

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 RESPONSE TO THE REPLY  
MEMORANDUM OF LAW THAT DEFENDANT SUBMITTED IN SUPPORT  
OF ITS MOTION TO DISMISS THE COMPLAINT PURSUANT TO RULES  
12(b)(1) AND 12(b)(6) OF THE FEDERAL RULES OF CIVIL PROCEDURE**

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## **RESPONSE TO DEFENDANT’S “INTRODUCTION”**

Defendant, NFL Properties LLC (“NFLP”), opens its reply brief not by addressing any of the points made in Bank’s opposition brief, but, instead, by attempting to sway the Court to take a dismissive attitude toward it. *See* Def. Reply Mem. at 1. Moreover, NFLP’s over-the-top self-serving characterization of Bank’s brief is false. Far from Bank’s brief’s being a “40-page . . . journey through lengthy quotes, tangents, and pontifications on what Bank thinks the law should be,” *id.*, and far from being “devoid . . . of applicable authority that the law is what Bank wishes it to be,” *id.*, the brief relies on both binding and non-binding, *i.e.*, persuasive, authorities that show, beyond question, that Bank has standing and that, in this Circuit, he is right on the merits, as NFLP’s purported trademark monopoly really is “built on sand.” Compl., ¶ 5 (citation and quotation marks omitted). Although the disparagement of Bank has been a key pillar of NFLP’s defense, the continuation of this *modus operandi* in NFLP’s reply does not make it any more appropriate and does not make it any more true.

## **ARGUMENT**

### **POINT I**

#### **PLAINTIFF HAS STANDING**

NFLP states: “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,” Def. Reply Mem. at 1-2 (emphases by NFLP); *see also id.* at 2 (“Bank’s complaint lacks evidence of any definite intent or apparent ability to engage in ongoing business operations.”); *id.* at 3 (“[Bank] provides no evidence of any plan to create a real or lasting enterprise.”); *id.* at 5 (“Bank is not pursuing a genuine business endeavor”). However, NFLP cites no authority for its false notion that Bank, in order to have standing, must intend to go into business in a long-term, or general, sense. *See* Pl. Opp. Mem. (Doc. 28) at 7-8. Indeed, NFLP’s letter to Bank (*see* Compl., Exh. “D”) did not threaten to sue him only if he placed

the FGM T-Shirts on sale in the context of such a business. Rather, NFLP threatened suit in the event that he were to take *any* action that NFLP (purportedly) believed to violate its trademark rights. *See* Pl. Opp. Mem. at 8. As it is indisputable that Bank has alleged, and shown, that he is ready, willing, and able to take such action by placing the 33 FGM T-Shirts on sale, and as NFLP has not indicated that its threat is good only at a threshold above 33 items, much less identified such threshold, *NFLP may not have it both ways*; that is, it may not maintain that it would sue Bank for acting in accordance with what he has alleged and shown, and, at the same time, claim that Bank's standing requires more than what he has alleged and shown. Thus, whereas NFLP claims that this case presents only the "illusion of a controversy," Def. Reply Mem. at 4, the actual illusion is NFLP's argument that there is *not* a controversy. Tellingly, NFLP never directly addresses, much less refutes, Bank's argument, that a general, long-term business is not required for standing.

NFLP, relying on the principle that a boldly told falsehood sounds true, states that, "Bank ignores the dispositive case law requiring a 'definite intent' and 'apparent ability' to use the NFL Marks in commerce," Def. Reply Mem. at 1, whereas, on the contrary: (i) Bank has gone beyond the requirements of that case law, *see* Pl. Opp. Mem., Point II; and (ii) NFLP falsely claims that, somehow, this case law favors NFLP when, in fact, the exact opposite is the case. *See* Pl. Opp. Mem., Point II.

NFLP describes "the uniform resource locator and domain name of [www.fairgamemerch.com](http://www.fairgamemerch.com) (the 'FGM Website')," Compl., ¶ 92, as a "password-protected, non-functioning website [Bank] created the day before filing this lawsuit." Def. Reply Mem. at 2, citing Pl. Opp. Mem. at 6. First, the timing of Bank's obtaining of the domain name, *i.e.*, on the same day as (but, prior to) the commencement of this action, is irrelevant. *See* Pl. Opp. Mem. at 7. Second, the content of the website, including its commercial pages, was designed before the date on which this action was commenced (not that it would matter if it had been created on the same day as, but prior to, the

commencement). Third, the commercial pages of the FGM Website are password-protected because, per the very nature of this case, Bank is not yet selling the FGM T-Shirts. Apparently, this is what NFLP means by describing the website as “non-functioning.” *Id.* at 2.

Whereas NFLP states that “[t]he remainder of the website is similarly underdeveloped,” Def. Reply Mem. at 4, this claim is simply boilerplate falsity. *See* [www.fairgamemerch.com](http://www.fairgamemerch.com) using, for the commercial pages, the password “fgmprivateview,” which would show that the website is functioning in all respects but one: it cannot currently accept orders per the very nature of this case.

NFLP, per its *m.o.* of carefully choosing its words for the obvious purpose of trying to maximize the potential for judicial bias against Bank, describes the current version of the FGM Website, which discusses and documents the present case, as “a sham intended to air grievances, not market NFL-branded merchandise.” Def. Reply Mem. at 3. However, the commercial pages of the website would operate “immediately upon being granted the relief requested herein[;] [that is][,] the [commercial] FGM Website Content [would] appear on the FGM Website (the ‘Post-Relief Website,’ a copy of the home page of which is attached as Exhibit ‘B’ hereto).” Compl., ¶ 94.

NFLP states: “[t]he 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.* at 4. Again, this is not “an error message,” as though Bank had tried to sell the FGM T-Shirts but could not figure out how to do so. Rather, that message is simply the result of the fact that the website is fully designed to sell the FGM T-Shirts but is not yet selling them. Of course, if “[t]he website’s purchasing features [*did*] work,” *that*, according to NFLP, “would thereby constitute trademark infringement, dilution, and/or unfair competition, and also will misappropriate the goodwill and reputation of the NFL and/or its Member Clubs,” Compl., Exh. “D” at 1-2, in which event NFLP would “treat any unauthorized use of the NFL Marks . . . as intentional and willful, which would entitle NFLP to enhanced damages and reimbursement of its attorneys’ fees.” *Id.* at 2.



