

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: May 21, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Nike, Inc.

v.

Barbara Lorenzo

Opposition No. 91286066
—

Helen Hill Minsker, Michael J. Harris, Michael Kientzle, and
Kathleen P. Duffy of Arnold & Porter Kaye Scholer, LLP,
for Nike, Inc.

Mark Terry of Mark Terry, P.A.,
for Barbara Lorenzo.

—
Before Goodman, Allard, and Elgin,
Administrative Trademark Judges.

Opinion by Elgin, Administrative Trademark Judge:

Barbara Lorenzo (“Applicant”) seeks registration on the Principal Register of the standard character mark DON’T JUST DO IT, GET IT DONE for goods ultimately identified as:

Clothing, namely, shirts, pants, skirts; T-shirts; Long-sleeved shirts; Short-sleeved shirts; Sweaters; Sweatshirts; Trousers; Shirts for men, women, and infants; Dresses; Shirts; Shoes; Pajamas; Shorts; Pants; Coats;

Belts for clothing; Headwear; Headwear, namely, hats, caps, in International Class 25.¹

Nike, Inc. (“Opposer”) opposes registration of the mark on the basis of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and dilution by blurring under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).² In support of its claims, Opposer pleaded ownership of (inter alia) the following marks registered on the Principal Register:³

JUST DO IT. (in typed format) for “Clothing, namely T-shirts, sweatshirts and caps” in Class 25;⁴

¹ Application Serial No. 97477402 was filed on June 27, 2022, on the basis of bona fide intent to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b). *See infra* Section II regarding abandoned classes 9 and 16.

As part of an internal Board pilot citation program on possibly broadening acceptable forms of legal citation in Board cases, this opinion varies from the citation form recommended in the TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2023). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion employs citation to the LEXIS database. To facilitate broader research, the proceeding or application number for cited Board decisions is listed. Until further notice, practitioners should continue to adhere to the practice set forth in TBMP § 101.03.

² *See* Notice of Opp. (1 TTABVUE). Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *4 n.1 (TTAB 2020).

³ Opposer also pleaded ownership of Application Serial No. 98030154 for JUST DO IT for “neck warmer, gloves, belt, hijab, wristbands, scarf, dresses, skirts,” but did not make of record any registration that may have resulted therefrom.

⁴ Registration No. 1875307 (the ’307 Registration) was issued on January 24, 1995 and has been renewed. A mark depicted as a typed drawing is the legal equivalent of a standard character mark, and thus we refer to these interchangeably herein. *See In re Viterra Inc.*, 671 F.3d 1358, 1363 n.2 (Fed. Cir. 2012).

JUST DO IT (in standard characters) for “Footwear; headbands; headwear; pants; shorts; sports bras; tank tops; tights; warm up suits” in Class 25;⁵ and

JUST DO IT (in standard characters) for “Retail store services and on-line retail store services featuring apparel, apparel accessories, footwear, footwear accessories, headwear, eyewear and accessories, sporting goods and equipment, bags, sports bags, sports and fitness products and accessories” in Class 35.⁶

In the answer to the notice of opposition, Applicant denied the salient allegations thereof. Applicant also asserted various putative defenses (i.e., amplifications of her denials), which we need not address.⁷ *JNF LLC v. Harwood Int’l Inc.*, Can. No. 92070634, 2022 TTAB LEXIS 328, at *4 n.8 (TTAB 2022) (citing *Mars Generation, Inc. v. Carson*, Opp. No. 91224726, 2021 TTAB LEXIS 386, at *4 (TTAB 2021)). As to the remaining defenses (laches, unclean hands, estoppel, acquiescence, and nonuse);⁸ to the extent they were sufficiently pleaded or are available defenses in this proceeding, they were not pursued at trial and therefore were waived or forfeited. *See In re Google Tech. Holdings LLC*, 980 F.3d 858, 863 (Fed. Cir. 2020) (“We have regularly stated and applied the important principle that a position not presented in the tribunal under review will not be considered on appeal in the absence of exceptional circumstances.”).⁹

⁵ Registration No. 4764071 (the ’071 Registration) was issued on June 30, 2015 and has been maintained.

⁶ Registration No. 5727940 (the ’940 Registration) was issued on April 16, 2019.

⁷ *See* Applicant’s Answer (fifth and eighth defenses) (4 TTABVUE 6-7).

⁸ Applicant’s Answer (first, second, third, fourth, sixth, and seventh defenses) (*id.*).

⁹ Although our caselaw historically refers to the failure to argue a pleaded defense at trial as waiver, the Federal Circuit distinguished waiver and forfeiture: “Whereas forfeiture is the failure to make the timely assertion of a right, waiver is the ‘intentional relinquishment or

I. Accelerated Case Resolution (“ACR”)

The parties stipulated to Accelerated Case Resolution (“ACR”), an expedited means of resolving inter partes cases.¹⁰ *See generally* TBMP §§ 528.05(a)(2), 702.04. The Board noted and approved the parties’ ACR stipulation, under which the Board may resolve and decide any genuine dispute of material fact it may find to exist based on the record, and render a final decision based on the record and briefs.¹¹

The case is fully briefed pursuant to the parties’ stipulation.¹²

II. Opposition to Classes 9 and 16 Dismissed

The application, as originally filed, included goods in International Classes 9 and 16. Pursuant to Applicant’s abandonment of the subject application as to the goods in these classes in connection with Opposition No. 91287069, to which Opposer consented, the present opposition is **dismissed without prejudice** as to Classes 9 and 16, and proceeds only as to the goods in Class 25. Trademark Rule 2.135, 37 C.F.R. § 2.135; *Aromatique, Inc. v. Lang*, Opp. No. 91087323, 1992 TTAB LEXIS 58, at *5 (TTAB 1992). Accordingly, we have not addressed evidence or argument relating to these classes.

abandonment of a known right.” *In re Google Tech. Holdings LLC*, 980 F.3d at 862 (internal quotations omitted).

¹⁰ 5 TTABVUE. The parties agreed, inter alia, that “[e]vidence that, under normal trial procedures, could be submitted by notice of reliance also may be submitted as attachments or exhibits to the parties’ ACR briefs.” *Id.* at 2-3.

¹¹ 6 TTABVUE.

¹² Opposer’s Main Brief is at 7 TTABVUE and its Rebuttal Brief is at 18 TTABVUE. Applicant’s Brief is at 17 TTABVUE.

