

This Opinion is not a
Precedent of the TTAB

Mailed: March 20, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
Nike, Inc.

v.

Cheryl Bauman-Buffone

—
Opposition No. 91234556

—
Helen Hill Minsker, Audra C. Eidem Heinze and Kevin Dam
of Banner & Witcoff, Ltd. for Nike, Inc.

M. Scott Alprin, William J. Morris III and Asha E. Velay
of Alprin Law Offices, P.C. for Cheryl Bauman-Buffone.

—
Before Ritchie, Adlin and Goodman,
Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Cheryl Bauman-Buffone seeks registration of the mark JUST SAY IT
in the form shown below

JustSayIt

for: “books” (in International Class 16), and “downloadable e-books” (in International
Class 9), both in “in the field of promoting healthy lifestyles encompassing physical,

social, emotional and spiritual aspects of positive human oral communications.”¹ In its notice of opposition, 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,² footwear, bags³ and ancillary products, including eyeglass frames,⁴ cell phone cases⁵ and bottles sold empty.⁶ As grounds for opposition, Opposer alleges that use of Applicant’s mark would be likely to cause confusion with, and dilute (by blurring), Opposer’s mark. In her answer, Applicant denies the salient allegations in the notice of opposition.

I. The ACR Stipulations, Record and Evidentiary Objections

The parties agreed to resolve this case via Accelerated Case Resolution (“ACR”), including by waiving disclosures, discovery and expert testimony. They agreed to

¹ Application Serial No. 86646019, filed May 29, 2015 under Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d), and later amended to Section 44(e), 15 U.S.C. § 1126(e), based on Canadian Registration No. TMA949786. The application includes this description of the mark: “The mark consists of the wording ‘JustSayIt’ with the letters ‘Say’ in bold and with the aperture inside the letter ‘A’ resembling the shape of a word bubble.” Shortly before Opposer’s ACR Brief and evidence was due, Applicant filed an unconsented motion to amend the involved application’s identification of goods, 20 TTABVUE, consideration of which was deferred until final decision. 31 TTABVUE. We address the motion to amend below in comparing the parties’ goods.

² Registration No. 1875307, issued January 24, 1995; renewed. This registration is for “clothing, namely t-shirts, sweatshirts and caps.”

³ 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.”

⁴ Registration No. 4350316, issued June 11, 2013; Section 8 Affidavit accepted, Section 15 Affidavit acknowledged.

⁵ Registration No. 4704671, issued March 17, 2015.

⁶ Registration No. 4902036, issued February 16, 2016.

submit their ACR trial briefs accompanied by supporting evidence, without requiring notices of reliance for materials subject to Trademark Rule 2.122(g). 18 TTABVUE 37 (ACR Stipulation Section I ¶¶ 1-3). The parties also stipulated to certain facts, including:

Opposer “is a leading sport and fitness company, and a leading provider of a broad range of clothing, footwear, sporting goods, athletic equipment, and related products and services.”

Applicant “is a leading voice in the field of promoting healthy lifestyles, which encompasses positive human oral and written communications.”

Opposer has standing.

Opposer used its mark for the goods in its pleaded registrations since before the involved application’s filing date.

Opposer’s pleaded mark is “famous’ as that term is defined by 15 U.S.C. § 1125(c)(2)(A),” and became famous before the involved application’s filing date.

Applicant did not use her involved mark before filing the involved application.

Id. at 4-7 (ACR Stipulation Section II ¶¶ 1-14).

The record also consists of the pleadings and, by operation of Trademark Rule 2.122(b), the file of Applicant’s involved application. In addition, Opposer introduced:

First Notice of Reliance (“NOR”) on printed publications and Internet printouts. 22-23 TTABVUE.

⁷ Citations to the record reference TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

First Testimony Declaration of Jennifer Reynolds, its Associate General Counsel, and the exhibits thereto (“Reynolds Dec. I”). 24 TTABVUE.

Testimony Declaration of Melanie Sedler, its Senior Trademark Paralegal, and the exhibits thereto (“Sedler Dec.”). 25 and 27 TTABVUE.

