

This Opinion is not a
Precedent of the TTAB

Hearing: February 18, 2020

Mailed: April 28, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Nike, Inc.

v.

Jamin Caldwell and Courtney Miles

—
Opposition No. 91240394
—

Helen Hill Minsker and Audra C. Eiden Heinze of Banner & Witcoff, Ltd.,
for Nike, Inc.

Jamin Caldwell and Courtney Miles, pro se.
—

Before Zervas, Shaw and Greenbaum,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Jamin Caldwell and Courtney Miles (“Applicants”), seek to register the standard character mark, JUST DREW IT! for “athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms” in International Class 25.¹

¹ Application Serial No. 87381081, filed March 22, 2017 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), asserting first use and first use in commerce on February 18, 2017.

In its Notice of Opposition,² Opposer Nike, Inc. alleges prior use of “the JUST DO IT Mark as a slogan in highly successful advertising and promotional campaigns over the course of many years,” and prior use and registration of JUST DO IT for clothing,³ footwear and bags,⁴ and ancillary products, including eyeglass frames,⁵ cell phone cases⁶ and bottles sold empty.⁷ As grounds for opposition, Opposer alleges that Applicants’ mark is likely to cause confusion with, and dilute (by blurring), Opposer’s mark. In their Answer, Applicants denied key allegations in the Notice of Opposition but admitted the following:⁸

1. Opposer is a leading provider of a broad range of clothing, footwear, equipment, and other products and services relating to sports, fitness, lifestyle and fashion.
2. Opposer is the owner of rights granted via federal registrations and common law rights for the mark JUST DO IT.
3. Opposer has continuously used JUST DO IT in interstate commerce since at least as early as 1989 in connection with various clothing items.
4. Opposer has made substantial sales of goods and services under JUST DO IT, and has used JUST DO IT as

² 1 TTABVUE.

³ Registration No. 1875307, issued January 24, 1995; renewed. This registration is for “clothing, namely t-shirts, sweatshirts and caps.”

⁴ Registration No. 4764071, issued June 30, 2015. This registration is for “footwear; headbands; headwear; pants; shorts; sports bras; tank tops; tights; warm up suits” and “all purpose sport bags; backpacks.”

⁵ Registration No. 4350316, issued June 11, 2013; Section 8 Affidavit accepted, Section 15 Affidavit acknowledged.

⁶ Registration No. 4704671, issued March 17, 2015.

⁷ Registration No. 4902036, issued February 16, 2016.

⁸ 6 TTABVUE 2-3.

a slogan in highly successful advertising and promotional campaigns over the course of many years.

5. Opposer has brought numerous successful oppositions based on the JUST DO IT mark.

6. As a result of Opposer's long use and registration of JUST DO IT, Opposer has developed substantial goodwill in its mark, and the public has come to associate JUST DO IT with the goods and services of Opposer.

7. Opposer's JUST DO IT mark, which has been in use in commerce for more than twenty-five years, and registered for more than twenty years, is famous within the meaning of Lanham Act Section 43(c), 15 USC § 1125(c).

8. Opposer's JUST DO IT mark became famous prior to the filing date of the application for Applicants' mark and prior to any use or any use in commerce by Applicants of Applicants' mark, JUST DREW IT!, as a trademark, service mark, or trade name.

Opposer and Applicants filed briefs on the case and Opposer filed a reply brief. We sustain the Opposition on both pleaded grounds.

I. The Record

The record consists of the pleadings; the TSDR records submitted with Opposer's Notice of Opposition for each of Opposer's pleaded registrations showing active status and title in Opposer pursuant to Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1); the file of Applicants' involved application, by operation of Trademark Rule 2.122(b); and the following:

Opposer's Notice of Reliance ("NOR") on printed publications and Internet printouts. 9-10 TTABVUE.

Testimony Declaration of Jennifer Reynolds, Opposer's Assistant General Counsel, and exhibits ("Reynolds Decl."). 11 TTABVUE.

