

This Opinion is Not a
Precedent of the TTAB

Mailed: July 9, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

NIKE, Inc.
v.
Timothy Jinks
—

Opposition No. 91278263
—

Helen Hill Minkser, Michael J. Harris, Michael Kientzle, and Kathleen P. Duffy, of
Arnold & Porter Kay Scholer LLP, for
NIKE, Inc.

Timothy Jinks, pro se.
—

Before Wellington, Pologeorgis, and Johnson, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Timothy Jinks (“Applicant”) filed an application to register the mark 4IR, in standard characters, on the Principal Register for use on “shirts” in International Class 25.¹

NIKE, Inc. (“Opposer”) opposes registration of Applicant’s mark, under Section 2(d) of the Trademark Act (“the Act”), 15 U.S.C. § 1052(d), based on a likelihood of

¹ Application Serial No. 90659215, filed April 20, 2021, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

confusion with its previously-used and registered marks. Opposer alleges it is “the owner of rights granted via federal registrations and common law rights for the mark ‘AIR’ alone (hereinafter the ‘AIR Mark’) and in combination with other words and designs (the ‘AIR-Formative Marks’).”² Opposer alleges that it “has continuously used marks consisting of or incorporating the word AIR in connection with footwear and apparel in interstate commerce for decades.”³ In all, Opposer pleaded ownership of thirteen AIR or AIR-formative live registrations and made them of record by submitting appropriate copies with the Notice of Opposition pursuant to Trademark Rule 2.122(d).⁴ However, and to be clear, Opposer did not plead a “family” of AIR marks.⁵

In the Notice of Opposition, Opposer alleges that “Applicant’s mark is highly similar in sight and overall commercial impression to Opposer’s AIR and AIR-Formative Marks” and the “goods identified in [the involved Application], specifically ‘Shirts,’ are identical to the goods included in several of Opposer’s pleaded

² 1 TTABVUE (Not. of Opp. ¶ 2).

³ 1 TTABVUE (Not. of Opp. ¶ 3).

⁴ 1 TTABVUE 18-129 (USPTO electronic database printouts for registrations). The pleaded registrations of record are Reg. Nos.: 2068075 (AIR with design); 6695024 (AIR stylized); 6124768 (AIR270); 1145812 (AIR-SOLE); 1284386 and 1571066 (both for NIKE AIR with design); 1307123 (NIKE AIR); 1370283 (AIR JORDAN); 3725535 (AIR JORDAN with design); 1508348 (AIR MAX); 1686515 (AIR FLIGHT); 3520484 (AIR FORCE 1); and 5286596 (NIKE AIR VAPORMAX). Opposer also pleaded ownership of Reg. No. 1789463 (AIR TRAINER MAX); however, that registration was cancelled on March 8, 2024.

⁵ Although Opposer submitted testimony mentioning an “AIR family of marks” (*see* 8 TTABVUE; Schechter Dec. ¶ 55), it did not plead a family of marks and thus cannot rely any such rights that may exist. *Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1107 (TTAB 2016) (“A plaintiff must plead ownership of a family of marks in its complaint in order to rely on the marks as a family as a basis for sustaining the opposition at trial ...”).

registrations and for which Opposer's AIR Marks and AIR-Formative Marks are used in commerce.”⁶ And, “[d]ue to at least the similarity of the marks and goods involved, and other factors, Applicant's use and registration of 4IR will inevitably lead to confusion, to mistake, or to deception of the public within the meaning of Section 2(d) of [the Act].”⁷

Applicant, in its Answer, made several admissions, including:

