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

Proceeding	91221511
Party	Plaintiff NIKE, Inc.
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Date	04/05/2016
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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 REBUTTAL BRIEF IN SUPPORT OF ENTRY OF
JUDGMENT SUBMITTED PURSUANT TO THE ACCELERATED CASE
RESOLUTION (ACR) STIPULATION**

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Opposer NIKE, Inc. (“NIKE”) respectfully submits this rebuttal brief in support of its request for entry of judgment pursuant to the Accelerated Case Resolution (ACR) Stipulation (Dkt. 14, NIKE Op. ACR Br.).

I. INTRODUCTION

Applicant Capital E Finance Co. LLC’s (“Applicant’s”) Response brief (Dkt. 23, App. Resp. Br., Section I¹) concedes NIKE’s JUST DO IT mark “has become even more famous” since the Trademark Trial and Appeal Board’s decision in *Nike, Inc. v. Maher*, 100 U.S.P.Q.2d 1018 (2011), where the Board deemed JUST DO IT a famous mark that is “entitled to a wide scope of protection,” *id.* at 1023. Despite that finding, Applicant, and other third-parties, have continued their attempts to register marks that are likely to cause dilution of and confusion with NIKE’s JUST DO IT mark. To combat those dilutive and infringing uses, NIKE has engaged in extensive enforcement efforts spanning over twenty-five years, including by filing numerous opposition and cancellation proceedings in the PTO and sending dozens of cease and desist letters. (*See, e.g.*, Decl. of Jaime Lemons to NIKE’s Op. ACR Br. ¶¶ 20–22, Ex. C-5; Stipulation of Facts Not In Dispute Pursuant to the Accelerated Case Resolution (ACR) Stipulation (“Stipulation of Facts”) ¶ 15.)

Applicant does not dispute the numerous examples of NIKE’s successful enforcement efforts set forth in the parties’ Stipulation of Facts and the Declaration of Jaime Lemons. (*See, e.g.*, App. Resp. Br., Section IV.). Instead, Applicant argues its

¹ As Applicant’s Response brief does not include page numbers, NIKE cites to the corresponding Section number.

“JUST DID IT” mark, and the marks of other third-parties, are somehow acceptable because they are “paying homage” to NIKE’s famous JUST DO IT mark. (*Id.*, Section VI.A.) But those types of dilutive and infringing uses are exactly what the Trademark Act, and the anti-dilution provision specifically, was enacted to prevent. Indeed, as the *Maher* decision recognized in sustaining NIKE’s opposition to the registration of “JUST JESU IT,” the existence of third party marks attempting to “play off” the JUST DO IT mark risks impairment of NIKE’s “ability to uniquely identify [itself] as a single source and thus maintain its selling power.” 100 U.S.P.Q.2d at 1031 (citing *Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, 96 U.S.P.Q. 2d 1479, 1497 (TTAB 2010) (“Over time, the gradual whittling away of distinctiveness will cause the trademark holder to suffer ‘death by a thousand cuts.’”)).

NIKE’s ongoing efforts to challenge dilutive and infringing uses of the JUST DO IT mark, like Applicant’s JUST DID IT mark, are necessary to protect the distinctiveness of, and prevent confusion with, the famous JUST DO IT mark. As set forth below, Applicant’s arguments to the contrary lack factual and legal support, and the minimal “evidence” on which Applicant relies is objectionable and should be excluded. 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. NIKE’S EVIDENTIARY OBJECTIONS TO APPLICANT’S FIRST NOTICE OF RELIANCE

Applicant’s Response brief includes a “First Notice of Reliance” containing three website links that Applicant contends reflect listings of alleged third-party uses of the

slogan “JUST DID IT.”² (App. Resp. Br., Section III, Ex. A.) Those website links, and their alleged content, should be excluded. While paragraph 4 of the Stipulation of Parties for Use of Accelerated Case Resolution (ACR) Procedure (Dkt. 10) permits evidence that could be submitted under normal trial procedures via a notice of reliance to be attached to the party’s ACR brief, the website links Applicant attaches to its brief with its “First Notice of Reliance” are not the type of evidence that can be introduced by notice of reliance.

