

Just Succ It: Nike Pressures Small Biz on Name Change

By *Chuck Dobrosielski*

In the process, Andrea Galbreath, Just Succ It's owner, has racked up millions of views on [TikTok](#), including, she said, from small business owners who are afraid they might someday find themselves in a similar position.

"I don't know what the outcome is going to be, I really don't," Galbreath told Sourcing Journal. "But I do know that I can handle this either way and that if there's a way that what I'm going through can help other small business owners learn and make decisions that could potentially avoid something like this, then I'm obviously going to keep sharing."

Galbreath originally applied to [trademark](#) her business' name in April last year. Roughly nine months later, on Jan. 4, the United States Patent and Trademark Office (USPTO) published the mark, kicking off a 30-day period where any person or entity is able to indicate their opposition or request further time to potentially file an opposition.

Nike, which is also currently wrapped up in a [separate trademark dispute](#) over StockX's [recent NFT release](#), filed an initial 30-day request to extend its time to oppose on Jan. 18. The USPTO granted the request that same day—opposers can request an initial 30-day extension without a showing of cause—moving the opposition deadline to March 5. For Galbreath, who "never thought" the Just Succ It name was anywhere close to Nike's "Just Do It" slogan, the sneaker company's filing was "very shocking."

"As a small business owner, getting a letter from a large corporation like that can be intimidating," she said. "I know that this is what they do... because they have, obviously, a lot of resources that a small business owner doesn't have. And then knowing that this brand that I've built and I love and brings a lot of people joy might have to change because of this is a little frustrating."

On Jan. 21, she went on TikTok and asked her followers to "tell Nike to leave me alone." In the weeks since, she has posted well over a dozen videos related to the footwear giant, including one that has been viewed more than 2 million times. Three posts have received more than 100,000 views.

"I think one of the reasons—or the primary reason—that this has resonated so much with a lot of people is that a lot of small businesses are worried about something like this happening to them," Galbreath said.

Though Nike has yet to formally oppose the "Just Succ It" trademark, the company did send the succulent seller a [cease-and-desist](#) letter on Jan. 25, just four days after her initial video. According to NBC News, which reviewed the letter, Nike said it was willing to work with Galbreath to determine a "reasonable time" to transition Just Succ It to another name. The company requested a response by Feb. 4.

Galbreath let the deadline pass and has yet to speak with Nike. “This is kind of a big deal for my business and there are a lot of other things to weigh,” she said. For now, she’s talking with business strategists and attorneys and trying to determine what it would mean if she pursued the matter or let it go.

“I’m just trying to make an informed decision for myself, my business—I’m a single mom, this is my thing,” Galbreath said. “They said they weren’t trying to stop me from doing my business, they just don’t want me to use my name. My business literally is my name.... I’d literally have to spend money on basically redoing my business... paying for the branding and the marketing material. I have stickers and tape and my website and all of that is costly and that affects a small business.”

Faith Mitton, a managing attorney at Mitton Law Firm who specializes in trademarks and copyrights, noted that Just Succ It could face some trouble given that it included “clothings” under its proposed goods and services. “It is entirely plausible that a likelihood of confusion exists despite the fact that consumers are likely to purchase apparel from these two companies for entirely different reasons,” Mitton said.

Just Succ It does not currently sell any apparel on its site. Galbreath said her succulent brand has only sold one T-shirt and face masks.

“It’s for marketing purposes, the same way that if you go to a restaurant, they’re a restaurant and they sell a shirt with their company name,” Galbreath said. “It’s just marketing. I’m not a clothing line.”

Brian B. Darville, chair of the Trademark and Copyright Practice Group at the intellectual property law firm Oblon, said Nike “clearly has a case” for trademark dilution, particularly given that it could argue its “Just Do It” slogan is “famous” under the Federal Trademark Dilution Act. “The slogan has been very heavily advertised for over a decade and sales of goods bearing the slogan have been in the hundreds of millions of dollars if not billions,” Darville said. According to the Trademark Trial and Appeal Board (TTAB) records that are available online, he added, Nike has been “extremely diligent in policing its ‘Just Do It’ mark” in the past, a fact that Galbreath herself has observed in her own videos.

“I imagine that a review of federal court actions would reveal the same enforcement diligence by Nike in policing this mark,” Darville said. “Many of the TTAB proceedings result in express abandonment of the application, a default judgment for Nike or a judgment by the board in a litigated proceeding.”

Though a brand in Nike’s position would typically argue a likelihood of confusion, Darville said such a claim in this instance “seems weak.” While it would be “premature” to judge the merits of such a claim, he still concluded that dilution would be “the stronger of the two claims.”

“Frequently, these cases come down to a practical decision as to whether an applicant wants to fight Nike with its war chest—a classic David and Goliath situation,” Darville said. “More often

the not, the applicant folds because the costs will exceed the benefits of litigating the matter through a decision on the merits.”

William Scott Goldman, the founder of Goldman Law Group and a prolific trademark filer, came to a similar conclusion. Though he acknowledged the case would appear “at first blush” to be a matter of “trademark bullying,” he said Nike’s position “has legal merit” and that the company would likely prevail on grounds of dilution.

“Galbreath could argue parody as a defense, but that could fail given the lewd connotations involved and the relative fame of Nike’s mark,” Goldman said. “As long as Nike is able to establish compelling evidence of tarnishment and/or blurring, particularly if supported by consumer surveys, then ‘Don’t Do It’ should have been the advice given to Galbreath from the outset.”

Zach Eyster, an intellectual property attorney at Founders Legal, is less confident in Nike’s chances. In his view, Just Succ It is unlikely to either confuse consumers or blur the relationship of Nike’s relationship to the “Just Do It” slogan.

“‘Just Succ It’ is not an identical mark,” Eyster said. “If someone were using the identical ‘Just Do It’ for plants, then Nike might be able to say ‘Ok, stop this, this is our famous mark and you’re blurring it.’ Nike might also try to say that ‘Just Succ It’ amounts to a dilution by ‘tarnishment’ of its senior brand. Again, a tall order in my view.”

Nike’s best shot, he said, would be to argue its “Just Do It” slogan is so well known that no matter the goods, people will become confused and think it is affiliated with Nike. In his view, however, the two marks “can coexist.”

Moving forward, Nike can file to extend the deadline to oppose Just Succ It’s trademark again, this time for 60 days, if it is able to show “good cause.” A third and final extension of 60 days would require Just Succ It’s consent or a showing of extraordinary circumstances.

“One thing that Nike cannot do is steal me of my joy,” Galbreath said. “I know how serious it is. I know how it can affect me and my kids and how I run my business, but it’s certainly not going to rob me of my joy, ever.”