Testimony Declaration of Melanie Sedler, Opposer's Senior Trademark Paralegal, and exhibits ("Sedler Decl."). 12 TTABVUE.

Testimony Declaration of Timothy J. Haugh, a Senior Litigation Paralegal with Opposer's law firm, and exhibits ("Haugh Decl."). 13-14 TTABVUE.

Applicants did not submit any evidence and rest on their application.

II. Standing

Opposer's pleaded registrations, made of record with its Notice of Opposition, establish its standing. 1 TTABVUE 13-42 (pleaded registrations). *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Applicants have not challenged Opposer's standing.

III. Priority

Because Applicants have not counterclaimed to cancel any of Opposer's pleaded registrations, priority is not at issue with respect to the mark and goods identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). In any event, Opposer has established, and Applicants have admitted, Opposer's prior common law use of its pleaded mark for the goods identified in its pleaded registrations. 11 TTABVUE 4-7 (Reynolds Decl. ¶¶ 5-15).

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. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (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. *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.”). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848.

A. The Fame of Opposer’s Mark

Applicants have admitted that Opposer’s JUST DO IT trademark is “famous within the meaning of Lanham Act Section 43(c), 15 USC § 1125(c).” 6 TTABVUE 5 (¶ 27). That is the section of the Lanham Act which defines “fame” for purposes of dilution claims. This admission as to dilution fame (and the evidence discussed below) also establishes that Opposer’s JUST DO IT mark is strong and famous for purposes of Opposer’s likelihood of confusion claim, and that the mark is entitled to a broad scope of protection against confusion. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1724 (Fed. Cir. 2012) (“Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing.”). *Cf. Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017).

In fact, where fame exists, as it does here, it “plays a ‘dominant role in the process of balancing the *DuPont* factors,’ ... and [f]amous marks thus enjoy a wide latitude of legal protection.” *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d

1303, 1305 (Fed. Cir. 2002) (quoting *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). A strong mark “casts a long shadow which competitors must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

While consumer surveys may provide direct evidence of fame, they are not necessary; indeed, they “rarely appear.” *Bose*, 63 USPQ2d at 1305. Rather, “fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Id.* Other relevant factors include “length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark.” *Coach Servs.*, 101 USPQ2d at 1720.

Here, given Applicants’ admission that JUST DO IT is a famous mark, we need not belabor the point, but some perspective is nevertheless in order as we consider whether there is a likelihood of confusion, because “likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). See also *Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35. It would be an understatement to deem Opposer’s pleaded mark merely “very strong.”

In fact, JUST DO IT is a household name (or phrase), and so strong that AdAge magazine deemed it the first runner-up to “Diamonds Are Forever” as the 20th century’s “Top 10 Slogans.” 13 TTABVUE 7, 233-36 (Haugh Decl. ¶ 15 and Exh. D-14). The Center for Applied Research conducted a case study on Opposer’s pleaded

mark -- which it described as “one of the most famous and easily recognized slogans in advertising history” -- and found that “[t]he Nike brand has become so strong as to place it in the rarified air of recession-proof consumer branded giants, in the company of Coca-Cola, Gillette and Proctor & Gamble.” 11 TTABVUE 6, 25-27 (Reynolds Decl. ¶ 18 and Exh. B-3). A third party’s 1999 “Historic Events” survey asked 1,000 respondents which company uses the “advertising slogan ‘Just Do It,’” and 79% correctly identified Opposer. *Id.* at 7-8, 30-35 (Reynolds Decl. ¶ 19 and Exh. B-4). Opposer’s JUST DO IT ads have featured, among many others, Michael Jordan, Bo Jackson, Carl Lewis, Pete Sampras, Tiger Woods, LeBron James and Serena Williams. 12 TTABVUE 5-6 (Sedler Decl. ¶ 12). Opposer uses JUST DO IT on Facebook, where it has 32 million followers; Twitter, where it has seven million followers; and Instagram, where it has 85 million followers. *Id.* at 14-15 (Sedler Decl. ¶¶ 30-32). Since 1989, Opposer spent approximately \$200 million advertising the JUST DO IT mark in the United States. *Id.* at 6 (Sedler Decl. ¶ 13). In addition, the following excerpts from printed publications reveal public perceptions concerning the strength of Opposer’s pleaded mark:⁹

