

Publishing Law Insight - The Perils of Mimicking a Famous Advertising Slogan

May 29, 2019

By [Robert J. Giordanella](#)

If you saw a book advertised by the slogan JUST SAY IT, would another famous advertising slogan come to mind?

Cheryl Bauman-Buffone, a Canadian citizen, filed a U.S. application based on a Canadian registration to register JUST SAY IT in stylized form for books and downloadable e-books “in the field of promoting healthy lifestyles encompassing physical, social, emotional and spiritual aspects of positive human oral communications.”



Nike, Inc. opposed the application claiming this mark was likely to cause confusion and would dilute (by blurring) its slogan JUST DO IT, previously used and registered for, among other things, clothing, footwear, bags and ancillary products, including eyeglass frames.

It might seem reasonable to think that JUST SAY IT is different enough from JUST DO IT, and that books and e-books are sufficiently different from clothing, footwear and ancillary products, that these marks can coexist. This assumption might seem especially strong if the publishing mark had been registered in another country. But, the publisher found out otherwise.

The Trademark Trial and Appeal Board sustained the opposition on both likelihood of confusion and dilution grounds. It found that JUST DO IT was a famous mark (as, indeed, the Applicant had stipulated). Further, the TTAB found Nike’s mark to be more than merely “very strong,” having become a household phrase like the marks of such giants as Coca-Cola, Gillette and Proctor & Gamble. As such, that mark was entitled to the highest level of protection.

Comparing the marks, the TTAB found that 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. Although the Applicant argued that “just say it” is a common English phrase, its evidence mostly revealed descriptive uses, not source indicators. Compared in their entirety, these marks were found more similar than dissimilar.

As for the goods, the TTAB concluded that Nike provided information relating to healthy lifestyles (and the physical aspects of them) and that its apps also concerned social, emotional and spiritual aspects of human communications. Providing information through e-books was not necessarily substantively different from providing it through apps.

In short, the TTAB held that consumers might very well be confused and mistakenly believe that Applicant's books and e-books were an extension of Nike's advertising campaigns. Further, the TTAB noted that Nike had guarded its substantially exclusive use of its mark JUST DO IT by declining to permit third parties to use "JUST ___ IT" marks, and by its numerous cease and desist letters, and scores of TTAB opposition and cancellation proceedings and civil lawsuits. This supported Nike's claim of dilution by blurring because a substantial percentage of consumers on seeing JUST SAY IT would immediately be reminded of JUST DO IT, even if they were not confused as to the source of the goods.

[Nike, Inc. v. Cheryl Bauman-Buffone, Opposition No. 91234556 \(March 20, 2019\).](#)

Author's Note: A publisher should use caution when choosing a slogan or other trademark for books that is obviously derived from a well-established slogan already in use for other goods. Further, the publisher should take into consideration the prior user's economic strength and record of taking protective action. In this case, the Applicant was not yet using her mark, so she did not have to change a mark or scrap any materials. But the delay in finding out the result of the opposition, and the legal fees and other costs incurred in fighting the opposition, might have been avoided.