

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

TODD C. BANK,

1:25-cv-03981-CM

Plaintiff,

-against-

NFL PROPERTIES LLC,

Defendant.

**PLAINTIFF'S MEMORANDUM OF LAW IN OPPOSITION TO DEFENDANT'S
MOTION FOR COSTS AND ATTORNEYS' FEES PURSUANT TO RULE
41(d) OF THE FEDERAL RULES OF CIVIL PROCEDURE**

TODD C. BANK,
ATTORNEY AT LAW, P.C.
119-40 Union Turnpike
Fourth Floor
Kew Gardens, New York 11415
(718) 520-7125
By Todd C. Bank

Counsel to Plaintiff

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
STATUTES AND RULES	ii
CASES	ii
OTHER AUTHORITIES	ii
ARGUMENT	1
I. DEFENDANT IS NOT ENTITLED TO COSTS IN CON- NECTION WITH THE PARTIES' PREVIOUS ACTION	1
II. DEFENDANT'S ATTEMPT TO PREJUDICE THIS COURT WITH IRRELEVANT MATTERS SHOULD NOT BE COUNTENANCED	8
CONCLUSION	10

TABLE OF AUTHORITIES

	Page
 STATUTES AND RULES	
15 U.S.C. §§ 1051 - 1141	4
Fed. R. Civ. P. 11	6, 7
Fed. R. Civ. P. 11(c)	6
Fed. R. Civ. P. 11(c)(2)	6
Fed. R. Civ. P. 41(d)	1, 3, 4, 5, 7
 CASES	
<i>Advanced Video Technologies LLC v. HTC Corp.</i> , No. 11-cv-06604, 2019 WL 13214942 (S.D.N.Y. Jan. 31, 2019) (McMahon, J.)	1
<i>ED Capital, LLC v. Bloomfield Investment Resources Corp.</i> , 316 F.R.D. 77 (S.D.N.Y. 2016)	6
<i>Horowitz v. 148 S. Emerson Assocs. LLC</i> , 888 F.3d 13 (2d Cir. 2018)	3, 4, 5
<i>Thompson v. Steinberg</i> , No. 21-2444-cv, 2023 WL 353359 (2d Cir. Jan. 23, 2023)	6
 OTHER AUTHORITIES	
Jodi S. Balsam, <i>Timeout for Sports Trademark Overprotection: Comparing the United States, European Union, and United Kingdom</i> , 52 Calif. Western Int’l Law Journal 351 (2022)	5-6
Colleen McMahon, <i>The Monastic Life of a Federal District Judge</i> , 70 Mo. L. Rev. 989 (2005)	8, 9-10
Charles A. Wright & Arthur R. Miller, <i>Federal Practice and Procedure</i> (3d ed. 2004)	6

ARGUMENT

POINT I

DEFENDANT IS NOT ENTITLED TO COSTS OR ATTORNEYS’ FEES IN CONNECTION WITH THE PARTIES’ PREVIOUS ACTION

Defendant, NFL Properties LLC (“NFLP”), asserts that Plaintiff, Todd C. Bank (“Bank”), “should be penalized by an award of costs and fees to NFLP for the time and money it expended on responding to his first attempt at litigating this case,” Def. Mem. at 1, *i.e.*, *Bank v. NFL Properties LLC*, No. 1:24-cv-08814-CM (“*Bank I*”). The question upon which rests a defendant’s entitlement to relief under Rule 41(d) of the Federal Rules of Civil Procedure is whether, following the plaintiff’s voluntarily dismissal of a prior action (here, *Bank I*), the plaintiff brings a second action that, *vis-à-vis* the first action, is brought improperly. *See Advanced Video Technologies LLC v. HTC Corp.*, No. 11-cv-06604, 2019 WL 13214942, *3-*5 (S.D.N.Y. Jan. 31, 2019) (McMahon, J.). Specifically, “[t]he purpose of [] [R]ule [41(d)] is to serve as a deterrent to forum shopping and vexatious litigation by preventing plaintiffs from voluntarily dismissing and re-filing cases.” *Id.* at *4.

