

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

TODD C. BANK,

Plaintiff,

v.

NFL PROPERTIES LLC,

Defendant.

Case No. 1:25-cv-03981-CM

**REPLY IN FURTHER SUPPORT OF
DEFENDANT NFL PROPERTIES LLC'S
MOTION TO DISMISS PLAINTIFF'S
COMPLAINT**

TABLE OF CONTENTS

I.	Introduction.....	1
II.	Bank’s Complaint Warrants Dismissal on both Standing and Discretionary Grounds	1
	A. Bank’s Actions are Insufficient as a Matter of Law	2
	B. The Court Should Decline to Adjudicate this Case	4
III.	Bank’s Legal Arguments are Meritless.....	5
	A. The NFL Marks are Not Functional.....	6
	1. The NFL Marks Are Not Utilitarianly Functional.....	6
	2. The NFL Marks Are Not Aesthetically Functional	7
	B. NFLP’s Marks Consistently Serve as Source Identifiers.....	9
IV.	Conclusion	10

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Admiral Ins. Co. v. Niagara Transformer Corp.</i> , 57 F.4th 85 (2d Cir. 2023)	5
<i>Bank v. Al Johnson's Swedish Rest. & Butik, Inc.</i> , 795 Fed. Appx. 822 (Fed. Cir. 2019).....	5
<i>Bank v. Katz</i> , 2009 WL 3077147 (E.D.N.Y. Sept. 24, 2009)	5
<i>Bruce Winston Gem Corp. v. Harry Winston, Inc.</i> , 2010 WL 3629592 (S.D.N.Y. Sept. 16, 2010).....	4
<i>Brunswick Corp. v. British Seagull Ltd.</i> , 35 F.3d 1527 (Fed. Cir. 1994).....	6
<i>Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.</i> , 696 F.3d 206 (2d Cir. 2012).....	6, 7
<i>City of N.Y. v. Blue Rage, Inc.</i> , 435 F. Supp. 3d 472	9
<i>Dippin' Dots, Inc. v. Frosty Bites Distrib.</i> , LLC, 369 F.3d 1197 (11th Cir. 2004).....	8
<i>Dondero v. Chopra & Nocerino LLP</i> , 2022 WL 320967 (2d Cir. Feb. 3, 2022).....	10
<i>Ford Motor Co. v. Lloyd Design Corp.</i> , 184 F. Supp. 2d 665 (E.D. Mich. 2002).....	7
<i>Inwood Labs. v. Ives Labs.</i> , 456 U.S. 844 (1982).....	6
<i>Plasticolor Molded Prods. v. Ford Motor Co.</i> , 713 F. Supp. 1329 (C.D. Cal. 1989), <i>vacated by consent judgment</i> , 767 F. Supp. 1036 (C.D. Cal. 1991).....	6, 7
<i>Qualitex Co. v. Jacobson Prods. Co.</i> , 514 U.S. 159 (1995).....	7
<i>Saleh v. Sulka Trading Ltd.</i> , 2020 WL 4059803 (S.D.N.Y. July 20, 2020)	2, 3, 4

<i>Saleh v. Sulka Trading, Ltd.</i> , 957 F.3d 348 (2d Cir. 2020).....	2
<i>Savannah Coll. of Art & Design, Inc. v. Sportswear, Inc.</i> , 2019 WL 11542685 (N.D. Ga. Mar. 1, 2019), <i>aff'd</i> , 983 F.3d 1273 (11th Cir. 2020)	8
<i>Starter Corp. v. Converse, Inc.</i> , 84 F.3d 592 (2d Cir. 1996).....	1
<i>Tex. Tech Univ. v. Spiegelberg</i> , 461 F. Supp. 2d 510 (N.D. Tex. 2006)	9
<i>TrafFix Devices, Inc. v. Marketing Displays, Inc.</i> , 532 U.S. 23 (2001).....	7
<i>Univ. Book Store v. Bd. of Regents of the Univ. of Wis. Sys.</i> , 33 U.S.P.Q.2d 1385 (T.T.A.B. 1994)	9, 10
<i>Univ. of Kan. v. Sinks</i> , 565 F. Supp. 2d 1216 (D. Kan. 2008).....	6
<i>Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.</i> , 916 F.2d 76 (2d Cir.1990).....	8
STATUTES	
15 U.S.C. § 1125(a)	9, 10
OTHER AUTHORITIES	
4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:97 (5th ed.)	8

