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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Nike, Inc.
v.
Pleasures of the Table, Inc.

Opposition No. 115,293
to Application No. 75/240,563
filed on February 12, 1997

Kathy J. McKnight of Shaw Pittman for Nike, Inc.

James C. Wray and Julie H. Gamotis of Law Offices of James
C. Wray for Pleasures of the Table, Inc.

Before Hairston, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Nike, Inc. filed its opposition to the application of
Pleasures of the Table, Inc. to register the mark shown
below for "food and beverage services, namely, food

preparation, distribution and serving, restaurant, cocktail lounge and catering services," in International Class 42.¹



As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services so resembles opposer's previously used and registered mark NIKE, alone and with various additional terms as a word mark, and in various design formats, for a variety of goods and services² (hereinafter "NIKE marks"), as to be likely to

¹ Application Serial No. 75/240,563, filed February 12, 1997, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified services. The application includes a disclaimer of BAR AND RESTAURANT EXTRAORDINAIRE apart from the mark as a whole; and a statement that the lining in the drawing is a feature of the mark. We note that the drawing of the mark in the USPTO automated records is illegible. If this mark is ultimately determined to be registrable, a legible drawing should be entered prior to issuance of a registration.

² Opposer relies on numerous registrations that were pleaded in the notice of opposition and properly made of record through the testimony of John Coburn, opposer's assistant general counsel and corporate assistant secretary. These include registrations for NIKE (Registration Nos. 978,952; 1,153,938; 1,214,930; 1,243,248; 1,277,066; 1,945,654; 2,025,926; 2,196,735) and NIKE with swoosh design (Registration Nos. 1,237,469; 1,238,853; 1,325,938; 1,772,987; 2,024,436; 2,209,815; 2,239,076) for a variety of products, including footwear, bags, clothing, sport balls, swim equipment, timepieces, posters and retail footwear and apparel services; NIKE TOWN (Registration No. 1,775,629)

cause confusion, under Section 2(d) of the Trademark Act. Opposer alleges that its NIKE marks are "exceedingly well known" and that its trade name and mark NIKE is famous.

Applicant, in its answer, denied the salient allegations of opposer's claim.

Procedural Matters

On April 9, 2002, applicant filed a motion objecting to opposer's notice of reliance, which was filed April 5, 2002, on various excerpts from publications. On May 14, 2002, the Board issued an order deferring consideration of this objection until final decision.³ Therefore, we now consider applicant's objection.

for various items of clothing; NIKE SHOP (Registration No. 2,237,132) for retail store services for clothing, footwear, bags and related accessories; and NIKE GOLF (Registration No. 1,944,436) for bags, footwear and clothing. The NIKE and swoosh design mark appears as follows:



Mr. Coburn testified to the status and ownership by opposer of several additional registrations that were not pleaded in the notice of opposition, but were exhibits to his testimony, including NIKE (Registration Nos. 1,924,353 and 2,239,077) for school materials and bags and swim equipment; NIKE and swoosh design (Registration Nos. 1,866,140; 2,473,828; 2,534,358; 2,104,329; 2,024,717) for school materials, sporting equipment, timepieces, footwear and clothing; NIKE ALPHA PROJECT and design (Registration No. 2,517,735) for footwear and various items of clothing; and NIKE GRIND and design (Registration No. 2,480,935) for artificial recreational surfaces; NIKE AIR and swoosh design (Registration NO. 1,571,066) for T-shirts; NIKE AIR (Registration No. 1,307,123) for footwear and cushioning elements; and NIKE TOWN and design (Registration No. 1,796,122) for retail store services for clothing, footwear, bags and accessories. Because these additional registrations were not properly pleaded in the notice of opposition, they have been considered only in connection with determining the scope of goods and services upon which opposer has used its NIKE marks.

³ Applicant also previously filed a motion to strike the testimony of John Coburn, which motion was denied by the Board in an order dated September 19, 2002.

The excerpts submitted by opposer are from various magazines, periodicals and newspapers. Opposer states in its notice of reliance that "the articles are relevant to show the fame of the mark NIKE, the expansion of the areas of business under the mark, the value of the mark, and the practice of licensing of valuable marks for unrelated products and services." Applicant objects on the ground that the articles are not publications amenable to submission by notice of reliance, and that the articles "are hearsay, are not probative, and are not relevant for any of the purposes alleged."

Clearly, these are publications which may be submitted by notice of reliance under Trademark Rule 2.122(e), and applicant has provided no basis for concluding otherwise. The evidence in question would be hearsay for the truth of the statements contained in the excerpts and it is not accepted for that purpose. However, it is relevant to show the extent of public exposure to opposer's marks, that is, it is reasonable to assume that some of the public has viewed these excerpts and, thus, has been exposed to the information contained therein. Thus, at a minimum, this evidence is relevant to establishing the fame of opposer's marks. Applicant's objection is overruled.

