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Just Say It Or Just Do It: Who Wins The Battle?

Amrit Singh (Nirma University) · Wednesday, April 10th, 2019

On 20th March 2019, the US Patent and Trademark Office had to decide about the conflict between the trademarks of Nike and Cheryl Bauman-Buffone. Cheryl Bauman-Buffone sought registration of her mark “JUST SAY IT” for books and downloadable e-books, both in “in the field of promoting healthy lifestyles encompassing physical, social, emotional and spiritual aspects of positive human oral communications.”

However, NIKE opposed the registration by alleging prior use of the mark “JUST DO IT” as a slogan in advertising and marketing campaigns and prior use and registration of the trademark for clothing, bags, footwear, etc. Thus, it opposed on the basis that that the applicant’s use would cause confusion and dilute the opponent’s mark.

15 U.S.C. Section 1125(c)(2)(A) lays down the criteria for a famous trademark. In the present case, the applicant admitted that “JUST DO IT” is a famous mark, but the Board looked at the degree of fame in detail because “fame varies along a spectrum from very strong to very weak”. NIKE produced a range of evidence through which it proved that it had been regarded as one of the most famous and easily recognized slogans in advertising history. The Board held that on this basis the opposer’s mark was entitled to the highest level of protection against confusion.

The Board also considered certain important attributes that both the marks shared. The Board observed the meaning of both the phrases and noticed that both the marks start with “JUST” and end with “IT”. The only difference was that the applicant’s mark had “SAY” and the opposer’s mark had “DO” as the middle word.

However, it was held by the Board that although the verb “SAY” used in the applicant’s mark is more specific in comparison to the opposer’s verb “DO”, “their meanings are not necessarily significantly different in the context of being commanded to take some action”. It held that consumers of applicant’s goods would make an association with the opposer’s goods as the marks are similar in how they look and sound and in the meaning they convey.

Moreover, the Board also deliberated on the relationship between the goods of the parties. The applicant’s books are related to “healthy lifestyles encompassing *physical* ... aspects of positive human oral communications”. The Board noted that the opposer has established prior use of goods related to “physical aspects” of being healthy such as working out, playing sports, etc.

The opponent provided information related to healthy lifestyles through mobile applications

whereas the applicant communicated through books and e-books. On this point, the Board held that there is not any significant distinction between information provided through e-books and mobile apps. Further, the opposer also proved that it used its slogan “JUST DO IT” in connection with social, emotional and spiritual aspects of human communications, by showing that:

“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.”

Thus, the Board held that the consumers seeking knowledge would definitely not limit themselves to books or e-books only and could access mobile applications as well, depending on their needs. It also held that the classes of consumers overlap in part as consumers of both parties are focused on “healthy lifestyles”. Thus, it noted that there is a likelihood of confusion.

Also, in order to see whether applicant’s use of the mark is likely to cause dilution by blurring, the Board took the six factors enumerated in Section 1125(c)(2)(B)(i-vi) into consideration. It found the marks to be similar and Nike’s mark to be inherently distinctive. It also observed that the opponent enforces its rights in the “JUST DO IT” mark vigorously, which indicated that it was engaged in “substantially exclusive use” of the mark. Moreover, the Board reiterated that the opponent’s mark is one of the most famous advertising slogans and it enjoys a broad spectrum of public recognition.

However, it held that there was no evidence to prove that the applicant intended to create an association with the opponent’s mark or that there was any actual association between the marks. Despite this, the strength of the reputation of the mark was sufficient for the tribunal to find that there would be blurring also.

The case shows how powerful a very well-known mark can be, and the breadth of the rights that come with one.

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