- Opposer has continuously used marks consisting of or incorporating the word AIR in connection with footwear and apparel in interstate commerce for decades.⁸
- In the decades since the launch of its various product lines featuring its AIR Marks and AIR-Formative Marks, including iconic brands such as NIKE AIR, AIR JORDAN, AIR MAX and AIR FORCE 1, Opposer has sold hundreds of millions of pairs of shoes and apparel products branded with its AIR Marks and/or AIR-Formative Marks in the United States, grossing billions of dollars in sales.⁹
- As a result of Opposer's long use and substantial promotion of its AIR Marks and AIR-Formative Marks, Opposer has developed substantial goodwill in said marks, and the public has come to associate the AIR Marks and AIR-Formative Marks with the goods of Opposer.¹⁰
- Opposer's use and registration of its AIR Marks and AIR-Formative Marks is long prior to the filing dates of the Applicant's '215 Application.¹¹
- Applicant was aware of Opposer's AIR Marks and AIR Formative Marks at the time he filed his Application.¹²

⁶ 1 TTABVUE (Not. of Opp. ¶¶ 28-29).

⁷ 1 TTABVUE (Not. of Opp. ¶ 30).

⁸ 4 TTABVUE (Answer ¶ 3).

⁹ 4 TTABVUE (Answer ¶ 5).

¹⁰ 4 TTABVUE (Answer ¶ 6).

¹¹ 4 TTABVUE (Answer ¶ 26).

¹² 4 TTABVUE (Answer ¶ 27).

Applicant otherwise denied the salient allegations regarding similarity of the marks and, ultimately, the likelihood of confusion allegations in the Notice of Opposition.¹³

Opposer filed a trial brief.¹⁴

Applicant did not file a trial brief nor introduce any evidence during its testimony period. It was not required to do either. Only Opposer was required to file a brief, Trademark Rule 2.128(a)(1), 37 C.F.R. § 2.128(a)(1), and to submit evidence because Opposer, as plaintiff, ultimately bears the burden of proving that Applicant is not entitled to registration “even in the absence of contrary evidence or argument.” *DC Comics v. Cellular Nerd LLC*, 2022 USPQ2d 1249, at *21 (TTAB 2022) (citing *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010)).

For the reasons explained below, we sustain the opposition.

I. Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), Applicant’s application file. As previously noted, Opposer has also made its pleaded registrations of record.

During its trial period, Opposer filed the following:

- Testimonial Declaration of Jennifer M. Reynolds, Opposer’s Assistant General Counsel, with accompanying exhibits;¹⁵ and

¹³ 4 TTABVUE (Answer ¶¶ 28-31).

¹⁴ 60-61 TTABVUE (“confidential” and public versions of Opposer’s brief).

¹⁵ 7 TTABVUE.

- Testimonial Declaration of David Schechter, Opposer's Vice President of Global Footwear Development, with accompanying exhibits.¹⁶

II. Opposer's Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

Here, Opposer has demonstrated it is entitled to oppose registration of Applicant's mark on the ground of likelihood of confusion. Opposer owns and has made of record several registrations for the mark AIR (stylized) and AIR-formative marks. As discussed more fully below in our priority and likelihood of confusion analysis, Opposer's has prior common law rights in the mark AIR, in various stylized formats, to which Applicant's proposed mark 4IR bears a visual similarity. Opposer has also

¹⁶ 8-11 TTABVUE.

its AIR mark on apparel, including shirts.¹⁷ In addition, Applicant admits that “Opposer is a leading provider of a broad range of clothing ...” and “has continuously used marks consisting of or incorporating the word AIR in connection with footwear and apparel in interstate commerce for decades.”¹⁸

Opposer’s evidence, along with the Applicant’s admissions, is sufficient to support Opposer’s direct interest and its allegation that registration of Applicant’s proposed mark is likely to cause confusion with Opposer’s AIR and AIR-formative marks. *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009); *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations “suffice to establish ...direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest); *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *11 (TTAB 2023) (valid and subsisting pleaded registration made of record establishes entitlement to oppose).

III. Priority of Use

Because Opposer’s pleaded registrations are of record and Applicant has not brought a counterclaim against any of them, priority is not an issue with respect to the AIR (stylized) and AIR-formative marks and the goods identified in the pleaded registrations. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182

¹⁷ 8 TTABVUE (Schechter Dec. ¶ 8, containing photographs of AIR mark on apparel).