Testimony Declaration of Timothy J. Haugh, a Senior Litigation Paralegal with Opposer’s law firm, and the exhibits thereto (“Haugh Dec.”). 26 TTABVUE.

Second Testimonial Declaration of Ms. Reynolds, and the exhibits thereto (“Reynolds Dec. II”). 45 TTABVUE 31-55.

Second Testimonial Declaration of Mr. Haugh, and the exhibits thereto (“Haugh Dec. II”). 45 TTABVUE 57-83.

Second NOR on portions of the file history of a third-party application. 45 TTABVUE 85-97.

Applicant introduced:

Her own Testimony Declaration, and the exhibits thereto (“App. Dec.”). 35-41 TTABVUE.

An Internet printout. 42 TTABVUE.

Cancelled and abandoned third-party applications and registrations. 43 TTABVUE.

Opposer makes a number of “objections” to Applicant’s evidence. 45 TTABVUE 18-28. Most are not true evidentiary objections going to whether the evidence is admissible, but are instead attacks on the credibility or probative value of the evidence. For example, Opposer points out that materials submitted under Trademark Rule 2.122(e) without accompanying testimony may not be considered for

the truth of the matter asserted.⁸ Similarly, Opposer points out that generally evidence from foreign sources to which United States consumers have not been exposed should not be considered.⁹ Opposer also argues that Applicant's testimony is "self-serving,"¹⁰ and that it includes her opinions.¹¹

To the extent the Internet printouts upon which Applicant relies were not submitted in accordance with Board rules, they have not been considered. Otherwise, suffice it to say, "we simply accord the evidence whatever probative value it deserves, if any at all ... Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations, and this precludes the need to strike the testimony and evidence." *Hunt Control Sys. Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011). *See also Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1200 (TTAB 2018) ("We also remind the parties that our proceedings are tried before judges not likely to be easily confused or prejudiced. Objections to trial testimony on bases more relevant to jury trials are particularly unnecessary in this forum.") (citing *U.S. Playing Card Co. v. Harbro LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006)); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125

⁸ This has been established Board law for the better part of a decade with respect to Internet printouts, and for at least several decades with respect to printed publications. *Safer Inc. v. OMS Inv. Inc.*, 94 USPQ2d 1031, 1037 n.14 and 1040 (TTAB 2010).

⁹ This is the Board's general policy and practice.

¹⁰ This is one reason why parties have the option to cross-examine witnesses.

¹¹ We are able to distinguish fact testimony from opinion testimony.

USPQ2d 1468, 1478 (TTAB 2017) (quoting *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017)). We have kept Opposer’s “objections” in mind in considering and determining the probative value of Applicant’s evidence.

II. Standing

Opposer’s pleaded registrations, made of record with its notice of opposition, establish its standing, as does Applicant’s stipulation that Opposer has standing. 1 TTABVUE 12-39 (pleaded registrations); 18 TTABVUE 4 (ACR Stipulation Section II ¶ 3) (stipulation). 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).

III. Priority

Because Applicant has 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 Applicant has stipulated to, Opposer’s prior common law use of its pleaded mark for the goods identified in its pleaded registrations. 24 TTABVUE 4-7 (Reynolds Dec. I ¶¶ 5-15); 18 TTABVUE 6 (ACR Stipulation Section II ¶ 7).

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. We consider the likelihood of confusion factors about which there is evidence, and treat the remaining factors as neutral.