Thus, according to NFLP, Bank *may not* sell the FGM T-Shirts, and yet, in order to have standing, *must* sell them. If NFLP really doubts that Bank is able to sell them, let NFLP enter into a stipulation with Bank allowing him to do so for a limited period of time without having to face a lawsuit.

NFLP states: “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.” Def. Reply Mem. at 3, n.1. According to this too-good-to-be-true argument (which, perhaps, is why NFLP puts it in a footnote), a trademark holder merely has to prohibit third parties from making its trademark in order to defeat standing in an action like the present one. In any event, this argument is irrelevant for two independent reasons. First, the 33 FGM T-Shirts in Bank’s possession, along with the ready-to-go commercial pages of the FGM Website, give him standing, thus making it irrelevant that “[h]e 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.” Def. Reply Mem. at 3. Second, though irrelevant given the first point, is that the Court’s granting of a declaratory judgment in favor of Bank would obviously make it most likely that Bank would find a willing manufacturer of more patches (that is, assuming that Bank would not purchase embroidery equipment and make them himself). That might not be certain, of course, but it need not be, for, “[t]o satisfy the redressability element of Article III standing, a plaintiff must show that it is likely as opposed to merely speculative, that the alleged injury will be redressed by a favorable decision.” *Marks-Ellis v. NYU Langone Health Systems*, No. 23-cv-9618, 2025 WL 1784814, \*6 (S.D.N.Y. June 27, 2025) (citations and quotation marks omitted).

NFLP states, regarding Bank’s purchase of the FGM domain name shortly before commencing this action: “Bank asserts that the timing of his actions is irrelevant. But in *Saleh v. Sulka Trading Ltd.*, No. 19-cv-8488, 2020 WL 4059803 (S.D.N.Y. July 20, 2020)], the court noted

that “[g]iven 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.” Def. Reply Mem. at 3, n.2, quoting *Saleh*, 2020 WL 4059803 at \*5. It is unclear what, if anything, NFLP is suggesting regarding a “lack of verifiable information” in this case: is it Bank’s possession of the FGM T-Shirts? The existence of the FGM Website? The fact that the actual t-shirts, rather than digital images, are shown on the website? If NFLP thinks that Bank has made false allegations, or submitted false evidence (presumably, in the exhibits to the Complaint), it ought to say so, upon which the matter should be addressed through jurisdictional discovery. However, NFLP’s indirect (at most) innuendo is pure nonsense. Indeed, NFLP appears to accept the truth of the facts upon which Bank relies for his standing. *See* Def. Reply Mem. at 2.

NFLP also makes a superficial, and entirely disingenuous, comparison between the present facts and *Saleh*’s mention of, *inter alia*, a website. *See* Def. Reply Mem. at 4. However, in *Saleh*, the court found, based on the website’s various problems, glitches, and shortcomings, *see Saleh*, 2020 WL 4059803 at \*6, that the site “simply does not amount to compelling evidence that [the plaintiff] is ready to immediately use the SULKA mark in commerce in the United States,” *id.*, and also found that the plaintiff had “provided no details to support his contention that he is ready to ship to customers in the United States.” *Id.* at \*5. NFLP’s continued reliance upon *Saleh* does not concern the facts in the present case, but, rather, shows NFLP’s eagerness to avoid a ruling on the merits.

NFLP also notes that in *Saleh*, the court found that the plaintiff had not ‘provided any hard evidence whatsoever to support [his] 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.’” Def. Reply Mem. at 2, quoting *Saleh*, 2020 WL 4059803. Again, Bank does not need to make any such allegations, or showings, because

he already possesses the FGM T-Shirts and a ready-to-go website.

NFLP is free to disparage Bank for merely having “taken . . . steps to establish . . . a fly-by-night business offering a smattering of NFL-branded apparel,” *id.* at 2-3, but that disparagement does not change the fact that Bank plainly has standing, just as it does not change the corresponding fact that NFLP has threatened to sue Bank if he were to engage in such supposed “fly-by-night business offering [such] smattering.” Again, NFLP may not have it both ways.

Interestingly, NFLP does not note that *Saleh*, in granting the defendant’s Rule 12(b)(1) motion, did so with leave to file an amended complaint, *see Saleh*, 2020 WL 4059803 at \*7; in any event, Bank’s Complaint, and the corresponding evidence, *see* Compl., Exh. “B,” and the FGM Website’s commercial pages, show that Bank has standing and does not need to file an amended complaint.

NFLP, again showing its real goal, *i.e.*, to avoid a ruling on the merits, asks the Court to decline to adjudicate this case because “Bank is not pursuing a genuine business endeavor,” Def. Reply Mem. at 5, but, “[a]s 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.” *Id.* Furthermore, Bank, according to NFLP, was required not only to intend to engage in a long-term business, but to be profitable, too. *See id.* (“[a]t \$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.”); *see also id.* at 5 (“Bank does not seek to create a profitable merchandising business because his actual business is filing lawsuits, not selling t-shirts.”). None of this castigation changes the fact that, potential profit or lack thereof, or “ability to launch a real business” or lack thereof, “the Complaint does not, and need not, allege that Bank intends to place more than the 33 FGM T-Shirts on sale, because the allegations of paragraphs ‘89’ through ‘98’ are themselves sufficient with respect to standing, for, even an identifiable trifle is enough for standing to fight out a question of principle.” Pl. Opp. Mem. at 8 (citation and quotation marks omitted).

NFLP *again* mentions two cases that Bank brought, *see* Def. Reply Mem. at 5, and, naturally, describes them so as to portray Bank as negatively as possible. *See id.* Of course, NFLP does not, because it cannot, explain how either of them are pertinent to the legal issues in *this* case. Indeed, they would not have been relevant even if Bank had prevailed in them. Instead, NFLP’s sole purpose in citing them is to prejudice this Court against Bank, because, evidently, NFLP believes (or, at least, hopes) that this Court would take those irrelevant cases into account.