¹⁸ 4 TTABVUE (Answer ¶¶ 1, 3).

USPQ 108, 110 (CCPA 1974). This includes Opposer’s pleaded registration for the

stylized AIR mark, that appears as , for “footwear.”¹⁹

As to Opposer’s alleged prior common law rights in the mark AIR, by itself and appearing in various fonts less stylized than that depicted in the aforementioned registration, it must prove such rights by a preponderance of the evidence. *See, e.g., Embarcadero Techs., Inc. v. RStudio, Inc.*, Opp. No. 91193335, 2013 WL 2365029, at *9 (TTAB 2013) (“[O]pposer must prove by a preponderance of the evidence that its common law rights were acquired before any date upon which applicant may rely.”) At a minimum, Applicant may rely on the filing date of its application, which is April 20, 2021. *See* 15 U.S.C. § 1057(c); *Bell’s Brewery, Inc. v. Innovation Brewing*, Opp. No. 91215896, 2017 WL 6525233, at *4 (TTAB 2017).

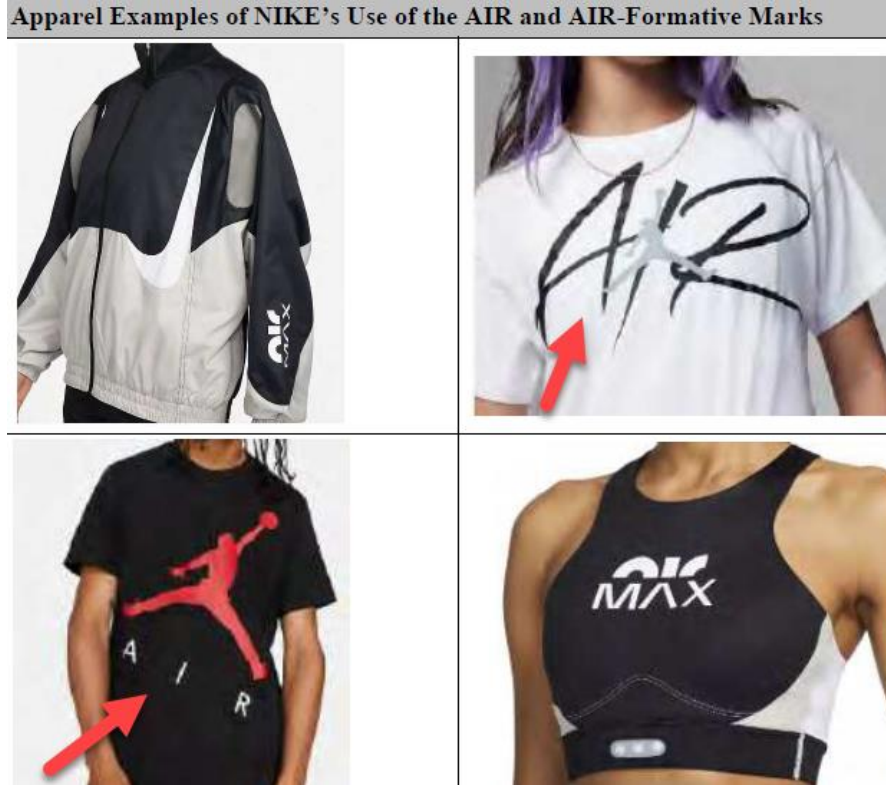
Here, Opposer has demonstrated prior use of the mark AIR in significantly less-stylized manner on apparel, including shirts. Specifically, Opposer’s witness and Vice President of Global Footwear Development, Mr. Schechter, testified that Opposer “has used and registered AIR and AIR-Formative Marks for apparel for decades,” and that the following illustration includes “[r]epresentative examples of such uses”:²⁰

¹⁹ Reg. No. 6695024; issued on April 5, 2022.

