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

Proceeding	91221511
Party	Defendant Capital E Finance Co, LLC
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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.,)
Opposer,) Opposition No. 91221511
vs.) Application No. 86330661
)
CAPITAL E FINANCE CO, LLC,) MARK: JUST DID IT
Applicant.)

_____)

APPLICANT CAPITAL E FINANCE CO. LLC 'S MEMORANDUM IN RESPONSE AND
REBUTTAL OF NIKE INC'S MEMORANDUM IN SUPPORT OF ENTRY OF JUDGMENT
SUBMITTED PURSUANT TO THE ACCELERATED CASE RESOLUTION (ACR)
STIPULATION

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I. INTRODUCTION

As the Opposer Nike, Inc (“Opposer” or “Nike”) states the salient facts of this Opposition are largely undisputed. Some of them however have nuanced but important differences. Applicant Capital E Finance Co., LLC (“Applicant” or “CEF”) concedes NIKE’s JUST DO IT mark is famous and concedes the Trademark Trial and Appeal Board (“TTAB”) previously found in favor of Nike in Nike v. Maher, 100 U.S.P.Q.2d 1018 (TTAB 2011).

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 “wearable garments and clothing for athletic use”—not surprisingly, the very same types of goods on which NIKE uses the JUST DO IT mark along with thousands of other companies with slogans and trademarks as well.

Since the Maher decision, JUST DO IT has become even more famous, more widespread and more ubiquitous due to, at least in part, (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 an increasing worldwide branding presence in an increasing and increasingly affluent world population.

Also, since the decision, tens of thousands of advertisements for Class 25 attire with the slogan “Just Did It” have appeared for sale on various internet web sites. For these reasons and the reasons explained below, Applicant’s registration of JUST DID IT is unlikely to cause dilution by blurring of NIKE’s famous JUST DO IT mark and is unlikely 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 Applicant, the Opposition should be rejected on grounds of no likelihood or chance of either dilution or of confusion, and registration of Applicant’s JUST DID IT mark should be accepted.

II. STATEMENT OF THE ISSUES

As stated by Opposer and agreed to by Applicant:

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

Applicant's Memorandum in response and rebuttal to Opposer'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);

Applicant's First Notice of Reliance, including numerous pages of websites listing apparel for sale with the slogan "Just Did It" 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).

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.)

- The following four trademarks have 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):

MARK	PROCEEDING NUMBER	TERMINATION DATE
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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: 91196082	November 4, 2010

MARK	PROCEEDING NUMBER	TERMINATION DATE
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.) There is no connection or affiliation between NIKE and Applicant or Applicant's goods or services. (Id. ¶ 23.)

Applicant admits JUST DO IT is famous and the TTAB Has previously found JUST DO IT famous. In fact it is so famous and widespread as to be unassailable in its position and ties to the NIKE brand of clothing.

“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.)

Those three words are in fact the exact opposite in meaning to the Applicant’s three little words “Just Did It”. These are a call to completion, success, and time for ease and relaxation.

Pages and pages of the same apparel being contested here using the words JUST DID IT are being sold every day without confusion or dilution with the NIKE mark.

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.

Applicant's Registration of "JUST DID IT" is NOT likely to dilute the Famous JUST DO IT Mark. The fame of NIKE and their mark will only increase by additional slogans paying homage to their greatness. There is no doubt that the NIKE mark achieves this greatness by ever expanding its reach and sales in a global economy. Their fame far exceeds the four factors set forth in the Lanham Act.

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.

As the Opposer states "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. "

Applicant's Registration of "JUST DID IT" is NOT likely to blur the distinctiveness of the JUST DO IT Mark. Applicant's registration of JUST DID IT is NOT 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).

Factors (i), (ii), and (v) favor the Applicant while factors (iii), (iv) and (vi) favors the Opposer in this matter.

First,

Applicant's JUST DID IT mark is substantially DIFFERENT to NIKE's famous JUST DO IT mark. Applicant's and NIKE's marks may start and end with the same words 'just' and 'it' with the ACTIVE verb part of the short sentence very different.

Both are only three words long, so one-third of them are different.

Indeed, JUST DID IT differs from JUST DO IT by only two letters, but that's 25% of them.

Additionally, NIKE's JUST DO IT mark reflects a "call to arms," encouraging consumers to follow through with their goals and to "compete, work, hustle". Every single one of the marks successfully opposed by NIKE in the past have been Just ____It, filled in with a verb of activity, (or something non-sensical). "Stick-It, Nail-It, Brew-It, DO It!!!!

On the other hand, Applicant's JUST DID IT mark, and only CEF's mark, embodies a call to celebrate and reflect on one's successes such as graduation, birth, marriage, etc...; and a call for others to recognize that success.

The Applicant intends to use its mark on the same categories of goods on which NIKE applies its JUST DO IT mark. This is due to obvious reasons—what NIKE is claiming as a conflict is the entire casual attire market, especially if you are looking to sell to high schools and colleges.

Second, to presume JUST DO IT is inherently distinctive because it was registered under Section 1(a) without any requirement of a Section 2(f) showing of acquired distinctiveness or that because 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" that it is likely to be diluted is a very weak argument with absolutely no substance. Just Do It is not distinctive because it has been and will continue to be used in regular conversation, unrelated to NIKE or sports, for decades.