A. The Strength/Fame of Opposer’s Mark

The parties stipulate that “NIKE’S JUST DO IT trademark is ‘famous’ as that term is defined by 15 U.S.C. § 1125(c)(2)(A).” 18 TTABVUE 6 (ACR Stipulation Section II ¶ 10). That is the section of the Lanham Act which defines “fame” for purposes of dilution claims. This stipulation 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 Services 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 Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (quoting *Recot, Inc. v. Benton*, 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 Industries, 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 Applicant’s 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 Fondée 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 Advertising Age magazine deemed it the first runner-up to “Diamonds Are Forever” as the 20th century’s “Top Ad Slogan.” 23 TTABVUE 8; *see also* 26 TTABVUE 9, 267-271 (Haugh Dec. ¶ 16 and Ex. D-15). 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.” 24 TTABVUE 8, 199-201 (Reynolds Dec. I ¶ 18 and Ex. 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 8, 204, 207 (Reynolds Dec. I ¶ 19 and Ex. B-4). Opposer’s JUST DO IT ads have featured, among many others, Michael Jordan, Bo Jackson, Carl Lewis, Tiger Woods, LeBron James and Serena Williams. 25 TTABVUE 13 (Sedler Dec. ¶ 30). Opposer uses JUST DO IT on Facebook, where it has 29 million followers; Twitter, where it has seven million followers; and Instagram, where it has 76 million followers. *Id.* at 15-16 (Sedler Dec. ¶¶ 34-36). Between 1989-2008, Opposer spent approximately \$5 billion advertising the JUST DO IT mark in the United States. *Id.* at 16 (Sedler Dec. ¶ 38).

In addition, the following excerpts from printed publications, spanning decades, reveal public perceptions concerning the strength of Opposer's pleaded mark¹²:

"The most visible thing about Nike is its marketing, not its matrix. The company's 'Just Do It' advertising slogan is one of those rare gems that have transcended advertising to enter popular culture and language." 22 TTABVUE 75 (James Cox, "Shoes With An Attitude; Nike Walks All Over Its Competition; Confidence Keeps Firm Running," USA Today Aug. 2, 1990).

"But when it comes to great ads, Nike has gotten all the airtime. Their star-filled ads are virtual news events and their slogans – from 'Just do it' to 'Bo knows' – quickly become buzzwords." *Id.* at 87 (Martha T. Moore, "Reebok Ads 'Play Hard,'" USA Today Aug. 2, 1991).

"Many ad executives cite the 6-year old Nike slogan, 'Just Do It' as among the most effective and easy-to-remember modern slogans. 'It's a tremendous call to action,' said Tony DeGregorio, chief creative officer at Lintas: New York." *Id.* at 99 (Harry Berkowitz, "Credo for Slogans: Life is Short; The Catch Words for Ad Campaigns Aren't Always Enduring, But Analysts Say Mottos are Important as Brand Names Depend More on Strong Identities, Orlando Sentinel May 30, 1993).

"Newlywed John F. Kennedy Jr. delighted an ad luncheon crowd in Portland, Ore., with quips about his new wife, Carolyn, including that she 'let me keep my maiden name.' Nike's famous slogan, he said, convinced him to take the wedding plunge." *Id.* at 150 ("People Watch," Fort Worth Star-Telegram Oct. 20, 1996).

"Nike's ad campaigns, such as 'Just Do It,' are icons of pop culture." 23 TTABVUE 56 (Michael McCarthy, "Wake Up Consumers? Nike's Brash CEO Dares to Just Do It," USA Today June 16, 2003).

¹² We have not considered any of these articles for the truth of the matters asserted therein, but instead for what they show about the publications', authors', and consumers' perceptions of the term, and what people are reported to have said about it.

“It’s been 20 years since Portland ad man Dan Wieden came up with the phrase ‘Do It,’ attached ‘Just’ to the front and pitched the tagline to lukewarm reception from Nike executives on the losing side of a shoe war with Reebok. Today, the eight-letter phrase is among the two or three slogans rated most memorable in advertising history, and Nike is the world’s largest sporting goods maker.” *Id.* at 104 (Brent Hunsberger, “‘Just Do It’ Tagline Still Gets It Done,” *The Oregonian* July 18, 2008).

The Board has previously found that Opposer’s JUST DO IT mark is famous, on a partially identical 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. This factor weighs quite heavily in favor of finding a likelihood of confusion.

B. Similarity of the Marks

Opposer’s mark JUST DO IT and Applicant’s mark  share many important attributes. They each consist of three short words, beginning with JUST and ending with IT. They both take the form of commands. They are both nonspecific as to what the IT, the thing to be done or said, may be, and they both convey the idea of not thinking or hesitating too much, but instead simply acting, either by doing or saying.