Turning to opposer's objection, in its brief, to the evidence submitted in applicant's June 14, 2002 notice of

reliance, opposer contends that the material is either copies of information downloaded from the Internet and, as such, is not self-authenticating, or that the evidence is from publications that are not identified properly or are not generally available to the public and, thus, this material is not properly submitted by notice of reliance.

Opposer's objections are well taken and, thus, this evidence submitted by applicant by notice of reliance has not been considered. See, *In re Total Quality Group Inc.*, 51USPQ2d 1474 (TTAB 1999); and *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). However, the Board has considered this evidence to the extent that it is the same evidence submitted as exhibits to Ms. Tibbetts' testimony. There was proper foundation and authentication of these documents through Ms. Tibbetts' testimony. Nonetheless, Ms. Tibbetts acknowledged that she had no independent knowledge of the facts contained in the documents submitted with her testimony. Therefore, the information contained in those documents is hearsay for the truth of the statements contained therein and the Board has not considered it for that purpose.

The Record

The record consists of the pleadings; the file of the involved application; excerpts from various publications submitted by opposer under notice of reliance; opposer's

responses to applicant's request for admissions, submitted by applicant under notice of reliance; the testimony deposition by opposer of John Coburn, opposer's assistant general counsel and corporate assistant secretary, with accompanying exhibits; and the testimony deposition by applicant of Jean Tibbetts,⁴ with accompanying exhibits. Both parties filed briefs on the case but an oral hearing was not requested.

The Parties

Opposer has established, through the testimony of Mr. Coburn, that opposer began its business in the early 1970's by offering a line of NIKE running and track footwear; that opposer expanded its NIKE footwear line to include other types of footwear and developed new footwear categories; that in the mid-1970's opposer expanded further to also offer NIKE clothing and sports equipment; and that opposer has expanded its NIKE line to include bags, eyeglasses, timepieces and electronics. Mr. Coburn described opposer's retail stores, identified by the mark NIKE TOWN, which are located throughout the country. In addition to retail product sales, Mr. Coburn stated that opposer's stores sponsor sports clinics and other events and provide rental space for private parties.

⁴ Ms. Tibbetts' connection to applicant is not identified in the deposition or elsewhere in the record.

Mr. Coburn stated that opposer's world corporate headquarters are located in Beaverton, Oregon, and that opposer refers to its headquarters as the "NIKE World Campus." At its campus, opposer offers public tours and sports clinics, among other events. For visitors and employees, opposer operates several restaurants on or adjacent to the campus, as well as conference centers with catering that can be rented by the public for local events. Opposer's restaurants have various names, including, *inter alia*, Airsole Restaurant, Boston Deli, Bowdoin's, and Café 19. The restaurants and the food service at the conference centers are operated by opposer through its Nike Food Services, which appears to be either a division or department of, or a company related to, opposer. However, there is no evidence indicating specifically when opposer began offering its restaurant services or when, or if, it began using the mark NIKE in connection with its restaurant and conference center food services.

Applicant submitted the testimony of Jean Tibbets, wherein she authenticated numerous exhibits in the nature of excerpts from various Internet sites that she had downloaded.⁵ The Internet excerpts include various uses of the term "Nike," some refer to the Nike Missile Project, and

⁵ In addition to excerpts from Internet web sites submitted in connection with Ms. Tibbets' testimony, applicant's documents properly submitted by its notice of reliance include numerous dictionary definitions of "Nike."

a substantial number of listings containing the term "Nike" appear on the Internet site www.SuperPages.com. On cross-examination, Ms. Tibbetts acknowledged that she did not know how many of the Nike references were to opposer or its licensees, or how many were duplicates. She also acknowledged that a significant number of the references were to foreign sources. Accordingly, this Internet material is of little evidentiary value.

Applicant also submitted, by notice of reliance, opposer's answers to applicant's request for admissions. The only admissions contained therein are opposer's admission that Nike is the name of the ancient Greek goddess of victory, and that the figure depicted in applicant's mark is similar to a sculpture, Nike of Samothrace, located in the Louvre Museum in Paris.

Analysis

Inasmuch as opposer has established, through Mr. Coburn's testimony, its ownership and the status of the pleaded registrations,⁶ these registrations are considered to be of record.⁷ Thus, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's*

⁶ Opposer pleaded numerous registrations, including Registration No. 1,849,639. However, Registration No. 1,849,639 was never properly made of record and, thus, has not been considered.

