

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: May 27, 2026

Mailed: July 29, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

NIKE, Inc.

v.

Gotemkicks

Opposition No. 91287908

Michael J. Harris, Michael Kientzle, Kathleen Duffy Lichtenstein, and Charles P. Guarino of Arnold & Porter Kaye Scholer LLP, for NIKE, Inc.

Zakari Kurtz of Sneaker Legal, and Erik M. Pelton of Erik M. Pelton & Associates, PLLC, for Gotemkicks.

Before Allard, Casagrande, and O'Connor,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

Gotemkicks (“Applicant”) seeks registration on the Principal Register of the standard character mark GOT EM KICKS (KICKS disclaimed) for “Retail consignment stores featuring retro sneakers and clothing,” in International Class 35.¹

¹ Application Serial No. 97315615 was filed on March 16, 2022, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce.

NIKE, Inc. (“Opposer”) filed a Notice of Opposition opposing the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the basis of priority and likelihood of confusion with its common law mark “GOT ’EM and the related design mark”² for “computer software application and web platform, and on-line retail store services featuring footwear and clothing; retail store services featuring footwear and clothing; pop-up retail store services featuring footwear and clothing.”³ Opposer also alleges ownership of a later-filed application to register the GOT ’EM mark (in standard characters), which identifies “on-line retail store services featuring footwear and clothing; retail store services featuring footwear and clothing; pop-up retail store services featuring footwear and clothing” in International Class 35.⁴

² 1 TTABVUE 4 (para. 2).

Citations to the record and briefs reference TTABVUE, the Board’s online docket system. Before the TTABVUE designation is the docket entry number; after this designation are the page references or paragraph numbers, as applicable.

³ See, e.g., 1 TTABVUE 1, 4-6, 7, 8 (paras. 2-7, 14, 17).

Opposer also alleges as grounds for its opposition “use analogous to trademark use.” 1 TTABVUE 1, 4, 6, 7 (paras. 3, 7, 14). Inasmuch as Opposer, in its brief, limits its likelihood of confusion claim to its prior common law GOT ’EM mark, we deem this likelihood of confusion claim based on use analogous to trademark use to be impliedly waived. *Illyrian Imp., Inc. v. ADOL Sh.p.k.*, No. 91234244, 2022 TTAB LEXIS 91, at *3 n.3 (TTAB 2022); *Swatch AG v. M.Z. Berger & Co.*, No. 91187092, 2013 TTAB LEXIS 515, at *47 n.3 (TTAB 2013) (pleaded claims not argued in its brief deemed waived), *aff’d*, 787 F.3d 1368 (Fed. Cir. 2015).

⁴ 1 TTABVUE 2, 6 (para. 7).

Opposer attached as an exhibit to the Notice of Opposition a copy of its pleaded application. 1 TTABVUE 11-12. However, except in limited circumstances which are not present here, “an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the period for the taking of testimony.” Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c). Accordingly, we give this exhibit no consideration.

In its Answer, Applicant denied the salient allegations of the Notice of Opposition and, under the header “Affirmative Defenses and Amplifications,” Applicant made twenty-two separate assertions.⁵ Applicant’s purported affirmative defense attempting to “reserve[] the right to assert any and all other affirmative defenses”⁶ is improper under the Federal Rules of Civil Procedure because it does not give Opposer fair notice of such defenses, so we do not consider it. *Tex. Lottery Comm’n v. Ansari*, No. 91264107, 2022 TTAB LEXIS 164, at *4 (TTAB 2022).

Many of Applicant’s asserted affirmative defenses are not true affirmative defenses but rather amplifications of its denials and will be treated as such. *Mars Generation, Inc. v. Carson*, No. 91224726, 2021 TTAB LEXIS 386, at *4 (TTAB 2021). To the extent that Applicant asserts a true affirmative defense, only one was argued by Applicant in its brief (i.e., that Opposer’s proposed mark fails to function as a mark, which we address herein); any others are deemed impliedly waived. *In re Google Tech. Holdings LLC*, 980 F.3d 858, 862-63 (Fed. Cir. 2020) (holding that arguments not presented to the Patent Trial and Appeal Board were forfeited, while noting that the loss of such rights has been identified as “waiver” in prior decisions); *Keystone Consol. Indus. v. Franklin Inv. Corp.*, No. 92066927, 2024 TTAB LEXIS 290, at *5-6 n.10 (TTAB 2024) (“Affirmative defenses that were asserted in an answer but

In addition, both parties inserted screen captures into their respective pleading. We consider such images only to the extent that they were properly made of record during trial. *See, e.g., Baseball Am. Inc. v. Powerplay Sports, Ltd.*, No. 91120166, 2004 TTAB LEXIS 443, at *4 n.6 (TTAB 2004) (factual allegations made in the pleadings are not evidence of the matters alleged, except insofar as they might be deemed to be admissions against interest).

⁵ 7 TTABVUE.

⁶ 7 TTABVUE 8 (para. 42).

then not pursued at trial may be deemed impliedly waived, while affirmative defenses that were never asserted may be deemed forfeited.”).

The case is fully briefed and the parties appeared for an oral hearing.⁷ Opposer, as the party in the position of plaintiff, bears the burden of proving its entitlement to a statutory cause of action and its Section 2(d) claim by a preponderance of the evidence. *DowntownDC Bus. Improvement Dist. v. Clarke*, No. 91275100, 2024 TTAB LEXIS 412, at *1 (TTAB 2024). Having considered the evidentiary record, the parties’ arguments and applicable authorities, we find that Opposer has carried this burden. For the reasons set forth below, we sustain the opposition.

I. Opposer’s Evidentiary Objections

Opposer objects to two of Applicant’s Notices of Reliance: Nos. 1 and 4.⁸

By way of background, Applicant alleged as one of its affirmative defenses that “numerous third parties use ‘GOT EM’ or a variation thereof in connection with footwear and/or retail store services.”⁹ During discovery, Opposer served discovery requests on Applicant seeking information and documents about such third party uses. One of Opposer’s interrogatories required Applicant to “[d]escribe the factual basis behind Applicant’s assertion that ‘numerous third parties use ‘GOT EM’ or a

⁷ 41 TTABVUE (Opposer’s brief); 45 TTABVUE (Applicant’s brief); 47 TTABVUE (Opposer’s reply brief); and 53 TTABVUE (Oral Hearing Appearance Record).

Because the certificate of service attached to Applicant’s brief improperly recited service of a document other than Applicant’s brief (45 TTABVUE 44), Applicant separately filed a proper certificate of service at 46 TTABVUE. Inasmuch as proof of service is of record, and Opposer does not allege that the brief was not properly served, we consider Applicant’s brief.

⁸ 40 TTABVUE. Opposer maintained its objection in its brief. 41 TTABVUE 11-18.

⁹ 7 TTABVUE 5 (para. 30).

variation thereof in connection with footwear and/or retail store services.”¹⁰ One of Opposer’s document requests asked for all documents relating to these alleged third-party uses¹¹ and another asked for all “documents ‘reflecting the commercial weakness of Opposer’s marks,’ as identified in Applicant’s Initial Disclosures served on April 3, 2024.”¹²

Applicant initially objected to Opposer’s interrogatory and document requests on the ground that they each “request[ed] information which is protected by attorney-client privilege and/or work product [doctrine].”¹³ Later, Applicant supplemented its responses to state that “Applicant confirms that no non-privileged information or material is being withheld.”¹⁴

Similarly, Opposer requested that Applicant identify all “[d]ocuments ‘reflecting the conceptual weakness of Opposer’s marks,’ as identified in Applicant’s Initial Disclosures served on April 3, 2024.”¹⁵ Applicant’s original response and its eventual supplemental response were the same as discussed above, i.e., it originally objected on the basis of attorney-client privilege and/or work product doctrine, and then, in its

¹⁰ 24 TTABVUE 14 (Interrog. No. 14).

¹¹ 24 TTABVUE 37 (Req. No. 12).

¹² 24 TTABVUE 39 (Req. No. 18).

¹³ 24 TTABVUE 14-15 (Resp. to Interrog. No. 14), 37 (Resp. to Req. No. 12).

¹⁴ 24 TTABVUE 23 (Supp. Resp. to Interrog. No. 14), 37 (Supp. Resp. to Req. No. 12), 39 (Supp. Resp. to Req. No. 18).

¹⁵ 24 TTABVUE 39 (Req. No. 19).

supplemental response, wrote that “Applicant confirms that no non-privileged information or material is being withheld.”¹⁶

Despite denying that no non-privileged information was being withheld, Applicant made of record during its testimony period two notices of reliance seeking to make of record third-party website printouts showing use of GOT EM formative marks and third-party registrations of third-party GOT EM formative marks.¹⁷

Applicant, in its brief, does not dispute that the documents are responsive to Opposer’s discovery requests or that they were not produced prior to trial.¹⁸ Rather, Applicant maintains that this evidence “[is] protected by attorney client and/or attorney work product privilege.”¹⁹ To the extent any internal research compilation or selection process reflected counsel’s mental impressions, Applicant continues, such materials constitute protected work product and Applicant had no duty to produce them.²⁰

The estoppel sanction under Rule 37(c)(1) of the Federal Rules of Civil Procedure, made applicable to Board proceedings under Trademark Rule 2.116, 37 C.F.R. § 2.116, states that:

If a party fails to provide information or identify a witness as required by [Federal] Rule 26(a) or (e), the party is not allowed to use that information or witness to supply

¹⁶ 24 TTABVUE 39 (Supp. Resp. to Req. No. 19).

¹⁷ 37 TTABVUE 4-36 (Applicant’s First NOR), 70-79 (Applicant’s Fourth NOR).

¹⁸ 45 TTABVUE 9-17.

¹⁹ 45 TTABVUE 9.

²⁰ 45 TTABVUE 13.

evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless.