The main dissimilarity between the marks is that the middle word in Opposer’s mark is DO while the middle word in Applicant’s mark is SAY. But both DO and SAY

are verbs, with DO being more general, in that it conveys performing an action of some unspecified type.¹³ The verb SAY is more specific, and means to speak.¹⁴ Thus, the command JUST DO IT could implore the listener to SAY something, depending on the circumstances. Furthermore, we do not need evidence to know that “saying” is often a precursor to “doing.” For example, people often talk about or “say” what their intentions are before performing or “doing” the act. The common expression “actions speak louder than words” also suggests that there is some relationship between the two terms. In short, while DO and SAY look and sound different, their meanings are not necessarily significantly different in the context of being commanded to take some action. *See generally, Nike, Inc. v. Maher*, 100 USPQ2d at 1022-23 (finding JUST JESU IT confusingly similar to JUST DO IT).

The stylization of Applicant’s mark is essentially irrelevant, because Opposer’s mark is registered in standard characters and typed forms, and could be displayed in any font or size, including in a manner similar to Applicant’s display of JUST SAY IT. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012).

Nor is the small, minor design element in Applicant’s mark sufficient to distinguish it from Opposer’s mark. In fact, the design merely forms a part of the letter “a” in Applicant’s mark. It also contributes little to the mark’s overall commercial impression — because Applicant identifies the design as a “word bubble,”

¹³ <http://www.dictionary.com/browse/do>. We may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹⁴ <http://www.dictionary.com/browse/say?s=t>.

it is at best suggestive of the term “say” and highlights its meaning. *See also In re Viterra*, 101 USPQ2d at 1911 (“the verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”).

Applicant argues, and introduces evidence, that JUST SAY IT is a common English phrase. Even if we accept this premise, we disagree with the conclusion which Applicant draws from it, “that a reasonable person and a relevant consumer of Applicant’s goods would NOT make an association with Nike (or its ‘Just Do It’ brand) when encountering” Applicant’s mark. 44 TTABVUE 21 (Applicant’s ACR Brief at 17).

Indeed, for the most part Applicant’s evidence merely reveals that “just say it” is often used descriptively, or as, for example, a song lyric, a film, book, song, sermon or article title, a request for comments on Reddit, or ornamentation on products bearing different marks. 36 TTABVUE 1-140. However, there are only a handful of even arguable trademark uses of JUST SAY IT, including: use as the trade name for a marketing company and a shirt and sign company; as part of the trade name JUST SAY IT WITH COOKIES; as a trademark for a “charades party game;” and as a service mark for a radio program. *Id.* at 26-30, 43, 44, 100-107, 127. Even if these are

all valid trademark uses of JUST SAY IT, none of the goods or services offered under the mark are related to those at issue here. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017) (“Symbolic has not pointed to any record evidence to support a finding that multiple third parties use the mark I AM for the listed goods in its class 3 and 9 applications.”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (“The relevant *du Pont* inquiry is ‘[t]he number and nature of similar marks in use on *similar goods*’ ... It is less relevant that ‘Century is used on unrelated goods or services such as ‘Century Dental Centers’ or ‘Century Seafoods.’”) (quoting *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990)). Moreover, Applicant presented no evidence regarding how many consumers have been exposed to these trade name or trademark uses of JUST SAY IT, and the evidence is simply too limited, quantitatively and qualitatively, for us to conclude that “the connotation and commercial impression of Applicant’s Mark do not point toward an association with Nike.” 44 TTABVUE 24 (Applicant’s ACR Brief at 20). As Opposer points out, the vast majority of Applicant’s evidence reveals nothing more than “everyday language” uses of “just say it.”

When we compare the marks in their entirety, we find that they are more similar than dissimilar, in how they look and sound and in the meaning they convey. This similarity is particularly significant in this case given how famous and strong Opposer’s mark is. This factor also weighs in favor of finding a likelihood of confusion.

C. The Goods, Channels of Trade, Classes of Consumers and Variety of Goods Sold Under Opposer's Mark

Before addressing these factors, we first consider Applicant's pending unconsented motion to amend its application.