Specifically, the TBMP explains that “Internet search summaries, which essentially are links to the website pages, are not admissible by notice of reliance.” TBMP § 704.08(b); *see also id.* § 1208.04 (the “Board will not utilize a link or reference to a website’s internet address to consider content that may appear there”); *In re King Koil Licensing Co.*, 79 U.S.P.Q.2d 1048, 1050 (TTAB 2006) (web page links “do little to show the context within which a term is used on the web page that could be accessed by the link”); TMEP § 710.01(b) (“Providing only a website address or hyperlink to Internet materials is insufficient to make such materials of record.”).

Likewise, a “search result summary from a search engine, such as Yahoo! or Google, which shows use of a phrase as key words by the search engine, is of limited probative value Nor does the fact that a search by an Internet search engine retrieves a large number of hits have probative value.” TBMP § 1208.03 (citing *In re Star Belly*

² Paragraph 5 of the Stipulation of Parties for Use of Accelerated Case Resolution (ACR) Procedure provides that “[s]ubstantive objections to evidence . . . may be raised in connection with the evidence submitted by a party with its ACR brief.” (Dkt. 10 ¶ 5.) To that end, “Opposer’s objections to any evidence submitted by Applicant in Applicant’s ACR brief shall be included with Opposer’s ACR reply brief.” (*Id.*)

Stitcher, Inc., 107 U.S.P.Q.2d 2059, 2062 n.3 (TTAB 2013) (Google search engine retrieval of over 100,000 results of “limited probative value”); *In re BetaBatt Inc.*, 89 U.S.P.Q.2d 1152, 1153 n.1 (TTAB 2008) (Google search engine retrieval of 22,200 hits not probative, and the “hit list” does not corroborate that there are 22,200 relevant references).

Internet evidence may also be excluded as hearsay if introduced to prove the truth of the matter asserted, TBMP § 704.08(b), or if the proponent fails to provide sufficient indicia of authentication, including, for example, a website’s date of publication or date that it was accessed and printed, and its source, *id.*; *see also Edom Labs. Inc. v. Lichter*, 102 U.S.P.Q.2d 1546, 1550 (TTAB 2012) (finding applicant’s web pages inadmissible where there was no URL or date (citing *Safer Inc. v. OMS Invests. Inc.*, 94 U.S.P.Q.2d 1031 (TTAB 2010)).

Here, Applicant did not submit website printouts of any of the search result listings identified in its First Notice of Reliance or otherwise provide an adequate summary of those listings; instead, Applicant merely provided website links. Because website links are not probative, NIKE respectfully requests that the Board exclude the website links and their alleged content. Even if the Board does not exclude the website links and their alleged content on that basis, the website links should be excluded because, to the extent Applicant seeks to introduce them for their truth, they constitute hearsay for which Applicant has not provided proper authentication.

III. APPLICANT'S ARGUMENTS LACK FACTUAL AND LEGAL SUPPORT

Applicant's remaining arguments rely on unsupported legal conclusions and self-serving factual statements, which lack support from the record. None of those arguments overcome NIKE's opposition to registration of Applicant's JUST DID IT mark; instead, they further demonstrate why registration should be denied. For example:

- Applicant does not cite any record evidence for its conclusory assertion that all of the marks NIKE has successfully opposed include a "verb of activity." (App. Resp. Br., Section VI.A.) In fact, the record confirms the opposite. The parties' Stipulation of Facts, as well as the enforcement efforts described in the Declaration of Jaime Lemons, demonstrate that NIKE's extensive enforcement efforts are not limited to verbs "of activity." (See Stipulation of Facts ¶ 15; Lemons Decl. to NIKE's Op. ACR Br. ¶ 22, Ex. C-5.) The JUST JESU IT mark at issue in the *Maher* proceeding, which did not involve a "verb of activity," is but one example.