NFLP’s final paragraph before addressing the (dreaded) merits of the case makes no sense. NFLP states that, “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.” Def. Reply Mem. at 5. Whether or not the present dispute is viewed as a “business dispute,” and whether or not it is in “further[ance] [of] [Bank’s] hobby of *pro se* ‘annoyance’ litigation,” do not change the nature of the dispute, the fact that it is concrete, the fact that Bank has, and has exceeded the requirements for, standing. Given these facts, NFLP’s contention that “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,” Def. Reply Mem. at 5 (citation and quotation marks omitted), is simply boilerplate, as is NFLP’s conclusion that, “Bank’s suits demonstrate gamesmanship that should not be rewarded or entertained.” *Id.*

## **POINT II**

### **WITH RESPECT TO THE MERITS, NFLP’S LEGAL ARGUMENTS ARE BASED NOT UPON PRINCIPLES OF TRADEMARK LAW, BUT, RATHER, ON A PERVERTED SIMULACRUM OF THOSE PRINCIPLES**

NFLP begins its section on the merits as follows: “[f]or 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.” Def. Reply Mem. at 5-6 (emphasis added). Of course, the emphasized portion of No. 3 dishonestly represents: (i) Bank’s position; (ii) the facts alleged regarding the nature of the NFL Principal Symbols; (iii) and common sense. In any event, for all of *its* bluster, NFLP’s argument on the merits can be summed up as follows: (1) the NFL Marks serve both source-identifying and allegiance-identifying purposes, but the latter is the same as the former, and, thus, by definition, not functional in any sense, *i.e.*, not in the utilitarian sense, not in the aesthetic sense, and not in the expressive or communicative sense; and (2) even if the allegiance-identifying purpose were functional in any (or all) of the aforementioned senses, “identify[ing] with their favorite Member Clubs,” *NFL Properties LLC v. The Partnerships*, No. 1:21-cv-05522 (N.D. Ill. Oct. 29, 2021), Amended Complaint (“*Partnerships AC*,” Doc. 26, a copy of which is attached as Exhibit “A” to the Declaration of Todd C. Bank in opposition), ¶ 8, it turns out, is an *afterthought* to, and thus *merely incidental* to, the main reason for such purchases, *i.e.*, the assurance, based upon the licensing agreement between NFLP and the manufacturer of the merchandise, that the merchandise “compl[ies] with NFLP’s rigorous quality standards,” Def. Mem. at 3, and, therefore, the allegiance-identifying functionality must be ignored, and the NFLP Marks should be given the same protection conferred by patent and copyright law, even though the latter two serve entirely different purposes than trademark law (indeed, unlike material that is protected by the latter two, the NFL-trademark monopoly should last forever).

NFLP seeks to distinguish, as follows, the utilitarian functionality that was found in *Brunswick Corp. v. British Seagull*, 35 F.3d 1527 (Fed. Cir. 1994): “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.” Def. Reply Mem. at 6. Entirely on the contrary, the court emphasized that the color of the engine’s paint (black) did *not* affect the use of the engine; that is, in “making the engine look smaller and more compatible with a variety of boats,” it was not functional in the *traditional*

utilitarian sense, because it “does *not* make the engines function better as engines[,] [and] [t]he paint on the external surface of an engine does *not* affect its mechanical purpose.” *Brunswick*, 35 F.3d at 1531 (emphases added). If, as NFLP argues, the color black affected the quality of the engines because of how it made them *look*, as opposed to having any effect on their mechanical performance or purpose, then the NFL Principal Symbols are, if anything, even *more* functional because they enable consumers to *do* something rather than merely *enjoy* something, *i.e.*, “to identify with their favorite Member Clubs,” *Partnerships AC*, ¶ 8, and the NFL Principal Symbols on the FGM T-Shirts are obviously “‘essential to th[at] use or purpose.’” Def. Reply Mem. at 6, quoting *Inwood Labs. v. Ives Labs.*, 456 U.S. 844, 850, n.10 (1982). Thus, the symbols are functional in the utilitarian sense, albeit not in the traditional, *i.e.*, technological way, but, rather, like (and even more than) the black paint in *Brunswick*.

NFLP contends that, “[c]ontrary 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.” Def. Reply Mem. at 6-7. NFLP is clearly suggesting that functionality is a defense to a claim of infringement only where the trademark (or trademarked feature) is *solely* functional, *i.e.*, is not source-identifying to any degree and thus not a mixed-use mark. Even aside from the fact that this makes no sense given that trademarks (or trademarked features), whether or not functional, are, by definition, source-identifying (to at least some degree), the Second Circuit, in recognizing the “unremarkable proposition,” did so precisely with respect to mixed-use trademarks. As shown on page 23 of Bank’s opposition brief, *Christian Louboutin, Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101 (2d Cir. 2001), and *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971 (2d Cir. 1987), each recognized not merely that functionality is a defense to a claim of trademark infringement, but, specifically, that this defense applies where the functional use of the

trademark causes consumers to be confused as to *source*, which, literally by definition, occurs only where the trademark is source-identifying. *See* 15 U.S.C. 1127 (“‘trademark[s]’ . . . identify and distinguish [one’s] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods”). Indeed, to what else, other than ‘mixed use,’ was the Supreme Court referring in stating that “[t]he Lanham Act . . . does not protect [a functional] trade[mark] . . . simply because an investment has been made to encourage the public to associate a particular functional feature *with a single manufacturer or seller*”? *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34-35 (2001) (emphasis added).

As “[t]he heart of a successful claim based upon ... the Lanham Act ... and common law trademark infringement is the showing of likelihood of confusion as to the source or sponsorship of [a competitor]’s products,” *Caliko, SA v. Finn & Emma, LLC*, No. 21-cv-3849, 2022 WL 596072, \*8 (S.D.N.Y. Feb. 28, 2022), quoting *Standard & Poor’s Corp. v. Commodity Exch., Inc.*, 683 F.2d 704, 708 (2d Cir. 1982), a trademark (or a putative trademark) that was *not* source-identifying would either not be, or could not act as, a trademark and thus could not be infringed in the first place, in which event the question of functionality (or any other possible defense to infringement) would be moot. Thus, like all defenses against infringement, the question of whether functionality defeats a trademark-infringement claim arises *only* where the trademark is source-identifying, *i.e.*, the question of functionality (like the question of other defenses) arises *only* with respect to mixed-use trademarks.

