25-2940-cv

United States Court of Appeals

for the

Second Circuit

TODD C. BANK,

Plaintiff-Appellant,

– v. –

NFL PROPERTIES LLC,

Defendant-Appellee.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

SUPPLEMENTAL APPENDIX

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

TODD C. BANK, *Plaintiff*, -against- NFL PROPERTIES LLC, *Defendant*.	1:25-cv-03981-CM

PLAINTIFF'S MEMORANDUM OF LAW IN OPPOSITION TO DEFENDANT'S 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 "PRELIMINARY STATEMENT" AND "FACTUAL BACKGROUND"

Defendant, NFL Properties LLC ("NFLP"), cherry-picks from the career of Plaintiff, Todd C. Bank ("Bank"), for the obvious purposes of trying to prejudice and mislead the Court; for example: NFLP asserts: "[a]s Bank set forth in the amended complaint in *Bank I* [(Doc. 21; No. 1:24-cv-08814-CM)], but deleted from the current complaint, Bank . . .—as he previously pleaded— . . . is an 'annoyance lawyer' whose business is filing *pro se* lawsuits, not selling t-shirts." Def. Mem. at 2. However, the basis of this assertion is the amended complaint's *quotations of statements* in *NFLP*'s motion to dismiss the original Complaint in *Bank I*, *see Bank I*, Am Compl., ¶ 1; *see also id.* ("[NFLP] has shown . . . that it is willing . . . to not only offer dubious legal arguments . . ., but, evidently reflecting its lack of full confidence in those arguments, to attempt to sway this Court with utter irrelevancies"). NFLP repeats the statements here. *See* Def. Mem. at 3-4.

NFLP, as in *Bank I*, adds some editorializing to its cherry-picking statements, such as in stating, based upon three cases over a 21-year period, that Bank "routinely lodges unsuccessful challenges to well-established legal principles, without regard to the strain on courts and opposing parties." *Id.* at 4. Tellingly, NFLP does not even allude to any of its statements in the Argument section of its brief even though it had plenty of room to do so, its brief being several pages under the maximum. This is likely because, as NFLP correctly notes in its Argument section, NFLP would be entitled to dismissal for lack of subject-matter jurisdiction if Bank had not, prior to the commencement of the present action, taken sufficient steps to show intent to sell his t-shirts. That question, as opposed to NFLP's win-at-all-costs attack on Banks' credibility, is what matters. *See Malinowski v. Int'l Bus. Machines Corp.*, No. 23-cv-8421, 2025 WL 965812, *3 (S.D.N.Y. Mar. 31, 2025). In essence, NFLP is saying to this Court: "even if the Complaint contains sufficient allegations as pertains to Bank's intent to sell his t-shirts, this Court should assume, for purposes of

this dismissal motion, that those allegations are untrue." As NFLP surely knows, this is the opposite of the applicable standard.

As to Bank's legal theory, *i.e.*, the merits of this case, NFLP puts up a veneer of confidence that this theory is so weak as to constitute a "request that this Court dismantle U.S. trademark law," Def. Mem. at 1, as if there were a recent, or perhaps even not-so-recent, Supreme Court or Second Circuit ruling on point. However, the most on-point case that NFLP cites in its favor is a roundly criticized Fifth Circuit ruling from 1975 that is in precise opposition to more recent rulings of the Supreme Court and Second Circuit (making, embarrassingly ironic, NFLP's false accusation that Bank relies upon "outdated" (Def. Mem. at 16) case law ranging from 1983 to 2024, *see* Def. Mem. at 16-19). Given NFLP's purported confidence regarding the merits, one might think that NFLP would welcome the opportunity to receive a favorable ruling. However, NFLP spends most of its brief virtually, and with utter disingenuousness, begging the Court not to address the merits, with respect to which NFLP proceeds with equal disingenuousness.

NFLP states: "Bank presses his claim for a declaratory judgment that all trademarks owned by the National Football League ('NFL') and its 32 member clubs ('Member Clubs') are unprotectable," Def. Mem. at 1, but, as NFLP knows, this is false, as Bank's "claim for a declaratory judgment" concerns only what he calls the 33 "NFL Principal Symbols," which are the "'NFL Shield,' [which] is the most widely known [trademark] to represent the National Football League," Compl., ¶ 73, and "32 [trademarks], each of which corresponds to one of the NFL Teams [and] are the most widely known to represent the NFL Teams," *id.*, ¶ 74; *see also id.*, ¶¶ 89-91, 96, 98, and Exh. "A."