- “Nike’s ‘Just Do It’ slogan, unveiled 25 years ago this month by Wieden + Kennedy, might be the last great tagline in advertising history.” Gianatasio, David, Nike’s ‘Just Do It,’ the Last Great Advertising Slogan, *AdWeek*, July 2, 2013. 13 TTABVUE 9, 266-76, Haugh Decl. ¶ 24, Exh. D-23.
- “Just Do It. Those three little words have inspired a whole host of people the world over to do just that. They compete. They work. They hustle. They just do it. That

⁹ We do not give weight to those articles from foreign webpages. *See*, for example, Hough Decl. Exhs. D-24 and D-25, 13 TTABVUE 277-91.

phrase, which has come to be synonymous with success, with strength, with perseverance, is Nike’s brand.” Wright, Meghan, *Just Do It: Nike’s Marketing Strategy and How They’re Getting it Done*, Advat, May 28, 2015. 13 TTABVUE 10, 293-300, Haugh Decl. ¶ 27, Exh. D-26.

- “Nike’s ‘Just Do It’ phrase is one of the most globally recognized slogans and a powerful distillation of the brand’s core values.” Dunne, Brendan, *How ‘Just Do It’ Saved Nike*, Sole Collector, August 17, 2015. 13 TTABVUE 10-11, 302-09, Haugh Decl. ¶ 28, Exh. D-27.

The Board has previously found that Opposer’s JUST DO IT mark is famous, on a similar record of fame. *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1024-27 (TTAB 2011).

This evidence establishes that JUST DO IT is not only famous for purposes of both of Opposer’s claims, but exceedingly so. It is entitled to the highest level of protection against confusion.

For the foregoing reasons, this factor weighs heavily in favor of finding a likelihood of confusion.

B. The Goods, Channels of Trade, Classes of Consumers and Purchasing Conditions

Most of Applicants’ and Opposer’s goods as set forth in their identifications of goods in two registrations are identical in part, legally identical, or are encompassed by the other:

Applicants’ Goods	Opposer’s Goods
Application No. 87381081: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms (Class 25)	Registration No. 1,875,307: Clothing , namely t-shirts, sweatshirts, and caps (Class 25) Registration No. 4,764,071: Footwear; Headbands; Headwear; Pants; Shorts; Sports bras; Tank tops; Tights; Warm up suits (Class 25)

In addition, Opposer's "warm up suits" encompass "warm up jackets," which are within the scope of "jackets" identified in Applicants' identification of goods. We therefore find that "jackets" and "warm up suits" are highly related goods.

As to trade channels and classes of purchasers, because the goods identified in the application and Opposers' registrations are in-part identical or legally identical, we may, and do, presume that the channels of trade and classes of purchasers are the same for such goods. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014). We hence are not persuaded by Applicants' arguments pointing out differences between the goods as actually sold and among actual purchasers. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) ("It was proper, however, for the Board to focus on the application and registrations rather than on real-world conditions, because the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application." (quotation omitted)).

There are no price limitations on Opposer's or Applicants' clothing goods, and we must therefore presume that these goods will be sold at all price points and include low-cost items. *See In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1413 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). One webpage advertises a

JUST DO IT child's t-shirt for \$20.¹⁰ Further, these are not the type of goods where ordinary consumers are likely to exercise great care in purchasing such inexpensive apparel. Indeed, such items may be subject to impulse purchases. *Recot Inc. v. Becton*, 54 USPQ2d at 1899 (“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984).

These *DuPont* factors strongly weigh in favor of finding a likelihood of confusion.

C. Similarity of the Marks

In considering the marks, we initially note that because some of the goods are identical or legally identical, the marks need not be as close as would be necessary if there were a disparity between the goods. *See, e.g., Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate 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.”).