Fed. R. Civ. P. 37(c)(1); *see also* *Mystery Ranch, Ltd. v. Terminal Moraine Inc.*, No. 91250565, 2022 TTAB LEXIS 418, at *8 (TTAB 2022); *Flame & Wax, Inc. v. Laguna Candles, LLC*, No. 92072343, 2022 TTAB LEXIS 272, at *19 n.27 (TTAB 2022) (party that fails to provide information during discovery may, upon motion or objection by its adversary, be precluded from using that information or witness at trial); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 527.01(e) (2026) (“A party that fails to provide information, or provides an untimely supplement, may be precluded from using that information or witness at trial unless the failure to disclose was substantially justified or is harmless.”) and cases cited therein.

In determining whether evidence should be excluded under Fed. R. Civ. P. 37(c)(1), the Board may be guided by the following factors:

(1) the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) importance of the evidence; and 5) the nondisclosing party’s explanation for its failure to disclose the evidence.

Great Seats, Inc. v. Great Seats, Ltd., No. 91189540, 2011 TTAB LEXIS 365, at *11-12 (TTAB 2011) (quoting *S. States Rack & Fixture, Inc. v. Sherwin-Williams Co.*, 318 F.3d 592, 597 (4th Cir. 2003)).

We find that all these factors weigh in favor of Opposer and, as a result, conclude that Applicant’s failure to timely produce the third-party use and registration evidence is neither substantially justified nor harmless. Applicant does not dispute

that this third-party evidence was requested by Opposer and not produced by Applicant. Opposer was understandably surprised by its introduction at trial, particularly given Applicant's unequivocal response that it was not withholding any nonprivileged information, and, at the late stage of this evidence's introduction, Opposer had little ability to meaningfully cure the surprise. Nor does Applicant's argument that the documents are privileged render the failure to disclose them "substantially justified." Similarly, we do not view Applicant's failure to produce this evidence as "harmless" given that Applicant seeks to rely on this evidence to support its argument that Opposer's mark is weak under the sixth *DuPont* factor. *See Heil Co. v. Tripleye GmbH*, No. 91277359, 2024 TTAB LEXIS 494, at *23-28 (TTAB 2024) (objection sustained to untimely production of software sales and subscription counts and untimely supplementation of hardware sales because failure to timely produce/supplement was not substantially justified or harmless); *Hunter Indus., Inc. v. Toro Co.*, No. 91203612, 2014 TTAB LEXIS 105, at *10 (TTAB 2014) ("A party that fails to provide information may, upon motion or objection by its adversary, be precluded from using that information or witness at trial, 'unless the failure was substantially justified or is harmless.'").

We reject Applicant's argument that the third-party evidence was properly not disclosed because it is privileged.²¹ A party may not refuse to produce evidence in response to a discovery request on the ground of privilege, as Applicant did here, and then introduce that same evidence during its trial period. *See Super Valu Stores Inc.*

²¹ 45 TTABVUE 13-14.

v. Exxon Corp., No. 91072174, 1989 TTAB LEXIS 18, at *16 (TTAB 1989) (“[A] party may not refuse to furnish information in response to a discovery request on the ground of ‘[privilege],’ ... and then introduce evidence on such matters during its trial period.”); *see also* 6 MOORE’S FEDERAL PRACTICE–CIVIL § 26.70[2][a] (2026) (“facts are not protected from disclosure by virtue of having been gathered by an attorney”). To permit a party to do so would defeat the purpose of the discovery process. *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, No. 91074797, 1988 TTAB LEXIS 60, at *6 n.5 (TTAB 1988) (Board granted motion to strike testimony, where a party refused to produce information sought in a discovery request based on attorney-client privilege, and did not allow the party to later rely on that information as evidence on its behalf).

Inasmuch as the third-party evidence was within the scope of Opposer’s discovery requests and Applicant did not produce these documents prior to their introduction at trial but sought to rely on the same evidence at trial, Opposer’s objection is sustained. In view thereof, the estoppel sanction applies and the evidence in Applicant’s first and fourth notices of reliance is excluded.²²

²² Because some of the evidence in the fourth notice of reliance consists of copies of registrations of the SNKRS mark and formatives thereof, which are owned by Opposer, not a third-party, this evidence is not considered to be the subject of Opposer’s objection and, because it is properly of record, *see* 37 TTABVUE 74-75, we consider it for whatever probative value it may have.

Applicant’s argument that we should overrule Opposer’s objections because Opposer did not first file a motion to compel (45 TTABVUE 16) is also unavailing. Inasmuch as Applicant unequivocally represented that “no non-privileged information or material is being withheld,” Applicant’s response was complete and clear, not evasive or incomplete, and therefore could not be treated as a failure to respond. *See* Fed. R. Civ. P. 37(a)(3)(B)(iii), (a)(4).

II. The Record

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file history of the involved application. In addition, the parties introduced the following evidence.

Opposer introduced during its case in chief the following evidence:

- First Notice of Reliance on the file history of Opposer's pleaded application to register its GOT 'EM mark.²³
- Second Notice of Reliance on Applicant's responses to some of Opposer's discovery requests and Applicant's initial disclosures.²⁴
- Third Notice of Reliance on the transcript of the discovery deposition of Daniel Webb, owner and president of Applicant, and related exhibits.²⁵
- Fourth Notice of Reliance on third-party website printouts.²⁶
- Testimony Declaration of Professor Isabella Cunningham, Opposer's expert, who conducted a survey showing that the GOT 'EM mark had acquired secondary meaning.²⁷
- Testimony Declaration of Samuel Lo, Senior Director, Launch & SNKRS Platform North America, for Opposer, and related exhibits.²⁸

²³ 23 TTABVUE 5-67.

²⁴ 24 TTABVUE (public)/25 TTABVUE (confidential).

We refer to information filed under seal in a manner sufficient to explain the basis of our decision to the parties, readers of this opinion, and any reviewing court. *See, e.g., Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, No. 92057394, 2016 TTAB LEXIS 100, at *11 n.21 (TTAB 2016).

²⁵ 26 TTABVUE (public)/31 TTABVUE (confidential). This was a combined personal deposition under Rule 30 and corporate deposition under Rule 30(b)(6) of the Federal Rules of Civil Procedure. 26 TTABVUE 13, 125-36.

²⁶ 27 TTABVUE. The notice of reliance indicates that 35 exhibits are attached, but only twelve are actually attached.

²⁷ 28 TTABVUE.

²⁸ 29 TTABVUE.

- Testimony Declaration of Ron Faris, VP/GM of Nike Virtual Studios for Opposer, and related exhibits.²⁹

Applicant made the following evidence of record:

- First Notice of Reliance on third-party website evidence of GOT EM formative marks.³⁰
- Second Notice of Reliance on Applicant's own responses to Opposer's discovery requests, offered "to provide the full picture of Applicant's responses to the Board."³¹
- Third Notice of Reliance on the decision in *Jones v. Nike Inc. et al.*, Case No. 22-cv-00103 (S.D. Tex. 2024).³²
- Fourth Notice of Reliance on (1) the unpleaded SNKRS and SNKRS and Design registrations in the name of Opposer, and (2) three third-party registrations of GOT EM formative marks.³³
- Fifth Notice of Reliance on select portions of the discovery deposition of Daniel Webb, owner and founder of Applicant, submitted to provide "proper context" for the portions of the transcript entered into the record by Opposer.³⁴
- Sixth Notice of Reliance on Opposer's responses to Applicant's first set of interrogatories.³⁵

²⁹ 30 TTABVUE.

³⁰ 37 TTABVUE 4-36. Opposer's objection to this evidence has been sustained. *See* discussion *supra* Section I.

³¹ 37 TTABVUE 37-51.

³² 37 TTABVUE 52-69.

³³ 37 TTABVUE 70-79. Opposer's objection to the third-party registration evidence has been sustained. *See* discussion *supra* Section I. As mentioned earlier, evidence regarding the SNKRS registrations, which are owned by Opposer, not a third-party, remains of record.

³⁴ 37 TTABVUE 80-89. Applicant submitted the transcript in condensed format, i.e., four pages of the transcript appear on a single sheet of paper. Our rules expressly provide that "the deposition transcript must be submitted [to the Board] in full-sized format (one page per sheet), not condensed (multiple pages per sheet)." Trademark Rule 2.123(g)(1), 37 C.F.R. § 2.123(g)(1). Because Opposer did not object to this submission, we deem the parties to have stipulated to it.

³⁵ 37 TTABVUE 90-118.

In rebuttal, Opposer introduced the following evidence:

- Opposer's First Rebuttal Notice of Reliance on third-party website printouts.³⁶
- Opposer's Second Rebuttal Notice of Reliance on select documents from *Nike, Inc. v. MSCHF Product Studio, Inc.*, Case No. 1:21-cv-01679-EK-PY (E.D.N.Y.).³⁷

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Id.*

Opposer, through the testimony of Samuel Lo, its Senior Director, Launch & SNKRS Platform North America, has established its common law use of the mark GOT 'EM in connection with its SNKRS Platform services, including specifically its computer software application featuring footwear for sale (as discussed in more detail herein). Based on this evidence, we find that Opposer has established a reasonable belief of damage that will be proximately caused by the registration of Applicant's mark. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029 (CCPA 1982) (plaintiff may establish standing by proving a real commercial interest in its

³⁶ 38 TTABVUE.

³⁷ 39 TTABVUE.

own marks and a reasonable belief that it would be damaged (e.g., a claim of likelihood of confusion that is not wholly without merit)); *Giersch v. Scripps Networks Inc.*, No. 92045576, 2009 TTAB LEXIS 72, at *7 (TTAB 2009) (common-law use sufficient to establish standing).