1. Applicant's Motion to Amend Its Identification of Goods

Applicant seeks to amend its identification of goods in both classes by indicating that the various aspects of oral communication discussed in her books are "interconnected," as follows:

From: "downloadable e-books in the field of promoting healthy lifestyles encompassing physical, social, emotional and spiritual aspects of positive human oral communications" (in International Class 9)

To: "downloadable e-books in the field of promoting healthy lifestyles encompassing **the interconnected** physical, social, emotional and spiritual aspects of positive human oral communications" (in International Class 9);

and

From: "books in the field of promoting healthy lifestyles encompassing physical, social, emotional and spiritual aspects of positive human oral communications" (in International Class 16)

To: "books in the field of promoting healthy lifestyles encompassing **the interconnected** physical, social, emotional and spiritual aspects of positive human oral communications" (in International Class 16).

The motion is denied, because even if the amendment is limiting as required by Trademark Rule 2.71(a), it would not avoid the likelihood of consumer confusion or dilution. *Cf. Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013) ("In order for such an affirmative defense to be considered, it must be

promptly asserted ... with an explanation or allegation as to how the restriction alleviates the likelihood of confusion.”) In fact, whether the “physical, social, emotional and spiritual aspects of positive human oral communications” discussed in Applicant’s books are “interconnected” or disconnected, Applicant’s books and e-books would still be in the same field, and targeted to the same consumers. Accordingly, in this decision we analyze Applicant’s identification of goods without the proposed amendment, and point out where appropriate that even if we had considered the goods with the proposed amendment, the ultimate result on both of Opposer’s claims would be the same.

2. The Goods

As we consider the goods, we keep in mind that fame remains “a dominant factor in the likelihood of confusion analysis ... independent of the consideration of the relatedness of the goods.” *Recot*, 54 USPQ2d at 1898. That is, “when a product reaches the marketplace under a famous mark, special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark.” *Bose Corp.*, 63 USPQ2d at 1310. As held in *Recot*:

... We think that the Board’s rule—that the fame of the FRITO-LAY marks extends no further than the products with which the marks are currently used—undercuts the legal standard of protection for famous marks. Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *See Kenner Parker*, 963 F.2d at 352, 22 USPQ2d at 1455-56. For this reason, this court emphasizes: “When an opposer’s trademark is a strong, famous mark, it can never be “of little consequence.” The fame of a trademark may affect the

likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.” *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675, 218 USPQ 1281, 1284 (Fed. Cir. 1984); *cf. Kenner Parker*, 963 F.3d at 354, 22 USPQ2d at 1457 (stating that the fame of a mark does not “cut both ways” in the analysis of the likelihood of confusion).

This reasoning applies with equal force when evaluating the likelihood of confusion between marks that are used with goods that are not closely related, because the fame of a mark may also affect the likelihood that consumers will be confused when purchasing these products. Indeed, it is precisely these circumstances which demand great vigilance on the part of a competitor who is approaching a famous mark, for, as the present case illustrates, the lure of undercutting or discounting the fame of a mark is especially seductive ... Accordingly, we hold that the fame of the mark must always be accorded full weight when determining the likelihood of confusion. When a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a “long shadow which competitors must avoid.” *Kenner Parker*, 963 F.3d at 353, 22 USPQ2d at 1457; *see also Nina Ricci S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 1074, 12 USPQ2d 1091, 1094 (Fed. Cir. 1989) (“There is no excuse for even approaching the well-known trademark of a competitor” (internal quotations omitted)).

Recot, 54 USPQ2d at 1897-98.