For factor (iv), any suggestion that Applicant intends to create an association with NIKE is absolutely false.

As stated earlier, the JUST DID IT mark is likely to be on the same goods on which NIKE uses JUST DO IT, because Just Do It (and the swoosh) is on essentially everything (although not on a Nun's habit, yet).

B.

Applicant's registration of "JUST DID IT" is NOT likely to cause confusion with the JUST DO IT mark .

Because the evidence demonstrates an uncertain likelihood of dilution under 15 U.S.C. § 1125(c), with only half the criteria in support of the possibility this Opposition should not be sustained with additional cause, and certainly NOT on that basis alone.

Applicant's registration of JUST DID IT is also NOT likely to cause confusion with the famous JUST DO IT mark under 15 U.S.C. § 10052(d) due to the fact that 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 significant differences in spite of the similarity of two of three words of the marks, and the need to put the marks on the same clothing as NIKE's as that is about all the apparel that exists.

As previously shown, the dissimilarities of these factors and the lack of a unanimous decision when looking at the relevant factors favors the Applicant: the Applicant's JUST DID IT mark is substantially and significantly different to NIKE's JUST DO IT mark, and will only sell to a common type of apparel because the NIKE term is so ubiquitous that it cannot be avoided. Thus, in addition to favoring Applicant on the issue of dilution, each of those factors also favors CEF on the issue of confusion.

Nevertheless, for completeness, but also brevity Applicant will address the point in primary contention briefly here in the context of the analysis of likelihood of confusion.

NIKE's JUST DO IT Mark and Applicant's JUST DID IT Mark Are NOT 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:

Wife (or husband): JUST DO IT

v.

Husband (or wife): Just did it.

This little exchange shows that the two have completely different connotations: A Call to action vs. A Call to relax and celebrate.

The only similarity is that they are both commonly used terms, in everyday speech without commercial connotation.

The Similarity and Nature of the Goods; the Similarity of Likely-to-Continue Trade Channels and Classes of Consumers factors favor CEF. The remaining factors, including similarity of the goods, channels of trade, and conditions of purchase (e.g. classes of consumers), likewise favor CEF on the issue of confusion. NIKE is so ubiquitous that no likelihood of confusion can possibly exist. The breadth of the apparel has its mark goes well beyond sports and sport clothes and therefore should not be protected.

The goods for which Applicant has applied to register JUST DID IT are often in the same class as NIKE's JUST DO IT registrations, and are often nearly identical to the goods on which NIKE uses JUST DO IT. Not surprisingly, t-shirts, sweat pants, etc... In sum, all of the most relevant likelihood of confusion factors strongly favor the Applicant. The strength and recognition is not, under any circumstances, going to be diluted or confused with a non-rival.

VII. CONCLUSION

For the foregoing reasons, NIKE's Opposition to registration of Applicant's JUST DID IT mark should be rejected. Applicant's registration and use of JUST DID IT is unlikely to cause dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and is unlikely to cause confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Pages and pages of the same apparel being contested here using the words JUST DID IT are being sold every day without confusion or dilution with the NIKE mark. These are shown in Exhibit A Accordingly, registration of Applicant's "Just Did It" mark should be accepted.

Submitted By:

/Matthew Heller/

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Exhibit A

First Notice of Reliance

Over 4 million results:

https://www.google.com/?gws_rd=ssl#q=just+did+it+nike+shirt

https://www.google.com/search?q=just+did+it&espv=2&biw=1024&bih=502&tbm=isch&imgil=60MbgIjKlEDtSM%253A%253BWjhAq1ziJQRidM%253Bhttp%25253A%25252F%25252Fwww.lovetispic.com%25252Fimage%25252F46469%25252Fjust-did-it&source=iu&pf=m&fir=60MbgIjKlEDtSM%253A%252CWjhAq1ziJQRidM%252C&usg=__7G23lzoJsmOnosW7mFobSxAxRPo%3D&ved=0ahUKEwiehqe94qfLAhXJeD4KHftjA-cQyicIjw&ei=dOLZVp78DMnx-QH7x424Dg#imgrc=60MbgIjKlEDtSM%3A

Over 2,000 listing for JUST DID IT on ebay at any one time, many with the NIKE swoosh:

<http://www.ebay.com/sch/i.html?from=R40&trksid=p2047675.m570.l1313.TR11.TRC2.A0.H0.Xjust+did+it.TRS1&nkw=just+did+it&sacat=0>

CERTIFICATE OF SERVICE

I hereby certify that a copy of Applicant Capital E Finance Co. LLC's RESPONSE TO Opposer's MEMORANDUM IN SUPPORT OF ENTRY OF JUDGEMNT SUBMITTED PURSUANT TO THE ACCELERATED CASE RESOLUTION STIPULATION, FIRST NOTICE OF RELIANCE were served by mail, as agreed to by the parties, to the following address on March 5, 2016, such being the Opposer's correspondence address listed in the TTABVUE system as of this date:

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/Matthew Heller/

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