Additionally, Opposer has made of record evidence that its pleaded pending application has been suspended in view of a likelihood of confusion with Applicant's prior-filed application.³⁸ This is also sufficient to establish Opposer's entitlement to bring this statutory cause of action. *See Austl. Therapeutic Supplies PTY. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1375 (Fed. Cir. 2020) ("A petitioner may demonstrate a real interest and reasonable belief of damage where the petitioner has filed a trademark application that is refused registration based on a likelihood of confusion with the mark subject to cancellation."); *Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 1274-76 (Fed. Cir. 2014) (affirming entitlement where USPTO refused to register plaintiff's mark based on a likelihood of confusion with the mark of defendant's registrations). Applicant, for its part, does not dispute Opposer's entitlement to a statutory cause of action or address the issue at all in its brief.

IV. Trademark Act Section 2(d) Claim

Having determined that Opposer is entitled to bring this opposition proceeding, we turn to Opposer's claim under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Section 2(d) prohibits registration of a mark that "so resembles a mark

³⁸ 23 TTABVUE 64.

registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive[.]” 15 U.S.C. § 1052(d). Thus, the statute requires proof both of priority and likelihood of confusion. *Barbara’s Bakery, Inc. v. Landesman*, No. 91157982, 2007 TTAB LEXIS 9, at *6 (TTAB 2007).

A. Priority

“To establish priority, [Opposer] must show proprietary rights in the mark that produce a likelihood of confusion.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320 (CCPA 1981)) (plaintiff must establish proprietary rights, either inherent in or by acquisition of secondary meaning in, pleaded common-law mark). “These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko*, 308 F.3d at 1162.

Here, because Opposer has not advanced arguments in its brief regarding use analogous to trademark use, and because it does not own any prior registrations, it must rely solely on its asserted common law rights, which must precede Applicant’s actual or constructive use of its mark. *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, No. 91221553, 2018 TTAB LEXIS 72, at *21-23 (TTAB 2018).³⁹

³⁹ Although Opposer did not expressly plead that its mark was inherently distinctive, Applicant asserted several affirmative defenses challenging its distinctiveness, all sounding

1. Applicant's Constructive Use Date

Although Applicant did not address the issue of its priority date in its brief, Applicant's constructive use date for purposes of priority in its GOT EM KICKS mark is March 16, 2022, the day it filed its application pursuant to Section 1(b) of the Trademark Act. *See Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, No. 91175091, 2009 TTAB LEXIS 70, at *18 (TTAB 2009) (“[A]pplicant may rely without further proof upon the filing date of its application as a ‘constructive use’ date for purposes of priority.”); *Zirco Corp. v. Am. Tel. and Tel. Co.*, No. 91084979, 1991 TTAB LEXIS 43, at *8 (TTAB 1991) (“[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights.”).

Daniel Webb, Applicant's owner and founder, testified that Applicant's first use of its mark for its identified consignment store services was April 1, 2022, when the consignment store was opened to the public.⁴⁰ Inasmuch as this date is later than Applicant's constructive use date (March 16, 2022), Opposer must establish priority prior to Applicant's constructive use date.

in failure to function. 7 TTABVUE 4, paras. 23-26. We construe Opposer's brief to argue that its mark is inherently distinctive and that, to the extent it is not inherently distinctive, its mark has acquired distinctiveness. *See, e.g.*, 41 TTABVUE 33. Though Applicant argues in its brief that Opposer's mark fails to function as a mark, Applicant does not argue the mark is merely descriptive nor does it address Opposer's evidence that its mark has acquired distinctiveness.

⁴⁰ 26 TTABVUE 47 (Depo. of Webb); 40 TTABVUE 17 (Applicant's brief).

2. Opposer's Priority

As mentioned, Opposer relies solely on its alleged common law rights in its GOT 'EM mark. To establish prior common law rights, Opposer must show use of a mark that is distinctive, inherently or otherwise, before the earliest date on which Applicant may rely. *Major League Baseball Players Ass'n v. Chisena*, No. 91240180, 2023 TTAB LEXIS 117, at *24 (TTAB 2023), *aff'd*, 2026 U.S. App. LEXIS 395 (Fed. Cir. 2026); *Arsa Distrib., Inc. v. Salud Natural Mexicana S.A. de C.V.*, No. 91240240, 2022 TTAB LEXIS 347, at *19-20 (TTAB 2022); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, No. 91212312, 2017 TTAB LEXIS 201, at *19 (TTAB 2017) (“[B]ecause unregistered marks are not entitled to the presumptions established under Trademark Act Section 7(b)-(c), it is Opposer’s burden to demonstrate that it owns a trademark that was used prior to Applicant’s first use or constructive use of its mark and not abandoned.”).

a. Opposer's Use

Samuel Lo, Opposer’s Senior Director, Launch & SNKRS Platform North America, and Ron Faris, Opposer’s VP/GM of Nike Virtual Studios, both testified that Opposer launched the SNKRS Platform in February 2015 and that Opposer has used the GOT 'EM mark in connection with its SNKRS platform since its launch.⁴¹ According to Mr. Faris, the SNKRS Platform “provides consumers access to exclusive Nike experiences, releases, and product launches.”⁴² According to both witnesses, the

⁴¹ 29 TTABVUE 3 (paras. 7, 9); 30 TTABVUE 2, 3 (paras. 1, 6).

⁴² 30 TTABVUE 3 (para. 7).

“SNKRS Platform includes a computer software application and web platform, on-line retail store services featuring footwear and clothing, retail store services featuring footwear and clothing, and pop-up retail store services featuring footwear and clothing”⁴³ Since the launch of the SNKRS Platform in 2015, Opposer has enjoyed “millions of active users”⁴⁴ and “has sold millions of footwear and clothing items[.]”⁴⁵ Both witnesses testified that, in connection with each of these successful sales, the GOT ’EM trademark is displayed to the user.⁴⁶

Prior to launch of the platform, Opposer internally discussed adopting a trademark that would be displayed to users when those users successfully purchase footwear or clothing through the SNKRS Platform.⁴⁷ “[T]hrough that discussion,” Mr. Lo testified, “[Opposer] coined GOT ’EM for use with the SNKRS Platform[.]” as corroborated by Opposer’s internal document (below):

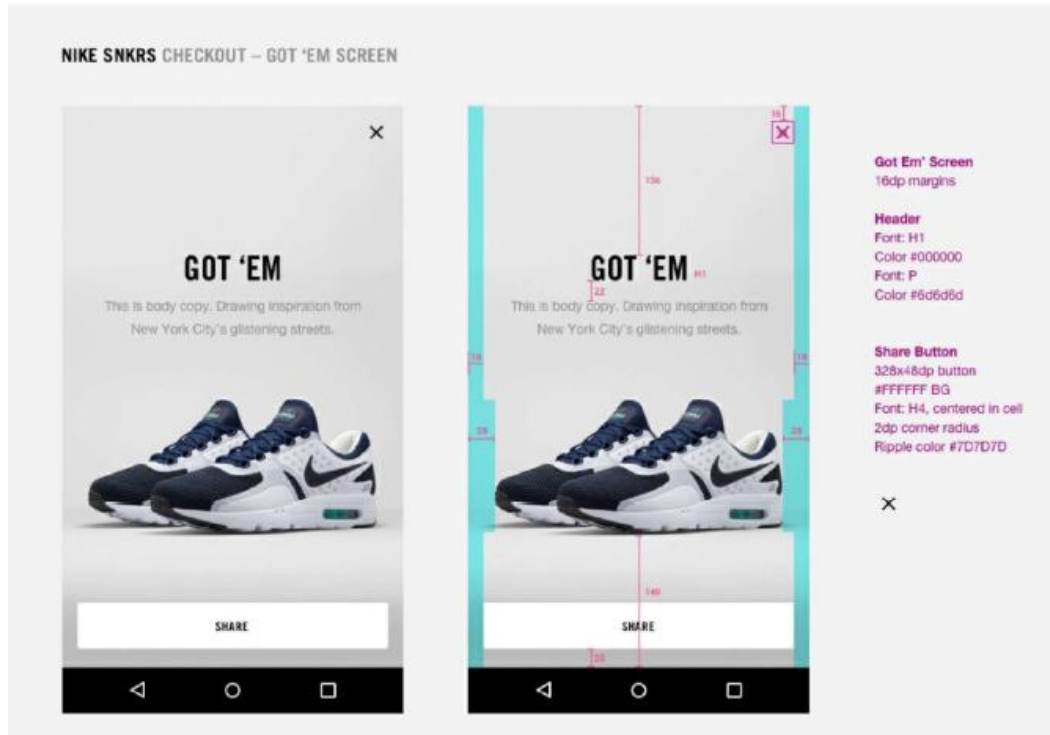
⁴³ 29 TTABVUE 3 (para. 8); 30 TTABVUE 3 (para. 6).

⁴⁴ 30 TTABVUE 3 (para. 7).

⁴⁵ 29 TTABVUE 5 (para. 12).

⁴⁶ 29 TTABVUE 5 (para. 12); 30 TTABVUE 3 (para. 7).

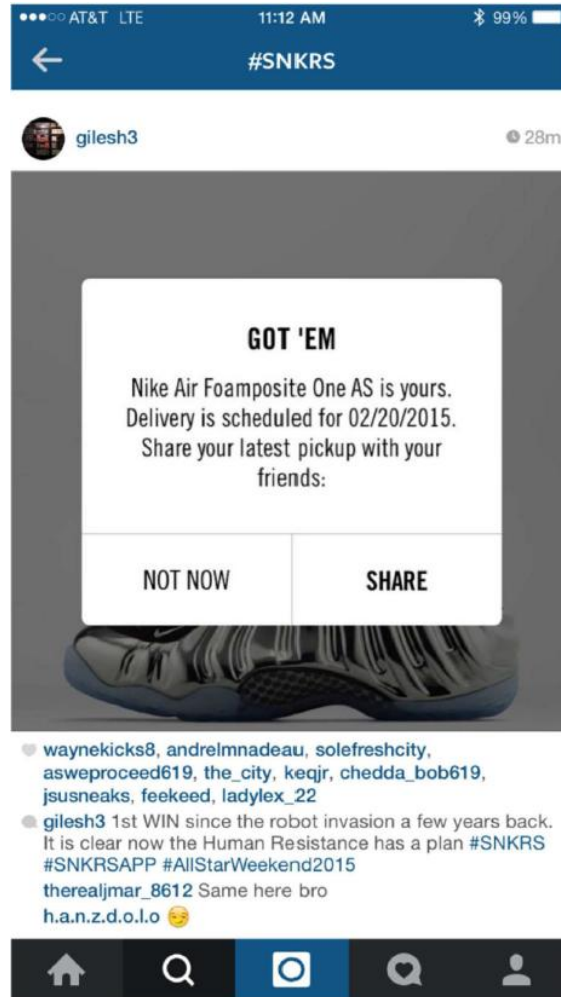
⁴⁷ 29 TTABVUE 3 (para. 10).