I. Introduction

Bank's 40-page opposition is a journey through lengthy quotes, tangents, and pontifications on what Bank thinks the law should be. It is devoid, however, of applicable authority that the law is what Bank wishes it to be. On subject matter jurisdiction, Bank ignores the dispositive case law requiring a "definite intent" and "apparent ability" to use the NFL Marks in commerce. As is evident from the current complaint as well as the previous two in *Bank I*, Bank is a litigator on a crusade—not a bona fide intended seller of NFL-branded merchandise. On a motion to dismiss for lack of subject matter jurisdiction, the Court can readily conclude from the allegations and available facts that there is no justiciable controversy.

Nor is there any merit to Bank's attempt to invalidate NFLP's—and, by extension, *all*—trademarks. Bank's fundamental argument is that he cannot compete in the market for NFL-branded merchandise without using the NFL Marks, rendering those marks functional. But there is no competitive market for NFL-branded merchandise. That market is created and controlled by NFLP because of the goodwill associated with the NFL Marks. Bank cannot compete in a market for NFL-branded merchandise any more than he can compete in a market for Coca-Cola-branded products, Disney-branded products, or any other branded products. That is what trademark law protects. Bank can compete in a market for the same goods on which the NFL Marks appear, but he cannot use the NFL Marks to sell those goods. His argument otherwise—while voluminous—is at its core meritless and must be dismissed with prejudice.

II. Bank's Complaint Warrants Dismissal on both Standing and Discretionary Grounds

To demonstrate standing, Bank must show that he "has engaged in a course of conduct evidencing a *definite intent* and *apparent ability* to commence use of the marks on the product." *Starter Corp. v. Converse, Inc.*, 84 F.3d 592, 595-96 (2d Cir. 1996) (emphasis added). Bank has

failed to allege *any* intent, much less *definite* intent, to operate any legitimate business venture using the NFL Marks. Nor does Bank plead facts that tend to show an apparent ability to launch an NFL merchandise business. To support his standing argument, Bank leans heavily on the de minimis steps he has allegedly taken since filing his prior complaint in *Bank I*: (i) making 33 t-shirts bearing NFL patches; and (ii) posting photos of the shirts on a password-protected, non-functioning website he created the day before filing this lawsuit. Opp. at 6. But these superficial actions are still insufficient to confer declaratory judgment standing.

A. Bank’s Actions are Insufficient as a Matter of Law

The futility of Bank’s most recent acts is demonstrated by their close parallels to the plaintiff’s insufficient conduct in *Saleh v. Sulka Trading, Ltd.*, 957 F.3d 348 (2d Cir. 2020). A few months after that case was dismissed on standing grounds, Saleh re-filed, seeking the same declaratory judgment regarding his rights to use a mark. *Saleh v. Sulka Trading Ltd.*, 2020 WL 4059803 (S.D.N.Y. July 20, 2020). His new complaint alleged he had invested over \$60,000 in building his U.S. business to sell trademarked items, including by “[c]ontracting with manufacturers to produce goods bearing the SULKA mark and with shipping services to ship goods to the United States” and “[p]urchasing the domain name sulka-phulka.com and engaging a web design company to stand up the website.” *Id.* at *5. The District Court found that these acts, plus others, were *still* insufficient to establish standing because Saleh had not “provided any hard evidence whatsoever to support these statements about the growth of his business,” such as “records that detail his arrangements with suppliers and manufacturers,” or “details to support his contention that he is ready to ship to customers in the United States.” *Id.* at *5.