III. The Record

The record consists of the pleadings and, pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the prosecution file for Applicant's involved application. In addition, because Opposer attached copies of its pleaded registrations printed from the USPTO's Trademark Status and Document Retrieval (TSDR) system showing the current status and title to the registrations to its Notice of Opposition, those registrations are of record. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

In addition, Opposer introduced:

1. Notice of Reliance No. 1 on news articles referring to Opposer's JUST DO IT mark from 1989 through 2018;¹³
2. Notice of Reliance No. 2 on Internet materials from 2015 through 2024 referring to Opposer's JUST DO IT mark in connection with awards, rankings, and other unsolicited recognition;¹⁴
3. Notice of Reliance No. 3 on Internet materials from Opposer's website nike.com and accounts on Facebook, Instagram, and Twitter depicting Opposer's use of the mark JUST DO IT;¹⁵
4. Testimony declaration of Jennifer Reynolds, Opposer's Assistant General Counsel, with exhibits;¹⁶
5. Testimony declaration of Kimberly J. Hedgren, Senior Paralegal II at Opposer's law firm, with exhibits;¹⁷ and

¹³ 10-11 TTABVUE ("Opp. First NOR").

¹⁴ 12-13 TTABVUE ("Opp. Second NOR").

¹⁵ 14 TTABVUE ("Opp. Third NOR"). These materials were captured by "Page Vault," a website capturing software application. The Notice of Reliance explains that "Page Vault" provides the "date, time, and URL stamp automatically generated by the browser indicating the date and time each page was printed, as well as the URL address of each page printed." *Id.* at 4.

¹⁶ 8 TTABVUE ("Reynolds Decl.").

¹⁷ 9 TTABVUE ("Hedgren Decl.").

6. Testimony declaration of Marion Costello, Opposer's Manager, Trademark Paralegal, with exhibits.¹⁸

Applicant did not introduce any evidence, but she was not required to do so. *See Shenzhen IVPS Tech. Co. Ltd. v. Fancy Pants Prods., LLC*, Opp. No. 91263919, 2022 TTAB LEXIS 383, at *3 (TTAB 2022) (citing *Yazhong Inv. Ltd. v. Multi-Media Tech. Ventures, Ltd.*, Can. No. 92056548, 2018 TTAB LEXIS 168, at *12 n.13 (TTAB 2018)). Nor did she object to any of Opposer's evidence.

IV. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes proceeding. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 1274 (Fed. Cir. 2014); *Illyrian Imp., Inc. v. ADOL Sh.p.k.*, Opp. No. 91234244, 2022 TTAB LEXIS 91, at *19 (TTAB 2022). "A party in the position of plaintiff may [oppose] registration of a mark when such [opposition] is within the zone of interests protected by the statute, 15 U.S.C. § 106[3], and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark." *JNF*, 2022 TTAB LEXIS 328, at *5 (citing *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 1070 (Fed. Cir. 2022) and *Corcamore*, 978 F.3d at 1303).

Opposer properly made of record TSDR printouts showing the current status and title of its pleaded registrations for its JUST DO IT Mark.¹⁹ Because Opposer's

¹⁸ 15-16 TTABVUE ("Costello Decl."). 16 TTABVUE is bulky media containing examples of Opposer's video advertising.

¹⁹ Notice of Opp., Exh. A (1 TTABVUE 14-39).

registrations are of record, Opposer has established its statutory entitlement to bring a Section 2(d) claim that is not wholly without merit. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, Opp. No. 91217095, 2016 TTAB LEXIS 604, at *6 (TTAB 2016) (entitlement established based on pleaded registration made of record).

Further, once statutory entitlement is sufficiently alleged (and established) for one claim, it is established for all claims, including Opposer's dilution claim. *Corporacion Habanos SA v. Rodriguez*, Can. No. 92052146, 2011 TTAB LEXIS 258, at *15 (TTAB 2011); *Enbridge, Inc. v. Excelerate Energy LP*, Opp. No. 91170364, 2009 TTAB LEXIS 642, at *21 n.10 (TTAB 2009) (citation omitted).

V. Likelihood of Confusion Claim

A. Priority

Priority is not an issue with respect to marks and the goods identified in Opposer's pleaded registrations because Applicant did not assert a counterclaim to cancel any of them. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, Opp. No. 91173963, 2016 TTAB LEXIS 151, at *13 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400 (CCPA 1974)).

B. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits the registration of a mark if it is "likely, when used on or in connection with the goods of the applicant, to cause confusion" with a registered mark. See *QuikTrip West, Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 1034 (Fed. Cir. 2021). Our determination of likelihood of confusion under

Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1381 (Fed. Cir. 2019); *In re Country Oven, Inc.*, Ser. No. 87354443, 2019 TTAB LEXIS 381, at *2 (TTAB 2019).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and relatedness of the goods. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (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.”). These factors, and others, are discussed below.

We focus our analysis on the marks JUST DO IT. and JUST DO IT in Opposer’s ’307 and ’071 Registrations,²⁰ which of the marks in the pleaded registrations have the most points in common with Applicant’s mark DON’T JUST DO IT, GET IT DONE. If we find confusion likely between the marks in the ’307 and ’071 Registrations and Applicant’s involved mark for the identified goods, we need not

²⁰ As we find below, the added punctuation in the mark JUST DO IT. is minimal and does not create a different commercial impression from JUST DO IT (without the punctuation). *See infra* Section V(B)(3). Therefore, we consider the marks to be equivalent and, for the sake of simplicity, refer to them herein as “Opposer’s Mark” or “Opposer’s JUST DO IT Mark.” Thus, we analyze the evidence regarding use and recognition of these marks, which is not segregated by mark, collectively.

consider the likelihood of confusion between Applicant's mark and Opposer's other pleaded marks, such as the mark of the '940 Registration for retail services. On the other hand, if we find no likelihood of confusion based on the '307 and '071 Registrations, we would not find confusion likely based on the other marks and the goods or services for which they are registered. *See Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 TTAB LEXIS 14, at *17 (TTAB 2023) (confining likelihood of confusion analysis to most similar pleaded mark) (subsequent history and citation omitted).

1. Strength/Fame of Opposer's Mark

Before comparing the marks, we turn to the strength of Opposer's JUST DO IT Mark under *DuPont* factors five and six. We consider both their conceptual strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength"); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, Opp. No. 91157248, 2011 TTAB LEXIS 367, at *25 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength) (citations omitted).

a. Conceptual Strength

Standard character marks registered without a claim of acquired distinctiveness are "held to be inherently distinctive." *See generally Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 107 (2000) (word marks that are arbitrary, fanciful, or suggestive are "held to be inherently distinctive."); *Two Pesos Inc. v. Taco Cabana*

Inc., 505 U.S. 763, 764 (1992) (suggestive, arbitrary and fanciful marks are deemed inherently distinctive); *Tea Bd. of India v. Republic of Tea, Inc.*, Opp. No. 91118587, 2006 TTAB LEXIS 330, at *52 (TTAB 2006) (a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods”).