Opposer's mark JUST DO IT and Applicants' mark JUST DREW IT! each consist of three short words, beginning with JUST and ending with IT. They are both nonspecific as to what the IT, the thing to be done or drawn, may be. Applicants state

¹⁰ Haugh Decl. Exh. D-3, 13 TTABVUE 110.

that IT refers to a drawing or work of art.¹¹ IT, in Opposer's mark, being equally indefinite, can also refer to a drawing or work of art (meaning, just do the drawing or work of art).

Opposer's mark is in standard character and typed form,¹² and Applicants' mark is in standard character form. They hence could be displayed in the same font or size. *In re Viterra*, 101 USPQ2d at 1909. Indeed, Applicants acknowledge as much in their brief.¹³

Applicants' mark includes an exclamation point, which is not in Opposer's mark. The exclamation point does not help distinguish the marks. Opposer has also used punctuation (a period) at the end of its mark and the exclamation mark does not change the meaning or commercial impression of Applicants' mark. It is worth noting that when analyzing marks, it is not improper to give more weight to a dominant feature of a mark, in this instance, the wording in the marks, and not punctuation. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987).

The main dissimilarity between the marks is that the middle word in Opposer's mark is DO while the middle word in Applicants' mark is DREW. But both DO and

¹¹ 19 TTABVUE 4.

¹² Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed or typeset mark is the legal equivalent of a standard character mark. *See In re Viterra*, 101 USPQ2d at 1909 n.2.

¹³ 19 TTABVUE 5 ("The Opposer's mark is registered in standard characters and typed forms. Furthermore, it could be displayed in any font or size, including in a manner similar to Applicant's [sic] display of JUST DREW IT!").

DREW are verbs, with DO being more general, in that it conveys performing an action of some unspecified type. The verb DREW is more specific, and is the past tense of the verb to draw. Thus, the command JUST DO IT could implore the listener to DO something, such as to DRAW something, depending on the circumstances. In short, while DO and DREW look different, their meanings -- and sound too -- are not necessarily significantly different. *See generally, Nike, Inc. v. Maher*, 100 USPQ2d at 1022-23 (finding JUST JESU IT confusingly similar to JUST DO IT).

Applicants note that JUST in Opposer's mark means "moments ago or recently" while JUST in Applicant's mark means "to act without hesitation."¹⁴ These are subtle differences between the marks and do not detract from the overall similarities in meaning, sound and commercial impression. When we compare the marks in their entireties, we find that they are more similar than dissimilar. This similarity is particularly significant in this case given how famous and strong Opposer's mark is.

Applicants argue that "[i]f someone sees the opposer's mark and applicants' mark side-by-side today, the source of either mark can be ascertained in seconds on a mobile phone."¹⁵ Applicants' argument is not persuasive because Applicants offer no proof that consumers actually do check the source of apparel on mobile phones before making purchases. In addition, our test is not whether the source of a good can be quickly verified but whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services

¹⁴ 19 TTABVUE 5.

¹⁵ 19 TTABVUE 4.

offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Assn. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

For the foregoing reasons, the *DuPont* factor regarding the similarity of the marks also weighs in favor of finding a likelihood of confusion.

D. Conclusion Regarding Likelihood of Confusion

All of the *DuPont* factors about which there is evidence weigh in favor of finding a likelihood of confusion. Indeed, Opposer's mark enjoys the highest level of fame and broadest scope of protection, the marks are similar, the goods are identical, overlapping or otherwise highly related, and the trade channels and classes of consumers are identical. Further, at least some of the parties' goods may be purchased on impulse. We conclude that confusion is likely.

V. Dilution

Opposer alleges dilution by blurring. To prevail, Opposer must show that: (1) it owns a famous mark that is distinctive; (2) Applicants are using a mark in commerce that allegedly dilutes Opposer's famous mark; (3) Applicants' use of its mark began after Opposer's mark became famous; and (4) Applicants' use of its mark is likely to cause dilution by blurring. *Coach Servs.*, 101 USPQ2d at 1723-24.