- Applicant's attempt to distinguish the meaning of its JUST DID IT mark from NIKE's famous JUST DO IT mark is also weak. (App. Resp. Br at Section VI.A.) For instance, Applicant argues its JUST DID IT mark embodies a call to celebrate one's successes. (*Id.*) So, too, does NIKE's JUST DO IT mark. Indeed, as the advertising and promotional materials attached to the Declaration of Melanie Sedler demonstrate, JUST DO IT is often associated with celebrating success, such as in the JUST DO IT commercial featuring a former smoker who won the New York marathon at age 42. (Sedler Decl. to NIKE's Op. ACR Br. ¶ 12, Ex. D-3.)

- Applicant suggests that JUST DO IT is not entitled to a presumption of inherent distinctiveness. (App. Resp. Br., Section VI.A.) Applicant does not cite any authority to support its argument, nor can it. The law is clear that a mark “is entitled to a presumption of inherent distinctiveness” where it registered “based upon a claim of use in commerce without a Section 2(f) showing of acquired distinctiveness.” *Nat’l Pork Bd. & Nat’l Pork Producers v. Supreme Lobster & Seafood Co.*, 96 U.S.P.Q.2d 1479, 1497 (TTAB 2010). Applicant does not provide any factual or legal support to overcome the presumption.

- Applicant states—without record support—that its JUST DID IT mark was not intended to create an association with NIKE. (App. Resp. Br., Section VI.A.) However, Applicant earlier suggests its mark *was* intended to “pay[] homage” to NIKE’s famous JUST DO IT mark. (*Id.*) Regardless of its intent, as set forth in NIKE’s opening ACR brief (Dkt. 14), Applicant’s JUST DID IT mark *does* create an association with NIKE and the famous JUST DO IT mark.

- Applicant identifies four trademark registrations that were previously issued by the PTO for “JUST ___ IT.” Applicant does not provide the reason for its reliance on those registrations. In any event, as Applicant recognizes, the *Maher* decision addressed those same registrations, explaining, “[t]hird-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.” (App. Resp. Br., Section IV.) *Maher*, 100 U.S.P.Q.2d at 1028. As in *Maher*, Applicant has “not submitted evidence or testimony to prove that the third-party marks are in use.” *Id.* Indeed, two of

the four registrations are now cancelled. (*See* Exhibit A, Trademark Status & Document Retrieval (TSDR) Reports for U.S. Trademark Registration Nos. 2,634,997 for “Just Be It” and 3,317,983 for “Just Grab It.”)

IV. CONCLUSION

For the foregoing reasons and the reasons set forth in NIKE’s Opening Brief, NIKE’s Opposition to registration of Applicant’s JUST DID IT mark should be sustained. Applicant admits JUST DO IT is a famous mark and concedes it intends to use its JUST DID IT mark on the “very same types of goods on which NIKE uses” JUST DO IT. (App. Resp. Br., Section I.) Applicant’s arguments in response to NIKE’s Opening Brief lack factual and legal support, and the limited evidence presented is inadmissible. Accordingly, registration of Applicant’s JUST DID IT mark should be denied.

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

Date: April 5, 2016

By: /helen hill minsker/

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CERTIFICATE OF SERVICE

I hereby certify that a copy of Opposer NIKE, INC.'s REBUTTAL IN SUPPORT OF ENTRY OF JUDGMENT SUBMITTED PURSUANT TO THE ACCELERATED CASE RESOLUTION (ACR) STIPULATION was served by overnight courier service, as agreed to by the parties, to the following address on April 5, 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

/helen hill minsker/

Exhibit A

Generated on: This page was generated by TSDR on 2016-04-05 14:15:57 EDT

Mark: JUST BE IT

JUST BE IT

US Serial Number: 76347481

Application Filing Date: Dec. 12, 2001

US Registration Number: 2634997

Registration Date: Oct. 15, 2002

Register: Principal

Mark Type: Trademark

Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: May 17, 2013

Publication Date: Jul. 23, 2002

Date Cancelled: May 17, 2013

Mark Information

Mark Literal Elements: JUST BE IT

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: clothing, namely shirts, T-shirts, sweat shirts, pants, shorts, swimwear, coats, jackets and socks; footwear - namely shoes, sandals, boots and athletic shoes; and headwear - namely caps, hats and visors

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Nov. 28, 2001

Use in Commerce: Nov. 28, 2001

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Just Be It, Inc.