On April 1, 2025, Bank, in *Bank I*, filed a notice of voluntary dismissal pursuant to Rule 41(a)(1)(A)(i) (*Bank I*, Doc. 24). NFLP argues that Bank, instead of commencing the present action (“*Bank II*”), should, in *Bank I*, have either submitted “opposition to NFLP’s motion to dismiss the amended complaint,” Def. Mem. at 5, or, “sought leave to further amend his amended complaint to add the factual allegations he made in *Bank II*.” *Id.* Because Bank did not choose either of these options, NFLP claims: “[t]his allowed him to skirt the 25-page limit for opposition briefs and submit it on his own time rather than on the due date. These acts of procedural gamesmanship should be discouraged.” *Id.* at 5-6.

In *Bank I*, NFLP argued in its dismissal motion that Bank did not have standing, and that this Court therefore did not have subject-matter jurisdiction, because Bank had not alleged “at least some

meaningful preparation to use the marks at issue such that he is actively preparing to produce the article in question,” *Bank I*, Def. Mem. (Doc. 23) at 7 (citation and quotation marks omitted); *see also id.* at 9 (“[b]eyond conducting undisclosed ‘research,’ Plaintiff simply identified some very basic steps that he is allegedly ‘willing and able’ to take towards creating and selling an unauthorized product bearing an NFL Mark, but has not actually done or even attempted to do,” citing *Bank I* Am. Compl., ¶¶ 31-37).

Bank, upon reviewing NFLP’s standing argument, concluded that NFLP was right. Thus, Bank could not have opposed the motion in good faith.

As to the second option, *i.e.*, seeking “leave to further amend his amended complaint to add the factual allegations he made in *Bank II*,” Def. Mem. at 5, Bank *could not have done so*. That is because, as NFLP itself notes in its pending dismissal motion in the present case, the determination of subject-matter jurisdiction “must be made considering *only the facts and circumstances at the time the suit was filed*.” Def. Mem. (Doc. 17) at 8 (emphasis added). Therefore, Bank could not have relied upon the “add[itional] . . . factual allegations he made in *Bank II* to seek leave to amend,” Def. Mem. at 5, as those additional facts, *see Bank II* Compl., ¶¶ 89-99, did not exist at the time that *Bank I* was commenced.

Because Bank, in *Bank I*, rightly declined to oppose NFLP’s dismissal motion, and rightly declined to seek leave to file a second amended complaint, Bank’s commencement of the present action *did not improperly substitute for the continuation of Bank I*. For this reason alone, NFLP is not entitled to the relief that it now seeks.

NFLP contends that the steps regarding standing that Bank took prior to the commencement of the present action were insufficient and therefore show that Bank improperly used them, not in good faith, but, instead, as an excuse to file *Bank II* instead of continuing to litigate *Bank I*. *See* Def. Mem. at 5-6. This argument ignores the indisputable fact that Bank’s steps not only met the criteria

for standing, but went well beyond those criteria. *See* Bank’s memorandum of law (Doc. 28) in opposition to NFLP’s motion to dismiss the Complaint (“Pl. Opp. Dismissal Mem.”), Point II. Thus, NFLP’s contention, with respect to the Complaint, that, “[t]he factual allegations were largely identical to those in Bank’s two prior complaints [in *Bank I*],” Def. Mem. at 3, while true insofar as the two cases concern the NFL Principal Symbols (and, of course, seek the same relief, *i.e.*, a declaratory judgment regarding those symbols), is not true with respect to the facts that are alleged only in *Bank II*, *i.e.*, the facts that concern Bank’s standing. *See* Compl., ¶¶ 89-99.