⁷ Contrary to opposer's request in its brief, we have not considered applicant's statements in its reply brief in support of its motion for summary judgment to be part of the record at trial, nor do we consider the statements contained therein to be an admission by applicant regarding the status and title of opposer's pleaded registrations.

Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We add, however, that, while opposer has established, through Mr. Coburn's testimony, that opposer is currently using its NIKE mark in connection with a food service offered in connection with its convention centers, opposer has not established its dates of first use of its NIKE mark in connection with such services.⁸ Thus, we cannot draw any conclusions about opposer's priority in connection with food services.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Turning, first, to consider the marks, we note that while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate

⁸ The evidence also establishes that opposer operates restaurants on and near its "campus," but there is insufficient evidence establishing that the NIKE mark is used to identify these restaurant services.

conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant incorporates into its composite mark opposer's NIKE word mark in its entirety. Additionally, the word NIKE, which appears twice in applicant's mark, appears once as the largest wording in the mark and is superimposed across the design of a statue,⁹ which both opposer and applicant agree is similar to a sculpture displayed in the Louvre and identified as Nike of Samothrace. Opposer and applicant also agree that "Nike" is the name of the Greek goddess of victory. Thus, the design of the statue, rather than distinguishing applicant's mark from opposer's NIKE mark, reinforces the term NIKE and reinforces its connotation as the Greek goddess of victory. The additional wording in applicant's mark, BAR AND RESTAURANT EXTRAORDINAIRE, is merely descriptive and laudatory, and it appears at the bottom of the mark in much smaller print than either of the two appearances of the term NIKE in the mark. Further, NIKE is the primary pronounceable word in applicant's mark. Thus, we conclude that NIKE is the dominant portion of applicant's mark.

⁹ We also point out that the composite marks in opposer's registrations of record show the word NIKE in capital letters in a font that is almost identical to the font used for the term NIKE superimposed across the statue in applicant's mark.

Applicant argues that the association in its mark with the statue and, hence, the Greek goddess, is a distinguishing factor between its mark and opposer's marks. However, aside from its trademark significance for opposer, there is no evidence or argument indicating that "Nike" would not similarly connote the Greek goddess in connection with opposer's mark. Thus, this is not a distinguishing feature of applicant's mark.

Therefore, we conclude that applicant's mark is highly similar to opposer's NIKE marks in sound, connotation and overall commercial impression.

We conclude, next, that opposer's NIKE marks and its NIKE trade name are famous, as opposer contends. Opposer has clearly established that its NIKE marks and trade name are famous in connection with the goods and retail store services identified in its registrations of record.¹⁰ Compelling evidence includes sales figures (e.g., almost \$5 billion of sales in 2001 in the United States), advertising figures (e.g., \$239.9 million in 2001 in the United States), the varied nature of its advertising (e.g., in print publications, web sites, television, direct mailing, etc.), and its endorsements by many professional athletes, including Tiger Woods, Michael Jordan, Derek Jeter, Ken

¹⁰ We cannot conclude from this record that opposer's NIKE mark and trade name is famous in connection with restaurant or catering services.

Griffey Jr., Mia Hamm and Ronaldo. Mr. Coburn testified that opposer's NIKE brand was listed by *Business Week Magazine*, in August 2001, as 34th among the top most recognized or valuable brands. The documentary evidence submitted through opposer's notice of reliance further supports this conclusion of fame by demonstrating the breadth of readers' exposure to opposer's mark.

A famous mark is entitled to a broader scope of protection than a lesser-known mark. As our primary reviewing court has stated, "the fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name." *Specialty Brands v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 6765, 223 USPQ 1281, 1284 (Fed. Cir. 1984). In addition, the fame of a mark magnifies the significance of the similarities between the marks which are compared. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), *cert. denied*, 113 S.Ct. 181 (1992). As the Court of Appeals for the Federal Circuit stated in the case, involving a famous mark, of *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1895, 1898 (Fed. Cir. 2000):

[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.

See also, Bose Corporation v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1309-1310 (Fed. Cir. 2002); and *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). It is clear, with respect to the goods and services of the parties in this case, that applicant's identified services are different in kind from, but related in the minds of consumers to, opposer's identified goods or its retail store services.

In this case, in view of the evidence that opposer in fact operates a food service at its conference centers under the NIKE mark (*cf.* footnote 8, p. 9), we find that this service is a logical expansion of opposer's business, certainly of its events and convention center services, into obvious collateral services. *See Ritz Hotel v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1470 (TTAB 1990).

In view of the fame of opposer's NIKE marks and the substantial similarity of the parties' marks, we find that the parties' goods and services are sufficiently related in the minds of the purchasing public that confusion as to sponsorship or affiliation is likely.

Additionally, it is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved

against the newcomer and in favor of the prior user or registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: The opposition is sustained and registration to applicant is refused.