Because Opposer’s JUST DO IT Mark registered on the Principal Register without any claim of acquired distinctiveness under Trademark Act Section 2(f), the mark as used in connection with the identified goods is an arbitrary mark and, therefore, inherently or conceptually strong.

b. Commercial Strength/Fame for Confusion

Under the fifth *DuPont* factor, “fame of the prior mark (sales, advertising, length of use)” we consider the extent of commercial strength in the marketplace. *DuPont*, 476 F.2d at 1361. This factor examines the extent to which the public perceives the mark as indicating a single source of origin. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1324-25 (Fed. Cir. 2017) (commercial strength is the extent to which the relevant public recognizes a mark as denoting a single source).²¹

²¹ Conversely, where there is evidence thereof, the sixth *DuPont* factor (“the number and nature of similar marks in use on similar goods”) mitigates against a mark’s potential recognition by considering whether, because of widespread third-party use of similar marks in the marketplace, “customers have been educated to distinguish between different such marks on the bases of minute distinctions.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). Applicant did not make any such evidence of record here.

Opposer pleads and argues that the JUST DO IT mark is famous for likelihood of confusion purposes.²² Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992).

The commercial strength or fame of a mark rests on the extent to which “a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards*, 857 F.3d at 1324-25 (citing *Palm Bay Imps., Inc.*, 396 F.3d at 1374-75). Commercial strength “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.” *Bose Corp.*, 293 F.3d at 1371. Direct evidence of fame, such as consumer surveys, is not necessary; indeed, it “rarely appears.”²³ *Id.* Other

²² Notice of Opp. ¶¶ 16-20 (1 TTABVUE 8-10); Opposer’s Main Br. at 1-3, 5, 12, 24 (7 TTABVUE 7-9, 11, 18, 30).

²³ Opposer provided evidence of a third-party survey regarding consumer recognition of the JUST DO IT mark. See Reynolds Decl. ¶ 29, Exh. JR-3 (8 TTABVUE 14, 34-40). A survey offered in litigation before the Board is not a freestanding piece of evidence, but instead is offered as the basis for expert opinion testimony. See generally *Promark Brands Inc. v. GFA Brands, Inc.*, Opp. No. 91194974, 2015 TTAB LEXIS 67, at *48-60 (TTAB 2015). The survey made of record by Opposer is of dubious probative value because Opposer “did not proffer a witness with first-hand knowledge of the study to explain how the study was conducted and the significance of the study.” *Coach Servs. v. Triumph Learning LLC*, Opp. No. 91170112, 2010 TTAB LEXIS 383, at *35 (TTAB 2010), *aff’d in part, vacated in part*, 668 F.3d 1356 (Fed. Cir. 2012). Nor has Opposer demonstrated that it has relied on the survey in the course of its business. Cf. *Chanel, Inc. v. Makarczyk*, Opp. No. 91208352, 2014 TTAB LEXIS 217, at *28 (TTAB 2014) (considering pre-litigation consumer recognition surveys commissioned and

relevant factors include “length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1367 (Fed. Cir. 2012); *see also Greater Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1323-24 (Fed. Cir. 2018) (unsolicited media attention).

Because of the wide latitude of legal protection that we accord a famous mark and the dominant role fame plays in the likelihood of confusion analysis, Opposer has the duty to clearly prove the fame of its pleaded marks. *Coach Servs.*, 668 F.3d at 1367 (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, Opp. No. 91160856, 2007 TTAB LEXIS 35, at *12 (TTAB 2007)). Opposer points out that the Board has deemed JUST DO IT “famous both for likelihood of confusion and likelihood of dilution purposes multiple times since 2011, most recently in April 2023” on similar records.²⁴

Nevertheless, Opposer acknowledges that fame is a factual matter that it must establish on the record in each proceeding. *Chicken Delight, Inc. v. Delight Wholesale Co.*, 1976 TTAB LEXIS 122, at *3-4 (TTAB 1976) (no proceeding number in original) (“[I]t is well settled that a decision in a prior case is incompetent as proof of any fact recited therein as against one who was not a party thereto”) (citing *Aloe Creme Labs., Inc. v. Bonne Bell, Inc.*, 1970 TTAB LEXIS 345 (TTAB 1970) (no proceeding number in original)). As detailed below, Opposer has submitted

used in the ordinary course of business); *NASDAQ Stock Mkt., Inc. v. Antartica, S.r.l.*, Opp. No. 91121204, 2003 TTAB LEXIS 391, at *37 (TTAB 2003) (considering results of annual awareness surveys to demonstrate fame).

²⁴ Opposer’s Main Br. at 5 (7 TTABVUE 11) (citing cases, while noting that the Board did not reach the claim of dilution in one case).

significant evidence of fame of the JUST DO IT mark in the United States, including the following:

i. Product Sales

Opposer claims to be the “largest seller of athletic footwear and apparel in the world.”²⁵ Opposer’s products are sold through a variety of channels, including through its own retail stores, mobile apps, and website, as well as through numerous third-party retailers, including department stores, such as Nordstrom and Macy’s, and sport specialty retailers, such as Foot Locker and Dick’s, via both their brick-and-mortar stores and websites.²⁶

Opposer commenced use of the JUST DO IT campaign in 1988, which has “remained a central part of NIKE’s overall strategy for thirty-five years.”²⁷ Opposer has “continuously sold products bearing JUST DO IT since at least as early as 1989” including “footwear, many different types of apparel, such as t-shirts, sweatshirts, tank tops, polo shirts, jackets, capris, shorts, pants, caps, hats, and socks, as well as backpacks, duffle bags, sunglasses, cell phone covers, bumper stickers, lanyards, keychains, and wristbands.”²⁸

²⁵ Costello Decl. ¶ 6 (15 TTABVUE 5). Some of Opposer’s evidence relates to use of the JUST DO IT mark outside the United States, or commingled use within and outside the United States. *See, e.g.*, Costello Decl. ¶¶ 6-8, 21, 25 (*id.* at 5-6, 10, 13). We are concerned here only with perception of the mark in the United States. Although Applicant has not specifically objected to Opposer’s evidence on this ground, in reaching our decision, we have not given probative weight to evidence of use by Opposer or consumer recognition thereof that is not clearly limited to the United States.

²⁶ Costello Decl. ¶ 7 (*id.* at 5).

²⁷ Costello Decl. ¶¶ 11, 15 (*id.* at 6, 8).

²⁸ Costello Decl. ¶ 40 (*id.* at 23); *see also* Costello Decl. Exh. MC-19 (excerpts of NIKE catalogs from 1989 to 2019 containing apparel items bearing JUST DO IT mark) (*id.* at 109-289).