NFLP, continuing its attempt to mislead the Court with prejudicial nonsense, states that Bank is trying "to convince the Court of a sudden intent to become an online retailer of NFL merchandise rather than a career plaintiff." Def. Mem. at 2. However, insofar as Bank has been "a career plaintiff," and even aside from the requirement to treat factual allegations as true at the motion-to-dismiss stage,

one can obviously be a "a career plaintiff" and also sell t-shirts online.

NFLP complains that Bank engaged in a "ruse" by referring to "John Doe" rather than himself in Bank's letter that is attached as Exhibit "C" to the Complaint. Def. Mem. at 5. However, that has nothing to do with the question of whether NFLP is entitled to dismissal.

NFLP contends: "Bank . . . *refiled* his complaint—effectively a second amended complaint—in a new action rather than opposing NFLP's motion to dismiss or seeking leave to file a second amended complaint" in *Bank I*. Def. Mem. at 1 (emphasis by NFLP). Rather, Bank filed a new action in order to ensure his standing, *i.e.*, that this Court would have subject-matter jurisdiction, in connection with which Bank, prior to the present action's commencement, took numerous steps that he had not taken prior to the commencement of *Bank I*, *see* Compl., ¶¶ 89-98; and, as NFLP itself notes, the determination of subject-matter jurisdiction "must be made considering *only the facts and circumstances at the time the suit was filed*," Def. Mem. at 8 (emphasis added), such that Bank could not have relied upon those steps to seek leave to amend. NFLP, aware of this, offers its Plan B argument, which is that those steps were insufficient and therefore show that Bank improperly used them as an excuse to file a new action. *See* Def. Mem. at 5-6. This Plan B argument ignores the indisputable fact that Bank's steps not only meet the criteria for standing, but went well beyond those criteria, thereby making this argument plainly frivolous. *See* Point II, *infra*.

ARGUMENT

POINT I

THE COMPLAINT'S LEGAL EXPLANATIONS FOR THE REQUEST FOR RELIEF DO NOT VIOLATE THE FEDERAL RULES OF CIVIL PROCEDURE

NFLP states: "'[i]t is inappropriate to include a legal argument and briefing within a complaint.'" Def. Mem. at 6, quoting *Hayles v. Aspen Props. Group, LLC*, No. 16-cv-8919, 2018 WL 3849817, *4 (S.D.N.Y. Aug. 13, 2018). In *Hayles*, the proposed amended complaint included

legal arguments explaining why the court had been wrong in the ruling that prompted the filing of that proposal, *see Hayles*, 2018 WL 3849817 at *4, and the court explained that "such an argument could [have] be[en] made in a motion to reconsider." *Id. Hayles* cited *Anthes v. New York Univ.*, No. 17-cv-2511, 2018 WL 1737540 (S.D.N.Y. Mar. 12, 2018), in which the plaintiff, in his proposed amended complaint, had "copied and pasted legal arguments from his papers opposing defendants' motion to dismiss." *Anthes*, 2018 WL 1737540 at *19. Thus, under *Hayles* and *Anthes*, the inclusion of legal arguments is improper in a proposed amended complaint where the plaintiff has either already, or already had the opportunity to have, made those arguments in, or in opposition to, a motion.

Although "'[t]he federal rules effectively abolish the restrictive theory of the pleadings doctrine, making it clear that it is unnecessary to set out a legal theory for the plaintiff's claim for relief,'" *Johnson v. Shelby, Miss.*, 574 U.S. 10, 12 (2014), quoting 5 C. Wright & A. Miller, *Federal Practice and Procedure*, § 1219 (3d ed. 2004), this does not mean that the loosening of the pleading requirement prohibits a complaint's inclusion of legal theory (although Bank recognizes that some District Court opinions in this Circuit have stated otherwise).

