

**THIS ORDER IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
September 15, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board**

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

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

\_\_\_\_\_  
ERRATUM

Kevin C. Parks and Michelle L. Calkins of Leydig, Voit & Mayer, Ltd. for Nike, Inc.

Peter Maher and Patricia Hoyt Maher, pro se.

\_\_\_\_\_  
Before Walters, Bergsman and Wolfson, Administrative  
Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

The caption for the Board's decision dated August 9, 2011, is corrected to reflect the participation of Kevin C. Parks as counsel for plaintiff. The decision, as corrected, is attached hereto. Time for filing an appeal continues to run from August 9, 2011, the original date of decision.

Opposition No. 91188789

**THIS OPINION IS A  
PRECEDENT OF THE T.T.A.B.**

Mailed:  
August 9, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

\_\_\_\_\_  
**Trademark Trial and Appeal Board**

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

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

\_\_\_\_\_  
Kevin C. Parks and Michelle L. Calkins of Leydig, Voit &  
Mayer, Ltd. for Nike, Inc.

Peter Maher and Patricia Hoyt Maher, pro se.

\_\_\_\_\_  
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).<sup>1</sup> In addition, opposer alleges that its mark is famous; that the mark became famous prior to the filing date

---

<sup>1</sup> 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;<sup>2</sup> 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.<sup>3</sup>

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

---

<sup>2</sup> 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).

<sup>3</sup> Reg. No. 2980221.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.