Ms. Reynolds testified that Opposer “conservatively calculates that it has sold more than 153.9 million units of products bearing JUST DO IT on the product itself in every state of the United States from 1989 to the present, totaling over \$1.4 billion in net sales.”²⁹ She supplied a summary of Opposer’s sales of products from its apparel, equipment, and footwear business units in the United States “containing either JDI or JUST DO IT in the style name” (which “generally indicates the product bears the JUST DO IT mark”) by year from 1989 through 2023.³⁰ This summary indicates that at least 10,000 different products have borne the JUST DO IT Mark.³¹ According to the breakdown of sales prior to 2022, Opposer’s total net sales for “apparel, equipment, and footwear” bearing the JUST DO IT Mark exceeded \$1.3 billion.³² Although these statistics are not broken down by type of products (e.g. clothing, footwear, or equipment), Applicant does not dispute that Opposer’s sales of the clothing and footwear products identified in the ’307 and ’071 Registrations under the JUST DO IT Mark has been enormously substantial.

The JUST DO IT Mark have been featured on some of Opposer’s most well-known shoes, such as its AIR MAX and AIR FORCE 1 lines of shoes.³³ An example is shown below, where the mark is repeated on the shoe:³⁴

²⁹ Reynolds Decl. ¶ 10 (8 TTABVUE 6).

³⁰ Reynolds Decl. ¶ 11 (*id.* at 6).

³¹ Reynolds Decl. ¶ 12 (*id.*).

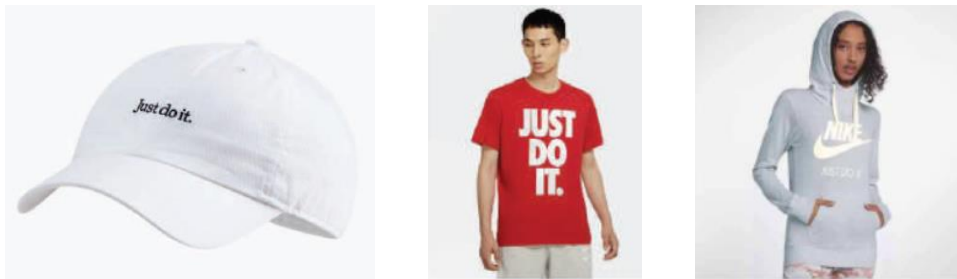
³² Reynolds Decl. Exh. JR-1 (*id.* at 28-29).

³³ Costello Decl. ¶ 42 (15 TTABVUE 23-24).

³⁴ Opp. Second NOR Exh. ONR2-28 (13 TTABVUE 88).



The JUST DO IT Mark often is featured on items of Opposer's clothing, as shown on the cap, t-shirt, and sweatshirt below:³⁵



Opposer also estimates that “[b]etween 2006 and 2010, NIKE distributed approximately 900 million shoe boxes displaying JUST DO IT. Since then, in the United States alone, NIKE has distributed over 2.4 billion shoe boxes displaying JUST DO IT,” as shown below:³⁶

³⁵ Opp. Third NOR Exh. ONR3-1 (14 TTABVUE 15, 23, 67).

³⁶ Costello Decl. ¶ 45, Exh. MC-20 (15 TTABVUE 27, 291).



ii. Advertising and Promotion

During its initial launch, Opposer supported the JUST DO IT campaign with over \$5.6 million in TV and print advertisements over a three-month period.³⁷ Opposer estimates that “in the United States alone, it has spent over \$200 million on advertisements and promotions featuring JUST DO IT since 2008.”³⁸ Opposer “has promoted the JUST DO IT mark through print advertisements, commercials, and digital platforms”:³⁹

JUST DO IT advertisements have featured numerous world-class athletes over the past 30 years, including Olympian, Carl Lewis; professional baseball and football player, Bo Jackson; professional basketball player, Michael Jordan; professional football player, Howie Long; professional tennis player, Pete Sampras; professional basketball player, Charles Barkley; professional golfer, Tiger Woods; professional basketball player, LeBron James; professional tennis player, Serena Williams; world-renown distance runner, Mo Farah; Olympian, Simone

³⁷ Costello Decl. Exh. MC-1 (*id.* at 33). Ms. Costello established this article as a business record of Opposer. Costello Decl. ¶ 11 (*id.* at 6).

³⁸ Costello Decl. ¶ 21 (*id.* at 10).

³⁹ Costello Decl. ¶ 19 (*id.* at 9).

Biles; and professional football player, Colin Kaepernick, among many others.⁴⁰

These advertisements, a sample of which Opposer provided in print and video form, have included commercials aired during the 2008 (“Bottled Courage”) and 2016 (“Unlimited”) Olympics, as shown by the screenshot below, featuring the JUST DO IT. Mark:⁴¹



Opposer celebrated the 30th Anniversary of the JUST DO IT campaign in 2018. As part of this celebration, it released an advertising campaign called “Dream Crazy” that featured athletes along with thought-provoking messages directed to various issues, such as ability, race, gender, and other social issues (“Dream Crazy Campaign”).⁴² One of these commercials, which was submitted in video format and is

⁴⁰ Costello Decl. ¶ 20 (*id.* at 9-10).

⁴¹ Costello Decl. ¶¶ 25, 27, 28 (*id.* at 13, 14-15); Costello Decl. Exh. MC-14 (video) (16 TTABVUE). Opposer provided “views” for commercials displayed on the YouTube platform, but these numbers are not probative because they were not segregated by location of viewers. *See supra* note 25.

⁴² Costello Decl. ¶ 30 (15 TTABVUE 16).

demonstrated by the screen shot shown below, received an Emmy award for “Outstanding Commercial” during the 71st Annual Emmy Awards in 2019:⁴³



This ad campaign also featured outdoor advertisements (including in New York and Los Angeles) featuring professional athletes such as Serena Williams, LeBron James, Shaquem Griffin, Colin Kaepernick, and Leo Baker.⁴⁴ The Dream Crazy Campaign was the subject of widespread publicity, including in news articles, social media discussions, and other media exposure, some of which Opposer submitted under its Second Notice of Reliance.⁴⁵ One of the commercials, entitled “Dream Crazier,” aired during the 2019 Academy Awards.⁴⁶

⁴³ Costello Decl. ¶ 31 (*id.* at 17); Costello Decl. Exh. MC-16 (16 TTABVUE).

⁴⁴ Costello Decl. ¶ 32 (*id.* at 17).

⁴⁵ Costello Decl. ¶ 33 (*id.* at 18); Opp. Second NOR Exh. ONR2-27, ONR2-32-ONR2-36 (13 TTABVUE 59-64, 181-244).

⁴⁶ Costello Decl. ¶ 34 (15 TTABVUE 18).