²⁰ 8 TTABVUE (Schechter Dec. ¶ 8 and Ex. C; arrows inserted for ease of reference to use of AIR mark); *see also* 8 TTABVUE (Schechter Dec. ¶ 24 and Ex. G (additional evidence of Opposer’s use of the AIR mark on apparel, including shirts)).



and



Applicant has not disputed Opposer's prior use of AIR on apparel or its inherent distinctiveness as a mark. Indeed, as noted supra, Applicant has admitted that "Opposer has continuously used marks consisting of or incorporating the word AIR in connection with ... apparel in interstate commerce for decades"²¹ and "has sold hundreds of millions of pairs of shoes and apparel products branded with its AIR Marks and/or AIR-Formative Marks in the United States, grossing billions of dollars in sales."²²

In sum, Opposer has demonstrated common law rights in the mark AIR in various stylized manners as illustrated above in photographs, on apparel, including shirts.


²¹ 4 TTABVUE (Answer ¶ 3).

²² 4 TTABVUE (Answer ¶ 5).

Opposer's use of its AIR mark long precedes April 20, 2021, Applicant's constructive use date, and Opposer thus has priority in regard to its common law AIR marks.

IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Although Opposer has registrations for various AIR-formative marks as well as a registration for the stylized AIR mark,  , we focus our likelihood of confusion analysis on Opposer's prior common law rights in the mark AIR in less stylized fonts on apparel, including shirts. We do so because Opposer's rights in the mark extend to shirts, the same as Applicant's identified goods, and the mark is more similar to Applicant's mark than any of Opposer's pleaded registered marks. Because we find a likelihood of confusion based on Opposer's prior common law rights in its AIR mark, in different stylized formats, vis-à-vis Applicant's AIR mark, we need not

consider whether there is a likelihood of confusion based on Opposer's registered AIR (stylized) and AIR-formative marks. On the other hand, if we had ultimately determined that there is no likelihood of confusion based on Opposer's prior common law rights in the AIR mark, we would not have found confusion likely based on Opposer's registered marks that are not as similar to Applicant's mark. *See, e.g., Monster Energy*, 2023 USPQ2d 87 at *12 (confining likelihood of confusion analysis to most similar pleaded mark) (citing *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *6 (TTAB 2020)) (subsequent history omitted); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Identity of the Goods and Their Trade Channels

We begin our analysis with the second *DuPont* factor, involving the "similarity or dissimilarity and nature of the goods or services as described in an application or registration." *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). "This factor considers whether 'the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods and services.'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard*, 62 USPQ2d at 1004).

Here, as illustrated above and in other evidence, Opposer has demonstrated prior use of the AIR mark, in various stylized fonts, on apparel, including different types

of shirts, such as tee shirts, sweatshirts, sleeveless quarter zip shirts, etc. Applicant's goods, as identified in the application, are for "shirts," which is broad enough to encompass all of the types of Opposer's types of shirts. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *9 (TTAB 2019) (Board "must consider the full scope of the goods and services as set forth in the application"). Put simply, the parties' goods are legally identical.

In terms of the third *DuPont* factor, involving "the similarity or dissimilarity of established, likely-to-continue trade channels," *DuPont*, 177 USPQ at 567, it is well established that legally identical goods are presumed to travel in the same channels of trade to the same classes of purchasers. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968); *see also In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("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"), *quoted in In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672-73 (TTAB 2018).

Accordingly, given the goods are legally identical in part, the *DuPont* factors involving relatedness of the goods and their trade channels weigh heavily in favor of likely confusion.

B. Strength of Opposer's AIR Mark

We now consider the strength of Opposer's AIR mark under the fifth *DuPont* factor, "[t]he fame of the prior mark (sales, advertising, length of use)." *DuPont*, 177 USPQ at 567. To prove commercial strength, Opposer may submit evidence in order

to expand the scope of protection afforded its mark commensurate with that strength. *See, e.g., Monster Energy*, 2023 USPQ2d at *19-20.