A. Owner of a Famous Mark

As discussed above, Opposer has established and Applicants have conceded that Opposer is the owner of a famous mark under Section 43(c).

B. Applicants' Use of a Mark in Commerce that Allegedly Dilutes Opposer's Mark

Opposer has not directly addressed this element in its brief. Because Opposer may rely on the filing date of Applicants' application as Applicants' constructive use date, this second element is satisfied. *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2023 (TTAB 2014) ("opposer is entitled to rely on applicant's filing date as applicant's date of constructive use. Opposer has therefore satisfied this second prong").

C. When Did the Mark Become Famous

Having found Opposer's mark to be famous, we must determine whether that fame attached to the mark prior to any date upon which Applicants may rely. In this case, because we have no evidence of Applicants' use, we must determine if Opposer's mark became famous "prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding." *Coach Servs.*, 101 USPQ2d at 1725 (citing *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001)).

Applicants admitted that Opposer has made long use of the mark JUST DO IT, that the mark has been in use in commerce for more than twenty-five years, and that Opposer's mark became famous prior to the filing date of the application for Applicants' mark and prior to any use or any use in commerce by Applicants of Applicants' mark. Additionally, Opposer established that it has been continuously using its mark since it was introduced in 1989 in connection with various clothing items and that the mark became famous well before Applicants' March 22, 2017 application filing date. *See*, for example, various articles published long prior to

Applicants' filing date, including: (i) Cox, James, Shoes with an Attitude, USA Today, August 2, 1990, ("The company's Just Do It advertising slogan is one of those rare gems that have transcended advertising to enter popular culture and language");¹⁶ (ii) Lewis, Jo Ann, It's Postmodern; and if you don't get it, you don't get it," The Washington Post, March 27, 1994, ("a simple declarative Nike slogan like Just Do It' became a cultural phenomenon");¹⁷ and (iii) Bloomberg Business News, Nike Just Does What Customers Want, Plain Dealer (Cleveland, Ohio), January 6, 1996, ("the company's Just Do It' slogan and swoosh' logo are part of U.S. pop culture.")¹⁸

D. Likelihood of Dilution by Blurring

Dilution by blurring is "an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." *Coach Servs.*, 101 USPQ2d at 1724 (quoting 15 U.S.C. § 1125(c)(2)(B)). It "occurs when a substantial percentage of consumers, on seeing the junior party's mark on its goods, are immediately reminded of the famous mark and associate the junior party's mark with the owner of the famous mark, even if they do not believe that the goods emanate from the famous mark's owner." *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1509 (TTAB 2015). The concern is that "the gradual whittling away of distinctiveness will cause the trademark holder to suffer 'death by a thousand cuts.'" *Nat'l Pork Bd. v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted). *See also Enter. Rent-A-Car Co.*

¹⁶ Opposer's Notice of Reliance Exh. A-16, 9 TTABVUE 75-77.

¹⁷ *Id.*, Exh. A-27, 9 TTABVUE 107-13.

¹⁸ *Id.*, Exh. A-37, 9 TTABVUE 140-41.

v. Advantage Rent-A-Car Inc., 330 F.3d 1333, 66 USPQ2d 1811, 1816 (Fed. Cir. 2003) (“dilution law is intended to protect a mark’s owner from dilution of the mark’s value and uniqueness”). Blurring may occur “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298 (TTAB 2016) (quoting 15 U.S.C. § 1125(c)).

To determine whether Applicants’ use of their mark is likely to cause dilution by blurring, we may consider:

The degree of similarity between their mark and Opposer’s famous mark;

The degree of inherent or acquired distinctiveness of Opposer’s mark;

The extent to which Opposer is engaging in substantially exclusive use of its mark;

The degree of recognition of Opposer’s mark;

Whether Applicants intended to create an association with Opposer’s JUST DO IT mark; and

Any actual association between Applicants’ mark and Opposer’s mark.