NFLP claims: “[a] plaintiff’s later-filed complaint need not be identical to its earlier-filed one to be subject to Rule 41(d). The complaints can involve different or additional facts, claims for relief, or theories of recovery, so long as they are based on the same underlying claims or depend on the same core showings.” Def. Mem. at 4, citing *Horowitz v. 148 S. Emerson Assocs. LLC*, 888 F.3d 13, 23-24 (2d Cir. 2018). First, that is true, but it is not the complete picture. *Horowitz*, in reference to the portion of Rule 41(d) that states, “[i]f a plaintiff who previously dismissed an action in any court files an action based on or including *the same claim* against the same defendant, the court ... may order the plaintiff to pay all or part of the costs of that previous action,” *Horowitz*, 888 F.3d at 22, quoting Fed. R. Civ. P. 41(d) (emphasis added), noted that, “[t]he district court concluded that Rule 41(d) was implicated due to the similarities in the allegations and relief sought as between the instant action and the Georgia state action, for which [the plaintiff] did not ‘demonstrate that there was a good reason ... to dismiss.’” *Id.* Not only is the scenario at issue in *Horowitz* very different than the one at present (as addressed below), but *Horowitz* does not indicate, much less state, that costs, let alone attorney’s fees, should be awarded pursuant to Rule 41(d) where the facts alleged in the second action could not have been alleged in the previously dismissed action.

Second, the circumstances at issue in *Horowitz* were not at all like the present circumstances in any event. *Horowitz* arose out of “one in a series of bitterly contested suits adjudicating rights

associated with . . . [the defendant’s] restaurant.” *Horowitz*, 888 F.3d at 16. Following a business relationship between the parties and a subsequent fall-out, *see id.* at 16-17, “[in] 2014, [the plaintiff] brought a declaratory judgment action in the Northern District of Georgia against [the defendant] seeking a ruling that [the plaintiff] owns the relevant trademarks and that [the defendant] does not.” *Id.* at 17. Next, in 2015, one of the defendant’s principals (*see id.* at 16) “sued [the plaintiff] in New York state court alleging that the [parties’] [l]icense [a]greement was not a valid arms-length agreement and is therefore void *ab initio*, which ultimately resulted in the Georgia federal action being stayed.” *Id.* at 17. Next, “[in] 2016, [the plaintiff] sued [the defendant] in Georgia state court,” *id.*, asserting various claims “relating to [the defendant]’s continued use of [the plaintiff’s] marks following [the plaintiff]’s termination of the [l]icense [a]greement.” *Id.*

The Georgia state court, “after a hearing [one month later], denied the TRO and at the same time suggested that [the plaintiff]’s filing of that action interfered with the state action in New York in violation of th[e] [New York] court’s March 16, 2016 order,” *id.* at 17-18, which had “ordered that: (i) [a] [r]eceiver shall take full control of [the restaurant]; (ii) [one of the defendant’s principals (*see id.* at 16)] must surrender all of his restaurant-related property to the [r]eceiver; and (iii) [that this principal] is restrained from interfering in any way with the Court-appointed [t]emporary [r]eceiver in his operation and management of the company.” *Id.* at 17. “Two days later, . . . [the plaintiff] voluntarily dismissed the state action in Georgia.” *Id.* One month after that, the plaintiff brought the District Court action, alleging, *inter alia*, violations of the Lanham Act, 15 U.S.C. §§ 1051 - 1141, *see id.* at 18, following which the defendant moved for dismissal and therein requested that “[the plaintiff] be ordered to pay the costs, including attorneys’ fees, [the defendants] incurred defending the discontinued state action in Georgia under the anti–forum shopping provision of Fed. R. Civ. P. 41(d),” *id.*, which the District Court did. *See id.* at 19.

