

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

wbc

Mailed: June 29, 2015

Opposition No. 91221511

NIKE, Inc.

v.

Capital E. Finance Co, LLC

Wendy Boldt Cohen, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on June 23, 2015.¹ Participating in the conference were opposer's attorneys, Hellen Hill Minsker and Maureen Knutsson, applicant, Matthew Heller and Board interlocutory attorney, Wendy Boldt Cohen.

The Board reminds the parties of the automatic imposition of the Board's standard protective order in this case. The standard form protective order is online at <http://www.uspto.gov>. The Board reminds the parties that they may negotiate an amended protective agreement, subject to Board approval.

The Board further reminds the parties that neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on

¹ Opposer requested Board participation on or about June 6, 2015.

the basis of *res judicata* or lack of Board jurisdiction) could occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f).

The parties indicated that they have not yet engaged in substantive settlement negotiations and that there is no other pending litigation, in federal court or before the Board, between the parties. The parties are reminded that the Board encourages settlement. To that end, the Board is generous with periods of extension or suspension to facilitate settlement discussions, although the Board does not get involved in the substantive settlement negotiations.

The Board discussed accelerated case resolution (ACR) and urged the parties to discuss it further at a later date. The parties noted that they are interested in ACR and plan to discuss it after receipt of the Board's order. Parties requesting ACR may stipulate to a variety of matters to accelerate disposition of this proceeding, including: abbreviating the length of the discovery, testimony, and briefing periods as well as the time between them; limiting the number or types of discovery requests or the subject matter thereof; limiting the subject matter for testimony, or limiting the number of witnesses, or streamlining the method of introduction of evidence, for example, by stipulating to facts and introduction of evidence by affidavit or declaration. The parties are directed to review the Board's website regarding ACR, links can be found at <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>, and TBMP §§ 528.05(a)(2) and

702.04. If the parties later agree to pursue ACR, they should notify the interlocutory attorney assigned to this proceeding by not later than two months from the opening of the discovery period.

Stipulations/Filings

The parties agreed to service pursuant to Trademark Rule 2.119(b)(4), with an email copy provided as a courtesy to the email addresses noted in the record, pursuant to Trademark Rule 2.119(b)(6). Because the parties have stipulated to accept service by first class or express mail with service by email as a courtesy, the parties may take advantage of the five additional days for service provided under Trademark Rule 2.119(c).

The parties are urged to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA) database, available online at: <http://estta.uspto.gov>. Throughout this proceeding, the parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure ("TBMP"). The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure.

Pleadings

The Board has reviewed the pleadings in this case. In the notice of opposition, opposer has adequately pleaded its standing. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP § 309.03(b) (3d ed. rev.2 2013); *see also King Candy Co. v. Eunice*

King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). That is, the statements in paragraphs 1-10 of the notice of opposition allege facts which, if proven, would show a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damages. *See Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

Likelihood of Confusion²

Opposer adequately set forth a claim of likelihood of confusion with its alleged prior common law use and registrations for the mark JUST DO IT under Trademark Act § 2(d), 15 U.S.C. § 1052(d), in paragraphs 13-18 of the notice of opposition. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); TMEP § 1207.01 *et seq.* To the extent opposer relies on its registrations, priority will not be an issue in this case because opposer included with its notice of opposition, status and title

² A mark may be refused registration under Section 2(d) of the Lanham Act where it: [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

See 15 U.S.C. § 1052(d). To allege a valid ground of cancellation under Section 2(d), petitioner need only allege it has priority of use and that respondent's mark so resembles petitioner's marks as to be likely to cause confusion. *See* Lanham Act § 2(d), 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

copies of its pleaded registrations. *See* Trademark Rule 2.122(d)(2); *King Candy Co.*, 182 USPQ 108.

Dilution³

With respect to the dilution claim set for in paragraphs 14-17 of the notice of opposition, opposer has alleged its “JUST DO IT Mark became famous prior to the filing date of the application for Applicants’ Mark and prior to any date of first use or first use in commerce of Applicants’ Mark”; and that applicant’s mark is likely to lessen the capacity of opposer’s mark “to identify and distinguish Opposer’s goods and services.” *Notice of Opposition*, ¶¶ 21-22. This claim is sufficiently pleaded under Trademark Act § 43(c).⁴ *See Research in Motion Ltd.*, 102 USPQ2d at 1197; *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000); *see also Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001).

In its answer applicant denied the salient allegations of the notice of opposition.

³ Dilution under Section 43(c) of the Act, 15 U.S.C. § 1125(c) requires the following elements: (1) whether the opposer's mark is famous; (2) whether the opposer's mark became famous prior to the date of the application to register the applicant’s mark; and (3) whether the applicant’s mark is likely to blur the distinctiveness of the opposer's famous mark. *Research in Motion Ltd. v. Defining Presences Marketing Group Inc.*, 102 USPQ2d 1187, 1197 (TTAB 2012).

⁴ “Fame for dilution purposes is difficult to prove. ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous.” *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). In other words, the requirement for proving “fame” for dilution purposes under Trademark Act § 43(c) is considerably more stringent than the proof of “fame” in a likelihood of confusion analysis. Moreover, while proof of the fame or renown of the plaintiff’s mark is optional in a likelihood of confusion case, it is a statutory requirement in a dilution analysis.

Applicant indicated that it intends to represent itself in this proceeding. While Patent and Trademark Rule 10.14 permits any person to represent himself, persons who are not acquainted with the technicalities of the procedural and substantive law involved in Board *inter partes* proceedings are advised to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

In addition, applicant is advised that, under Patent and Trademark Rule 11.18(b),

[b]y presenting to the Office ... any paper, the party presenting such paper ... is certifying that ... [t]o the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, ... [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; ... [and t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery.

See also Fed. R. Civ. P. 11(b); TBMP § 527.02.

Applicant is reminded that Trademark Rules 2.119(a) and (b) require that every submission filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the submission will be considered by the Board. Consequently, copies of all submissions which the parties may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in

which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as *prima facie* proof of service.

Because opposer is represented by counsel, applicant should not contact opposer directly.

Dates remain as set in the Board's April 15, 2015 order. The next significant due date is July 24, 2015, when the parties' initial disclosures are due. In such disclosures, the parties should provide to each other

the name and, if known, the address and telephone number of each individual likely to have discoverable information — along with the subjects of that information — that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment [and] a copy — or a description by category and location — of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii). The parties need not file those disclosures with the Board.

The Board thanks the parties for their participation.