Like Saleh, Bank’s complaint lacks evidence of any definite intent or apparent ability to engage in ongoing business operations. He does not, and cannot, allege that he has taken any steps

to establish more than a fly-by-night business offering a smattering of NFL-branded apparel. On the contrary, he affirmatively concedes that he has no intent to become an online retailer of NFL merchandise in a “general, long-term sense.” Opp. at 7-8.

Confirming this, Bank alleges no significant monetary investment into his “business,” nor anything approaching the investment made in *Saleh*—which itself was not enough. And he provides no evidence of any plan to create a real or lasting enterprise. He does not claim to have a supplier of the materials needed to manufacture and distribute NFL apparel at scale, nor agreements with any factory, assembler, warehouse, or distribution service.¹

Bank’s creation of a website does not save his claims, just as it did not save Saleh’s:

[T]he one piece of information that the Court can verify, *i.e.*, Mr. Saleh’s use of the domain name sulka-phulka.com, does not materially strengthen Mr. Saleh’s renewed case for declaratory relief. Defendants argue that the website (and Mr. Saleh’s business) is a sham. . . . Moreover, when Defendants’ counsel attempted to order products from the website they did not arrive until two days after that fact was pointed out to the Court.

Saleh, 2020 WL 4059803 at *6 (internal citations omitted). Likewise, Bank’s website is a sham intended to air grievances, not market NFL-branded merchandise. He created it the day before filing this lawsuit.² The home page, which Bank updated after NFLP moved to dismiss, states:

Having not yet won the case, of course, I am not currently in the business of selling the t-shirts, but I am already in the business of standing up for what I believe, and:

I WILL NOT BE INTIMIDATED

¹ Bank also does not allege how he would procure NFL patches en masse, which is not surprising given that NFLP does not authorize the production of loose patches. Bank would therefore be unable to find any supplier able to provide such patches for the mass production of merchandise.

² Bank asserts that the timing of his actions is irrelevant. But in *Saleh*, the court noted that “Given how quickly Mr. Saleh filed his second action after the dismissal of his first request for declaratory relief, this lack of verifiable information about these steps raises questions as to the actual scope of Mr. Saleh’s business and his ‘apparent ability’ to use the Sulka mark.” *Id.* at *5.

See Swanson Decl., Ex. A.³ The website’s purchasing features do not work, as an attempt to buy a shirt from the password-protected “Products” page returns an error message: “We can’t accept online orders right now.” *Id.* The remainder of the website is similarly underdeveloped. *See id.*

Even if Bank could show his website is technically functional, that does not make it legitimate for standing purposes. As further noted in *Saleh*:

The Court, however, does not need to find that Mr. Saleh’s website is a sham to conclude that it does not demonstrate his ability to use the SULKA mark in the United States. Even accepting all of Mr. Saleh’s explanations about the functionality of the website as true, the Court on a motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(1) is not required to ‘draw all reasonable inferences in the plaintiff’s favor.’ Here, the most reasonable inference to be drawn from the multitude of issues with the Sulka Phulka website is that Mr. Saleh’s business is perhaps more ‘fledgling’ than he would care to admit. Again, it is Mr. Saleh’s burden to affirmatively demonstrate jurisdiction by preponderance of the evidence, and the Sulka Phulka website simply does not amount to compelling evidence that he is ready to immediately use the SULKA mark in commerce

Saleh, 2020 WL 4059803, at *6 (internal citations omitted).

Bank clearly lacks the “definite intent” and “apparent ability” to engage in a legitimate business venture using the NFL Marks. To find otherwise would encourage future plaintiffs to undertake similarly simple and disingenuous actions to fabricate the illusion of a controversy. The Court should dismiss the complaint with prejudice for lack of subject matter jurisdiction.

B. The Court Should Decline to Adjudicate this Case

Putting aside that Bank’s minimal actions do not establish standing, the Court should exercise its “broad discretion to decline jurisdiction” in any event. *Admiral Ins. Co. v. Niagara Transformer Corp.*, 57 F.4th 85, 99 (2d Cir. 2023) (internal quotation marks omitted).