According to Mr. Lo, since the launch of the SNKRS Platform in 2015, the GOT 'EM trademark has been displayed to users who have successfully purchased items through it.⁴⁸ One representative example from 2015 appears below:⁴⁹

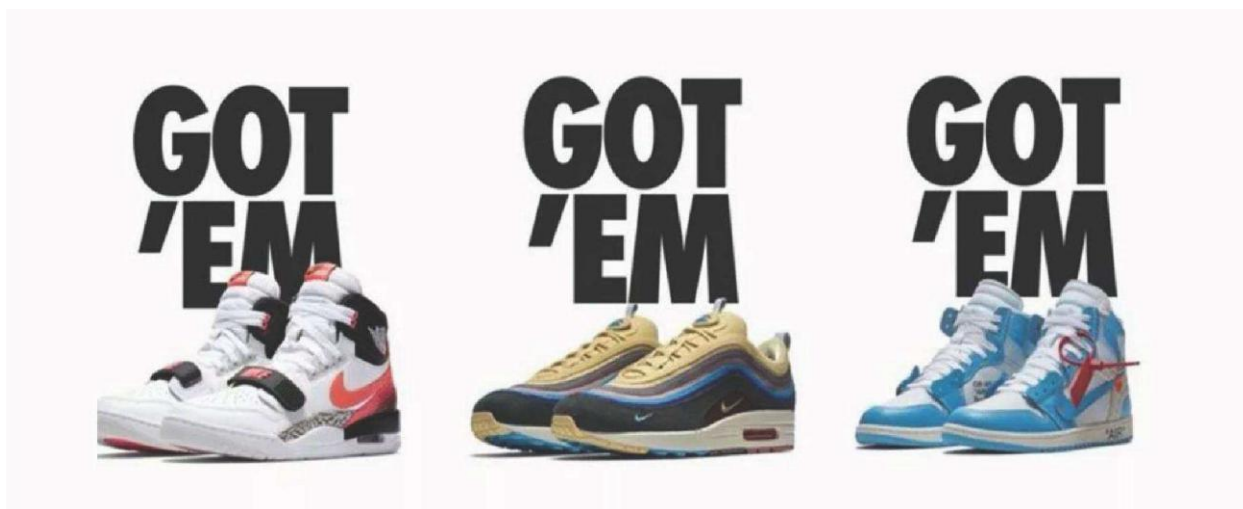
⁴⁸ 29 TTABVUE 4 (para. 11).

⁴⁹ 29 TTABVUE 5 (para. 11).



At some point, however, Opposer began displaying the phrase in a larger, bolded typeface. The record shows consistent usage of this stylized version since at least as early as March 27, 2018:⁵⁰

⁵⁰ 27 TTABVUE 47.

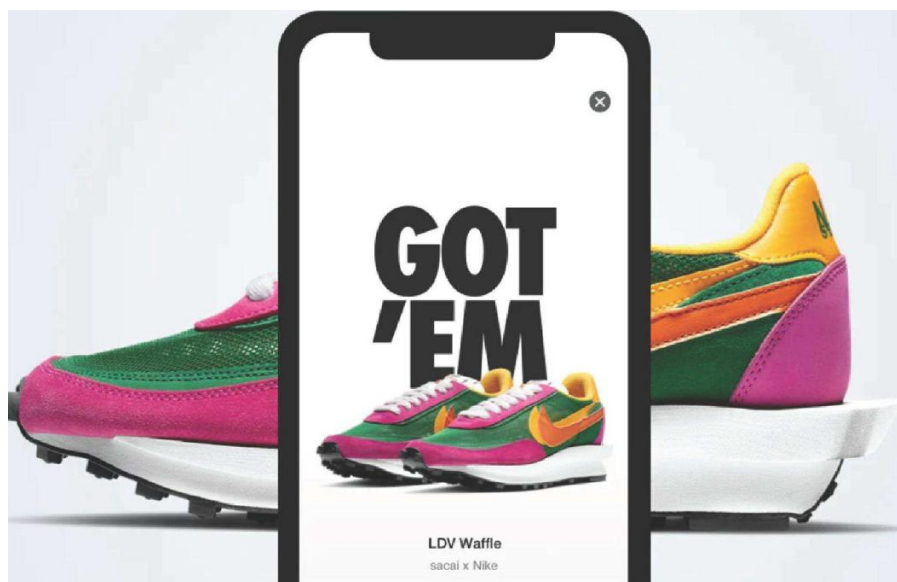


In another example (below), a user, having purchased footwear on Air Max Day in 2018, shows off confirmation of his successful purchase:⁵¹

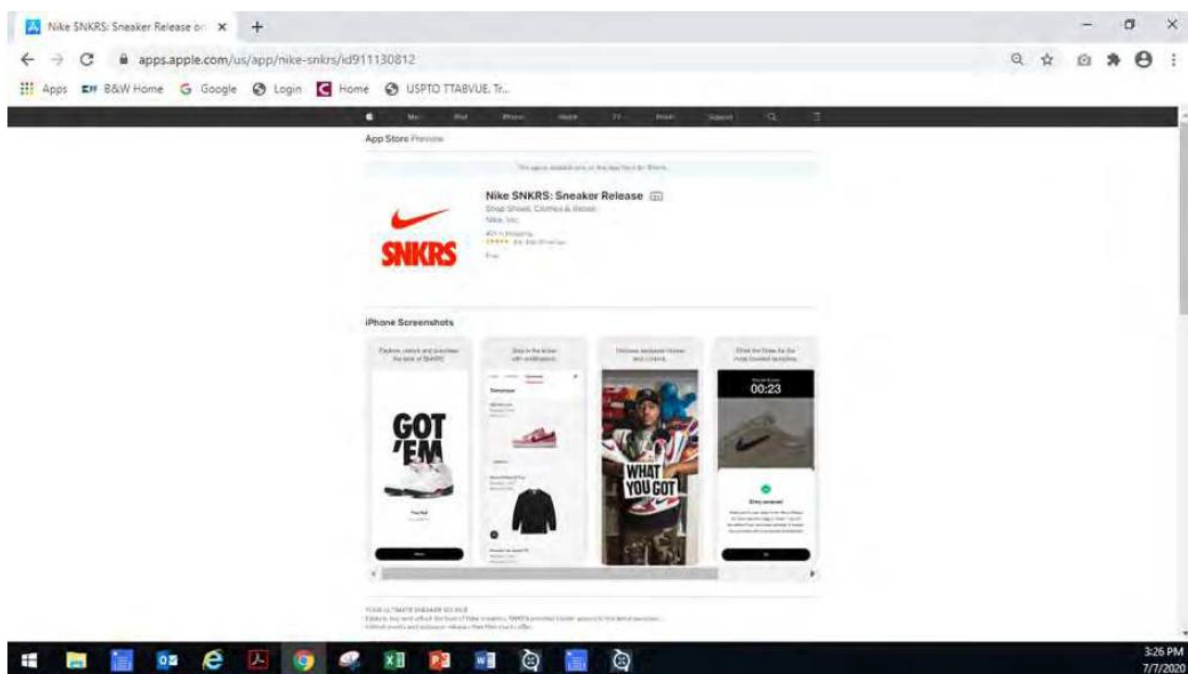


Use of this stylized version of the mark in 2020 is also of record:

⁵¹ 29 TTABVUE 7 (para. 13).



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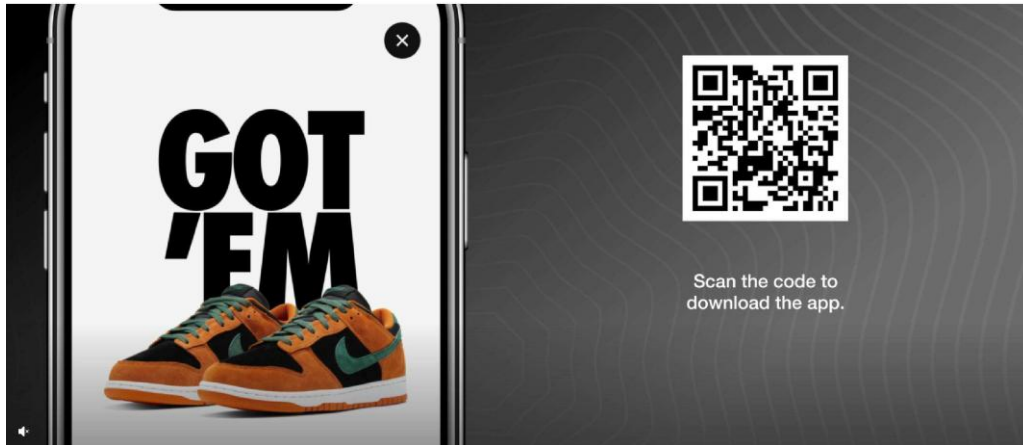


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⁵² 27 TTABVUE 3, 65.

⁵³ 30 TTABVUE 9.

