evidence of the fame of JUST DO IT is its widespread recognition among the public. *Maher*, 100 U.S.P.Q.2d at 1024. The array of evidence presented above in Section IV and in the accompanying Declarations and Notice of Reliance is overwhelming. More than twenty-five years after it was introduced, JUST DO IT remains one of the most famous advertising slogans of all time.

In short, the popularity of JUST DO IT “resonates over a broad spectrum of the public,” *Maher*, 100 U.S.P.Q.2d at 1026, and is famous under the Lanham Act.

2. Applicant’s Registration of “JUST DID IT” is Likely to Blur the Distinctiveness of the JUST DO IT Mark

Applicant’s registration of JUST DID IT is likely to cause dilution by blurring of NIKE’s famous JUST DO IT mark. The Lanham Act establishes six factors for evaluating likelihood of dilution by blurring:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.

- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B).

Each applicable factor favors a finding of likely dilution in this matter. First, Applicant's JUST DID IT mark is substantially similar to NIKE's famous JUST DO IT mark. Applicant's and NIKE's marks "start and end with the same words 'just' and 'it.' Both are only three words long. This gives the marks a similar look." *Maher*, 100 U.S.P.Q. 2d at 1022 (also explaining that the "harm dilution does to the selling power of a mark is not only caused by a third-party use or registration of an identical mark. It may be caused by a 'look-alike' mark, one that is close enough to the famous mark that consumers will recall the famous mark and be reminded of it"). Indeed, JUST DID IT differs from JUST DO IT by only two letters, changing "DO" to its past-tense version, "DID." Additionally, NIKE's JUST DO IT mark reflects a "call to arms," encouraging consumers to follow through with their goals. Applicant's JUST DID IT mark embodies that same "call to arms," encouraging others to follow through with their goals. The similarity of the marks is even more apparent given that Applicant intends to use its mark on the same categories of goods on which NIKE applies its famous JUST DO IT mark. Accordingly, the overall commercial impression of the marks is similar, and weighs in

favor of dilution. *Maier*, 100 U.S.P.Q. 2d at 1022–23 (finding JUST DO IT and JUST JESU IT similar).

Second, JUST DO IT is presumed inherently distinctive because it was registered under Section 1(a) without any requirement of a Section 2(f) showing of acquired distinctiveness. *Id.* Additionally, JUST DO IT does not describe attributes of the products or services being provided or “have any specific meaning in relation to [NIKE’s] goods.” *Id.* Accordingly, this factor also weighs in favor of dilution.

Third, in the *Maier* case, the Board found that “Opposer has shown that it vigilantly enforces its rights to the mark JUST DO IT”. *Maier*, 100 U.S.P.Q. 2d at 1028. The Board went on to find that the third dilution factor, the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark, also favored NIKE. *Id.* The strong record of enforcement that NIKE presented in the *Maier* case has been substantially augmented in recent years. NIKE continues to decline requests to use JUST DO IT, or variations thereof, without regard to the underlying purpose of the request. Additionally, NIKE has sent dozens of cease and desist letters over the last twenty-five years. As evidenced by the list of proceedings in Section IV.A, NIKE has successfully opposed or cancelled numerous trademarks in the TTAB on the basis of its mark, JUST DO IT, and it has successfully enforced its rights to JUST DO IT in the courts. Accordingly, this factor also weighs in favor of dilution. *Maier*, 100 U.S.P.Q. 2d at 1028.

Fourth, as set forth in Section IV.A and B above, JUST DO IT enjoys widespread recognition throughout the United States, Applicant admits JUST DO IT is a famous

mark, and the TTAB previously found the mark famous. Accordingly, this factor weighs in favor of dilution. *Maher*, 100 U.S.P.Q. 2d at 1024–26, 1028.

Fifth, circumstantial evidence suggests Applicant intended to create an association with NIKE. For instance, Applicant acknowledges that NIKE’s JUST DO IT mark is famous, and seeks to use its JUST DID IT mark on the very same goods on which NIKE uses JUST DO IT, including athletic apparel. Even if this does not give rise to bad faith intent, this factor is neutral at worst, and “consistent with a likelihood of dilution by blurring.” *See Maher*, 100 U.S.P.Q. 2d at 1030 (quoting *Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, 96 U.S.P.Q.2d 1479, 1498 (TTAB 2010)).