Opposer argues that its AIR and AIR-formative marks are “famous marks that have achieved a significant degree of public recognition and renown.”²³ In this regard, Opposer relies on Applicant’s admissions, including that “[i]n the decades since the launch of its various product lines featuring its AIR Marks and AIR-Formative Marks, including iconic brands such as NIKE AIR, AIR JORDAN, AIR MAX and AIR FORCE 1, Opposer has sold hundreds of millions of pairs of shoes and apparel products branded with its AIR Marks and/or AIR-Formative Marks in the United States, grossing billions of dollars in sales.”²⁴ Applicant also admits that, [a]s a result of Opposer’s long use and substantial promotion of its AIR Marks and AIR-Formative Marks, Opposer has developed substantial goodwill in said marks, and the public has come to associate the AIR Marks and AIR-Formative Marks with the goods of Opposer.”²⁵

In addition, Opposer’s witness, Mr. Schechter, testified that Opposer “conservatively calculates that it has sold more than 87 million units of apparel products bearing the AIR and AIR-Formative Marks on products sold in every state of the United States from 1989 to the present, totaling over \$1 billion in net sales.”²⁶

²³ 12 TTABVUE 32.

²⁴ 4 TTABVUE (Answer ¶ 5).

²⁵ 4 TTABVUE (Answer ¶ 6).

²⁶ 8 TTABVUE (Schechter Dec. ¶ 20); *id.* ¶ 19.

Mr. Schechter further testified that, during this same time, Opposer “calculates that it has sold more than 1 billion pairs of footwear products bearing the AIR and AIR-Formative Marks ... sold in every state of the United States ... totaling over \$79 billion in net sales.”²⁷ Opposer, in advertising its shoes, “often highlights AIR” and will place the AIR mark, by itself, on the shoes, and in 1996 “took its use of AIR as a trademark to a new level ... showcasing the word AIR alone on the shoe.”²⁸ While much of Opposer’s evidence regarding the renown of its AIR and AIR-formative marks is in relation to shoes, Opposer’s apparel is also feature alongside the footwear on Opposer’s website.²⁹

Based on the record, including Applicant’s admissions and testimony, we find Opposer’s AIR mark is commercially strong in connection with apparel, including shirts, and should be accorded a broader scope of protection than marks without any demonstrated commercial strength. Thus, the fifth *DuPont* factor weighs in Opposer’s favor.

C. Similarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *In re Embiid*, 2021 USPQ2d 577, at *11 (TTAB 2021) (quoting *Palm Bay*

²⁷ 8 TTABVUE (Schechter Dec. ¶ 19).

²⁸ 8 TTABVUE (Schechter Dec. ¶¶ 49-51); *see also* Schechter Dec. ¶¶ 52-54 (use of AIR on shoes).

²⁹ 9 TTABVUE (Schechter Ex. N).

Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005)).

“We keep in mind that where, as here, the goods are in-part identical, less similarity between the marks is needed for us to find a likelihood of confusion.” *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Est. Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