Similarly, evidence of use of the stylized mark as of August 2023 is of record:⁵⁴



As part of Opposer's launch of its SNKRS Platform in 2015, Opposer also established a retail pop-up store in New York City, which coincided with the NBA All Star Weekend.⁵⁵ Another pop-up store opened in Atlanta the week of the Super Bowl in 2019.⁵⁶ The Atlanta pop-up store was, according to Mr. Lo, "a mixture of digital in app experiences and the physical in store journey."⁵⁷ Physical signage bearing the GOT 'EM mark appeared at the Atlanta store:⁵⁸

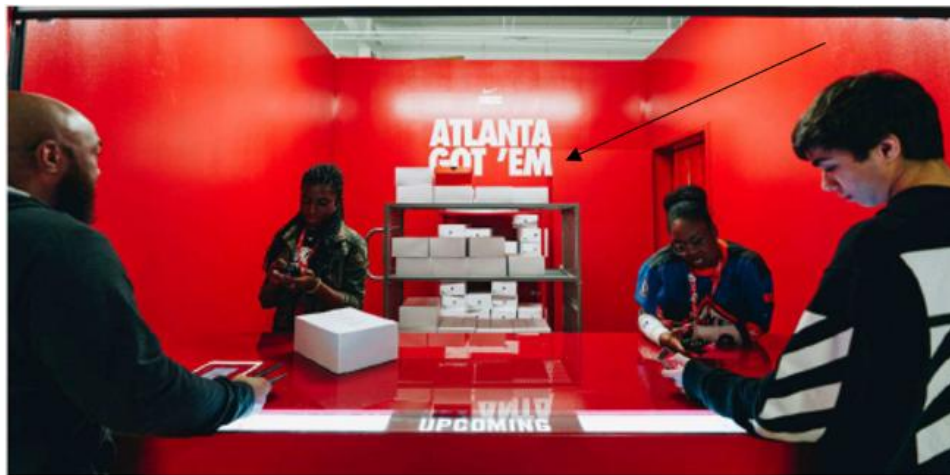
⁵⁴ 27 TTABVUE 4, 79 (Exhibit 4-10).

⁵⁵ 30 TTABVUE 15 (para. 13).

⁵⁶ 29 TTABVUE 8 (para. 16); 30 TTABVUE 15 (para. 14).

⁵⁷ 29 TTABVUE 8 (para. 16).

⁵⁸ 29 TTABVUE 8-9 (para. 16) (arrow added).



As for sales, “[t]housands of customers visited the pop-up that week [in 2019] resulting in nearly a million dollars in sales.”⁵⁹

⁵⁹ 29 TTABVUE 8 (para. 16).

At that same Atlanta pop-up store, the GOT 'EM mark appeared on various promotional items, including jewelry and cards inside mini-matchbox-style gift boxes, referred to as “mystery boxes:”



In 2020, Opposer reinforced use of the mark by impressing it on hang tags on limited edition Air Force 1 footwear.⁶²



⁶⁰ 29 TTABVUE 8, 10 (para. 16).

⁶¹ 29 TTABVUE 8, 10 (para. 16).

⁶² 29 TTABVUE 7-8 (para. 15).

For purposes of establishing priority, the testimony of Opposer's witnesses, particularly Mr. Lo, is clear, consistent, and corroborated by documentary evidence. *See, e.g., W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 1125-26 (Fed. Cir. 1994) (we must consider all probative evidence in evaluating priority); *Exec. Coach Builders*, 2017 TTAB LEXIS 201, at *36 ("Oral testimony is strengthened by corroborative documentary evidence."). Notably, although Applicant makes some arguments seeking to discredit Opposer's evidence (discussed below), Applicant did not cross-examine either Messrs. Lo or Faris. In view of the foregoing, we find that

Opposer has established use of its  mark at least in connection with its computer software application featuring footwear for sale since at least March 27, 2018,⁶³ which is prior to any date upon which Applicant may rely.

b. Distinctiveness

As mentioned earlier, Opposer must not only show use of the mark before Applicant, but also that its mark is distinctive as to the goods and services with which it is used. "A mark is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning." *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 1332 (Fed. Cir. 2003) (cleaned up; citation omitted). Turning first to inherent distinctiveness, "[m]arks are often classified, according to their increasing degree of inherent distinctiveness, as: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful. Suggestive or

⁶³ 27 TTABVUE 47.

arbitrary marks are deemed inherently distinctive and are entitled to registration as such; generic or descriptive marks are not.” *Id.* (citation omitted). A mark is suggestive rather than merely descriptive if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *See, e.g., In re Fat Boys Water Sports LLC*, No. 86490930, 2016 TTAB LEXIS 150, at *11 (TTAB 2016). That is the case

here. Accordingly, as a suggestive mark, we find Opposer’s mark  is inherently distinctive as used with its computer software application featuring footwear for sale, as it does not directly describe, but rather only suggests, a feature of Opposer’s goods. *See Major League Baseball*, 2023 TTAB LEXIS 117, at *38 (“Moreover, ALL RISE and HERE COMES THE JUDGE do not describe the apparel on which they appear, such as t-shirts, jerseys, and caps, and are thus inherently distinctive.”). Here,  does not immediately describe Opposer’s computer software application but rather suggests that a user successfully acquired a desired pair of shoes using it. *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 973 (Fed. Cir. 2018) (considering a mark inherently distinctive if it is suggestive, arbitrary, or fanciful); *MBNA Am. Bank*, 340 F.3d at 1332 (same).

The literal elements of Opposer’s mark are identical to the dominant portion of Applicant’s GOT EM KICKS mark (which we discuss in more detail herein), recognizing of course that Applicant’s mark incorporates the additional term KICKS. Opposer’s mark is at least as distinctive as Applicant’s standard character mark,

which has been published for registration on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). Indeed, Applicant “tacitly admits [that Opposer’s mark is inherently distinctive] by seeking [its] own registration[] on the Principal Register without a claim of acquired distinctiveness.” *Major League Baseball*, 2023 TTAB LEXIS 117, at *38.

We find that Opposer obtained common law rights in its  mark at least as early as March 27, 2018 with its computer software application featuring footwear for sale and that such usage has been followed by a reasonably continuous pattern of use of the mark. In this regard, we find that Opposer has established priority of its inherently distinctive GOT 'EM mark well prior to Applicant’s constructive use date of March 16, 2022.

c. Applicant’s Arguments

Applicant asserts various arguments challenging Opposer’s priority, which we address in turn.

i. Failure to Function

The bulk of Applicant’s brief focuses on the argument that Opposer’s mark is a “commonly understood message [that] does not function as a trademark because it does not identify and distinguish source.”⁶⁴

⁶⁴ 45 TTABVUE 22.

If a proposed mark is perceived as a commonplace expression and not a source indicator, it fails to function as a mark and thus is not registrable. *See, e.g., D.C. One Wholesaler, Inc. v. Chien*, No. 91199035, 2016 TTAB LEXIS 536, at *21-23 (TTAB 2016) (I ♥ DC for bags, clothing, plush toys); *In re Eagle Crest, Inc.*, No. 77114518, 2010 TTAB LEXIS 346, at *6-14 (TTAB 2010) (ONCE A MARINE, ALWAYS A MARINE for clothing); *In re Volvo Cars of N. Am., Inc.*, No. 74212578, 1998 TTAB LEXIS 20, at *15-18 (TTAB 1998) (DRIVE SAFELY for automobiles). This flows from the definition of a trademark in Section 45, 15 U.S.C. § 1127 (“The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof ... to identify and distinguish ... goods ... and to indicate the source of the goods”).

“The critical inquiry in determining whether a designation functions as a mark is how it would be perceived by the relevant public.” *Major League Baseball*, 2023 TTAB LEXIS 117, at *46. In determining how a designation would be perceived by the relevant public, the Board looks to the mark owner’s evidence of use, where available, and any other evidence of record showing how the designation is actually used in the marketplace. *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 1351 (Fed. Cir. 2022); *see also In re Lizzo LLC*, No. 88466264, 2023 TTAB LEXIS 22, at *7-8 (TTAB 2022).

Applicant argues that “GOT ’EM” is a common expression used merely to indicate a successful transaction:

The phrase “GOT ’EM” is a ubiquitous, celebratory expression long used in sports, gaming, retail, and everyday speech to signal success or victory. When consumers encounter “GOT ’EM” after completing a transaction, they perceive it as a congratulatory confirmation of success—the equivalent of “Order

Confirmed” or “You’re In”—not as a designation of source. Trademark law does not permit the monopolization of such common, culturally embedded expressions. Because Opposer’s use conveys a routine celebratory message rather than identifying the source of retail services, it fails to function as a trademark and cannot establish protectable rights.⁶⁵

This argument fails for several reasons. First, we sustained Opposer’s objection to Applicant’s evidence of third-party use of GOT ’EM formative marks and, as a consequence, the record does not support Applicant’s argument that use of the phrase is “ubiquitous.”⁶⁶ More importantly, and contrary to Applicant’s arguments, other evidence of record shows that consumers do indeed perceive the GOT ’EM phrase as identifying Opposer as the source of the online shopping platform services and computer software application. For example, the use of the term GOT ’EM in these third-party articles clearly references Opposer and/or its SNKRS Platform:

- An article titled, “A Tutorial on how to Enter Nike SNKRS Reservation or Draw Launches,” published on snobettte.com:⁶⁷ “If you’re lucky, you will receive the **famed ‘GOT ’EM’** message in ‘Notifications’ shortly after you make your payment.”⁶⁸
- An article titled, “Tips to Help You Cop On Nike’s SNKRS App,” published on sneakerfreaker.com,⁶⁹ prominently features a cell phone displaying the **GOT ’EM mark** in connection with a successful purchase of a pair of shoes⁷⁰ and states, “experience does count for a lot, so we’ve compiled some tips to help ensure your next **‘GOT ’EM’** is just around the corner.”⁷¹

⁶⁵ 45 TTABVUE 23.

⁶⁶ 45 TTABVUE 23.

⁶⁷ 30 TTABVUE 85-96 (Exhibit 7 to Decl. of Faris).