In *Broidy Capital Mgmt. LLC v. Benomar*, 944 F.3d 436 (2d Cir. 2019), the court stated: "permitting plaintiffs to amend their complaint as requested would have been futile. Plaintiffs' proposed amended complaint simply adds conclusory allegations and *legal arguments* already *either included in the original complaint or presented to the district court in plaintiffs' opposition to the motion to dismiss*." *Id.* at 447 (emphases added; footnote omitted). However, the court did not imply that the proposed complaint's inclusion of legal arguments was improper as a general matter, but only that, as those arguments had already been presented to the court in opposition to the dismissal motion, which the court had properly granted (*see id.* at 441), the repetition of those arguments in the proposed amended complaint did not overcome the latter's futility.

In *Schwartzco Enterprises LLC v. TMH Mgmt.*, LLC, 60 F. Supp. 3d 331, 338 (E.D.N.Y.

2014), the defendant argued that he "'would certainly be prejudiced by allowing [] an amend[ed] [complaint], which consists no less than 74 pages and often reads as a legal brief, because it would force him to expend significant additional resources in responding thereto and unnecessarily delay his rightful dismissal from this litigation.'" *Id.* at 338. However, the court rejected this argument: "to the extent the proposed amended complaint contains legal arguments, [the defendant] has had ample opportunity to respond to those arguments, thereby minimizing any prejudice." Likewise, NFLP had that opportunity in its dismissal motion. Indeed, NFLP: (i) took the opportunity to address some of the Complaint's legal explanations, *see* Def. Mem. at 16-19, albeit while ignoring the various scholarly opinions that support Bank's position, including by an author who was in-house counsel for the National Football League from 1994 to 2007, and managed, *inter alia*, intellectual-property litigation, *see* Compl., ¶¶ 3, 33, 58; (ii) did not move to strike the legal explanations; (iii) did not ask Bank to withdraw the explanations, such as by stipulation or by filing an amended complaint; (iii) submitted a brief that is several pages under the maximum, and thus cannot complain that it was unable to address any of the explanations; and (iv) did not request permission to exceed the page limit so as to be able to address the explanations. Thus, it is clear that NFLP has not been prejudiced.

POINT II

PLAINTIFF HAS STANDING

In *Saleh v. Sulka Trading Ltd.*, 957 F.3d 348 (2d Cir. 2020), the court observed: "to determine whether the case-or-controversy requirement was satisfied '[i]n a declaratory judgment action involving trademarks,'" *id.* at 354, quoting *Starter Corp. v. Converse, Inc.*, 84 F.3d 592, 595 (2d Cir. 1996), "the plaintiff [must] adequately allege 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,'" *id.*, quoting *Starter*, 84 F.3d at 595-596; that is, the plaintiff "must allege that he is prepared to sell products bearing the [relevant] mark in the United States." *Id.* In *Saleh*: "[v]irtually all of the conduct

alleged in the FAC, however, relates to Saleh's business activities in India and Thailand. Saleh alleges that he 'could' expand his business to cover the United States, but does not allege that he has taken any steps whatsoever to do so." *Id.* at 355. Thus, "[i]t [was] not enough for Saleh to aver that he has the intent and ability to enter the U.S. market; he [was required to] point to specific conduct on his part that evidences such intent and ability." *Id.*

Saleh further observed:

> [A]s of the date that the [FAC] was filed, Saleh was *not in possession of any actual shirts* bearing the [] mark. His *website*, which purported to offer such shirts for sale, *simply digitally added the mark to images of the shirts*. Only after Saleh filed his opposition to the motion to dismiss did he represent that he had finally received "*samples*" of the actual shirts from his supplier. That Saleh *lacked any inventory for months after this lawsuit was filed undermines his assertion that he would be able to quickly transition his business to the United States*.

Id. at 355-356. By contrast: (i) Bank possesses the merchandise, *i.e.*, the FGM ("Fair Game Merch") T-Shirts, *see* Compl., ¶¶ 89-91, 95, 96; (ii) "[t]he images of the FGM T-Shirts that would appear on the Post-Relief Website, *see* Exh. 'B,' are of the actual FGM T-Shirts as opposed to any non-physical, *e.g.*, digital, versions," *id.*, ¶ 98; and (iii) Bank would not merely be able to "quickly transition" to putting the FGM T-Shirts on sale upon obtaining a declaratory judgment, but would do so "immediately upon being granted the relief requested herein." *Id.*, ¶ 94.