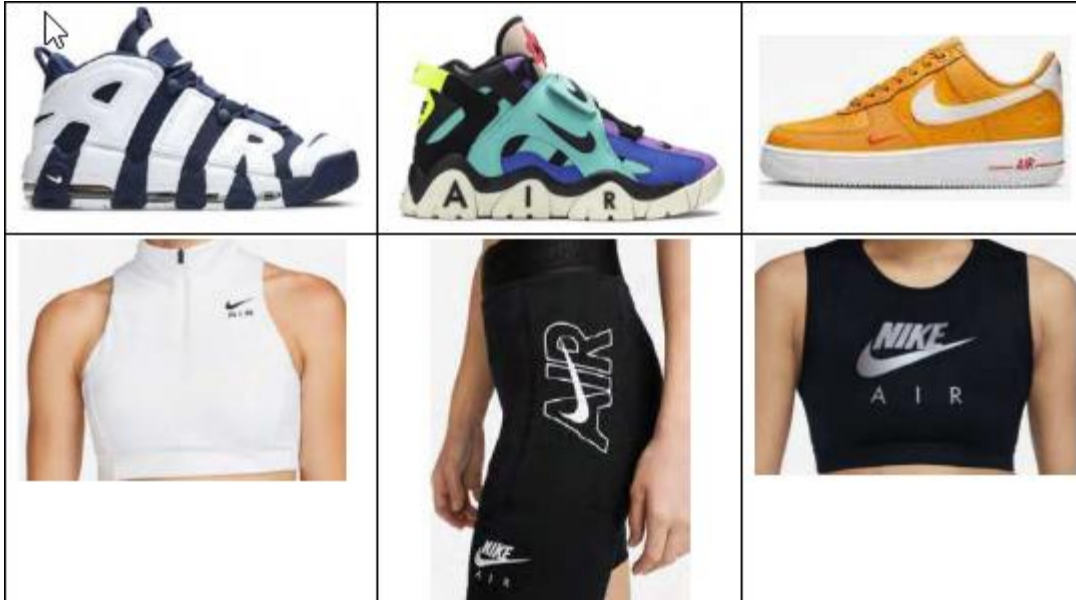
Here, Applicant seeks to register the standard character mark 4IR. Opposer has demonstrated prior rights in the mark AIR, appearing in various lettering styles or fonts.

Opposer argues that the parties’ marks are overall similar because they only differ by Applicant’s “substitution” of the numeral 4 for the letter A in Opposer’s mark, and that this “similarity of the marks is magnified because many common typefaces depict the number 4 with a closed top, which is visually similar to the letter A.”³⁰ Opposer further argues that [w]ith the inclusion of the number 4, the mark 4IR gives the same or substantially the same commercial impression as, and could easily be mistaken for, the mark AIR.”³¹ Finally, Opposer points to the “examples of [Opposer’s] actual

³⁰ 12 TTABVUE 26-27.

³¹ 12 TTABVUE 27.

uses of AIR, ... the similarity of the marks is immediately obvious given the similarity of the number 4 and the letter A,"³² referencing the following uses:



.33

We agree with Opposer that the numeral 4 may be presented in a variety of manners that closely approximate the letter A. Indeed, Applicant seeks to register its mark in standard character format, meaning that, if registered, it is conferred rights in the mark depicted in any font style, size or color. Trademark Rule, 2.52(a), 37 C.F.R. § 2.52(a). In other words, we must anticipate Applicant's mark being displayed in a manner that where the numeral 4, in 4IR, can appear in a manner such that the overall mark will look quite similar to Opposer's AIR mark. Thus, we find that the marks are similar in appearance.

³² 12 TTABVUE 28.

³³ The photographs are a collection placed in Opposer's brief (at 12 TTABVUE 28) and introduced into evidence (8-9 TTABVUE; Schechter Dec. ¶¶ 8 and 24, Exs. C and G).

Should Applicant employ a stylized version of its 4IR mark, whereby the number 4 closely resembles the letter A, consumers encountering that mark on shirts may mistakenly believe this is another fanciful use by Opposer of its AIR mark on apparel. In which case, Applicant's mark, to the extent it is visually confused for Opposer's mark AIR, will convey a similar commercial impression.

In sum, the first *DuPont* factor weighs in favor of finding confusion likely.

V. Conclusion

All factors for which we have argument and evidence favor a finding of likelihood of confusion or remain neutral. Because Applicant seeks to register the mark 4IR that is visually similar to Opposer's commercially strong AIR mark, and the parties' goods are legally identical and will be offered for sale in the same trade channels to the same classes of consumers, we find confusion is likely and judgment should be entered in favor of Opposer on its Section 2(d) claim.

Decision: The opposition is sustained on the ground of priority and likelihood of confusion under Section 2(d) of the Act.