³ The Court need not accept Bank’s jurisdictional factual allegations as true and can consider evidence in making its determinations. “Where jurisdictional facts are in dispute, a district court has the ‘power and obligation’ to refer to evidence outside the pleadings.” *Saleh*, 2020 WL 4059803, at *3 (quoting *Bruce Winston Gem Corp. v. Harry Winston, Inc.*, 2010 WL 3629592, at *1 (S.D.N.Y. Sept. 16, 2010)).

Bank is not pursuing a genuine business endeavor. As noted, he admits he intends to sell only the 33 t-shirts he has made and does not intend (and lacks the ability) to launch a real business. Opp. at 7-8 (NFLP “incorrectly treats the Complaint as expressing Bank’s intent ‘to become an online retailer’ (Def. Mem. at 6) in a general, long-term sense”). At \$18 per shirt, even if Bank sold all his inventory, he would not even offset the \$810 he has paid to file this case twice.

Bank does not seek to create a profitable merchandising business because his actual business is filing lawsuits, not selling t-shirts. As discussed in NFLP’s opening brief, Bank is a lawyer and serial *pro se* plaintiff who has sued for matters as trivial as his desire to wear a baseball hat and jeans in court. *Bank v. Katz*, 2009 WL 3077147 (E.D.N.Y. Sept. 24, 2009). Indeed, Bank lost a trademark suit for lack of standing when the only injury he could allege was feeling offended because he believed the subject trade dress was “demeaning to goats.” *Bank v. Al Johnson's Swedish Rest. & Butik, Inc.*, 795 Fed. Appx. 822, 825 (Fed. Cir. 2019).

Bank’s goal is not to resolve an actual business dispute, but rather to further his hobby of *pro se* “annoyance” litigation and his crusade to attack well-established precedent. Thus, a judgment will not “serve a useful purpose in clarifying and settling the legal relations in issue,” nor will it “terminate and afford relief from the uncertainty, insecurity, and controversy giving rise to the proceeding.” *Admiral*, 57 F.4th at 96. Bank’s suits demonstrate gamesmanship that should not be rewarded or entertained.

III. Bank’s Legal Arguments are Meritless

For all its bluster, Bank’s argument on the merits can be summed up in just a few allegations: (1) the NFL Marks serve both source-identifying and allegiance-identifying purposes; (2) the allegiance-identifying purpose is either utilitarianly or aesthetically functional; and (3) any modicum of functionality defeats any source-identifying purpose a mark may have, rendering it

unprotectable and available for use by anyone. As shown below, the NFL Marks are not functional, so this argument fails. Moreover, the NFL Marks’ undisputed source-identifying purpose is precisely what trademark law protects.

A. The NFL Marks are Not Functional

1. The NFL Marks Are Not Utilitarianly Functional

NFL Marks on t-shirts serve no utilitarian function. They are not “essential to the use or purpose” of the t-shirts, nor do they “affect[] the cost or quality” of manufacturing them. *Inwood Labs. v. Ives Labs.*, 456 U.S. 844, 850 (1982). Bank’s analogies suggesting otherwise are strained.

He first compares NFL Marks to black paint on a boat engine, citing *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1530 (Fed. Cir. 1994). But the boat engine paint affected the use and quality of the overall physical article by making the engine look smaller and more compatible with a variety of boats. Bank does not point to any comparable visual function of the NFL Marks on t-shirts beyond a display of allegiance to NFL-branded teams. *See Univ. of Kan. v. Sinks*, 565 F. Supp. 2d 1216, 1261 (D. Kan. 2008) (“The Court agrees with plaintiffs that there is no evidence that KU’s marks are essential to the quality of T-shirts, or affect how the T-shirts ‘work.’”).