Owner Address: 9597 Northshore Trail
Forest Lake, MINNESOTA UNITED STATES 55025

Legal Entity Type: CORPORATION

State or Country Where Organized: MINNESOTA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Douglas L. Tschida

Docket Number: 201073

Correspondent

Correspondent Name/Address: DOUGLAS L TSCHIDA
633 LARPEN TEUR AVE W STE B
SAINT PAUL, MINNESOTA UNITED STATES 55113-6544

Phone: (651)488-8285

Fax: (651)488-8305

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 17, 2013	CANCELLED SEC. 8 (10-YR)/EXPIRED SECTION 9	
Sep. 27, 2008	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	60132
Sep. 22, 2008	ASSIGNED TO PARALEGAL	60132
Sep. 15, 2008	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Sep. 15, 2008	PAPER RECEIVED	
Jun. 23, 2008	CASE FILE IN TICRS	
Oct. 15, 2002	REGISTERED-PRINCIPAL REGISTER	
Jul. 23, 2002	PUBLISHED FOR OPPOSITION	
Jul. 03, 2002	NOTICE OF PUBLICATION	
Mar. 21, 2002	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 28, 2002	ASSIGNED TO EXAMINER	78431

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Sep. 27, 2008

Generated on: This page was generated by TSDR on 2016-04-05 14:16:37 EDT

Mark: JUST GRAB IT

JUST GRAB IT

US Serial Number: 78917283

Application Filing Date: Jun. 26, 2006

US Registration Number: 3317983

Registration Date: Oct. 23, 2007

Register: Principal

Mark Type: Trademark

Status: Registration cancelled because registrant did not file an acceptable declaration under Section 8. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: May 30, 2014

Publication Date: Aug. 07, 2007

Date Cancelled: May 30, 2014

Mark Information

Mark Literal Elements: JUST GRAB IT

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Clothing; namely, shirts, pants, underwear, socks, shoes, headwear, coats, jackets, wrist bands, belts, and scarves

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: May 09, 2006

Use in Commerce: May 09, 2006

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Fast Trends, Inc.

Owner Address: 6360 Broadview Drive
Prior Lake, MINNESOTA 55372
UNITED STATES

Legal Entity Type: CORPORATION

State or Country MINNESOTA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Walter K. Roloff

Docket Number: WRA-08 TM

Correspondent

Correspondent Name/Address: WALTER K ROLOFF
490 HARBOR CT
SHOREVIEW, MINNESOTA 55126
UNITED STATES

Phone: 651-481-8634

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 30, 2014	CANCELLED SEC. 8 (6-YR)	
Oct. 23, 2007	REGISTERED-PRINCIPAL REGISTER	
Aug. 07, 2007	PUBLISHED FOR OPPOSITION	
Jul. 18, 2007	NOTICE OF PUBLICATION	
Jun. 29, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	76537
Jun. 29, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 27, 2007	EXAMINER'S AMENDMENT ENTERED	76537
Jun. 27, 2007	ASSIGNED TO LIE	76537
Jun. 26, 2007	EXAMINERS AMENDMENT MAILED	
Jun. 25, 2007	ASSIGNED TO LIE	68552
Jun. 25, 2007	EXAMINERS AMENDMENT -WRITTEN	81111
May 31, 2007	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 30, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 30, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 30, 2006	NON-FINAL ACTION MAILED	
Nov. 30, 2006	NON-FINAL ACTION WRITTEN	81111
Nov. 28, 2006	ASSIGNED TO EXAMINER	81111
Jun. 30, 2006	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Oct. 23, 2007