In *Wonderful Co. LLC v. Nut Cravings Inc.*, No. 23-7540-cv, 2025 WL 212064 (2d Cir. Jan. 16, 2025), which concerned trademark infringement (trade-dress infringement to be more precise, but a trade dress is simply a type of trademark, *see* Pl. Opp. Mem. at 18-19), *see id.* at \*1, the court “conclude[d] that the Complaint alleges enough of an overlap between the trade dresses in both appearance and product market to plausibly allege, for purposes of [Rule] 12(b)(6), that consumers viewing either [the plaintiff’s] or [the defendant’s] product package could be confused as to their true

source,” *id.* at \*4; that is, the court found that the trademark was valid because it was source-identifying. The court then addressed the question of whether the trademark was functional, *see id.* (and found that it was not, *see id.*). However, according to NFLP’s mixed-use denial, the court’s discussion of functionality was mooted by its finding of source identification. If that were so, the court would presumably have said so, but, of course, it did not.

NFLP continues in its patently disingenuous argument regarding mixed-use trademarks by claiming that “other circuits have flat-out rejected the reasoning in *Plasticolor* [*Molded Products v. Ford Motor Co.*, 713 F. Supp. 1329 (C.D. Calif. 1989), *vacated by consent judgment*, 767 F. Supp. 1036 (C.D. Calif. 1991)],” Def. Reply Mem. at 7, citing *one case regarding one Circuit, i.e., Ford Motor Co. v. Lloyd Design Corp.*, 184 F. Supp. 2d 665 (E.D. Mich. 2002). Although *Lloyd Design*, and the Sixth Circuit’s supposed rejection of “the mixed-use’ trademark theory,” Def. Reply Mem. at 6-7, would be irrelevant in any event given the law of the Second Circuit, *Lloyd Design* did not say that which NFLP attributes to it; that is, it did not say that the Sixth Circuit rejects “the mixed-use’ trademark theory” (and, of course, no Circuit does). Rather, the “[t]he Sixth Circuit has rejected *Plasticolor*’s reliance on the dual purpose of [the] [p]laintiffs’ trademarks being placed on floor mats,” Def. Reply Mem. at 7, quoting *Lloyd Design*, 184 F. Supp. 2d at 675, because “[t]he precedent in th[e] [Sixth] [C]ircuit suggests that *aesthetic functionality* will not preclude a finding of nonfunctionality where the design also indicates source,” *Lloyd Design*, 184 F. Supp. 2d at 675 (emphasis added; citation and quotation marks omitted). *See also* Pl. Opp. Mem. at 29. Although the law of the Sixth Circuit does not determine the applicable law in *this* Court, the Sixth Circuit has, in any event, since recognized the doctrine of aesthetic functionality. *See DayCab Co., Inc. v. Prairie Technology, LLC*, 67 F.4th 837, 847-848 (6th Cir. 2023).

NFLP notes that, “[a] mark is aesthetically functional where a mark holder’s exclusive use of it ‘would put competitors at a significant *non-reputation-related* disadvantage,’” Def. Reply Mem.



at 7, quoting *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995) (emphasis by NFLP), and that, “[i]n evaluating this, ‘courts must avoid jumping to the conclusion that an aesthetic feature is functional merely because it denotes the product’s desirable source.’” *Id.*, quoting *Christian Louboutin*, 696 F.3d at 222. First: a non-reputation-based disadvantage, and thus aesthetic functionality, exists where a trademark holder’s would-be competitor (here, Bank), if *precluded* from copying a trademark (here, the NFL Principal Symbols), would be at a significant disadvantage in the market *other than* the disadvantage of being unable to represent that the trademark holder is the Primary Product Source or a Product Sponsor of the competitor’s products. That is, the “reputation” in “non-reputation-related disadvantage” is the reputation of a trademark holder as either the Primary Product Source or a Product Sponsor of a product, *i.e.*, the reputation of a trademark holder *as* a trademark holder.

In *Qualitex*, the Court gave an example (a mixed-use example, no less) in which the “exclusive use of [a product] feature would put competitors at a significant non-reputation-related disadvantage,” *Qualitex*, 514 U.S. at 165:

Functionality doctrine . . . would require, to take an imaginary example, that even if customers have come to *identify* the special illumination-enhancing shape of a . . . light bulb *with a particular manufacturer*, the manufacturer *may not use that shape as a trademark*, for doing so . . . would *impede competition—not by protecting the reputation* of the original bulb maker, but by frustrating competitors’ legitimate efforts to produce an equivalent illumination-enhancing bulb.

*Id.* (emphases added). As another court explained:

[T]he “special illumination-enhancing shape of a . . . light bulb,” *even if identifying a particular manufacturer as the product’s source*, would not receive trademark protection if this would frustrate “competitors’ legitimate efforts to produce an equivalent illumination-enhancing bulb.” [*Qualitex*, 514 U.S.] at 165. Even if the light bulb shape *identifies a particular manufacturer as the source*, if that shape is deemed “functional,” it is *not a protectable trademark*.

*Who Dat Yat Chat, LLC v. Who Dat, Inc.*, No. 10-cv-1333, 2012 WL 1118602, \*12 (E.D. La. Apr. 3, 2012) (emphases added).

The *Qualitex* example’s competitor would be at a disadvantage in the market if precluded from copying the illumination-enhancing feature because, *irrespective* of that feature’s status as a trademark, and *irrespective* of whether consumers (incorrectly) believe that the trademark holder is the Primary Product Source or a Product Sponsor of the competitor’s light bulbs, the feature increases the demand for light bulbs that contain it. This type of disadvantage is the opposite of the type of disadvantage that would not, and, per common sense, *should* not be the basis of allowing a competitor to use another’s trademark, *i.e.*, a disadvantage based solely upon the lack of the right of a competitor to represent, with respect to the competitor’s products, that the trademark holder is the Primary Product Source or a Product Sponsor of those products. This latter type of disadvantage is a *reputation-based* disadvantage, whereas a primary purpose of trademark law is to *protect* the reputation a trademark holder in his capacity as a Primary Product Source or Product Sponsor. As the Supreme Court has explained:

[A] trademark . . . *identifies a product’s source* (this is a Nike) *and distinguishes that source from others* (not any other sneaker brand). In other words, a mark tells the public *who is responsible for a product*. [¶] In serving that function, trademarks benefit consumers and producers alike. A *source-identifying mark* enables customers to select “the goods and services that they wish to purchase, as well as those they want to avoid.” *Matal v. Tam*, 582 U.S. 218, 224 (2017). The mark “quickly and easily assures a potential customer that *this* [(emphasis in original)] item—the item with this mark—is *made by the same producer* as other similarly marked items that he [ ] liked (or disliked) in the past.” *Qualitex*[,], 514 U.S. [at] 164 (1995). And because that is so, the producer of a quality product may derive significant value from its marks. They ensure that the producer itself—and not some “imitating competitor”—will reap the financial rewards associated with *the product’s good reputation*. *Ibid*.

*Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 599 U.S. 140, 146 (2023) (emphases added).

The distinction between a reputation-related disadvantage and a *non*-reputation-related

disadvantage was applied in *Bubble Genius LLC v. Smith*, 239 F. Supp. 3d 586, 597 (E.D.N.Y. 2017), which, again addressing mixed use, recognized that “the non-functionality requirement *protects competition even at the cost of potential consumer confusion*,” *id.* at 594 (emphasis added; citation and quotation marks omitted), and explained, in ruling in favor of the trademark holder’s competitor, that, “protecting [the] plaintiff’s claimed trade[mark] would hinder competition for periodic[-]table[-]inspired novelty soaps; competitors in [the] market . . . for [such] soaps would be placed at a ‘*significant non-reputation-related disadvantage*’ if [the] plaintiff had *exclusive rights to produce and sell* [those] soaps.” *Id.* at 597 (emphases added).

Second: as to not “jumping to the conclusion that an aesthetic feature is functional merely because it denotes the product’s desirable source,” Def. Reply Mem. at 7, quoting *Christian Louboutin*, 696 F.3d at 222, the context in which that quotation appears shows that, again, the court was referring to trademark-law source identification, as *contrasted* to aesthetic functionality:

Because *aesthetic function* and *branding success* can sometimes be difficult to distinguish, the *aesthetic functionality analysis is highly fact-specific*. In conducting this inquiry, courts must consider both the markholder’s right to enjoy the benefits of its effort to distinguish its product *and* the public’s right to the “vigorously competitive market [ ]” protected by the Lanham Act, *which an overly broad trademark might hinder*. *Yurman Design, Inc.*, 262 F.3d at 115 (internal quotation mark omitted). In sum, *courts must avoid jumping to the conclusion that an aesthetic feature is functional merely because it denotes the product’s desirable source*.

*Christian Louboutin*, 696 F.3d at 222 (emphases added). Given that it is indisputable that the NFL Principal Symbols are desired by consumers in order “to identify with their favorite Member Clubs,” *Partnerships AC*, ¶ 8, it is, for that reason, indisputable that they are functional, with the only question therefore being whether Bank, as he alleges, “would be at a significant disadvantage in the market of NFL Fans,” Compl., ¶¶ 86, 88, “if unable to sell NFL Merchandise,” *id.*, *i.e.*, “merchandise bearing NFL Trademarks.” *Id.*, ¶ 2.

NFLP contends: “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.” Def. Reply Mem. at 8 (emphases by NFLP). First, the relevant market is “the market of NFL Fans,” *i.e.*, “people in the United States [who] purchase . . . merchandise . . . that [they] view as pertaining to an NFL Team, the League, or each.” Compl., ¶ 75 (NFLP’s contention that this cannot be the relevant market is addressed below). Second, such merchandise does not always need to bear an NFL Mark, nor does Bank allege that it does. Rather, Bank alleges, as shown above, that he would not be able to *adequately compete* without such marks, *i.e.*, without the NFL Principal Symbols. Third, as discussed below, Bank’s argument would obviously not “render every trademark aesthetically functional.”

NFLP contends that, “Bank’s argument that the NFL Marks’ popularity makes them functional is precisely what the Second Circuit cautions against,” Def. Reply Mem. at 7, because courts must ““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.*, quoting *Christian Louboutin*, 696 F.3d at 222 (emphasis added). Thus, and again per common sense, the court was referring to source identification, *i.e.*, a trademark’s role in identifying the source of a product, *i.e.*, the source within the meaning of trademark law, as opposed to the identification of a trademark holder in a capacity *other than* as trademark holder: in the present case, an NFL Team in its Team Capacity or the NFL in its League Capacity. This is made clear from the context in which NFLP’s selected quotation appears:

[A] product feature’s successful *source indication* can sometimes be *difficult to distinguish from the feature’s aesthetic function*, if any. . . . [F]iguring out which designs produce *a benefit other than source identification* can be tricky. Therefore, 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. See Wallace Int’l Silversmiths, Inc. [v. Godinger Silver Art Co., Inc.], 916 F.2d [76] at 80 [(2d Cir. 1990)] (rejecting argument that “the commercial success of an aesthetic feature automatically destroys all of the originator’s trademark interest in it, notwithstanding the feature’s secondary meaning and the lack of any evidence that competitors cannot develop non-infringing, attractive patterns”).*

*Christian Louboutin*, 696 F.3d at 222 (emphases added; citation and quotation marks omitted). Given that consumers typically purchase merchandise bearing NFL Principal Symbols “to identify with their favorite Member Clubs,” *Partnerships AC*, ¶ 8, “figuring out [whether those symbols] produce a benefit other than source identification” is not “tricky” at all, just as it is not tricky to figure out whether “identify[ing] with their favorite Member Clubs” is but an afterthought to such purchases so as to be “merely incidental” to the symbols’ quality-assurance, *i.e.*, trademark-law, role. Although NFLP seeks to avoid the *effects* of the fact that the NFL Principal Symbols enable consumers to “identify with their favorite Member Clubs,” NFLP does not actually deny that they do (indeed, how could it?).

In [Louis] *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769 (9th Cir. 1981), the court explained the difference between a trademark’s source-identification, *i.e.*, non-functional, benefits and *non*-source-identification, *i.e.*, functional, benefits: “[f]unctional features of a product are features which constitute the *actual benefit* that the consumer wishes to purchase, *as distinguished from an assurance that a particular entity made, sponsored, or endorsed* a product.” *Id.* at 774 (emphases added; citation and quotation marks omitted). Thus, “[i]f the [Louis] Vuitton mark increases consumer appeal *only* because of the *quality associated with [Louis] Vuitton goods*, or because of the *prestige associated with owning a genuine [Louis] Vuitton product*, then the design is serving the *legitimate function of a trademark*; it is *identifying the source of the product*, and thus should be protected. [¶] . . . [T]he only *legally relevant* function of a trademark is to *impart information as to the source or sponsorship of the product*.” *Id.* at 776 (emphases added; citation and

quotation marks omitted).