Opposer also uses the JUST DO IT Mark on social media, including Facebook, Twitter, and Instagram, “not only to promote its products, but to connect with consumers and to motivate consumers to live healthier lives and achieve their goals.”⁴⁷ Opposer has over 39 million followers on Facebook; over 9.9 million followers on Twitter; and over 306 million followers on its main Instagram account.⁴⁸

iii. Unsolicited Media Attention

Opposer has introduced numerous examples of unsolicited media attention and accolades, dated from 1989 to present day, directed to its JUST DO IT advertising campaign, including the following:

- A February 6, 1989 article in The Washington Post, regarding the success of the JUST DO IT campaign.⁴⁹
- An August 2, 1990 USA TODAY article noting that “[Opposer’s] ‘Just Do It’ advertising slogan is one of those rare gems that have transcended advertising to enter popular culture and language.”⁵⁰
- An October 20, 1992 article in the Miami Herald stating that ““The advertisement is one of Nike’s, although the name doesn’t appear anywhere in the ad. Only the now familiar slogan ‘Just do it’ gives it away.”⁵¹
- A May 19, 1995 article in the Seattle Times referencing a former Nike executive who “introduced ‘Just Do It’ into the nation’s lexicon of popular sayings...”⁵²

⁴⁷ Costello Decl. ¶ 35 (*id.* at 19).

⁴⁸ Costello Decl. ¶¶ 36-38 (*id.* at 19-20). We interpret these as global figures; accordingly, they are not probative because Opposer did not provide its social media following in the United States. *See supra* note 25.

⁴⁹ Opp. First NOR Exh. ONR-1-3 (10 TTABVUE 38-39).

⁵⁰ Opp. First NOR Exh. ONR-1-13 (*id.* at 65-68).

⁵¹ Opp. First NOR Exh. ONR-1-19 (*id.* at 85-87).

⁵² Opp. First NOR Exh. ONR1-30 (*id.* at 120-21).

- A May 11, 1998 article in the New York Times describing the “Just Do It” advertising campaign as “one of the most successful advertising campaigns ever.”⁵³
- An April 11, 1999 article in the Buffalo News reporting on Advertising Age’s special edition on “Top Ad Slogans,” including “Runner Up - ‘Just Do It,’ Nike”⁵⁴
- A Dec. 29, 1999 article in the Pittsburgh Post-Gazette, including the quote: “No slogan encapsulated the spirit of 20th century America better, perhaps, than Nike’s ‘Just Do It.’”⁵⁵
- A February 6, 2002 article from The Cincinnati Enquirer calling JUST DO IT the second of “Top 10 Slogans of the century.”⁵⁶
- A June 16, 2003 USA Today article stating “Nike’s ad campaigns, such as ‘Just Do It,’ are icons of pop culture.”⁵⁷
- A March 14, 2007 article in the N.Y. Post, including the quote: “Wieden & Kennedy crafted one memorable ad after another for Nike, including one of the most enduring slogans in advertising history: ‘Just Do It.’”⁵⁸
- An August 21, 2013 article in USA Today stating: “‘You did not see Nike without ‘Just Do It.’ The slogan became synonymous with the brand, and vice versa.”⁵⁹
- A November 11, 2013 article in ADWEEK stating: “Inspired, oddly enough, by death-row inmate Gary Gilmore’s final words, ‘Let’s do it,’ Wieden wrote the line, ‘Just do it.’ It became a mantra that elevated Nike to a global lifestyle and fashion brand accessible to beginners and Olympians alike. On its 25th anniversary, Adweek called the line ‘one of the biggest ad ideas ever.’”⁶⁰

⁵³ Opp. First NOR Exh. ONR1-39 (11 TTABVUE 3-5).

⁵⁴ Opp. First NOR Exh. ONR1-42 (*id.* at 12-14).

⁵⁵ Opp. First NOR Exh. ONR1-45 (*id.* at 22-23).

⁵⁶ Opp. First NOR Exh. ONR1-50 (*id.* at 36-39).

⁵⁷ Opp. First NOR Exh. ONR1-55 (*id.* at 53-57).

⁵⁸ Opp. First NOR Exh. ONR1-65 (*id.* at 84-86).

⁵⁹ Opp. First NOR Exh. ONR1-77 (*id.* at 121-23).

⁶⁰ Opp. First NOR Exh. ONR1-78 (*id.* at 124-34).

- An August 6, 2015 article in Branding Strategy Insider reporting that “After the launch of Just Do It, Nike brand sales were rejuvenated, increasing 1,000% over the next ten years. And Nike truly stepped into its role as one of the world’s premiere iconic and soulful brands.”⁶¹
- A February 12, 2018 online article from ADWEEK stating that JUST DO IT “might be the last great tagline in advertising history.”⁶²

iv. Enforcement Efforts

Opposer argues that it “Engages in Substantially Exclusive Use of the JUST DO IT Mark as Evidenced by Its Extensive Enforcement Efforts,”⁶³ but this factor appears to relate to its dilution claim. See Trademark Act Section 43(c)(B)(2)(iii) (considering “the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark”). Evidence of its enforcement efforts, however, is often submitted to show strength or fame of a mark under the fifth *DuPont* factor. *Burns Philp Food Inc. v. Modern Prods. Inc.*, Opp. No. 91077433, 1992 TTAB LEXIS 35, at *2 n.2 (TTAB 1992) (policing efforts go to the strength of the mark).

Opposer submitted a list of various federal court and Board proceedings it has brought, accompanied by testimony from Ms. Reynolds that these cases were resolved in Opposer’s favor through consent decrees, default judgments, or voluntary withdrawals of applications.⁶⁴ There is no evidence regarding the nature of the court cases except that the UPSTO received notice of their existence. And, although we may

⁶¹ Opp. First NOR Exh. ONR1-81 (*id.* at 148-53).

⁶² Opp. Second NOR Exh. ONR2-15 (12 TTABVUE 89-101).

⁶³ Opposer’s Main Br. at 28 (7 TTABVUE 34).

⁶⁴ See Reynolds Decl. ¶¶ 37-42 (8 TTABVUE 16-25).

take judicial notice of the results of Board proceedings, *see Greater Omaha Steaks Int'l, Inc.*, 908 F.3d at 1323-24, asking us to review over 120 cases would be a Sisyphean task that we decline to undertake. *Id.* at 1324 (“The Board is not required to scour, not just the dockets, but the multiple pleadings referenced in those dockets to determine the substance of the litigations referenced”).

We accord Ms. Reynold’s vague and summary testimony regarding the outcome of these proceedings only slight probative weight because it could be that these parties acquiesced to Opposer’s demands to avoid litigation rather than because they believed their marks were likely to cause confusion with Opposer’s Mark. *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, Can. No. 92059634, 2019 TTAB LEXIS 384, at *60 (TTAB 2019) (“[W]e find that competitors likely acquiesced to Freud’s assertion of its exclusive right to use the color red on saw blades to avoid litigation.”); *In re Hikari Sales USA, Inc.*, Serial No. 86439012, 2019 TTAB LEXIS 73, at *19-20 (TTAB 2019) (applicant’s evidence “only shows” that “competitors ceased use of that term, but does not shed light on its competitors’ motivation for stopping their respective uses.”); *cf. In re Wella Corp.*, 565 F.2d 143, 144 n.2 (CCPA 1977) (“[W]e agree with the TTAB that such evidence shows a desire of competitors to avoid litigation rather than distinctiveness of the mark.”).

c. Conclusion as to Strength/Fame

In the likelihood of confusion analysis, “fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards*, 857 F.3d at 1325 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340,1344 (Fed. Cir. 2003)). Opposer’s evidence establishes that the mark JUST DO IT is not only famous, but remarkably so. It is entitled to the

highest level of protection against confusion. This factor weighs heavily in favor of finding a likelihood of confusion.