In affirming “[t]he district court[’s] conclu[sion] that Rule 41(d) was implicated due to the

similarities in the allegations and relief sought as between the instant action and the Georgia state action, for which [the plaintiff] did not ‘demonstrate that there was a good reason ... to dismiss,’” *id.* at 22, the court rejected the plaintiff’s reliance upon “the fact that the Georgia state action was contract-based and the instant action [was] brought under the Lanham Act,” *id.* at 23, explaining: “[the plaintiff] could have asserted a Lanham Act violation in the Georgia state action by simply amending its complaint,” *id.*, and that, “[the plaintiff] chose instead to voluntarily dismiss the Georgia state action and file its Lanham Act claims in federal court in another state. Moreover, it did so immediately after the Georgia state court stated its belief that the action was meritless and that its filing likely contravened an order of another court, which was itself addressing substantially related claims. This is the precise type of litigation tactic that Rule 41(d) is meant to deter.” *Id.* (insofar as NFLP might argue that Bank, with respect to the steps that he took in preparation for *Bank II*, should have taken those steps prior to *Bank I*, this would have concerned *Bank I*, rather than whether Bank commenced *Bank II* improperly *vis-à-vis Bank I*).

In *Bank I*, the Court, in approving NFLP’s request for approval of a briefing schedule regarding its motion to dismiss the original complaint, wrote: “OK. Having read the Complaint, I assume the response will be a motion to dismiss, and possibly for sanctions, since the pro se plaintiff is an attorney” (*Bank I*, Doc. 15). Although NFLP mentions this, *see* Def. Mem. at 2, it is not clear whether NFLP is suggesting that this notation therefore makes the present situation comparable to that in *Horowitz*. In any event, the notation did not indicate why the Court had anticipated a possible motion for sanctions, but, in retrospect, it appears to Bank that it was due to the standing issue, rather than the merits, because, first, as Bank acknowledges above, NFLP was correct about standing, and, second, Bank has believed, throughout *Bank I* and *II*, that he is correct on the merits. Indeed, among the various scholars, quoted in the Complaint, who agree with Bank on the merits is Jodi S. Balsam, who was an attorney with the National Football League from 1994 to 2007, wherein she managed,

inter alia, intellectual-property litigation, *see* Prof. Balsam’s *curriculum vitae* at 2, available at www.brooklaw.edu/media/qcybymcc/balsamcv2025a.pdf (last checked July 10, 2025), and has been teaching sports law at New York University School of Law since 2016, *see id.* at 1; *see also* Jodi S. Balsam, *Timeout for Sports Trademark Overprotection: Comparing the United States, European Union, and United Kingdom*, 52 Calif. Western Int’l Law Journal 351 (2022); Compl., ¶¶ 3, 33, 58.

The fact that Bank had not taken sufficient steps in *Bank I* regarding standing does not make the Complaint in *Bank II* deficient. Instead, it made Bank’s pleadings in *Bank I* deficient. As a result, NFLP had the right to seek dismissal in *Bank I* for lack of standing, which it did. If NFLP also believed that the deficiency warranted sanctions, it had the right to avail itself of the Rule 11 procedure, which it did, having sent, to Bank, Rule 11(c)(2) safe-harbor notices on February 12, 2025, with respect to the original complaint, and on March 19, 2025, with respect to the amended complaint (each letter contended that the corresponding complaint was frivolous with respect to standing and the merits). However, Bank, pursuant to his right under the safe-harbor provision, filed an amended complaint before the first 21-day period expired, *i.e.*, on March 5, 2025 (*Bank I*, Doc. 21), and a notice of voluntary dismissal pursuant to Rule 41(a)(1)(A)(i) before the second 21-day period expired, *i.e.*, on April 1, 2025 (*Bank I*, Doc. 24). *See Thompson v. Steinberg*, No. 21-2444-cv, 2023 WL 353359, *3, n.2 (2d Cir. Jan. 23, 2023) (“[t]he safe harbor protection of Rule 11 is available to a litigant who ‘withdraws’ the offending paper. F.R.C.P. 11(c).”); *ED Capital, LLC v. Bloomfield Investment Resources Corp.*, 316 F.R.D. 77, 82 (S.D.N.Y. 2016) (“[t]he purpose of the safe harbor provision is to permit the opposing party an opportunity to withdraw or correct its pleadings in response to the proposed motion”); 51 Charles A. Wright & Arthur R. Miller, *Federal Practice and Procedure*, § 1337.2 (3d ed. 2004) (“the procedural requirements of the Rule 11 safe harbor provision are designed to protect the person against whom sanctions are sought”).