We are also mindful that the goods need not be identical or even competitive in order to find likelihood of confusion. Rather, the question is whether the goods are marketed in a manner that “could give rise to the mistaken belief that [the] goods emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (“Even

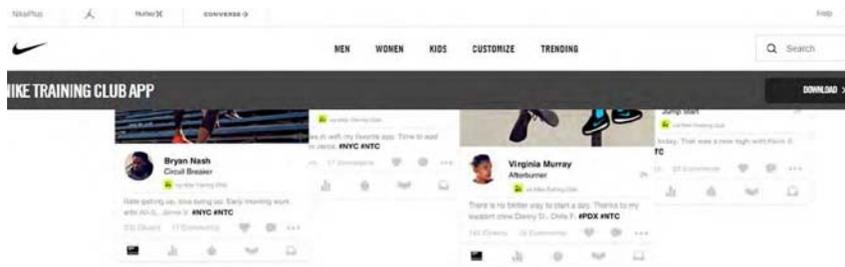
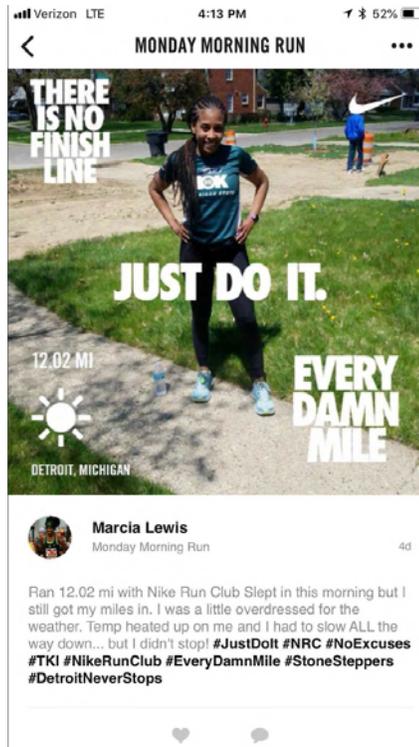
if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.”); *Recot*, 54 USPQ2d at 1898 (“even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods”); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1109 (2007).

Here, there is a relationship between the goods. Applicant’s books are focused on “healthy lifestyles encompassing *physical* ... aspects of positive human oral communications” (emphasis added). Because Applicant’s identification does not specify what the “physical” aspects of oral communications are, we must presume that they could encompass a variety of physical activities, perhaps, under certain circumstances, including physical activities for which Opposer’s goods are intended to be used. Opposer has established prior use of its mark not only for a variety of goods related to healthy lifestyles, but more specifically the *physical* aspects of being healthy, such as working out and playing sports.

Moreover, and perhaps more importantly, sports clothing and sports-related equipment are not the only goods and services Opposer provides which relate to “healthy lifestyles” and their “physical” aspects. Like Applicant, Opposer also provides, albeit through different mediums of communication, information related to healthy lifestyles (and the physical aspects thereof). Specifically, Opposer uses its JUST DO IT mark in connection with information provided not through books or e-

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books, but through its NIKE+ Run Club and NIKE Training Club mobile applications, screenshots of which are depicted below:



WORKOUT SHARING

It's easier than ever to share your workout with friends. Post your latest milestone, customize photos with NYC stickers, and take inspiration from others in the NYC app.

26 TTABVUE 6, 151, 164, 166 (Haugh Dec. ¶ 8 and Ex. D-7). While Applicant provides its information through books and e-books rather than mobile apps, there

is not necessarily any substantive difference between information provided through books, and especially e-books, on the one hand, and mobile apps on the other.¹⁵

Furthermore, while Opposer’s focus is on sports and physical fitness, it also uses JUST DO IT in connection with social, emotional and spiritual aspects of human communications, and this is recognized in the media and by the public at large. As Ms. Reynolds testifies: “In September 2018, NIKE released an advertising campaign to celebrate the 30th anniversary of its JUST DO IT mark ... This campaign included advertisements featuring athletes along with thought-provoking messages directed to various issues, such as ability, race, gender, and other social issues.” 45 TTABVUE 32 (Reynolds Dec. II ¶ 7). For example, the billboard on the left depicts LeBron James and the JUST DO IT mark in connection with “changing the world” and the billboard on the right depicts Colin Kaepernick and the JUST DO IT mark in connection with “believing in something” and “sacrificing everything”:

¹⁵ Whether the physical and other aspects of positive human oral communications are interconnected or not is irrelevant to whether the healthy lifestyle information Applicant provides through e-books and other books is related to the healthy lifestyle information Opposer provides through mobile apps.