2. Similarity or Dissimilarity of the Goods, Channels of Trade, and Classes of Purchasers

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” while the third and fourth *DuPont* factors consider the similarity or dissimilarity of trade channels in which the goods or services travel and the classes of consumers of such goods or services. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306, 1308 (Fed. Cir 2018) (quoting *DuPont*, 476 F.2d at 1361); *Sabhnani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 TTAB LEXIS 464, at *24 (TTAB 2021). In analyzing the relatedness of the goods under the second and third *DuPont* factors, we look to the identifications in the application and pleaded registrations. *See In re Detroit Athletic Co.*, 903 F.3d at 1306; *Stone Lion Cap. Partners v. Lion Cap. LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990)).

Both Applicant’s identification of goods and Opposer’s identifications of goods in the ’307 and ’071 Registrations include t-shirts, sweatshirts, shoes/footwear, pants, headwear, and caps. We need not go beyond these identical goods to consider Applicant’s other goods. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336 (CCPA 1981) (it is sufficient for a finding of likelihood of confusion as to a class if relatedness is established for any one of the identified goods within the class); *In re*

i.am.symbolic, llc, Serial No. 85044494, 2015 TTAB LEXIS 369, at *8 (TTAB 2015), *aff'd*, 866 F.3d 1315 (Fed. Cir. 2017).

Because the goods described in the application and the '307 and '071 Registrations are in part identical and have unrestricted trade channels, we must presume that the channels of trade and classes of purchasers are the same. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods”) (citing *In re Viterra Inc.*, 671 F.3d at 1362); *Monster Energy Co.*, 2023 TTAB LEXIS 14, at *23 (“[W]e must presume that the channels of trade and classes of purchasers are the same as to those legally identical services.”).

The identity of these goods and their presumed overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion under these factors, but also reduces the degree of similarity between the marks necessary to find a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992), *quoted in In re Viterra*, 671 F.3d at 1367 and *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348 (Fed. Cir. 2010).

3. Similarity or Dissimilarity of the Marks

The entirety of Applicant’s argument is devoted to the first *DuPont* factor concerning “[t]he similarity or dissimilarity of the marks in their entireties as to

appearance, sound, connotation and commercial impression.” 476 F.2d at 1361.⁶⁵ This is always one of the most important considerations. *See, e.g., Herbko Int’l, Inc.*, 308 F.3d at 1165 (“the ‘similarity or dissimilarity of the marks in their entirety’ is a predominant inquiry”) (citation omitted). “Marks are compared along the axes of their ‘appearance, sound, connotation and commercial impression.’” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340 (Fed. Cir. 2015) (citation omitted); *accord In re i.am.symbolic, llc*, 866 F.3d at 1324.

We also consider the first factor in light of the identical nature of the goods and the extreme fame of Opposer’s JUST DO IT mark, discussed above. *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992) (“A strong mark . . . casts a long shadow which competitors must avoid Thus, the Lanham Act’s tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls.”); *Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 1074 (Fed. Cir. 1989), quoting *Planter’s Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 924-25 (CCPA 1962) (There is “no excuse for even approaching the well-known trademark of a competitor . . . and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous[.]”).

To recap, Applicant is seeking to register DON’T JUST DO IT, GET IT DONE and Opposer’s marks are JUST DO IT and JUST DO IT. (both in standard

⁶⁵ Applicant’s Br. at 7-12 (17 TTABVUE 8-13).

characters). Applicant argues that Opposer's pleaded marks "are textually different from the Applicant's mark, and the overall commercial impression of the [] marks is not similar to the Applicant's mark."⁶⁶ In particular, Applicant contends that the textual portions of the Applicant's mark and the Opposer's JUST DO IT Mark differ by "4 words, 13 letters, 4 syllables, 5 vowels, 8 consonants and 4 spaces."⁶⁷ Applicant also argues in a conclusory manner and without evidentiary support that its mark conveys a different meaning from Opposer's pleaded mark:

[T]he word DON'T in front of the words JUST DO IT indicates that the mark is not about just doing it. The following phrase GET IT DONE indicates that the mark is indeed about getting things done or doing something to completion. It is notable that Applicant's mark, when read and understood using the regular standards of the English language indicates that mark draws a distinction between just doing it and getting something done. The Applicant's mark states that just doing it is not enough. Instead, a person should get things done, or finish something to completion. Therefore, the mark DON'T JUST DO IT, GET IT DONE indicates that the listener or viewer should not just do something – that is frowned upon. The listener or viewer should get things done or finish something to completion. There is a definite distinction drawn in Applicant's mark between JUST DO IT and GET IT DONE. With regard to cited marks, JUST DO IT, this phrase is known to be understood as the idea of just doing something, which is a straight forward phrase that is easily understood. Note that Applicant's mark frowns upon just doing something. For this reason, Applicant's mark has a meaning than the cited marks.⁶⁸

⁶⁶ Applicant's Br. at 7 (17 TTABVUE 8). Applicant does not distinguish between JUST DO IT. (with punctuation) and JUST DO IT (without punctuation).

⁶⁷ *Id.* at 9.

⁶⁸ *Id.* (emphasis in original).

Although Applicant's mark contains the additional wording "don't" before JUST DO IT, and "get it done" after it, Applicant's mark subsumes the mark of the cited registration, increasing the similarity between the two. *See e.g., China Healthways Inst. Inc. v. Wang*, 491 F.3d 1337, 1340 (Fed. Cir. 2007) (CHI PLUS similar to CHI both for electric massagers); *Double Coin Holdings Ltd. v. Tru Dev.*, Can. No. 92063808, 2019 TTAB LEXIS 347, at *20 (TTAB 2019) (ROAD WARRIOR similar to WARRIOR; "[l]ikelihood of confusion often has been found where the entirety of one mark is incorporated within another.") (quoting *Hunter Indus., Inc. v. Toro Co.*, Opp. No. 91203612, 2014 TTAB LEXIS 105, at *33 (TTAB 2014)).