As the Complaint alleges: (i) rather than "'actively preparing to produce the article in question,'" Def. Mem. at 10, quoting *Starter*, 84 F.3d at 596, which is "'the last point before the point of no return,'" *id.*, quoting *Starter*, 84 F.3d at 596, Bank went beyond that, *i.e.*, he has *already produced* the articles in question, *see* Compl., ¶¶ 89-91, and has thus gone beyond merely "demonstrat[ing] an actual intent and ability to imminently engage in the allegedly infringing conduct," *Starter*, 84 F.3d at 596; (ii) Bank is not "actively preparing" to create an online store; rather, he has *already created* it, *see id.*, ¶¶ 92-94, 96, 98; (iii) Bank is not "actively preparing" to

"obtain[] the uniform resource locator and domain name of www.fairgamemerch.com (the 'FGM Website')," *id.*, ¶ 92; rather, he has already done so, *see id.* (NFLP complains that this was done on "the morning before filing this latest lawsuit," Def. Mem. at 2, as if a certain passage of time needed to occur between the taking of relevant steps (or, at least, this step) and the commencement of the present action in order for Bank to have standing, but, of course, NFLP cites no authority for this nonsensical notion; (iv) Bank is not "actively preparing" to take "all necessary preliminary steps to enable the Post-Relief Website to immediately operate upon being granted the relief requested herein, *i.e.*, to enable purchases, accept payments, and collect applicable sales taxes," Compl., ¶ 97; rather, he has *already taken* those steps. *See id.*

NFLP contends that Bank has taken only "a series of superficial acts," Def. Mem. at 2, *i.e.*, "perfunctory steps to create an appearance of legitimacy," *id.* at 9; *see also id.* ("creating ***one*** t-shirt bearing a trademark for each NFL Member Club, as well as one for the NFL itself (for a total of just 33 shirts), were not for the genuine purpose of establishing an online retail store to sell merchandise bearing NFL trademarks, but rather as an ill-conceived attempt to overcome the deficiencies raised by NFLP in *Bank I*," *id.* (emphasis by NFLP)); *id.* ("*Bank* has no prior experience in the sports merchandizing industry or any online retail"). NFLP is simply wrong. First, NFLP does not deny any of the allegations of paragraphs "89" through "99" of the Complaint, which must be deemed true. In any event, the Complaint's "one page of basic content for the website," Def. Mem. at 6, clearly supports the allegations of paragraphs "89" through "99" in any event, *see* Compl., Exh. "B," and includes hyperlinks to additional pages titled "Home," "Terms," "Privacy," "Contact," and "Cart/Checkout," *see* Exh. "B" at 4, which can be accessed at www.fairgamemerch.com with the password "fgmprivateview."

Second, NFLP: (i) incorrectly treats the Complaint as expressing Bank's intent "to become an online retailer" (Def. Mem. at 6) in a general, long-term sense; and (ii) suggests that the allegations

of paragraphs "89" through "99" do not reflect such intent. However, 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, "[e]ven [a]n identifiable trifle is enough for standing to fight out a question of principle," *Citizens for Responsibility and Ethics in Washington v. Trump*, 953 F.3d 178, 189 (2d Cir. 2019), *vacated on other grounds*, *Trump v. Citizens for Responsibility and Ethics in Washington*, 141 S. Ct. 1262 (2021) (citation and quotation marks omitted) (whether 33 t-shirts constitute a trifle is, of course, a matter of opinion, but, again, is irrelevant). It is therefore hardly surprising that NFLP cites no authority in support of its implied notion that Bank's standing requires him to allege or demonstrate the intent to place a minimum number of items on sale (let alone that such minimum must exceed 33).

NFLP stated in its letter to Bank (Compl., Exh. "D") that "NFLP will treat *any* unauthorized use of the NFL Marks by your client as intentional and willful, which would entitle NFLP to enhanced damages and reimbursement of its attorneys' fees." *Id.* at 2 (emphasis added). Of course, "*any* unauthorized use" would include the placement of even *one* FGM T-Shirt on sale, let alone 33.