Id. at 37, (Reynolds Dec. II Ex. E-1). An article in Adweek specifically discusses Opposer’s use of JUST DO IT in connection with oral communications and their social aspects:

Nike’s marketing has historically *started conversations about tough subjects* from ageism to Title IX and HIV. And its 30th anniversary celebration of its ‘Just do it’ tagline doesn’t stray from that tradition. The brand’s black-and-white, close-up photo of football player Colin Kaepernick, with the words ‘Believe in something. Even if it means sacrificing everything,’ and the two-minute spot that ran during the first game of the NFL season *ignited a social media firestorm.*

Id. at 57, 60-62 (Diana Pearl, “As Nike Controls the Conversation With Its Kaepernick Ad, the NFL Must Decide What It Stands For,” Adweek Sept. 9, 2018) (Haugh Dec. ¶ 3 and Ex. F-1) (emphasis added). Similarly, an article on CNBC specifically discusses Opposer’s use of JUST DO IT in connection with “shaping conversations”:

Kaepernick is just one of several athletes-turned-changemakers that Nike will spotlight in its latest ‘Just Do It’ campaign. Other athletes include Serena Williams, LeBron James, Odell Beckham Jr., Lacey Baker and Shaquem Griffin, all known for pushing barriers and *shaping conversations on race, gender and ability*.

Id. at 57-58, 65-75 (Zameena Mejia, “Meet the Changemakers in Nike’s Controversial New ‘Just Do It’ Campaign,” cnbc.com, Sept. 6, 2018) (Haugh Dec. ¶ 4 and Ex. F-2) (emphasis added). While Opposer’s use of JUST DO IT in connection with social issues and oral communications might be intended to ultimately increase shoe and clothing sales, consumers may very well nevertheless believe that Applicant’s books and e-books are an extension of Opposer’s JUST DO IT advertising campaigns.

There is no evidence that Opposer uses JUST DO IT in connection with books, but its mobile apps and advertising campaigns relate to some of the same subject matter as Applicant’s books and e-books, including “healthy lifestyles encompassing physical, social ... aspects” of “positive human oral communications.” There is no evidence or reason to believe that consumers seeking information on particular topics would necessarily limit themselves to books/e-books or mobile apps; rather, they could choose one product or the other, or both, depending on their needs. In any event, given the widespread use and fame of Opposer’s iconic mark, Applicant’s use of a similar mark for goods which bear at least some relationship to Opposer’s goods could give rise to the mistaken belief that the parties’ goods emanate from the same source. This factor also weighs in favor of finding a likelihood of confusion.

3. Channels of Trade

While the parties both provide information about and support “healthy lifestyles” and “oral communications,” there is not sufficient evidence of record for us to find that the channels of trade overlap. This factor therefore weighs against a finding of likelihood of confusion.

4. Classes of Consumers

On the other hand, we find that the classes of consumers overlap in part. Consumers of Opposer’s and Applicant’s products are focused on “healthy lifestyles,” including the physical aspects thereof. Like Applicant, Opposer provides information about healthy lifestyles and the physical aspects thereof, albeit in a different medium.¹⁶ It is likely that some consumers of Applicant’s books and e-books would be interested in the types of messages conveyed by Opposer’s advertising campaign associated with JUST DO IT’s 30th anniversary. This factor weighs in favor of a finding of likelihood of confusion.

5. Variety of Goods Offered Under Opposer’s Mark

The Ninth *du Pont* factor is “the variety of goods on which a mark is or is not used.” *In re E.I. du Pont*, 177 USPQ at 567. Here, Opposer uses its mark, for, at the very least, many types of clothing (including shirts, hats, footwear, pants, bras and warm up suits), sport bags and backpacks, bottles sold empty, cases for cell phones

¹⁶ The difference between mobile apps and e-books may not always be clear (or substantive).

