

ESTTA Tracking number: **ESTTA1339995**  
Filing date: **02/13/2024**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer information

Name	NIKE, Inc.
Granted to date of previous extension	03/13/2024
Address	ONE BOWERMAN DRIVE BEAVERTON, OR 97005 UNITED STATES

Attorney information	HELEN HILL MINSKER ARNOLD & PORTER KAYE SCHOLER LLP 70 W. MADISON STREET, SUITE 4200 IP DOCKETING CHICAGO, IL 60602 UNITED STATES Primary email: helen.minsker@arnoldporter.com Secondary email(s): michael.harris@arnoldporter.com, michael.kientzle@arnoldporter.com, kathleen.duffy@arnoldporter.com, kim.hedgren@arnoldporter.com, trademarkdocketing@arnoldporter.com 3125832428
Docket no.	1104164.5699

### Applicant information

Application no.	97483698	Publication date	11/14/2023
Opposition filing date	02/13/2024	Opposition period ends	03/13/2024
Applicant	Inventive Preventives LLC 141 UNDERHILL AVENUE E. WHITE PLAINS, NY 10604 UNITED STATES		

### Goods/services affected by opposition

Class 010. First Use: None First Use In Commerce: None  
All goods and services in the class are opposed, namely: Face masks for use by dental care providers; Face masks for use by health care providers

### Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Registration barred by claim or issue preclusion	Mayer/Berkshire Corp. v. Berkshire Fashions Inc., 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005)

## Marks cited by opposer as basis for opposition

U.S. registration no.	1875307	Application date	10/03/1989
Register	Principal		
Registration date	01/24/1995	Foreign priority date	NONE
Word mark	JUST DO IT.		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Jan 26, 1989 First Use In Commerce: Jan 26, 1989 CLOTHING, NAMELY T-SHIRTS, SWEATSHIRTS AND CAPS		

U.S. registration no.	4350316	Application date	12/06/2012
Register	Principal		
Registration date	06/11/2013	Foreign priority date	NONE
Word mark	JUST DO IT		
Design mark			
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: Oct 31, 2008 First Use In Commerce: Oct 31, 2008 Eyeglass frames; Sunglasses		

U.S. registration no.	4764071	Application date	11/04/2014
Register	Principal		
Registration date	06/30/2015	Foreign priority date	NONE
Word mark	JUST DO IT		
Design mark			
Description of mark	NONE		
Goods/services	Class 018. First use: First Use: Jul 1, 2011 First Use In Commerce: Jul 1, 2011 All purpose sport bags; Backpacks Class 025. First use: First Use: Jan 26, 1989 First Use In Commerce: Jan 26, 1989 Footwear; Headbands; Headwear; Pants; Shorts; Sports bras; Tank tops; Tights; Warm up suits		

U.S. registration no.	4902036	Application date	09/21/2015
Register	Principal		
Registration date	02/16/2016	Foreign priority date	NONE

Word mark	JUST DO IT
Design mark	
Description of mark	NONE
Goods/services	Class 021. First use: First Use: Jul 1, 2015 First Use In Commerce: Jul 1, 2015 Bottles, sold empty

U.S. registration no.	5727940	Application date	10/26/2018
Register	Principal		
Registration date	04/16/2019	Foreign priority date	NONE
Word mark	JUST DO IT		
Design mark			
Description of mark	NONE		
Goods/services	Class 035. First use: First Use: Jul 1, 1994 First Use In Commerce: Jul 1, 1994 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		

U.S. registration no.	6185209	Application date	04/17/2020
Register	Principal		
Registration date	10/27/2020	Foreign priority date	NONE
Word mark	JUST DO IT		
Design mark			
Description of mark	NONE		
Goods/services	Class 026. First use: First Use: Mar 2013 First Use In Commerce: Mar 2013 Hair accessories, namely, hair ties, hair bands, ponytail holders		

Attachments	Notice of Opposition.pdf(193151 bytes ) Exhibit A.pdf(349317 bytes ) Exhibit B.pdf(360034 bytes )
-------------	---

Signature	/Helen Hill Minsker/
Name	HELEN HILL MINSKER
Date	02/13/2024

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Applicant  
Inventive Preventives LLC

Mark: **just DON it!**

Serial No.: 97/483,698

Filed: June 30, 2022

Published in the Official Gazette dated Nov. 14, 2023

NIKE, INC.,  
Opposer,

vs.

INVENTIVE PREVENTIVES LLC,  
Applicant.

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposer, NIKE, Inc., a corporation of Oregon, whose address is One Bowerman Drive, Beaverton, Oregon 97005, believes it will be damaged by registration of the above-identified mark, applied for on the Principal Register by Inventive Preventives LLC, a New York limited liability company, whose address is 141 Underhill Avenue, E. White Plains, New York, 10604, and opposes the same.

The grounds for the opposition are as follows:

**BACKGROUND ON OPPOSER AND ITS “JUST DO IT” MARK**

1. Opposer is a leading provider of a broad range of clothing, footwear, accessories, equipment, and other products and services relating to sports, fitness, health and wellness, lifestyle and fashion.

2. Opposer is the owner of rights granted via federal registrations and common law rights for the marks “JUST DO IT.” and “JUST DO IT” (collectively the “JUST DO IT Mark”).

3. Opposer has continuously used the JUST DO IT Mark in interstate commerce since at least as early as 1989 in connection with various clothing items.

4. In addition to continuous use of the JUST DO IT Mark in interstate commerce in connection with clothing, Opposer has continuously used the JUST DO IT Mark in interstate commerce in connection with a variety of goods and services for many years, including, but not limited to, the goods and services covered by the registrations for the JUST DO IT Mark identified below, and other registrations owned by Opposer over the years for the JUST DO IT Mark.

**OPPOSER OWNS MULTIPLE  
TRADEMARK REGISTRATIONS FOR THE “JUST DO IT” MARK**

5. Opposer is the owner of multiple U.S. Trademark Registrations for the JUST DO IT Mark, including the following U.S. Trademark Registrations pleaded in paragraphs 6 through 11 below.

6. Opposer is the owner of U.S. Trademark Registration No. 1,875,307 for the mark “JUST DO IT.” for “Clothing, namely T-shirts, sweatshirts and caps” in International Class 25, registered January 24, 1995. This Registration is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and thus serves as conclusive evidence of the validity of Opposer’s “JUST DO IT” mark pursuant to 15 U.S.C. § 1115(b).

7. Opposer is the owner of U.S. Trademark Registration No. 4,350,316 for the mark “JUST DO IT” for “Eyeglass frames; sunglasses” in International Class 9, registered June 11, 2013. This Registration is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and thus serves as conclusive evidence of the validity of Opposer’s “JUST DO IT” mark pursuant to 15 U.S.C. § 1115(b).

# 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.