NFLP contends: “[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.” Def. Reply Mem. at 8. Similarly, NFLP contends that the NFL Principal Symbols are not “core, aesthetically functional elements,” Def. Reply Mem. at 8, but, instead, “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.” *Id.* at 8-9.

First, if a would-be competitor of, for example, Gucci or Nike wished to sell only Gucci or Nike merchandise, and brought the same type of action that Bank has brought, he would presumably fail; but, he would not fail because of his definition of the market, which would simply be based on the products at issue. Instead, he would fail because of the reasoning of cases like *Vuitton*. In any event, “[i]n deciding NFLP’s motion, it would not be possible to rule that, as a matter of law, Bank, absent the ability to use the NFL Principal Symbols, would nevertheless be able to adequately compete in the market [that NFLP contends is at issue, *i.e.*, the market] for ‘football-related merchandise.’” Pl. Opp. Mem. at 32, quoting Def. Mem. at 16. *Cf. Pennsylvania State Univ. v. Vintage Brand, LLC*, 715 F. Supp. 3d 602, 647 (M.D. Pa. 2024) (“*Penn State II*”) (“there are two likely markets that could apply to Penn State’s Marks: the collegiate goods market in general, or the Penn State-branded goods market specifically. The Court need not assess which market is at play here because, even accepting the narrower definition, it cannot be said, as a matter of law, that Penn State’s exclusive use and control of its marks would put Vintage Brand at a significant non-reputation related disadvantage” (footnote omitted); likewise, the court found that it could not be said as a

matter of law that Vintage Brand would *not* be put at a significant non-reputation related disadvantage.” *See* Pl. Opp. Mem. at 37-38.

Second, the functionality doctrine does not exempt a trademark because it serves a “core trademark function,” *i.e.*, source identification; rather, the notion of such an exemption regarding aesthetic functionality was the *Boston Hockey* association rationale (from *Boston Prof’l Hockey Assn v. Dallas Cap & Emblem Mfg. Corp.*, 510 F.2d 1004 (5th Cir. 1975)), which is not applicable in the Second Circuit; and, again: (i) if a trademark (or trademarked feature) did not serve a “core trademark function,” it would be ineligible for protection in the first place, in which case questions of functionality would be moot; and (ii) functionality trumps source identification. *See* Pl. Opp. Mem. at 18, 23. In short, NFLP’s “core trademark function” is just another way of denying the applicability of the functionality doctrine to mixed-use trademarks.

NFLP states: “[a] trademark does not define its own relevant economic market.” Def. Reply Mem. at 9, quoting 4 *McCarthy on Trademarks and Unfair Competition*, § 31:97 (5th ed. 2017) (a copy of which is attached as Exhibit “B” to the Declaration of Nicole O. Swanson (Doc. 32-2)). However, NFLP takes this quotation out of context. Section 31:97 did not address functionality, but, rather, the indisputable fact that, as a general matter, “[a] trademark does not define its own relevant economic market.” Interestingly, Section 31:97 also stated that this is not always the case: “this is not to say that a single brand of a product can never constitute a relevant market. For example, a relevant market may consist of those companies that sell service and parts for Kodak brand photocopying machines because the service and parts for Kodak equipment are not interchangeable with other manufacturers’ service and parts,” citing (in footnote) *Eastman Kodak Co. v. Image Technical Servs.*, 504 U.S. 451 (1992). *See also Eastman Kodak*, 504 U.S. at 481-482. Although common sense makes clear that merchandise bearing an NFL Principal Symbol is not interchangeable with other merchandise where a seller, like Bank, seeks to enable purchasers “to identify with their favorite

Member Clubs,” *Partnerships AC*, ¶ 8, it remains that, even under NFLP’s incorrect definition of the relevant market, *i.e.*, the market for “football-related merchandise,” Def. Mem. at 16, the question of whether Bank would be able to adequately compete in that market without using the NFL Principal Symbols cannot be resolved, in favor of either Bank or NFLP, on a Rule 12(b)(6) motion.

NFLP quotes as follows from *Savannah College of Art & Design, Inc. v. Sportswear, Inc.*, No. 14-cv-2288, 2019 WL 11542685, at \*4 (N.D. Ga. Mar. 1, 2019), *aff’d*, 983 F.3d 1273 (11th Cir. 2020): “[i]ndeed, 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.” Def. Reply Mem. at 8. However, the Eleventh Circuit, per *Boston Hockey*, does not recognize aesthetic functionality. *See* Pl. Opp. Mem. at 29-31. Furthermore, by the very nature of the functionality doctrine (regardless of the type of functionality), a competitor of a trademark holder *may* use the trademark; indeed, that is the whole point of the doctrine.

Theoretically, it is possible that most or virtually all consumers who purchase products bearing an NFL Principal Symbol view that symbol as an assurance of the product’s quality, or find the symbol appealing because of the prestige of owning an NFLP-licensed product. However, even if this were so (notwithstanding that it plainly seems doubtful), it would remain that: (i) such purchases are *also* driven by a desire “to identify with their favorite Member Clubs,” *Partnerships AC*, ¶ 8, in those Member Clubs’ Team Capacities (or to identify with the NFL in its League Capacity); and (ii) the ability of the NFL Principal Symbols to satisfy this desire is not ‘merely incidental’ to the purchases; indeed, it is a (and, realistically, *the*) main reason for them. *See* Compl., ¶¶ 80-83.

NFLP seems to acknowledge that the NFL Principal Symbols play more than a source-identifying role: “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.” Def. Reply Mem. at 9



(emphasis added). NFLP is right; it is only NFLP's implied *conclusion* that is wrong, *i.e.*, that "communicat[ing] allegiance to the NFL or a team" is "merely incidental" to the source-identifying role and therefore non-functional.

NFLP contends that, "[a] mark is protectable even when it serves both as a decoration or symbol of affiliation and an identification of source." Def. Reply Mem. at 9. For this contention, NFLP first cites *Texas Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510 (N.D. Tex. 2006). *See* Def. Reply Mem. at 9. First, *Texas Tech* addressed only one type of functionality, *i.e.*, utilitarian, *see Texas Tech*, 461 F. Supp. 2d at 520, in which the court treated such functionality as being of the technological type only, *see id.*; but, as Bank has argued, utilitarian functionality is broader than that. On the other hand, the court did not address aesthetic functionality; nor did it need to given that "[t]he Fifth Circuit rejects the doctrine of aesthetic functionality entirely." *Christian Louboutin*, 696 F.3d at 221, n.17.