15 U.S.C. § 1125(c)(2)(B)(i-vi).

a. Similarity of the Marks

For the reasons stated in connection with Opposer’s likelihood of confusion claim, the marks are similar. As a result of the marks’ similarity, and especially their structure and cadence, Applicants’ mark will cause consumers to “conjure up” Opposer’s famous mark, and “associate the two.” *N.Y. Yankees*, 114 USPQ2d at 1507. As we held in the *Maher* case with respect to JUST JESU IT, “[u]pon encountering

applicants' mark, consumers will be immediately reminded of opposer's JUST DO IT mark and associate applicants' mark with opposer's mark." *Nike, Inc. v. Maher*, 100 USPQ2d at 1030. This factor weighs in favor of finding a likelihood of dilution.

b. The Degree of Distinctiveness of Opposer's Mark

There is no evidence or basis upon which to find that Opposer's mark is anything other than inherently distinctive, and in the *Maher* case we found that it is inherently distinctive on a similar record. *Id.* at 1028. In any event, "[e]ven if the mark is not viewed as inherently distinctive, we found above that the mark is famous, which necessarily subsumes a finding that the mark has high acquired distinctiveness. This factor favors a likelihood of dilution." *N.Y. Yankees*, 114 USPQ2d at 1507. *See also Chanel*, 110 USPQ2d at 2025 ("In any event, the discussion above regarding opposer's extensive evidence of fame of the CHANEL mark used in connection with clothing, fashion accessories, beauty products and boutiques more than sufficiently establishes that opposer's CHANEL mark has acquired a high degree of distinctiveness among consumers."). This factor also weighs in favor of finding a likelihood of dilution.

c. The Extent to Which Opposer is Engaging in Substantially Exclusive Use of Its Mark

Opposer generally declines permission for third parties to use not only JUST DO IT, but also other marks, such as Applicants', in the form "JUST ___ IT." 11 TTABVUE 7-8 (Reynolds Decl. ¶¶ 24-25). Applicants have admitted that Opposer has brought numerous successful oppositions based on the JUST DO IT mark.¹⁹ It enforces its rights in the JUST DO IT mark vigorously, including through numerous

¹⁹ Answer ¶ 14, 6 TTABVUE 3.

cease and desist letters, scores of Board opposition and cancellation proceedings and civil litigation. 11 TTABVUE 9-15, 36-95 (Reynolds Decl. ¶¶ 26-33 and Exhs. B-5 and B-6). This type of evidence has been found to establish “substantially exclusive use.” *Chanel*, 110 USPQ2d at 2025; *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1899 (TTAB 2011); *Nike, Inc. v. Maher*, 100 USPQ2d at 1028 (involving the same mark Opposer pleads in this case).

This factor weighs in favor of finding a likelihood of dilution.

d. Degree of Recognition of Opposer’s Mark

As discussed in connection with Opposer’s likelihood of confusion claim, JUST DO IT is one of the most recognized marks of this and the last century, given, inter alia, Opposer’s extensive use, sales and promotional efforts, and the media’s attention to and recognition of the mark. As we previously held based on a partially identical record, “JUST DO IT is one of the most famous advertising slogans created,” and it enjoys a “broad spectrum of public recognition.” *Id.* at 1028. The evidence in this case establishes that this remains true today and that JUST DO IT enjoys the highest “level of fame.” This factor weighs in favor of finding a likelihood of dilution.

e. Whether Applicants Intended to Create an Association with Opposer’s Mark

There is no evidence that Applicants intended to create an association with Opposer’s mark. This factor is neutral.

f. Actual Association Between the Marks

There is no evidence of any actual association between the parties’ marks. This factor is neutral.

E. Conclusion Regarding Dilution

All of the factors weigh in favor of finding a likelihood of dilution or are neutral.

Therefore, dilution is likely.

VI. Conclusion

Use of Applicants' mark would be likely to cause confusion with, and dilute (by blurring), Opposer's mark.

Decision: The opposition is sustained on both Opposer's Section 2(d) claim and its claim of dilution by blurring, and registration of Applicants' mark is refused.