NFLP relies upon *Geisha, LLC v. Tuccillo*, 525 F. Supp. 2d 1002 (N.D. Ill. 2007), *see* Def. Mem. at 9, but *Geisha* did not hold that one must have experience in a particular business in order to have standing in a case like the present one; rather, *Geisha* reasoned that, "'play[ing] around with the menu' and beginning to search for a suitable location did not demonstrate actual preparations that 'advanced significantly beyond [a] statement of intent.'" Def. Mem. at 8, quoting *Geisha*, 525 F. Supp. 2d at 1007, 1015. As to experience, NFLP omits the context, which was: "[a]s of the time of his deposition . . ., [the defendant] had not found a location . . ., and when asked directly if he had found a property, he answered that he merely "ha[s] some properties in mind," *Geisha*, 525 F. Supp. 2d at 1015; "when asked to explain what he meant by 'aggressively pursuing' a location, he answered, 'I am out myself driving around and doing my due diligence,'" *id.*; and: "[e]ven his testimony that he

was searching in Manhattan's meatpacking district is offset by the fact that he also testified to looking in other areas near the city, including Nassau County and elsewhere on Long Island. Nor does the record reveal whether [he] has ever opened a restaurant before, or indeed whether he has any food service experience beyond his frozen seafood business." Under *Geisha*, Bank's lack of experience might have been relevant if Bank were not ready, willing, and able to sell the FGM T-Shirts.

NFLP's invocation of *Starter*, *see* Def. Mem. at 10, is misleading. *Starter* found standing, *see* *Starter*, 84 F.3d at 596-597, where:

> Starter's complaint alleges that but for Converse's threat of a trademark infringement suit, Starter would have been immediately prepared, at the time the complaint was filed, to begin manufacture and sale of shoes bearing the Starter Marks. It has invested a significant amount of time and money in this project; designed styles and prepared prototype shoes; conducted a consumer survey; made strategic decisions regarding who should manufacture the shoes; hired an external licensing agent; and attempted to find a manufacturing partner. It is this final step that Starter claims has been delayed by Converse's threats of litigation.

Starter, 84 F.3d at 596. Bank is *ahead* of the plaintiff in *Starter*, as Bank was not merely "prepared, at the time the complaint was filed, to begin manufacture" of the 33 FGM T-Shirts, and had not merely "designed styles and prepared prototype[s]," but had *already* made the shirts, and since then and now, possess them, and is ready, willing, and able to sell them. Whereas the plaintiff's spending of "a significant amount of time and money" might have been relevant in *Starter* to assessing the plaintiff's preparedness to sell merchandise that *had not yet been made*, the question of how much time and money Bank spent, or even *whether* he spent any time or money, is irrelevant because he already possesses the FGM T-Shirts.

Although the *Starter* plaintiff's "conduct[ing] [of] a consumer survey" was one of "the steps *Starter* has taken are specific and evidence a concrete intention," *Starter*, 84 F.3d at 597, Bank did not need to make such allegation, because Bank, unlike the *Starter* plaintiff, has the merchandise at

issue and is ready, willing, and able to place it on sale. As the Second Circuit has explained:

> We *emphasize* that we do not mean to imply that *any particular action or combination of actions is always necessary to find that a case or controversy exists*. For example, because he intends to start an *online store*, [the plaintiff] may not need to cultivate relationships with retail partners. *Nor do we hold* that *Starter* or any other case *sets out the bare minimum that a plaintiff must do before a declaratory judgment action can be maintained, for each case must be judged on its own merits*.

Saleh, 957 F.3d at 356 (emphases added).

NFLP's reliance on *Sobini Films v. Tri-Star Pictures, Inc.*, No. 01-cv-06615, 2001 WL 1824039 (C.D. Calif. Nov. 21, 2001), *see* Def. Mem. at 10, fares no better. There, the plaintiff "assert[ed] that it has developed a written treatment for a major motion picture with the working title 'Zorro 2040,'" *id.* at *1, and the court ruled against standing because the plaintiff "has nothing comparable to the plaintiff's prototype shoe provided to the *Starter* court. In fact, Sobini has not even reached 'preliminary agreements' or obtained commitments from 'key talent' such as a director and lead actors, nor has Sobini even entered into a contract with a writer (or writers) to create a screenplay for 'Zorro 2040.'" *Id.* at *5. The court also found that "Sobini has no writer for a screenplay and has not hired, nor even entered into preliminary agreements with, the parties integral to the commencement of production of a major motion picture," *id.* at *6, that there was no "estimated time frame for completing the potentially infringing product," *id.* at *7, and that, "it is also possible that the final product will not infringe on any trademark." *Id.* The night-and-day differences between *Sobini* and the present case are obvious.