NFLP notes that, in the present case, “[t]he civil cover sheet [(Doc. 3)] filed with the

complaint identified *Bank II* as the same case as *Bank I*.” Def. Mem. at 3. Nevertheless, Bank did not file a Related Case Statement, and, although NFLP does not mention this, Bank notes that, in the event that NFLP were to argue, in its reply, that Bank filed *Bank II* in order to have the possibility of having it assigned to a different judge, this argument would be incorrect. *See* Declaration of Todd C. Bank (Doc. 9). Moreover, Bank had expected, based upon his completing of the section of the Civil Cover Sheet (Doc. 3) whose title tracks the language of Rule 4(b) of the Rules for the Division of Business among District Judges, Southern District of New York, *i.e.*, “[h]as this action, case, or proceeding, or one essentially the same, been previously filed in SDNY at any time?,” that *Bank II* would receive the same judicial assignment as had *Bank I* pursuant to Rule 4(b).

NFLP contends that, “Bank’s ulterior motive in dismissing and refileing his complaint [was] to have the benefit of an opposition to NFLP’s motion to dismiss without the restrictions of a deadline or page limit.” Def. Mem. at 6. Again, Bank properly withdrew *Bank I*. Thus, insofar as NFLP contends that the *Bank II* Complaint improperly contained legal argument, *see* Def. Mem. at 4-5, that contention should be addressed with respect to that Complaint on its own terms, rather than in relation to *Bank I*; and, indeed, NFLP has done so. *See* Defendant’s memorandum of law in support of dismissal motion (“Def. Dismissal Mem”; Doc. 17) at 5-6; *see also* Pl. Opp. Dismissal Mem., Point I.

In effect, NFLP is seeking to use Rule 41(d) to revive what might have been its Rule 11 motion in *Bank I*, but Rule 41(d) is not a fallback for a Rule 11 motion that a plaintiff in a previous action precluded by exercising his rights under Rule 11. Again, Rule 41(d) does not concern a previously dismissed action on its own terms, but, instead, whether a second action was brought improperly *vis-à-vis* the previous action. If NFLP believes that the present action warrants sanctions, it is free to avail itself of the Rule 11 procedure, which it has done, having sent Bank a Rule 11 safe-harbor notice on June 10, 2025 (again with respect to standing and the merits).

POINT II

**DEFENDANT’S ATTEMPT TO PREJUDICE THIS COURT WITH
IRRELEVANT MATTERS SHOULD NOT BE COUNTENANCED**

As addressed below, NFLP, as has been its *modus operandi* throughout this case and in *Bank I*, continues to openly seek to prejudice the Court against Bank. Such attempts are entirely inappropriate in and of themselves, and, furthermore, are necessarily reliant upon a lack of judicial integrity. However, this Court has emphasized that judges must avoid being influenced by prejudices and irrelevancies:

[W]e district judges have to save ourselves from our own worst instincts - the instinct to be proud, to be arrogant, to be hasty, to be careless, to be unduly harsh, to be unduly lenient, and yes, to be absolutely certain that we are right. We have to be honest with ourselves about the forces that will, if we are not vigilant, impinge on our ability to make decisions for right reasons: ambition, a desire to be liked, a need to be respected, and above all, a desire to impose some agenda on society. More than that, we have to be willing to bring ourselves up short when we catch ourselves factoring inappropriate considerations into our decision-making, be they preconceived notions, prejudices, public opinion, or whatever happens to be flying around in the political winds.

Colleen McMahon, *The Monastic Life of a Federal District Judge*, 70 Mo. L. Rev. 989, 992 (2005).

NFLP’s attempts are less to *convince* the Court that NFLP is truly entitled to the relief it now seeks, and more to have the Court *want to punish Bank*; but this Court has stated:

[I]t is important - especially for [district] judges . . . , who do not engage in dialogue with colleagues in the process of deciding a case - to know ourselves down to the root of ourselves and to be completely honest with ourselves about why we are doing what we are doing. Because there will inevitably be times when we must conclude that the law compels us to do things that we would not do if we made the rules rather than interpreted and enforced them.

