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August 9, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Nike, Inc.
v.
Peter Maher and Patricia Hoyt Maher

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Opposition No. 91188789
to application Serial No. 77539642
filed on 8/5/2008

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Michelle L. Calkins of Leydig, Voit & Mayer, Ltd. for Nike, Inc.

Peter Maher and Patricia Hoyt Maher, pro se.

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Before Walters, Bergsman and Wolfson, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Applicants, Peter Maher and Patricia Hoyt Maher, filed a trademark application for the mark JUST JESU IT for the following clothing items:

> athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; bermuda shorts; board shorts; boxer shorts; button-front aloha shirts; fleece shorts; golf shirts; gym shorts; hat bands; hats; hooded sweat shirts; knit shirts; long-sleeved shirts; night shirts; open-necked shirts; panties, shorts and

briefs; pique shirts; polo shirts; rugby shirts; rugby shorts; shirts; short sets; short trousers; short-sleeved or long-sleeved t-shirts; short-sleeved shirts; shorts; sleep shirts; sport shirts; sports shirts with short sleeves; sweat shirts; sweat shorts; t-shirts; tee shirts; toboggan hats, pants and caps; underwear, namely, boy shorts; walking shorts; wearable garments and clothing, namely, shirts; woolly hats.

Nike, Inc. ("opposer") has filed an opposition against applicants' application, alleging prior use and ownership of the following registrations of the mark JUST DO IT, in typed drawing form:

1. Reg. No. 1875307 for "clothing, namely t-shirts, sweatshirts and caps"; registered January 24, 1995; renewed.

2. Reg. No. 1817919 for "paper goods and printed matter; namely, bumper stickers, note pads, posters and banners; non-metallic key chains and ornamental novelty buttons; mugs"; registered January 25, 1994; renewed.

3. Reg. No. 1931937 for "binders, student planners, portfolio covers"; registered October 31, 1995; renewed.

Opposer further alleges that applicants' mark JUST JESU IT so closely resembles opposer's mark that confusion is likely under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).[1] In addition, opposer alleges that its mark is famous; that the mark became famous prior to the filing date

[1] Opposer alleges use of the mark JUST DO IT both with and without a final period (".."). With the exception of Reg. No. 1931937, its pleaded registrations include the final period. For ease of reference, the form of the mark we use herein is without the final period.

of the application; and that applicants' mark is likely to dilute the distinctiveness of opposer's famous mark under Section 43(c), 15 U.S.C. § 1125(c), by lessening the capacity of the mark to identify and distinguish opposer's goods and services. Applicants generally denied each of the salient allegations in the complaint. After trial, both sides filed trial briefs and opposer filed a reply brief.

The Record

By rule, the record includes applicants' application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b).

I. Opposer's Evidence

Opposer introduced the following testimony of its employees and the following evidence during its testimony period:

1. The testimony deposition of Jaime Schwartz, Assistant General Counsel, with attached exhibits Nos. 1-11.
2. The testimony deposition of Melanie Sedler, Trademark Paralegal, with attached exhibits Nos. 12-27.
3. The testimony deposition of Jessica Shell, Trademark Paralegal, with attached exhibits Nos. 28-32.
4. The testimony deposition of Mark Thomashow, Global Director, Business Affairs.

Opposer also filed notices of reliance on certified copies of its pleaded registrations prepared by the USPTO showing the current status of and title to the

registrations; applicants' answers to opposer's first set of interrogatories, requests for admissions, and requests for production of documents and things;[2] and newspaper and other periodical articles divided by year, starting with 1989 and continuing through 2010, purporting to show the fame of opposer's mark.

II. Applicants' Evidence

During their testimony period, applicants filed a notice of reliance on certified copies of five third-party registrations showing the current status of and title to the registrations. Applicants did not introduce any testimony.

Evidentiary Objections

Opposer objected to the introduction of one of the third-party registrations introduced by applicants on grounds that it has been cancelled.[3]

While a cancelled registration "does not provide constructive notice of anything," *Action Temporary Services*

[2] Opposer also attached copies of documents applicants submitted in response to opposer's request for production of documents and things. Such documents cannot be submitted by notice of reliance alone except to the extent that they are admissible under the provisions of § 2.122(e). 37 C.F.R. § 2.120(j)(3)(ii). None of the documents submitted by opposer in connection with applicants' answers to the document production request are admissible under this rule, and accordingly they have not been considered. However, applicants' responses, in connection with several of the requests, that no such documents exist, have been treated as being of record. *See L.C. Licensing Inc. v. Berman,* 86 USPQ2d 1883 n.5 (TTAB 2008); TBMP § 704.11 (3d ed. 2011).

[3] Reg. No. 2980221.

Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989), it is admissible under 37 C.F.R. § 2.122(e) as an official record. In addition, third-party registrations may be used to indicate that a commonly registered element has a suggestive meaning. *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpub'd,* No. 92-1086 (Fed. Cir. June 5, 1992). To the extent the registrations, including the cancelled registration, have been offered for the purpose of showing the suggestive nature of any commonly registered element, we have considered them for whatever probative value they may have.[4]

Standing and Priority

Because opposer has properly made of record certified copies of its pleaded registrations, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Moreover, priority of use for Section 2(d) purposes is not an issue in this proceeding. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

[4] To the extent the cancelled registration has any evidentiary value, it is limited to the short time that the mark was registered; i.e., from July 26, 2005 to April 5, 2006.

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