Second, NFLP also cites *City of New York v. Blue Rage, Inc.*, 435 F. Supp. 3d 472 (E.D.N.Y. 2020), *see* Def. Reply Mem. at 9, but fails to refute Bank's discussion of *Blue Rage*. *See* Bank Opp. Mem. at 31-32.

NFLP argues: "[t]o conclude . . . [that a] mark is [not] protectable . . . when it serves both as a decoration or symbol of affiliation and an identification of source . . . 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." Def. Reply Mem. at 9. Similarly, NFLP cites *University Book Store v. Univ. of Wisc. Bd. of Regents*, Oppn. No. 84,223, 1994 WL 747886 (T.T.A.B. 1994), *see* Def. Reply Mem. at 9, for stating: "[t]aken 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.”” Def. Reply Mem. at 10, quoting *Univ. Book Store*, 1994 WL 747886 at \*22 (emphasis by NFLP), which adopted the *Boston Hockey* view. *See Univ. Book Store*, 1994 WL 747886 at \*22; *see also* Pl. Opp. Mem. at 29.

First, NFLP’s slippery-slope argument does not take into account cases such as *Vuitton*. Thus, NFLP’s scare tactic, *i.e.*, that “Bank[] attempt[s] to invalidate NFLP’s—and, by extension, *all*—trademarks,” Def. Reply Mem. at 1, is patently false, and whereas this argument implies that Bank’s arguments lack foundation, it is NFLP’s purported trademark monopoly that has “been built on sand.” *Pennsylvania State Univ. v. Vintage Brand, LLC*, 614 F. Supp. 3d 101, 114 (M.D. Pa. 2022) (“*Penn State I*”).

Second, the instant motion should be resolved based upon the relevant facts, Bank’s allegations, and the applicable law.

Third, as the Ninth Circuit Court of Appeals recognized:

It is not uncommon for a *name or emblem* that serves in one context as a . . . *trademark* also to be merchandised for its *own intrinsic utility to consumers*. *We commonly identify ourselves by displaying emblems expressing allegiances*. Our jewelry, clothing, and cars are emblazoned with inscriptions showing the organizations we belong to, the schools we attend, the landmarks we have visited, *the sports teams we support*, the beverages we imbibe. Although these inscriptions frequently include names and emblems that are also used as . . . trademarks, *it would be naive to conclude that the name or emblem is desired because consumers believe that the product somehow originated with or was sponsored by the organization the name or emblem signifies*.

*Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918 (9th Cir. 1980) (emphases added). *See also Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188, 1196 (S.D.N.Y. 1983) “[w]e commonly identify ourselves by displaying emblems expressing allegiances. Our jewelry,

clothing, and cars are emblazoned with inscriptions showing the organizations we belong to, the schools we attend, the landmarks we have visited, the sports teams we support, the beverages we imbibe. Although these inscriptions frequently include ... trademarks, it would be naive to conclude that the name or emblem is desired because consumers believe that the product somehow originated with or was sponsored by the organization the name or emblem signifies,” quoting *Job’s Daughters*, 633 F.2d at 918); *id.* (“[t]he Lanham Act imposes *no restraint on the free marketing of functional marks* which consumers or manufacturers mount on collateral items *as a means of personal expression*” (emphases added)); C. Knox Withers, Note, *Sine Qua Non: Trademark Infringement, Likelihood of Confusion, and the Business of Collegiate Licensing*, 11 Journal of Intellectual Property Law 421, 448 (2004) (describing the type of functionality in *Job’s Daughter* as “communicative functionality”); *id.* at 452-453 (“[p]rimarily, the ‘*Job’s Daughters*’ cases refuse to concede that consumers purchase unlicensed promotional items bearing registered trademarks *because* [(emphasis in original)] they believe that the mark owner sponsored the goods. Instead, these opinions adopt the notion that consumers buy those items in an attempt to *express allegiance to, or support for, the entity whose mark is used, irrespective of whether that entity actually endorsed the product or owned the trademark*” (emphasis added)); Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory Law Journal 461, 463, n.9 (2005) (“[i]magine, for example, that I am a Dallas Cowboys fan who wants to wear a Cowboys t-shirt *to show my support for the team*. In that case, the trademark is an *essential part of the product* I’m seeking-I am not looking to buy just *any* t-shirt, but a t-shirt *with COWBOYS as its defining feature*” (emphases added)).

NFLP contends: “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.” Def. Reply Mem. at 1. First, to the extent that there is “no competitive market for NFL-branded merchandise,” that is because “[t]he NFL has, to a considerable degree, convinced the public that the NFL has, and is legally entitled to have, a monopoly over the [NFL Principal Symbols] . . . . based not on fundamental principles of trademark law, but, rather, on a perverted simulacrum of those principles.” Compl., ¶ 2.

Second, prior to the house-of-sand trademark monopoly that the NFL created, there *was* a competitive market for NFL merchandise. *See* 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), whose author was in-house counsel for the NFL from 1994 to 2007, wherein she managed, *inter alia*, intellectual-property litigation (*see* author’s *curriculum vitae* at 2, available at [www.brooklaw.edu/media/qcybymcc/balsamcv2025a.pdf](http://www.brooklaw.edu/media/qcybymcc/balsamcv2025a.pdf) (last checked July 7, 2025)), and has been teaching sports law at New York University School of Law since 2016. *See id.* at 1.

Third, the instant case, which does not concern “Coca-Cola-branded products, Disney-branded products, or any other branded products,” should be resolved on its own merits.

Fourth, trademark law does *not* protect trademarks to the extent that they are functional, which the NFL Principal Symbols indisputably are; indeed, NFLP, obviously knowing this, seeks to avoid the required outcome by falsely contending that such functionality equals trademark-law source identification, thereby relying on the law of the Fifth Circuit rather than that of the Second Circuit.