Next, he points to *Plasticolor Molded Prods. v. Ford Motor Co.*, 713 F. Supp. 1329 (C.D. Cal. 1989), *vacated by consent judgment*, 767 F. Supp. 1036 (C.D. Cal. 1991), for the court’s commentary in dicta that a Mets fan does not care who made his Mets jacket or whether its production is authorized. As noted in NFLP’s motion, that unsupported statement was unrelated to the facts of that case, nor has the Second Circuit expressly adopted the “mixed-use approach” applied in that case. Contrary to Bank’s assertion, *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 217 (2d Cir. 2012), does not discuss the “mixed-use” trademark

theory: it merely restates the unremarkable proposition that functionality—where it exists—is a defense to a claim of infringement. And other circuits have flat-out rejected the reasoning in *Plasticolor*. See *Ford Motor Co. v. Lloyd Design Corp.*, 184 F. Supp. 2d 665, 675 (E.D. Mich. 2002) (“[T]he Sixth Circuit has rejected *Plasticolor*’s reliance on the dual purpose of Plaintiffs’ trademarks being placed on floor mats. The fact that floor mats bearing Plaintiffs’ trademark could be considered harmonious accessories does not preclude Defendant’s liability where the trademarks are also capable of indicating sponsorship or origin.”). Regardless, as discussed in NFLP’s opening brief, the marks have no utilitarian functionality in the first place.

2. The NFL Marks Are Not Aesthetically Functional

Bank argues in the alternative that the NFL Marks are aesthetically functional. See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001) (aesthetic functionality is “the central question” where there is no indication that the mark has any bearing on the product’s utility). This argument is just as strained.

A mark is aesthetically functional where a mark holder’s exclusive use of it “would put competitors at a significant *non-reputation-related* disadvantage.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995) (emphasis added). In evaluating this, “courts must avoid jumping to the conclusion that an aesthetic feature is functional merely because it denotes the product’s desirable source.” *Louboutin*, 696 F.3d at 222. “In determining whether a mark has an aesthetic function so as to preclude trademark protection, we take care to ensure that the mark’s very success in denoting (and promoting) its source does not itself defeat the markholder’s right to protect that mark.” *Id.*

Bank’s argument that the NFL Marks’ popularity makes them functional is precisely what the Second Circuit cautions against. Bank characterizes the relevant market here as “merchandise

bearing NFL trademarks.” Opp. at 24. In other words, according to Bank, the NFL Marks are functional because Bank needs to use NFL Marks to compete in a market for goods *bearing NFL Marks*. That tautological argument is flawed and would render *every* trademark aesthetically functional. *See* 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:97 (5th ed.) (“It is quite incorrect to state something like: ‘Ford Motor Co. has a monopoly of FORD autos.’ That is a non sequitur. ‘FORD automobiles’ is not a relevant economic market for which no reasonable substitutes exist. The relevant product market is automobiles, not one firm’s brand of auto[.]”).

A competitor cannot compete in the market for, say, Gucci handbags, without using the Gucci trademark. But that does not render the Gucci mark aesthetically functional and, therefore, unprotectable. The absurdity of this argument highlights the frivolousness of Bank’s position. *See Savannah Coll. of Art & Design, Inc. v. Sportswear, Inc.*, 2019 WL 11542685, at *4 (N.D. Ga. Mar. 1, 2019), *aff’d*, 983 F.3d 1273 (11th Cir. 2020) (“Indeed, the inability to use the trade name of another on one’s own product would appear to be precisely the kind of ‘reputation-related disadvantage’ sanctioned by trademark law.”).

Further, the NFL Marks are not comprised of general qualities, like other marks determined to be aesthetically functional. For example, the NFL Marks are not like the baroque silverware in *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76 (2d Cir.1990). Opp. at 24-25. Baroque silverware can come in a variety of styles, and an overall style cannot be monopolized by a single mark-holder. Nor are they like flash-frozen ice cream that must look a certain way to convey its texture and flavor. *Dippin’ Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1204, 1206 (11th Cir. 2004); Opp. at 25. These categories of products have certain core, aesthetically functional elements. The NFL Marks, on the other hand, are unique symbols of ownership or sponsorship that serve no aesthetic purpose beyond identification of the NFL or

its teams—a core trademark function. Bank can compete in the market for sneakers, but not the market for Nike sneakers. He can compete in the market for coffee, but not the market for Starbucks coffee. And Bank can compete in the market for t-shirts or football-related t-shirts, but not the market for NFL-branded t-shirts without NFLP’s permission. That is a fundamental tenet of trademark law. 4 MCCARTHY § 31:97 (“A trademark does not define its own relevant economic market.”). Accordingly, Bank’s (now third) complaint must be dismissed with prejudice.