and computing devices, and eyewear, including eyeglass frames and sunglasses. The difference between bottles and eyewear on the one hand and Opposer's core clothing and footwear products on the other may appear no greater to relevant consumers than the difference between books and clothing products. Moreover, Opposer's mark is exceedingly famous, and in fact ubiquitous. Under these circumstances, consumers could very well believe that having used its mark on far-flung products such as eyewear and cases for computing devices, Opposer also uses it on e-books or traditional books. In an analogous case, we found toy vehicles related to collateral products offered by a record company, because "[i]t requires no stretch of the imagination for consumers to believe that these varied collateral goods could reasonably include toy cars ... particularly in view of the fame of opposer's MOTOWN marks in connection with its music and entertainment services." *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1884 (TTAB 2011). *See also Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1271 (TTAB 2003) ("this factor may favor a finding that confusion is likely even if the goods are not obviously related"); *Uncle Ben's Inc. v. Stubenberg Int'l Inc.*, 47 USPQ2d 1310, 1313 (TTAB 1998) ("Section 2(d) of the Trademark Act also covers situations where the public, because of the similarity of the marks, is likely to believe that a recognizably different product, because of the similarity of the marks, emanates from, or is authorized, sponsored or licensed by the prior user or registrant."). This factor weighs in favor of finding a likelihood of confusion.

D. Conclusion Regarding Likelihood of Confusion

While there is no evidence of overlapping trade channels, all of the other *du Pont* 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 related, the classes of consumers overlap in part and Opposer is known to offer a variety of goods under its mark. Confusion is likely.

V. Dilution

Opposer alleges dilution by blurring. 21 TTABVUE 31 (Opposer's ACR Brief at 25). To prevail, it "must show that: (1) it 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" *Coach Servs.*, 101 USPQ2d at 1723-24. As discussed above, Opposer has established and Applicant has conceded the first three elements, leaving only the question of whether Applicant's use is likely to cause 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." *Id.* 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 Board v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1497 (TTAB 2010) (citation omitted). *See also, Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 330 F.3d 1333, 66 USPQ2d 1811, 1816 ("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 Applicant's use of her mark is likely to cause dilution by blurring, we consider:

the degree of similarity between her 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 Applicant intended to create an association with Opposer's JUST DO IT mark; and

any actual association between Applicant's 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, cadence and essential nature (commands/calls to action), Applicant’s 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 partially identical record. *Nike Inc. v. Maher*, 100 USPQ2d 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 P’ship*, 114 USPQ2d at 1507. *See also, Chanel, Inc. v. Majarczyk*, 110 USPQ2d 2013, 2025 (TTAB 2014) (“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 Applicant’s, in the form “JUST ___ IT.” 24 TTABVue 9 (Reynolds Dec. I ¶ 22). It enforces its rights in the JUST DO IT mark vigorously, including through numerous cease and desist letters, scores of Board opposition and cancellation proceedings and civil litigation. *Id.* at 9-16, 210-254 (Reynolds Dec. I ¶¶ 23-30 and Exs. B-5 and B-6). This type of evidence has been found to establish “substantially exclusive use.” *Chanel*, 110 USPQ2d at 2025; *UMG Recordings*, 100 USPQ2d at 1899; *Nike*, 100 USPQ2d at 1028 (involving the same mark Opposer pleads in this case).

While Applicant argues that Opposer’s efforts are unsuccessful in many cases, the evidence does not support the argument. As indicated, most of Applicant’s evidence of third party use reveals descriptive, ordinary language or other non-trademark uses of “just do it” or variations thereof. To the extent there are a relatively small number of trademark uses of JUST ___ IT, “even if not entirely exclusive,” Opposer’s use is “substantially exclusive,” *McDonald’s Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1289-90 (TTAB 2014), and it “is not diminished by the noted non-commercial uses of the term.” *UMG Recordings*, 100 USPQ2d at 1899.

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 centuries, 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." *Nike*, 100 USPQ2d at 1028. The evidence in this case establishes that this is even more true today, eight years later, and that JUST DO IT enjoys the highest "level of fame." This factor weighs in favor of finding a likelihood of dilution.

E. Whether Applicant Intended to Create an Association with Opposer's Mark

There is no evidence that Applicant 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.

G. 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 Applicant's mark would be likely to cause confusion with, and dilute (by blurring), Opposer's mark.

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