

ESTTA Tracking number: **ESTTA51587**

Filing date: **11/02/2005**

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

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Nike, Inc.
<b>Granted to Date of previous extension</b>	11/02/2005
<b>Address</b>	One Bowerman Drive Beaverton, OR 97005 UNITED STATES

<b>Attorney information</b>	Jennifer J. Ruttenberg DLA Piper Rudnick Gray Cary US LLP 203 N. LaSalle St.Suite 1900 Chicago, IL 60601 UNITED STATES ch.tm@dlapiper.com,jennifer.ruttenberg@dlapiper.com Phone:312-368-4000
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#### Applicant Information

<b>Application No</b>	78420313	<b>Publication date</b>	07/05/2005
<b>Opposition Filing Date</b>	11/02/2005	<b>Opposition Period Ends</b>	11/02/2005
<b>Applicant</b>	The Active Network, Inc. Suite 250 1020 Prospect Street		

La Jolla, CA 92130 UNITED STATES
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**Goods/Services Affected by Opposition**

Class 035. First Use: 19980101 First Use In Commerce: 19980101 All goods and services in the class are opposed, namely: Providing online registration for participatory sports events
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<b>Attachments</b>	NOTICE OF OPPOSITION DO IT SPORTS.pdf ( 5 pages )
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<b>Signature</b>	/Jennifer J. Ruttenberg/
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<b>Name</b>	Jennifer J. Ruttenberg
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<b>Date</b>	11/02/2005
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Serial No. 78/420,313  
Mark: DO IT SPORTS  
Published: July 5, 2005

<b>NIKE, INC.,</b>	)	
	)	
<b>Opposer,</b>	)	
	)	Opposition No.
<b>v.</b>	)	
	)	Mark: DO IT SPORTS
<b>THE ACTIVE NETWORK, INC.,</b>	)	
	)	
<b>Applicant.</b>	)	

**NOTICE OF OPPOSITION**

U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

Sir:

**NIKE, INC.**, an Oregon corporation, located at One Bowerman Drive, Beaverton, Oregon 97005 (hereinafter "Opposer"), believes that it would be damaged by registration of the mark shown in Application Serial No. 78/420,313 ("the '313 Application"), filed May 17, 2004 by The Active Network, Inc. (hereinafter "Applicant"), published in the Official Gazette of the United States Patent and Trademark Office on July 5, 2005, and hereby opposes the registration of such mark. The time to oppose was extended by a timely request for extension of time to file this opposition.

The grounds for the opposition are as follows:

**OPPOSER AND ITS RIGHTS IN “JUST DO IT”**

1. Opposer is a leading provider of a broad range of sports and fitness equipment, clothing, footwear, and accessories.

2. Since at least 1989, Opposer has continuously used the mark JUST DO IT in interstate commerce in connection with a wide range of goods, including, but not limited to sporting equipment, clothing and apparel, footwear, bags and school supplies.

3. When used in connection with Opposer’s goods, the JUST DO IT mark is inherently distinctive. Although not necessary because of the mark’s inherent distinctiveness, the JUST DO IT mark has also acquired secondary meaning by reason of Opposer’s extensive advertising, promotion and other use thereof.

4. Moreover, Opposer is the owner of the following United States Trademark Registrations for the JUST DO IT mark:

Mark	Reg. No.	Goods	Appl. Date	Reg. Date
JUST DO IT.	1,875,307	Clothing, namely t-shirts, sweatshirts and caps	10/3/89	01/24/95
JUST DO IT	1,931,937	Binders, student planners, portfolio covers, pouches for carrying school materials	4/29/03	10/31/95
JUST DO IT.	1,817,919	Paper goods and printed matter; namely, bumper stickers, note pads, posters and banners, non-metallic key chains and ornamental novelty buttons, mugs	10/3/89	01/25/94

5. Opposer’s foregoing registrations for the mark JUST DO IT are valid, subsisting, and are incontestable pursuant to 15 U.S.C. § 1065.

6. Opposer has used and is using the JUST DO IT mark in interstate commerce in connection with the goods described in the Opposer's Registrations.

7. Through extensive advertising and promotion, Opposer's JUST DO IT mark has become and is a famous mark in the United States.

**COUNT I**  
**THERE IS A LIKELIHOOD OF CONFUSION WITH OPPOSER'S MARK**

8. Opposer realleges paragraphs 1 through 7 as paragraph 8 of this Count I.

9. On May 17, 2004, Applicant filed the '313 Application for the mark DO IT SPORTS for "providing online registration for participatory sports events" in class 35.

10. Opposer's use and registration of its JUST DO IT. mark long pre-dates the filing date of the '313 Application.

11. The grant of a registration to Applicant for its DO IT SPORTS mark as sought in the '313 Application should be denied on the grounds of Opposer's prior use of the JUST DO IT mark. The mark sought to be registered by Applicant is confusingly similar to Opposer's JUST DO IT mark, and the use of the DO IT SPORTS mark by Applicant is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant's goods are those of Opposer or are endorsed, sponsored or otherwise affiliated or connected with Opposer, or that Opposer's goods and services are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

12. The grant of a registration to Applicant for its DO IT SPORTS mark as sought in the '313 Application, should be denied based on likelihood of confusion with Opposer's prior JUST DO IT mark.

**COUNT II**  
**THE '313 APPLICATION DILUTES OPPOSER'S MARK**

13. Opposer realleges paragraphs 1 through 12 as paragraph 13 of this Count II.

14. Through extensive advertising and promotion, Opposer's JUST DO IT mark has become and is a famous mark in the United States. Opposer's JUST DO IT mark had become famous prior to May 17, 2004.

15. Applicant filed the '313 Application on May 17, 2004 based on use of the mark. The '313 Application was filed after Opposer's JUST DO IT mark became famous.

16. Applicant's use of the DO IT SPORTS mark will cause and is likely to cause dilution of Opposer's JUST DO IT mark to the injury of Opposer by lessening the capacity of the JUST DO IT mark to identify and distinguish Opposer's goods and services and by diluting the distinctive quality of Opposer's famous mark.

17. The grant of a registration to Applicant for its DO IT SPORTS mark as sought in the '313 Application, should be denied based on likelihood of confusion with Opposer's prior JUST DO IT mark and dilution of Opposer's famous JUST DO IT mark.


**WHEREFORE**, Opposer files this Notice of Opposition and prays that the aforesaid application of The Active Network, Inc. herein opposed, be rejected; that no registration be issued thereon to Applicant; and for such other and further relief as may be deemed just and proper.

The Deposit Account No. 18-2284 should be charged the amount of \$300.00 to cover the filing fees of this notice of opposition in one class. Please charge any additional fees to Deposit Account No. 18-2284. Please address all correspondence regarding this opposition to:

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Respectfully submitted,

**NIKE, INC.**

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