Monastic Life of a Federal District Judge, 70 Mo. L. Rev. at 993.

NFLP states that Bank, in *Bank I*, “attached[,] [to the Complaint[,] a letter he wrote to the NFL explaining the legal theories underlying his complaint, where he purported to be writing on

behalf of a ‘John Doe’ client, but was really writing on behalf of himself.” Def. Mem. at 1-2, citing *Bank I* Compl., Exh. “A.” NFLP does not explain how this has anything to do with the question of whether Bank commenced *Bank II* improperly *vis-à-vis Bank I* (a copy of the letter is also attached as Exhibit “C” to the *Bank II* Complaint).

NFLP states that, in *Bank I*, “the parties spent several hours conferring over e-mail and videoconference about potential schedules for briefing and discovery, but ultimately could not agree on a joint submission,” Def. Mem. at 2, but does not explain how this has anything to do with the question of whether Bank commenced *Bank II* improperly *vis-à-vis Bank I* (in any event, the parties’ telephone call on December 20, 2024 (not a video conference), lasted just under one hour, and their “conferring over e-mail,” together with the telephone call, surely did not take “several hours”).

NFLP notes that the parties had entered into a briefing schedule in *Bank I*, *see* Def. Mem. at 2, but does not explain how this has anything to do with the question of whether Bank commenced *Bank II* improperly *vis-à-vis Bank I*.

NFLP then states: “Bank [filed a] letter [on] January 8, 2025, admonishing the Court for ‘giving legal advice to a party,’ accusing it of partiality, and demanding rescission of its suggestion regarding sanctions. The Court acknowledged receipt of the letter that same day, and assured Bank of its competency to evaluate the complaint impartially.” Def. Mem. at 2. NFLP does not explain how this exchange has anything to do with the question of whether Bank commenced *Bank II* improperly *vis-à-vis Bank I*. Instead, as is plainly transparent, NFLP is yet again seeking to prejudice the Court against Bank. Indeed, there is little doubt that NFLP carefully chose the word “admonishing,” for it is acceptable for judges to “admonish” counsel, but perhaps not the other way around. In any event, Bank’s letter, as well as the Court’s response, speak for themselves, and, regardless of what the Court might have thought of Bank’s letter, Bank does not believe that the Court would hold the type of grudge against him that NFLP obviously hopes it will; indeed, this Court recognized that judges “are

too often lionized rather than humanized.” *Monastic Life of a Federal District Judge*, 70 Mo. L. Rev. at 990.

NFLP’s tactic of trying to prejudice the Court against Bank based upon matters that have nothing to do with the question of whether Bank commenced *Bank II* improperly *vis-à-vis Bank I*, is abhorrent and, at the very least, should be disregarded.

CONCLUSION

Plaintiff respectfully requests that this Court: (i) deny Defendant’s motion; and (ii) grant, to Plaintiff, any lawful and proper relief.

Dated: July 14, 2025

Respectfully submitted,

s/ Todd C. Bank
TODD C. BANK,
ATTORNEY AT LAW, P.C.
119-40 Union Turnpike
Fourth Floor
Kew Gardens, New York 11415
(718) 520-7125
By Todd C. Bank

Counsel to Plaintiff

CERTIFICATE OF COMPLIANCE WITH LOCAL RULE 7.1(c)

This memorandum of law contains 3,418 words.

Dated: July 14, 2025

s/ Todd C. Bank _____

Todd C. Bank

CERTIFICATE OF SERVICE

I hereby certify that on July 14, 2025, a true and accurate copy of the foregoing is being filed electronically via the Court's electronic-filing (ECF) system. Notice of this filing will be sent to all parties by operation of the Court's ECF system and copies will be mailed to those parties, if any, who are not served via the Court's ECF system.

Dated: July 14, 2025

s/ Todd C. Bank

Todd C. Bank