NFLP concludes its reply with the same level of desperation with which it commenced it: “Bank also brushes off the importance of trademark licensing, set forth in Lanham Act Section 43(a) [15 U.S.C. § 1125(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].” Def. Reply Mem. at 10 (emphases by NFLP). First, the word “association” does not mean *Boston Hockey* association, but, consistent with “affiliation,” connection,” “origin,” “sponsorship,” and “approval,” means the association of a trademark holder with a specific product, *i.e.*, a trademark holder in its role as a Primary Product Source or Product Sponsor. See *Int’l Info. Systems Security Certification Consortium v. Security Univ. LLC*, 823 F. 3d 153, 161-162 (2d Cir. 2016); see also *Hamilton Int’l Ltd. v. Vortic LLC*, 13 F.4th 264, 272 (2d Cir. 2021) (“[t]o prove confusion, a plaintiff may show that the public believed the owner of the mark *actually produced the item and placed it on the market*, or that the public believed [that] the mark’s owner *sponsored or otherwise approved the use of the trademark*” (emphases added; citation and quotation marks omitted)).

Second, Bank does not deny that the NFLP Principal Symbols are source-identifying; however, functionality trumps source identification.

NFLP next states that, “[w]hen 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.” Def. Reply Mem. at 10 (emphases added). Thus, NFLP again acknowledges that such purchases are driven not only by trademark-law source identification, but also by the desire of consumers to purchase merchandise with “their favorite team’s logo” in order “to identify with their favorite Member Clubs.” *Partnerships AC*, ¶ 8. Thus, NFLP recognizes that, with respect to such purchases, the NFL Principal Symbols are mixed-use trademarks (but nonsensically contends that the functionality doctrine does not apply to mixed-use trademarks).

NFLP then states that, “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.” Def. Reply Mem. at 10. First: the Complaint’s allegations, that, “[i]nsofar as NFL Fans, in purchasing NFL Merchandise, know and care that the NFL has trademark rights in any of the features that enable that merchandise to satisfy one or each of the Primary Purposes, the importance of that fact to them is, with respect to nearly one hundred percent of the purchases, less important than the ability of those features to satisfy one or each of the Primary Purposes,” Compl., ¶ 82, and that, “[i]nsofar as NFL Fans, in purchasing NFL Merchandise, know and care that the NFL is a Product Sponsor of that merchandise, the importance of that fact to them is, with respect to nearly one hundred percent of the purchases, less important than the ability of that merchandise to satisfy one or each of the Primary Purposes,” *id.*, ¶ 83, are not required to be supported by evidence at the Rule 12(b)(6) stage.

In *GeigTech E. Bay LLC v. Lutron Electronics Co.*, 352 F. Supp. 3d 265 (S.D.N.Y. 2018) (McMahon, J.), *abrogated in part on other grounds*, *Cardinal Motors, Inc. v. H&H Sports Protection USA Inc.*, 128 F.4th 112, 124 (2d Cir. 2025), for example, this Court denied a motion to dismiss a trademark-infringement claim (*see id.* at 272-273), explaining that “Defendant’s arguments regarding the qualitative nature of Plaintiff’s advertising, its lack of consumer surveys, and questions regarding prior attempts to plagiarize are all evidentiary in nature and properly reviewed on motion for summary judgment.” *Id.* at 282. Essentially, NFLP contends that the above-quoted allegations are “conclusory” because the Complaint does not cite evidence, but as this Court recognized, evidence is required at the Rule 56 stage, not the Rule 12(b)(6) stage. That the Complaint does not support the aforementioned allegations with evidence does not make them “conclusory,” and it is difficult for Bank to avoid believing that NFLP’s charge in literally the last paragraph of its reply brief is intended as nothing but a kitchen-sink throwaway line; *see also* Def. Mem. in Chief at 1-2 (“[t]he . . . [C]omplaint adds no new facts to the prior complaints [(i.e., in *Bank I*)] relevant to the substantive claim—just improper legal argument and conclusory statements,” without citing any such supposed

statements). One court addressed, as follows, the overuse of defendants' claims that allegations are "conclusory":

A truly conclusory statement looks something like this: "CALIBER, on behalf of U[.]S[.] BANK, caused an illegal, fraudulent and willfully oppressive sale of PLAINTIFF'S PROPERTY, in clear violation of Civil Code § 2924." See [*Bell Atl. Corp. v. Twombly*, 550 U.S. [544] at 555 [(2007)]. ("[A] formulaic recitation of the elements of a cause of action will not do ....").

What is the relevant difference between a conclusory allegation on one hand, and a sufficient allegation on the other? The distinction can be a hard one to draw in formal terms. See *Brownlee v. Conine*, 957 F.2d 353, 354 (7th Cir. 1992) (referring to the term "conclusory," in the context of pleading, as an *ill-defined*, "*overused lawyers' cliché*"); see generally 5 Charles Alan Wright, et al., *Federal Practice & Procedure* § 1218 (3d ed.) (noting that "years of frustrating experience" show that it is "difficult, if not impossible, to draw meaningful and consistent distinctions between or among 'evidence,' 'facts,' and 'conclusions' —concepts that "tend [ ] to merge to form a continuum [with] no readily apparent dividing markers ... to separate them"). Better instead to approach the distinction in practical terms. To be effective, a plaintiff's complaint need only offer a set of facts that *put a defendant on notice* of a legal wrong the plaintiff alleges plausibly that the defendant committed. See *Twombly*, 550 U.S. at 556–57 (2007)

*Medrano v. Caliber Homes Loans, Inc.*, No. 14-cv-02038, 2014 WL 7236925, \*6-\*7 (C.D. Calif. Dec. 19, 2014) (emphases added). Clearly, the Complaint, including the allegations that NFLP contends are conclusory, has provided more than sufficient notice to NFLP of what this case is about (even absent those allegations, the Complaint indisputably provides sufficient notice).

Second: contradictions between (indeed, within) pleadings are irrelevant, but, in any event, NFLP does not explain how any such contradiction exists; and, to be sure, none does.

NFLP concludes its reply as follows: "Bank creates a false choice between identification of *origin* and identification of *allegiance* that has no support in applicable trademark law." Def. Reply Mem. at 10 (emphases added). As set forth in the Complaint, Bank's memorandum of law in opposition, and herein, it is NFLP that advocates for a false *equivalence* between the two.

### **CONCLUSION**

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

Dated: July \_\_, 2025

Respectfully submitted,

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**CERTIFICATE OF COMPLIANCE WITH REQUIREMENT OF LENGTH**

This memorandum of law complies with the Order dated July \_\_\_\_, 2025.

Dated: July \_\_\_\_, 2025

*s/ Todd C. Bank*

Todd C. Bank

**CERTIFICATE OF SERVICE**

I hereby certify that on July \_\_\_, 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 \_\_\_, 2025

**s/ Todd C. Bank**

Todd C. Bank