We are not persuaded by Applicants' argument that the differences between the numbers of words, letters, syllables, vowels, consonants and spaces are sufficient to distinguish the marks. A determination of likelihood of confusion is not made on a purely mechanical basis, counting the number of words, syllables, or letters that are similar or different. *Fuji Jyukogyo K.K. v. Toyota Jidosha K.K.*, Opp. No. 91063523, 1985 TTAB LEXIS 31, at *8 (TTAB 1985) ("Purchasers do not count letters when reacting to trademarks in the marketplace."); *Am. B.D. Co. v. N.P. Beverages, Inc.*, Opp. No. 91060900, 1981 TTAB LEXIS 117, at *2 (TTAB 1981) (no proceeding number in original) ("Purchasers are not expected to, and do not, count the number of letters which marks have in common.") (citing cases); *In re John Scarne Games, Inc.*, 1959 TTAB LEXIS 31, at *1 (TTAB 1959) (no proceeding number in original) ("Purchasers of game boards do not engage in trademark syllable counting[;] they are governed by general impressions made by appearance or sound, or both.").

Likewise (although not addressed by Applicant), the addition of the period after the textual portion of the mark JUST DO IT. in the '307 Registration, like other items of punctuation or similar symbols, does not alter the commercial impression of the mark. *In re White Swan Ltd.*, Serial No. 617169, 1988 TTAB LEXIS 37, at *3 (TTAB 1988) (when the same words are used in marks, the presence or absence of hyphens or other punctuation marks generally will be of little significance); *In re Burlington Indus.*, Serial No. 463814, 1977 TTAB LEXIS 115, at *5 (TTAB 1977) (“[A]n exclamation point does not serve to identify the source of the goods.”). If anything, the period serves as a further imperative command, bringing it closer to the meaning of Applicant’s mandate to GET IT DONE.⁶⁹

Finally, both parties’ marks are in standard characters, which means that the marks can be depicted in any font style, size, or color. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). Therefore, Applicant’s mark could be presented in the same font style, size, and color as Opposer’s Mark. *In re Aquitaine Wine USA, LLC*, Serial No. 86928469, 2018 TTAB LEXIS 108, at *13 (TTAB 2018) (“[T]he rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”) (citation omitted).

When we compare the marks in their entirety, we find that they are far more similar than dissimilar in how they look, sound, and in the meaning they convey. The

⁶⁹ See Opposer’s Rebuttal Br. at 9 (18 TTABVUE 14) (“However, the manner in which Nike has advertised and promoted its JUST DO IT mark from its very first advertisement to the present indicates that JUST DO IT is not only intended to be a call to action, it is a successful one.”).

marks are very similar in overall commercial impression. This similarity is particularly significant in this case given how famous Opposer's JUST DO IT Mark is. The first *DuPont* factor weighs in favor of finding a likelihood of confusion.

4. Summary of *DuPont* Factors

All of the *DuPont* factors about which there is evidence weigh in favor of finding a likelihood of confusion. Indeed, Opposer's JUST DO IT Mark enjoys the highest level of fame and broadest scope of protection, the marks are similar, the goods, channels of trade, and classes of consumers are identical in part. In sum, we find that confusion is likely, and sustain Opposer's claim of likelihood of confusion under Section 2(d) of the Trademark Act.

VI. Dilution Claim

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."⁷⁸ Trademark Act Section 43(c)(2)(B), 15 U.S.C. § 1125(c)(2)(B). Dilution may be likely "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." Section 43(c)(1) of the Trademark Act, 15 U.S.C. § 1125(c)(1).

The Federal Circuit has set forth the following four elements a plaintiff must prove in a Board proceeding in order to prevail on a claim of dilution by blurring:

- (1) the plaintiff owns a famous mark that is distinctive;
- (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark;
- (3) the defendant's use of its mark began after the plaintiff's mark

became famous; and

- (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment.

Coach Servs., 668 F.3d at 1372.

We note that Applicant's entire argument regarding Opposer's dilution claim, like its argument on likelihood of confusion, is limited to similarity of the marks.⁷⁰ Nonetheless, we must determine whether Opposer has proven its claim by preponderance of the evidence.

A. Fame for Dilution

A threshold question in a federal dilution claim is whether the plaintiff's mark is "famous." *Coach Servs.*, 668 F.3d at 1372. A mark is famous for dilution purposes "if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." Trademark Act Section 43(c)(2)(A), 15 U.S.C. § 1125(c)(2)(A).

Opposer must show that, when the general public encounters the mark "in almost any context, it associates the term, at least initially, with the mark's owner." *Coach Servs.*, 668 F.3d at 1373 (quoting *Toro Co. v. ToroHead, Inc.*, Opp. No. 91114061, 2001 TTAB LEXIS 823, at *55 (TTAB 2001)).⁷¹ A famous mark is one that has become a

⁷⁰ See, e.g., Applicant's Br. at 10 (17 TTABVUE 11) ("On this issue, due to the significant differences in the textual portions of the marks, it is hard to imagine that a reasonable consumer would be confused as to source or sponsorship. Therefore, Applicant's mark and the cited marks are distinct. Consequently, there can be no likelihood of confusion between Applicant's mark and the cited marks, and there can be no likelihood of dilution by blurring.").

⁷¹ "Although the Board's *Toro* decision predates the TDRA, its discussion of fame for dilution purposes remains relevant." *Coach Servs.*, 668 F.3d at 1373 n.8.

“household name.” *Coach Servs*, 668 F.3d at 1373 (internal citations omitted). Although fame for likelihood of confusion is a matter of degree along a continuum, fame for dilution “is an either/or proposition” – it either exists or it does not. *Id.* (quoting *Palm Bay Imps., Inc.*, 396 F.3d at 1374-75, and cited in *Joseph Phelps Vineyards*, 857 F.3d at 1325).

In addition, “a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner’s goods or services, i.e., devoid of its trademark context.” *Toro Co.*, 2001 TTAB LEXIS 823, at *40 (citing H.R. Rep. No. 104-374, at 3 (1995) (“the mark signifies something unique, singular, or particular”)).

There are four non-exclusive factors to consider when determining whether a mark is famous:

- (1) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties;
- (2) The amount, volume, and geographic extent of sales of goods or services offered under the mark;
- (3) The extent of actual recognition of the mark;
- (4) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

Id.; accord *McDonald’s Corp. v. McSweet LLC*, Opp. No. 91178758, 2014 TTAB LEXIS 351, at *51-52 (TTAB 2014).