Last, because Applicant has not used JUST DID IT in commerce, there is no actual association between the marks. Accordingly, this factor is neutral. *See Maher*, 100 U.S.P.Q. 2d at 1030.

C. Applicant’s Registration of “JUST DID IT” is Likely to Cause Confusion With the Famous JUST DO IT Mark

Because the evidence demonstrates a likelihood of dilution under 15 U.S.C. § 1125(c), this Opposition may be sustained on that basis alone. Nevertheless, Applicant’s registration of JUST DID IT is also likely to cause confusion with the famous JUST DO IT mark under 15 U.S.C. § 1052(d). The TTAB’s determination “as to whether there is a likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion.” *Maher*, 100 U.S.P.Q. 2d at 1021 (citing *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)). In *Maher*, the Board then went on to find that the facts in evidence bore on the following *DuPont* factors: the fame of NIKE’s JUST DO IT mark,

the similarity of the marks, similarity of the goods, channels of trade, conditions of purchase, and the absence of similar marks in use on similar goods. *Maher*, 100 U.S.P.Q. 2d at 1021. Those same *DuPont* factors inform the likelihood of confusion analysis in this case as well.

Many of these factors overlap significantly with the factors discussed in Section VI.A above in the context of dilution under 15 U.S.C. § 1125(c), including the fame of NIKE's JUST DO IT mark, similarity of the marks, and the absence of similar marks in use. As previously shown, each of these factors favors NIKE: the JUST DO IT mark is famous, which the Applicant concedes; Applicant's JUST DID IT mark is substantially similar to NIKE's JUST DO IT mark, and NIKE has enjoyed substantially exclusive use of JUST DO IT for over twenty-five years as a result of its consistent enforcement efforts. Thus, in addition to favoring NIKE on the issue of dilution, each of those factors also favors NIKE on the issue of confusion. Nevertheless, for completeness, NIKE addresses them briefly here in the context of the analysis of likelihood of confusion.

1. NIKE's JUST DO IT Mark is Famous for Likelihood of Confusion and Dilution Purposes

Applicant admits that NIKE's JUST DO IT mark is famous, and became famous before Applicant adopted its mark. (Stipulation ¶¶ 8, 9.) The TTAB likewise held that NIKE's mark is famous under both the lesser standard of fame for likelihood of confusion purposes, and the more stringent standard required for dilution purposes. *Maher*, 100 U.S.P.Q. 2d at 1021 (citing *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). NIKE has updated its evidence of fame of the JUST DO IT mark since the decision in *Maher* as

discussed in detail above. As a famous mark, JUST DO IT is entitled to a wide scope of protection. *Maher*, 100 U.S.P.Q. 2d at 1021 (citing *Bose Corp. v. QSC Audio Prod.'s Inc.*, 63 U.S.P.Q.2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000)). The fame factor strongly supports NIKE's claim of likelihood of confusion.

2. NIKE's JUST DO IT Mark and Applicant's JUST DID IT Mark Are Similar

When comparing the similarity of marks for likelihood of confusion purposes, the typical test is the similarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. *DuPont*, 476 F.2d at 1361 and *Palm Bay*, 73 U.S.P.Q.2d at 1694. Here, the similarity of the marks in all respects is obvious:

JUST DO IT
v.
JUST DID IT

The marks differ by only two letters, changing "DO" to its past-tense version, "DID." *Cf. Maher*, 100 U.S.P.Q. 2d at 1022–23 (finding JUST DO IT and JUST JESU IT similar).

3. The Similarity and Nature of the Goods; the Similarity of Likely-to-Continue Trade Channels and Classes of Consumers Factors Favor NIKE

The remaining factors, including similarity of the goods, channels of trade, and conditions of purchase (e.g. classes of consumers), likewise favor NIKE on the issue of confusion.