⁶⁸ 30 TTABVUE 90 (Exhibit 7 to Decl. of Faris) (emphasis added).

⁶⁹ 30 TTABVUE 98-102 (Exhibit 8 to Decl. of Faris).

⁷⁰ 30 TTABVUE 99 (Exhibit 8 to Decl. of Faris) (emphasis added).

⁷¹ 30 TTABVUE 100 (emphasis added).

- An article titled, “Nike Commemorates the SNKRS ‘GOT ’EM’ with the Air Force 1 Low,” published on December 3, 2020, on SneakerNews.com, states: “Since 2015, the Nike SNKRS app has been making [and] ruining entire days with a word-and-a-half: ‘GOT ’EM.’”⁷²
- In an article published on sixfiguresneakerhead.com, an article titled “How to Win Sneakers Straight from SNKRS and Nike.com”⁷³ shows three pair of shoes, each with the **GOT ’EM** mark prominently on the first page of the article (shown below):



Considering the totality of the evidence of record, the record does not demonstrate that Opposer’s mark is used in general parlance or that it conveys a common social, political, patriotic, religious or other informational message, such as was found to be the case in the phrases I ♥ DC, ONCE A MARINE, ALWAYS A MARINE and DRIVE

⁷² 27 TTABVUE 82-92 (Exhibit 4-11).

⁷³ 30 TTABVUE 73-76.

⁷⁴ 30 TTABVUE 76.

SAFELY. Instead, we find that it shows that consumers perceive **GOT 'EM** used with a computer software application as associated with Opposer rather than as a commonplace expression. Here, the bulk of the third-party publicity of the phrase that Opposer submitted is contemporaneous with or subsequent to the launch of Opposer's SNKRS Platform and, importantly, it associates Opposer with the mark's use. On this limited record we are simply not persuaded by Applicant's arguments and cannot find, as Applicant argues, "widespread use and public exposure"⁷⁵ of the phrase.

Applicant requests that we take judicial notice of the dictionary definition attached to its brief as evidence that the term GOT 'EM is "widely understood by consumers as a celebratory expression meaning 'successfully obtained.'"⁷⁶ However, even considering this dictionary definition, it does not support Applicant's contention. The attached definition defines "got em" as: "Often used in conjunction with memes, **got em** is a phrase said in triumph **after successfully tricking someone, pulling off a prank, or making a joke at someone else's expense.**"⁷⁷ Here, Opposer mischaracterizes the definition and, when considered in its entirety, it simply does not support Applicant's argument.

⁷⁵ 45 TTABVUE 33.

⁷⁶ 45 TTABVUE 6 & n.1, 43 (definition).

⁷⁷ 45 TTABVUE 43 (emphasis in italics in original, bold here and bold added).

Applicant also argues that Opposer's use is ornamental and for that reason fails to function as a mark.⁷⁸ It is true that prominent ornamental use of a proposed mark "is probative in determining whether a term or phrase would be perceived in the marketplace as a trademark or as a widely used message." *In re Lizzo LLC*, 2023 TTAB LEXIS 22, at *19-20 (quoting *In re Mayweather Promotions, LLC*, No. 86753084, 2020 TTAB LEXIS 467, at *11 (TTAB 2020)). To support its argument, Applicant points to evidence of use of the mark with Opposer's match-box style mystery boxes with cards displaying the GOT 'EM mark that indicate which free promotional item the consumer would receive.⁷⁹ Here, however, the promotional uses relied upon by Applicant reference Opposer itself and its SNKRS Platform. Thus, this type of evidence, which under other circumstances, may establish that the phrase fails to function as a mark, in this instance is not probative of such. *See In re Lizzo LLC*, 2023 TTAB LEXIS 22, at *26-27 ("We acknowledge that to some degree consumers ... have been exposed to use of the proposed mark 100% THAT BITCH in a non-source-identifying (i.e., ornamental) manner on the same and similar goods to those of Applicant. We find, however, that that circumstance is outweighed by references in most of those uses to Lizzo and/or her music.").

To the extent Applicant argues that Opposer fails to establish priority because Opposer's mark appeared on promotional items that were given away, not sold, to

⁷⁸ 45 TTABVUE 21, 24, 27.

⁷⁹ 45 TTABVUE 24-25.

consumers,⁸⁰ this argument is also unavailing. As an initial matter, it ignores the fact that Opposer did in fact sell millions of items of footwear through its platform, where each successful sale caused the GOT 'EM mark to be displayed to the buyer.⁸¹ Regardless, “[t]he [Trademark Act] does not require that goods or services be sold for purposes of establishing priority.” *DeVivo v. Ortiz*, No. 91242863, 2020 TTAB LEXIS 15, at *33 (TTAB 2020); *see also Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, No. 91183362, 2010 TTAB LEXIS 1294, at *11 n.3 (TTAB 2010) (“[U]se of marks in conjunction with the rendering of free services still constitutes a ‘use in commerce’ under the Trademark Act.”); *Cap. Speakers Inc. v. Cap. Speakers Club of Washington D.C. Inc.*, 92019861, 1996 TTAB LEXIS 23, at *16 n.3 (TTAB 1996) (“A for-profit sale is not required.”).

ii. Opposer’s Purported One-Off Pop-Up Events

Applicant argues that Opposer’s pop-up events (in 2015 and 2019) are “temporary” and “geographically limited” and, for these reasons, insufficient to establish priority.⁸² Having found that Opposer established use of its mark with its computer software application featuring footwear for sale, we need not consider whether Opposer also established priority with regard to its two pop-up stores. We focus on Opposer’s computer software application featuring footwear for sale because there is

⁸⁰ 45 TTABVUE 21-27.

⁸¹ 29 TTABVUE 4 (para. 11).

⁸² 45 TTABVUE 7, 21-25.

no doubt that Opposer's use of its mark with it has been consistent, not sporadic, limited or geographically limited.

For this same reason, Applicant's reliance on *Jones v. Nike Inc.*, case no. 22-cv-00103 (S.D. Tex. Filed Mar. 31, 2022), is misplaced. Applicant contends that in *Jones*, the court found that sales of "55-65 units ... from a pop-up [store] did not constitute 'use as a trademark' and failed to even establish enforceable common-law rights."⁸³ In *Jones*, the plaintiff sold approximately 55-65 shirts from a single Wisconsin gym, with no interstate activity, and the *Jones* court held that such "sporadic and insubstantial transactions" were insufficient to establish trademark rights. In contrast, and as discussed above, Opposer's usage in connection with its computer software application featuring footwear for sale is far from "sporadic and insubstantial."

iii. Opposer's Purported Delay in Filing its Pending Application

Still, Applicant continues, Opposer's delay in seeking registration of its mark suggests Opposer itself did not consider the phrase to function as a mark.⁸⁴ Instead of filing the GOT 'EM application contemporaneously with its SNKRS and its SNKRS and Design applications, both of which Opposer filed in 2020,⁸⁵ Opposer waited until August 10, 2023 to file its application to register the GOT 'EM mark.⁸⁶ Applicant

⁸³ 45 TTABVUE 27-28 (Applicant's brief); 37 TTABVUE 56-69 (*Jones* court Memorandum and Recommendation).

⁸⁴ 45 TTABVUE 18-19.

⁸⁵ 37 TTABVUE 74, 75.

⁸⁶ 23 TTABVUE 9.

draws attention to the fact that Opposer's filing date is one week after Opposer sent Applicant a demand letter on August 3, 2023.⁸⁷ Had Opposer considered the GOT 'EM mark to indicate source, Applicant continues, Opposer would have filed the application at or near the same time Opposer filed its applications to register the SNKRS marks.⁸⁸

This is not persuasive, as there is no requirement that a mark owner apply to register its marks at all, much less that it seek to register all marks used with a particular good or service at the same time, or contemporaneously with the launch of the good or service. *Major League Baseball*, 2023 TTAB LEXIS 117, at *45 ("Registration of a mark is not mandatory.") (quoting *Iancu v. Brunetti*, 588 U.S. 388, 391 (2019)).

B. Likelihood of Confusion

Having established Opposer's priority, the remaining element of the claim is likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) ("*DuPont*") (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 1379-80 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1355 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 1206

⁸⁷ 37 TTABVUE 25 (Exhibit 4 to Decl. Lo).

⁸⁸ 45 TTABVUE 18-19, 26.

(Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Section 2(d) of the Trademark Act, which are to prevent confusion as to source and to protect trademark owners from damage caused by the registration of similar marks for related goods or services that are likely to cause confusion. *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 146 (2023); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). Opposer makes arguments addressing the first, second, third, fourth, fifth and sixth *DuPont* factors, while Applicant addresses only the first, seventh and eighth factors.

1. Similarity or Dissimilarity of Parties’ Goods and Services, Channels of Trade and Classes of Consumers

Under the second and third *DuPont* factors, we base our determination on the goods and services as they are identified in Applicant’s application and any goods or services for which Opposer has established prior common law rights through use of

its  mark. *See Major League Baseball*, 2023 TTAB LEXIS 117, at *63. The issue is not whether purchasers would confuse the parties’ goods and services, but rather

whether there is a likelihood of confusion as to the source of these goods and services. *In re Ox Paperboard, LLC*, No. 87847482, 2020 TTAB LEXIS 266, at *16 (TTAB 2020); *L'Oreal S.A. v. Marcon*, No. 91184456, 2012 TTAB LEXIS 77, at *20 (TTAB 2012).

Recall that Applicant seeks to register its mark for “retail consignment stores featuring retro sneakers and clothing.” As for Opposer, we have determined that Opposer has established priority as to its common law mark with its computer software application featuring footwear for sale.⁸⁹ Because Applicant’s retail store services and Opposer’s computer software application are used for the same purpose, i.e., purchasing footwear, including NIKE-branded footwear,⁹⁰ we find that the parties’ goods and services are closely related. Opposer’s computer software application featuring footwear for sale is merely an extension of retail store services featuring footwear for sale.