NFLP requests that, the question of standing aside, "the Court should also use its discretion to decline to proceed with the declaratory judgment action," Def. Mem. at 10, based upon *Rolex Watch U.S.A., Inc. v. PRL USA Holdings, Inc.*, No. 12-cv-6006, 2015 WL 1909837 (S.D.N.Y. Apr. 25, 2015). *See id.* However, unlike in *Rolex*, a declaratory judgment would not "require the Court

to 'construct the future framework of the interaction between the parties in the absence of a specific dispute about an imminent activity.'" *Id.* at 11, quoting *Rolex*, 2015 WL 1909837 at *4. The court further explained: "PRL's evidence of its intent is mostly circumstantial, and well short of conclusive. It is noteworthy, for example, that PRL has not been able to produce stronger evidence of its intentions to commercialize the new marks, in the form of an email, a business plan, or a product design contemporaneous to the application." *Rolex*, 2015 WL 1909837 at *7. Bank's plan, by contrast, is both imminent and fully set forth. *See* Compl., ¶¶ 89-98.

NFLP attempts to mislead the Court by stating: "[s]imilarly, proceeding with this declaratory[-]judgment action would require the Court to make myriad assumptions about Bank's potential conduct because he has yet to commercialize or place the products in the marketplace." Def. Mem. at 11. First, the very nature of the present case (or any other of its type), which seeks to avoid the risk of being sued under the Lanham Act, 15 U.S.C. §§ 1051 - 1141, is that the party seeking a declaratory judgment has not yet "commercialize[d] or place[d] the products in the marketplace." The lack of doing so, therefore, was not the reason why *Rolex* declined to preside over the request for such judgment. Rather, as shown in the above quotation, it was because the party seeking the judgement, unlike Bank, had not sufficiently set forth a plan to "commercialize or place the products in the marketplace." According to NFLP's sophistic contention, one must infringe upon a trademark (*i.e.*, from the markholder's perspective) in order to seek a declaratory judgment whose sole purpose is to avoid the risk of being sued for that very (putative) infringement. It is thus unsurprising that the only way in which NFLP is able to make this nonsensical argument is to engage in such sophistry.

NFLP's reliance upon *Bruce Winston Gem Corp. v. Harry Winston, Inc.*, No. 09-cv-7352, 2010 WL 3629592 (S.D.N.Y. Sept. 16, 2010), *see* Def. Mem. at 11, fares just as poorly. There, the plaintiff had "filed an 'intent-to-use' . . . [a]pplication for the trademark BRUCE WINSTON" with the United States Patent and Trademark Office [('USPTO')]," *Bruce Winston*, 2010 WL 3629592

at *2, which the defendants opposed before the USPTO's Trademark Trial and Appeal Board ("TTAB"), *see id.*, leading to "the TTAB trial phase . . .[;] but the [TTAB] proceedings were stayed after [the plaintiff] filed the declaratory judgment action ['DJA']." *Id.* The court, noting that, "[t]his is an unusual case," *id.* at *4, as "[t]he defendants have not alleged in this case that what [the plaintiff] is doing is infringing [their] marks[;] [i]ndeed even after reviewing [the plaintiff's] single advertisement in the New York Times, two issues of a trade journal and its appearance at a trade show, the defendants concede that these actions do not infringe HWI's marks," *id.*, such that, "[e]ven taking all of the asserted . . . activities into account, [the defendants] do[] not assert that those actions have violated [the defendants'] marks and has represented to the Court that it has no intent to stop those activities," *id.*, meaning that, "[t]hus, to date, [the plaintiff] has not engaged in any infringing activities and has not put forth evidence suggesting it has any intent or ability to do so." *Id.*

The court declined to exercise DJA jurisdiction on the above facts, observing: "[t]here are numerous hypothetical situations that could cause actual conflicts between the parties. For example, while the defendants have not objected to the plaintiff's advertisements or signs, it is conceivable that future advertisements could be misleading or deceptive. While the plaintiff has not presented any plans for a retail store, much less any details for such a store, the defendants might well object to such plans, depending on all the circumstances." *Id.* at *5. Therefore, the court concluded, "[t]his is not a case where the plaintiff needs an adjudication of its rights so that it can conduct its business affairs without . . . risking potential damages," *id.*, but, instead, "is a case where the defendants do not object to the plaintiff's current [conduct], and the only immediate and definite controversy is over the registration of that mark," but that controversy was already before the TTAB, *see id.*, such that "[t]he effect of the current proceeding is to derail the TTAB proceeding without the resolution of any other specific concrete controversy." *Id.* at *6.