The goods for which Applicant has applied to register JUST DID IT are in the same class as NIKE's JUST DO IT registrations, and are nearly identical to the goods on which NIKE uses JUST DO IT. For example, Applicant seeks to register JUST DID IT

in Class 25 for use with, *inter alia*, “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps...” and “Wearable garments and clothing, namely, shirts.”

Similarly, NIKE’s incontestable U.S. Trademark Registration No. 1,875,307 is also in Class 25 for use in connection with t-shirts, sweatshirts, and caps.

There are no restrictions on the channels of trade or classes of consumers. Both Applicant’s and NIKE’s clothing are broadly identified. For instance, NIKE places no limitations or restrictions on the specific type of clothing, channels of trade, or classes of consumers. Likewise, Applicant broadly includes “Wearable garments and clothing, namely shirts.” To the extent Applicant makes any attempt to limit the scope of the goods, the limitations underscore that Applicant’s goods will be distributed through the same channels of trade and to the same classes of consumers as NIKE. For example, the Application also states JUST DID IT will be used in connection with “Athletic apparel,” “Clothing for athletic use,” “Sun protective clothing,” and “Triathlon clothing”—all of which directly compete with the type of clothing and apparel on which NIKE uses JUST DO IT. It is thus reasonable to assume that both Applicant’s and NIKE’s goods will be sold in the same channels of trade and to the same classes of consumers. *See Maher*, 100 U.S.P.Q.2d 1022 (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.” (quoting *Genesco Inc. v. Martz*, 66 U.S.P.Q.2d 1260 (TTAB 2003))). Accordingly, this factor favors NIKE. *See UMG Recordings Inc. v. O’Rourke*, 92 U.S.P.Q.2d 1042, 1048 (T.T.A.B. 2009).

In sum, all of the most relevant likelihood of confusion factors strongly favor NIKE. The fame of JUST DO IT—which Applicant concedes—entitles it to a wide scope of protection against infringing uses. *Maier*, 100 U.S.P.Q.2d 1023 (citing *Bose Corp. v. QSC Audio Prods. Inc.*, 63 U.S.P.Q.2d 1303, 1309 (Fed. Cir. 2002)); *see also Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 22 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1992) (“In consonance with the purposes and origins of trademark protection, the Lanham Act provides a broader range of protection as a mark's fame grows.”). That, coupled with the similarity of the marks, similarity of goods, NIKE’s substantially exclusive use of the mark, and similarity of the goods, channels of trade, and conditions of purchase, demonstrates Applicant’s JUST DID IT mark is likely to cause confusion with NIKE’s famous JUST DO IT mark.

VII. CONCLUSION

For the foregoing reasons, NIKE’s Opposition to registration of Applicant’s JUST DID IT mark should be sustained. JUST DO IT is undeniably famous and Applicant’s registration and use of JUST DID IT is likely to cause dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and is likely to cause confusion under Section 2(d) of

the Lanham Act, 15 U.S.C. § 1052(d). Accordingly, registration of Applicant's JUST DID IT mark should be denied.

Respectfully submitted,
BANNER & WITCOFF, LTD.
Attorneys for Opposer

Date: February 4, 2016

By: 
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CERTIFICATE OF SERVICE

I hereby certify that a copy of Opposer NIKE, INC.'s MEMORANDUM IN SUPPORT OF ENTRY OF JUDGMENT SUBMITTED PURSUANT TO THE ACCELERATED CASE RESOLUTION (ACR) STIPULATION, FIRST NOTICE OF RELIANCE, SECOND NOTICE OF RELIANCE, DECLARATION OF JAIME LEMONS, DECLARATION OF MELANIE SEDLER, AND DECLARATION OF NATHAN KAPPES, AND ALL EXHIBITS THERETO were served by overnight courier service, as agreed to by the parties, to the following address on February 4, 2016, such being the Applicant's correspondence address listed in the TTABVUE system as of this date:

Matthew Heller
Capital E Finance Co, LLC
53 Appleton Street
Boston, Massachusetts 02116-6213
United States

A handwritten signature in blue ink, appearing to read "Matthew Heller", is written over a horizontal line.