Applicant, for its part, does not dispute that the parties’ goods and services are related, nor does it even address the second *DuPont* factor at all in its brief. Notably, Applicant does not argue that the limitation in its identification, i.e., “consignment stores featuring retro sneakers,” somehow differentiates its services from the goods and services of Opposer. Inasmuch as “consignment” is defined as “the act or process

⁸⁹ See discussion *supra* Section IV(A)(2).

We note that in describing the nature of the goods on which the common-law mark is used, we are not bound by Opposer’s identification set out in its pending application, which Opposer relies on at least in part in its brief.

⁹⁰ Applicant acknowledges that it sells a variety of brand-named products, including Nike products. 24 TTABVUE 14, 16-17 (Resps. to Interrog. Nos. 12, 13, 22, 24).

of consigning,”⁹¹ and “on consignment” refers to goods shipped to a seller who only pays for what is sold (returning unsold goods),⁹² where such goods, such as shoes, can be both new and used, this limitation would not help Applicant prevail even if it were to have argued it. Similarly, Applicant’s “retro sneakers” is of no help because new shoes may be inspired from “retro” designs. In any event, Opposer itself has offered retro sneakers on its platform, including the “Air Jordan XI Retro Three-Quarter.”⁹³

And Applicant’s founder, Mr. Webb, even testified that he sometimes buys “products directly from Nike” to sell in his store.⁹⁴ He purchases them in various ways, including through the Mercer Street Store and Nike ID, both of which allow consumers to customize Nike products, which he has done for goods that Applicant re-sells in its store.⁹⁵ Because the outlets offer cheaper prices, Mr. Webb also buys some Nike shoes through the Nike outlet.⁹⁶ Mr. Webb has even purchased Nike shoes through a Nike app:

14 Q Similar question. Would you buy authentic

15 products from any Nike app?

16 A If Nike directs me there, then yeah. Wherever

⁹¹ MERRIAM-WEBSTER DICTIONARY, accessed on July 28, 2026. <https://www.merriam-webster.com/dictionary/consignment>.

⁹² MERRIAM-WEBSTER DICTIONARY, accessed on July 28, 2026. <https://www.merriam-webster.com/dictionary/on%20consignment?src=search-dict-hed>.

⁹³ 26 TTABVUE 157.

⁹⁴ 26 TTABVUE 25 (Webb Depo. 29:11-13).

⁹⁵ 26 TTABVUE 25 (Webb Depo. 29:14-30:5).

⁹⁶ 26 TTABVUE 25 (Webb Depo. 30:6-13).

17 it directs me to pay, that's where I pay.⁹⁷

Mr. Webb's own testimony shows that consumers are accustomed to purchasing shoes via a computer software application and also in retail stores. Opposer's witness, Mr. Lo, also testified that Opposer itself offers its Nike products via computer software application and also via both traditional retail stores and also pop-up stores.⁹⁸ Because Opposer's computer software application featuring footwear is marketed to the general population,⁹⁹ even considering that Applicant's consignment store services are targeted to members of the general population seeking "retro sneakers and clothing," the parties' consumers overlap to the extent they both include consumers seeking "retro sneakers."

As with the second factor, here Applicant does not argue that the parties' channels of trade or classes of consumers are dissimilar, nor does it even address the third *DuPont* factor in its brief.

The second and third *DuPont* factors weigh in favor of a likelihood of confusion.

2. Strength or Weakness of Opposer's Mark

Because it affects the scope of protection to which it is entitled, we commence by addressing the strength or weakness of Opposer's mark. "Two of the *DuPont* factors (the fifth and sixth) consider [the] strength" of a plaintiff's mark. *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023). The fifth *DuPont* factor enables Opposer to prove that its pleaded mark is entitled to an expanded scope of protection by

⁹⁷ 26 TTABVUE 25 (Webb Depo. 30:14-17).

⁹⁸ 29 TTABVUE 3 (para. 8).

⁹⁹ 29 TTABVUE 12-13 (para. 18).

adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 476 F.2d at 1361. The sixth *DuPont* factor, in contrast, allows Applicant to contract that scope of protection by adducing evidence of “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 476 F.2d at 1361; *see also Spireon*, 71 F.4th at 1362 (sixth *DuPont* factor “is a measure of the extent to which other marks weaken the assessed mark”) (citing *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371 (Fed Cir. 2005)). This *DuPont* factor allows a defendant to contract the scope of protection of a plaintiff’s mark by adducing evidence of conceptual and commercial weakness. *Spireon*, 71 F.4th at 1362-63.

a. Conceptual Strength

“Conceptual strength is a measure of a mark’s distinctiveness, ... and distinctiveness is ‘often classified in categories of generally increasing distinctiveness[:] ... (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.’” *Spireon*, 71 F.4th at 1362. We previously determined that Opposer’s mark is suggestive, meaning that it is inherently distinctive.

b. Asserted Strength or Fame of Opposer’s Mark

“Fame/commercial strength is the extent to which a significant portion of the relevant public recognizes a mark as denoting a single source.” *Heil*, 2024 TTAB LEXIS 494, at *49. Here, the relevant consumers are purchasers of footwear and clothing.

Commercial strength or fame is not a binary “all-or-nothing” factor. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017).

Rather, likelihood of confusion fame/commercial strength “varies along a spectrum from very strong to very weak.” *Palm Bay Imps.*, 396 F.3d at 1375 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003)).

We may measure commercial strength (or fame) indirectly, by volume of sales and advertising expenditures and factors such as length of use of the mark, widespread critical assessments, notice by independent sources of the goods or services identified by the mark, and general reputation of the goods or services. *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, No. 91199352, 2014 TTAB LEXIS 2, at *18-19 (TTAB 2014); *see also Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength). “Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it.” *Made in Nature, LLC v. Pharmavite LLC*, No. 91223352, 2022 TTAB LEXIS 228, at *3 (TTAB 2022).

Opposer argues that “the GOT ’EM Mark has achieved a significant degree of public recognition and renown”¹⁰⁰ for several reasons: its longtime use (over ten years, i.e., since 2015); its high volume of sales of products via the SNKRS Platform, all of which have featured the GOT ’EM mark being presented to the consumer when he/she completes a successful purchase; its widespread and longtime promotion of the

¹⁰⁰ 41 TTABVUE 45.

mark through social media and the SNKRS Platform; consumers' widespread promotion of the mark via social media; and unsolicited media attention.¹⁰¹

As to longtime use, Mr. Lo, Opposer's Senior Director, Launch & SNKRS Platform North America, testified that Opposer has used its GOT 'EM mark since 2015 in connection with its SNKRS Platform,¹⁰² and we previously determined that Opposer

has used its  mark, the mark upon which we base our decision, since at least as early as March 27, 2018. Although Opposer's witness testified that Opposer has sold "millions of pair of footwear and items of clothing" through its SNKRS Platform since its launch,¹⁰³ this number is not broken down in any way, so we do not know how many sales were made via its computer application software as opposed to, for example, other means for selling footwear that are encompassed by Opposer's defined term "SNKRS Platform," which is defined to include, for example, retail stores and pop-up stores,¹⁰⁴ nor do we know how many sales were made where the stylized mark



as opposed to the less stylized typed version of the mark used originally.

Moreover, while we agree that "millions" of sales can be objectively large, this testimony is vague in that we have no idea how many "millions" of pairs of shoes or items of clothing have been sold. Further, we have no context in which to place this raw sales data, so its significance is difficult to assess. *See Omaha Steaks Int'l, Inc.*

¹⁰¹ 41 TTABVUE 45.

¹⁰² 29 TTABVUE 3 (para. 7).

¹⁰³ 29 TTABVUE 5 (para. 12).

¹⁰⁴ 29 TTABVUE 3 (para. 8).

v. Greater Omaha Packing Co., 908 F.3d 1315, 1320 (Fed. Cir. 2018); *see also Fossil Inc. v. Fossil Grp.*, No. 91098191, 1998 TTAB LEXIS 388, at *20 (TTAB 1998) (“Raw sales and advertising figures -- unless they are extraordinarily large, which is not the case with opposer’s FOSSIL products -- are simply not sufficient by themselves to establish that the mark is famous.”).

According to Lo, “[u]sers of the SNKRS Platform often share their GOT ’EM screens through social media[,]”¹⁰⁵ and, since 2015, “many thousands of users have shared GOT ’EM screens through social media posts.”¹⁰⁶ As a result, he concluded, the “GOT ’EM trademark has become a cultural symbol associated with Nike through this process.”¹⁰⁷ Because we focus herein on the  mark, again, we cannot tell from Mr. Lo’s testimony how many consumers have seen the stylized mark, as opposed to the original version of the mark.

Mr. Lo testified that since 2015, in the United States alone, “there have been more than 9,000,000 active users of the SNKRS Platform and more than 700,000,000 visits to the platform.”¹⁰⁸ While this evidence shows that a very high number of consumers have visited the SNKRS Platform, without more information, we cannot discern how

¹⁰⁵ 29 TTABVUE 7 (para. 14).

¹⁰⁶ 29 TTABVUE 7 (para. 14). Applicant’s brief (41 TTABVUE 28) states that examples of consumers sharing their purchase displaying the mark are of record in Exhibits 14-34 attached to its Fourth Notice of Reliance, but, as explained earlier, these exhibits are not of record.

¹⁰⁷ 29 TTABVUE 7 (para. 14).

¹⁰⁸ 30 TTABVUE 8 (para. 7).

many consumers were successful in purchasing footwear, who are the only consumers who would have seen the stylized version of the mark via the platform.