Opposer’s ’307 and ’071 Registrations are registered on the Principal Register, under the fourth factor. The testimony and evidence regarding the fame or commercial strength of Opposer’s JUST DO IT Mark previously discussed in the

likelihood of confusion section, which addresses the other three factors set out above, are more than sufficient to prove that JUST DO IT is famous for purposes of dilution.⁷²

B. When Opposer's Mark Became Famous

Having found Opposer's Mark to be famous for dilution purposes, we must now determine whether that fame attached to the mark prior to any date upon which Applicant may rely. Because there is no evidence that Applicant has started using the subject mark, the earliest date upon which she may rely is June 27, 2022, the filing date of the application. *See Nike, Inc. v. Maher*, Opp. No. 91188789, 2011 TTAB LEXIS 234, at *29-30 (TTAB 2011) (citing *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, Opp. No. 91177415, 2010 TTAB LEXIS 40, at *12 n.13 (TTAB 2010), *aff'd*, 637 F.3d 1344 (Fed. Cir. 2011)).

Opposer has established that it has been continuously using JUST DO IT since 1988, and the unsolicited media of record, discussed above, demonstrates that the marks became famous well before Applicant's 2022 filing date.⁷³

C. Likelihood of Dilution

The final element of the dilution analysis assesses whether Applicant's mark is likely to dilute Opposer's JUST DO IT Mark. As noted above, dilution by blurring occurs when a substantial percentage of consumers, on seeing the junior party's use of a mark on its goods or services, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not

⁷² *See supra* Section V(B)(1)(b).

⁷³ *See, e.g.*, text accompanying notes 49-62.

believe that the goods or services come from the famous mark's owner. *N.Y. Yankees P'ship v. IET Prods. & Servs.*, Opp. No. 91189692, 2015 TTAB LEXIS 96, at *25-26 (TTAB 2015) (citing *UMG Recordings Inc. v. Mattel Inc.*, Opp. No. 91176791, 2011 TTAB LEXIS 286, at *63 (TTAB 2011)).

The Trademark Act enumerates six non-exhaustive factors we may consider in determining whether Applicant's mark is likely to cause dilution by blurring, each of which we consider here in turn. Trademark Act Section 43(c)(B)(i)-(vi), 15 U.S.C. § 1125(c)(B)(i)-(vi).

1. The Degree of Similarity Between the Mark or Trade Name and the Famous Mark

In the dilution analysis, “[t]he marks do not have to be identical or nearly identical.” *TiVo Brands LLC v. Tivoli, LLC*, Opp. No. 91221632, 2018 TTAB LEXIS 439, at *49 (TTAB 2018) (citing *Nike*, 2011 TTAB LEXIS 234, at *40); *see also Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93, 111 n.18 (2nd Cir. 2010) (“[T]he similarity between the famous mark and the allegedly blurring mark need not be substantial in order for the dilution by blurring claim to succeed.”) “[A]n important question in a dilution case is whether the two involved marks are sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark.” *Nat'l Pork Bd. v. Supreme Lobster & Seafood Co.*, Opp. No. 91166701, 2010 TTAB LEXIS 225, at *62 (TTAB 2010).

We already found the parties' marks to be similar for purposes of likelihood of confusion. Taking into account the similarities of the marks and the fame for dilution purposes of Opposer's Mark, we find that Applicant's mark DON'T JUST DO IT, GET

IT DONE is sufficiently similar to JUST DO IT to “trigger consumers to conjure up” Opposer’s famous mark. *Id.* Upon encountering Applicant’s mark, consumers will immediately be reminded of Opposer’s JUST DO IT Mark and associate Applicant’s mark with Opposer’s Mark, favoring a finding of likelihood of dilution.

2. The Degree of Inherent or Acquired Distinctiveness of the Famous Mark.

As we have previously found, JUST DO IT is conceptually strong. It has been registered numerous times on the Principal Register without resort to a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. In addition, the evidence shows that JUST DO IT is a famous mark. It has attracted widespread recognition and success as an indicator of source for Opposer’s goods and services. Therefore, we find that JUST DO IT is “so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner’s goods or services,” *NASDAQ Stock Mkt., Inc.*, 2003 TTAB LEXIS 391, at *59 (citing *Toro*, 2001 TTAB LEXIS 823, at *40). This factor favors a finding of likelihood of dilution.

3. The Extent to Which the Owner of the Famous Mark is Engaging in Substantially Exclusive Use of the Mark.

Opposer has shown that it vigilantly enforces its rights to the mark JUST DO IT.⁷⁴ In addition, Opposer receives requests for third parties to use JUST DO IT or variations thereof. Opposer “has generally not permitted others to use or modify it

⁷⁴ Reynolds Decl. ¶¶ 38-42 (8 TTABVUE 15-25)

trademarks, including JUST DO IT.”⁷⁵ Applicant has not proffered any evidence indicating that Opposer’s use of JUST DO IT is not substantially exclusive. This factor favors a finding of likelihood of dilution.

4. The Degree of Recognition of the Famous Mark.

With respect to the degree of recognition of Opposer’s famous JUST DO IT Mark, we have no direct evidence, e.g., a survey, showing a level of recognition of Opposer’s Mark.⁷⁶ However, Opposer’s evidence of strong and consistent presence in print, television advertising, and Internet media, as well as unsolicited media coverage, proves that JUST DO IT has attained a significant level of recognition. As such, this factor also favors a finding of likelihood of dilution.

5. Whether the User of the Mark or Trade Name Intended to Create an Association with the Famous Mark.

Opposer concedes that there is no evidence that Applicant intended to create an association with Opposer’s Mark,⁷⁷ and we decline to infer any merely based on similarity of the marks. Thus, this factor is neutral.

6. Any Actual Association Between the Mark or Trade Name and the Famous Mark.

There is no evidence of any actual association between Applicant’s mark and Opposer’s JUST DO IT Mark inasmuch as Applicant filed an intent to use application

⁷⁵ Reynolds Decl. ¶ 34 (*id.* at 15).

⁷⁶ See *supra* note 23 (third party survey evidence not considered).

⁷⁷ See Opposer’s Main Br. at 36 (7 TTABVUE 42) (“There is no direct evidence of an intent by Applicant to create an association with Nike”).

and there is no evidence that she has started using the mark. Thus, this factor also is neutral.

7. Summary of Dilution Factors

All of the factors in regard to the Section 43(c) dilution by blurring claim weigh in Opposer's favor or are neutral. Accordingly, we find that Applicant's mark is likely to dilute Opposer's JUST DO IT Mark under Trademark Act 43(c)(2)(B), 15 U.S.C. § 1125(c)(2)(B).

Opposer has shown on this record that its mark is famous, that it became famous prior to the filing date of Applicant's application for her mark, and that an association exists between the parties' marks that would impair the distinctiveness of Opposer's famous mark. In view thereof, we sustain Opposer's claim of dilution by blurring under Section 43(c) of the Trademark Act.

Decision

The opposition to registration of the mark DON'T JUST DO IT, GET IT DONE in Application Serial No. 97477402 is **dismissed without prejudice** as to the goods in Classes 9 and 16, and **sustained** as to the goods in Class 25 on the grounds of likelihood of confusion and dilution by blurring under Trademark Act Sections 2(d) and 43(c), respectively.