B. NFLP’s Marks Consistently Serve as Source Identifiers

NFLP’s marks are not functional, but rather serve as identifiers of source, affiliation, or approval that are protected under the Lanham Act. 15 U.S.C. § 1125(a). The allegation that they also communicate allegiance to the NFL or a team does not change that.

A mark is protectable even when it serves both as a decoration or symbol of affiliation and an identification of source. *See, e.g., Tex. Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 520 (N.D. Tex. 2006) (Texas Tech marks are not functional and “automatically signal to the purchasing public that those products are licensed by the University”); *City of N.Y. v. Blue Rage, Inc.*, 435 F. Supp. 3d 472, 491 (“The marks are clearly source-identifying despite Defendants’ unsupported argument that their use of the NYPD and FDNY marks are ‘decoration to signify the service.’”). To conclude otherwise would make a mark’s protectability inversely correlated to how strongly individuals identify with it. A person might want to be perceived as a member of an organization, supporter of police, fan of a particular cartoon, or wearer of luxury watches. That does not mean that the ABA, NYPD, Mickey Mouse, or Rolex trademarks lose protection merely because a consumer’s primary purpose in wearing the mark on merchandise is to express allegiance. *See Univ. Book Store v. Bd. of Regents of the Univ. of Wis. Sys.*, 33 U.S.P.Q.2d 1385, *22 (T.T.A.B. 1994) (“While ... it is undisputed that many purchasers buy such garments because they find

‘Bucky’ to be ‘cute’ or otherwise appealing and do not care about the particular quality of the goods or whether the University sponsors or endorses them, these facts are legally immaterial. ... *Taken to its logical conclusion, opposers’ argument would eliminate trademark protection and registrability for any popular and commercially successful design which is imprinted on clothing, irrespective of whether the design additionally is source-indicative to at least some consumers.”*) (emphasis added).

Bank also brushes off the importance of trademark licensing, set forth in Lanham Act Section 43(a), which prohibits uses of marks “likely to cause confusion, or to cause mistake, or to deceive as to the *affiliation, connection, or association* of such person with another person, or as to the origin, *sponsorship, or approval* of [goods].” (Emphasis added.) When customers purchase a product through legitimate channels bearing an NFL Mark, they may do so not only because it has their favorite team’s logo, but also because they know the product is “sponsored or approved” by NFLP and therefore is of quality high enough to warrant such approval. Bank’s assertion otherwise—that “nearly one hundred percent of [] purchases” bearing the NFL Marks are motivated by team affiliation rather than quality—is conclusory, contradicts his prior pleadings, and is unsupported by factual allegations, so the Court should not accept it as true. *See Dondero v. Chopra & Nocerino LLP*, 2022 WL 320967, at *1 (2d Cir. Feb. 3, 2022). Nor does it impact the result in any event, as discussed above. Bank creates a false choice between identification of origin and identification of allegiance that has no support in applicable trademark law.

IV. Conclusion

For the foregoing reasons, NFLP respectfully requests that the Court dismiss the complaint with prejudice.

Dated: June 30, 2025

Respectfully submitted,

/s/ Craig B. Whitney

PROSKAUER ROSE LLP

Craig B. Whitney

Jeffrey Warshafsky

Nicole Sockett

Nicole Swanson

Eleven Times Square

New York, NY 10036

T: (212) 969-3241

cwhitney@proskauer.com

jwarshafsky@proskauer.com

nsocket@proskauer.com

Attorneys for Defendant

NFL Properties LLC

CERTIFICATE OF COMPLIANCE

Pursuant to Local Rule 7.1(c) of the United States District Court for the Southern District of New York, I hereby certify that this brief contains 3,179 words. In making this certification, I have relied on the word count feature of Microsoft Word, the computer program that I used to prepare this brief.

Dated: June 30, 2025

/s/ Craig B. Whitney
Craig B. Whitney