As we previously discussed, there is evidence that consumers associate the GOT 'EM mark with Opposer, and, for purposes of the fifth *DuPont* factor, this also constitutes evidence of unsolicited media attention. Recall that the record contains the following:

- An article titled “A Tutorial on how to Enter Nike SNKRS Reservation or Draw Launches,” published on snobettte.com:¹⁰⁹ “If you’re lucky, you will receive the **famed “GOT 'EM”** message in “Notifications” shortly after you make your payment.”¹¹⁰
- An article titled “Tips to Help You Cop On Nike’s SNKRS App,” published on sneakerfreaker.com,¹¹¹ prominently features a cell phone displaying the **GOT 'EM mark** in connection with a successful purchase of a pair of shoes¹¹² and states, “[E]xperience does count for a lot, so we’ve compiled some tips to help ensure your next ‘GOT 'EM’ is just around the corner.”¹¹³
- An article published on Sneaker News is titled, “Nike Commemorates The SNKRS ‘GOT 'EM’ With The Air Force 1 Low.”¹¹⁴
- On sixfiguresneakerhead.com, an article titled “How to Win Sneakers Straight from SNKRS and Nike.com” shows three pair of shoes, each with the **GOT 'EM** mark prominently on the first page of the article (shown below):¹¹⁵

¹⁰⁹ 30 TTABVUE 85-96.

¹¹⁰ 30 TTABVUE 90 (emphasis added).

¹¹¹ 30 TTABVUE 98-102.

¹¹² 30 TTABVUE 99 (emphasis added).

¹¹³ 30 TTABVUE 100 (emphasis added)

¹¹⁴ 27 TTABVUE 82 (emphasis added).

¹¹⁵ 30 TTABVUE 73.



Opposer did not make of record any circulation information about any of these media sites, such as snobette.com and sneakerfreaker.com, so we do not know how many consumers visit these websites or how many may have seen these articles. While this evidence is probative to the extent that it shows unsolicited media attention, its probative value is lessened due to the lack of information around website traffic.

Applicant, for its part, did not challenge Opposer's evidence of commercial success or even address it in its brief, nor did Applicant cross-examine Mr. Lo.

The record is clear that the SNKRS Platform is popular. However, with regard to the fifth *DuPont* factor, it is difficult to discern how many sales of footwear products were made via Opposer's computer software application and how many of the consumers who visited the SNKRS Platform successfully purchased footwear and, as a consequence, were exposed to Opposer's stylized mark. Even considering the unsolicited media evidence, we cannot find, on this record, that Opposer's mark is entitled to be placed on the very high end of the fame/commercial strength spectrum; rather, we find that Opposer's mark is entitled to the normal scope of protection.

As a result, the fifth *DuPont* factor is neutral.

c. Asserted Weakness of Opposer's Mark

Applicant argues that Opposer's mark is commercially weak under the sixth *DuPont* factor.¹¹⁶ "The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015).

This argument is premised on the third-party evidence to which Opposer objected. Because we sustained Opposer's objection,¹¹⁷ Applicant's arguments are unsupported by record evidence. Accordingly, Applicant has been unsuccessful in diminishing the commercial strength of the GOT 'EM mark.

d. Conclusion as to Strength or Weakness of Opposer's Mark

Considering the fifth and sixth *DuPont* factors, because Opposer was not successful in enhancing the scope of protection to which its mark is entitled, and because Applicant was not successful in diminishing the strength of Opposer's mark, we find that Opposer's mark is entitled to "the normal scope of protection to which inherently distinctive marks are entitled." *See Bell's Brewery, Inc. v. Innovation Brewing*, No. 91215896, 2017 TTAB LEXIS 452, at *20 (TTAB 2017) (stating that likelihood of confusion fame varies along a spectrum from very strong to very weak).

¹¹⁶ 45 TTABVUE 34.

¹¹⁷ *See* discussion *supra* Section I.

3. Similarity or Dissimilarity of the Marks

We now turn to the first *DuPont* factor, which assesses the similarity or dissimilarity of the marks. *DuPont*, 476 F.2d at 1361. We consider “the marks in their entirety as to appearance, sound, connotation and commercial impression.” *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (quoting *DuPont*, 476 F.2d at 1361). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Inn at St. John’s, LLC*, No. 87075988, 2018 TTAB LEXIS 170, at *13 (TTAB 2018) (quoting *In re Davia*, No. 85497617, 2014 TTAB LEXIS 214, at *4 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

The proper test “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012)). “[S]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (quoting *Coors Brewing*, 343 F.3d at 1344).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, the analysis cannot be predicated on dissecting the marks into their various components. Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (“[T]here is nothing improper in stating that, for rational reasons, more or less weight has been

given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.”); *see also Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1322 (Fed. Cir. 2014). The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *In re i.am.symbolic, llc*, No. 85916778, 2018 TTAB LEXIS 281, at *11 (TTAB 2018).

Recall that Applicant seeks registration of its mark GOT EM KICKS in standard character format, while Opposer has established common law rights in its  mark.

The dominant portion of Applicant’s mark is GOT EM, as these terms appear first and are the most distinctive. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1303 (Fed. Cir. 2018) (“The identity of the marks’ two initial words is particularly significant because consumers typically notice those words first.”); *Presto Prods.*, 1988 TTAB LEXIS 60, at *8 (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered[.]”). As noted above, Applicant has disclaimed KICKS, reinforcing the determination that the phrase GOT EM is the dominant portion of the mark. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407 (Fed. Cir. 1997) (affirming TTAB’s finding that “DELTA,” not the disclaimed generic term “CAFE,” is the dominant portion of the mark THE DELTA CAFE); *Detroit Athletic*, 903 F.3d at 1305 (rational to give non-source identifying words “Co.” and “Club” less weight in the likelihood of confusion analysis).

When comparing the marks in their entirety, the parties’ marks share the terms GOT EM, in the same order, causing them to sound and look similar to the extent

they share these terms. As for connotation and commercial impression, the dominant portion of Applicant's mark, i.e., GOT EM, which constitutes the entirety of Opposer's mark, has the same connotation and engenders the same commercial impression. Specifically, when considered in light of their respective goods and services for purchasing footwear, both parties' marks connote and engender the commercial impression of successfully having purchased a pair of shoes.

Applicant argues that the marks are dissimilar due to Applicant's inclusion of the term KICKS and Opposer's use of an apostrophe.¹¹⁸ We disagree that these differences are enough to distinguish the marks. While the apostrophe does cause the dominant portion of Applicant's mark to look slightly different from Opposer's mark, it does not cause the marks to be pronounced differently or to have a different connotation or to engender a different commercial impression. *See, e.g., Lipton Indus.*, 670 F.2d at 1025 n.3 ("The sole difference between the respective marks of the parties is that appellant's registration shows FANCY FIXIN'S with an apostrophe. No apostrophe is in appellee's mark. This difference is de minimis, and we will refer to the marks and goods of the parties as identical."). Similarly, Applicant's use of KICKS is insufficient to distinguish the marks, particularly where, as here, both parties sell footwear under their marks and the record shows that KICKS is slang for "shoes or sneakers."¹¹⁹

The first *DuPont* factor weighs heavily in favor of a likelihood of confusion.

¹¹⁸ 45 TTABVUE 38-39.

¹¹⁹ December 28, 2022 Office Action at TSDR 6 (MERRIAM-WEBSTER DICTIONARY).

4. Lack of Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of actual confusion, if any, in light of the length of time and conditions under which there has been concurrent use of the subject marks. *Monster Energy Co. v. Lo*, No. 91225050, 2023 TTAB LEXIS 14, at *52 (TTAB 2023) (citing *DuPont*, 476 F.2d at 1361). “A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however.” *In re Majestic Distilling*, 315 F.3d at 1317. “The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its mark[].” *Citigroup Inc. v. Cap. City Bank Group, Inc.*, No. 91177415, 2010 TTAB LEXIS 40, at *50 (TTAB 2010), *aff’d*, 637 F.3d 1344 (Fed. Cir. 2011).

Here, Applicant argues that there have been no incidents of actual confusion,¹²⁰ a point that Opposer does not dispute.¹²¹ While the opposed application was filed based on intent to use and no amendment to allege use has been filed, the record shows that Applicant has been using its mark since April 1, 2022, when its consignment store was opened to the public.¹²² Although Applicant’s sales are filed under seal,¹²³ its sales numbers are relatively low for purposes of this analysis.

¹²⁰ 45 TTABVUE 40.

¹²¹ 47 TTABVUE.

¹²² 26 TTABVUE 47-48 (Deposition of Webb).

¹²³ 25 TTABVUE 11 (Response to Inter. No. 23).

Here, Applicant's co-existence as of the time of trial of about three years without evidence of actual confusion when the extent of its use is limited to services offered at a single location that has itself had low sales does not render confusion unlikely. *See Monster Energy*, 2023 TTAB LEXIS 14, at *53-54; *Barbara's Bakery*, 2007 TTAB LEXIS 9, at *14 (where the respective marks coexisted in the marketplace for at least nine years, absence of actual confusion nonetheless deemed "of little probative value" because of the absence of a significant opportunity for such confusion to occur, given "the minimal scope of applicant's actual use of her mark in the marketplace").

We find the seventh and eighth *DuPont* factors neutral.

5. Weighing of the *DuPont* Factors

The final step in analyzing likelihood of confusion is to weigh the *DuPont* factors for which there has been evidence and argument and explain the results of that weighing. *In re Charger Ventures LLC*, 64 F.4th 1375, 1384 (Fed. Cir. 2023).

Opposer's computer application software featuring footwear for sale and Applicant's retail consignment store services featuring retro sneakers are closely related and the channels of trade and classes of consumers overlap. Thus, the second and third *DuPont* factors weigh in favor of a likelihood of confusion. Considering the fifth and sixth factors, Opposer's mark is entitled to the normal scope of protection to which inherently distinctive marks are entitled. The marks are similar, so the first *DuPont* factor weighs in favor of a likelihood of confusion. The seventh and eighth *DuPont* factors (the nature and extent of actual confusion and conditions under which there has been concurrent use without evidence of actual confusion, respectively) are

neutral. Inasmuch as all factors weigh in favor of a likelihood of confusion or are neutral, and none weigh against it, confusion is likely.

Decision

The opposition to registration of the mark is sustained on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act.