It goes without saying that the facts of the present case are not even remotely analogous to

the facts that prompted *Bruce Winston* to decline hear the DJA.

POINT III

WITH RESPECT TO CONSUMERS'S ASSOCIATING OF THE FGM T-SHIRTS' NFL PRINCIPAL SYMBOLS WITH AN NFL TEAM IN ITS TEAM CAPACITY, OR THE NFL IN ITS FOOTBALL-LEAGUE CAPACITY, THOSE SYMBOLS ARE NOT SOURCE IDENTIFIERS UNDER TRADEMARK LAW

NFLP gives away the game beginning on page one of its brief:

> Bank presses his claim for a declaratory judgment that all trademarks owned by the National Football League ("NFL" [(or the "League")]) and its 32 member clubs ("Member Clubs" [(or "NFL Teams")]) are unprotectable because consumers who buy NFL-branded products *associate the NFL trademarks with the NFL or its Member Clubs*, that is, with the *source or sponsor of the product*. Bank's claim fails because *that association by consumers is precisely what trademark law protects*—the goodwill that a business creates through its operations and identifies with its trademarks. Contrary to Bank's contention, there is *no distinction under U.S. trademark law between the NFL and its Member Clubs . . . as "Primary Product Sources"* [(*see* Compl., ¶ 19 ("[t]he NFL does not manufacture, *i.e.*, is not the 'Primary Product Source' of, NFL Merchandise," *i.e.*, "merchandise bearing NFL Trademarks," *i.e.*, "certain names and symbols of the NFL Teams and the League," *id.*, ¶ 2))] *or "Product Sponsors"* [(*see id.*, ¶ 20 ("[t]he NFL is affiliated with NFL Merchandise as a 'secondary source' by sponsoring, or endorsing, it by licensing third parties to manufacture it, and is therefore a 'Product Sponsor' of NFL Merchandise."))] *(i.e., trademark holders) and as a football league and teams*.
>
> ***
>
> Merely because consumers may purchase products bearing NFL Marks to communicate allegiance to the league or a team does not make the trademarks aesthetically functional under the law. Instead, the fact that fans ***associate*** *the NFL Marks with the NFL and its Member Clubs* (*see* Compl. ¶¶ 76-83) means that the NFL Marks serve as ***source identifiers***—*which is precisely what trademark law protects*. *See* 15 U.S.C. § 1125(a)(1)(A) (any person who uses another's trademark in a manner that "is likely to cause confusion . . . as to the origin, sponsorship, or approval of his [] goods . . ." is liable for trademark infringement).

Def. Mem. at 1, 15 (emphases added, except for "which is precisely what trademark law protects,"

which was emphasized by NFLP; ellipsis in second para. by NFLP). As this quotation shows, NFLP's argument concerns a consumer's association of an NFL Trademark (*i.e.*, an NFL Principal Symbol as pertains to the present case) with an NFL Team or the NFL (or "League") itself. That argument, as pertaining to the present case, is:

> **(i)** Bank alleges that the NFL Principal Symbols on the FGM T-Shirts are functional under trademark law because consumers would associate those symbols with "an NFL Team in its capacity as a football team ('Team Capacity') or with . . . the [NFL] in its capacity as a football league ('League Capacity')," Compl., ¶ 76;
>
> **(ii)** Bank *contrasts* the Team Capacity and League Capacity with what Bank refers to as the capacities of an NFL Team and the NFL as "Primary Product Sources or Product Sponsors," Compl., ¶ 76, *i.e.*, as trademark holders; and
>
> **(iii)** Insofar as the FGM T-Shirts' NFL Principal Symbols create the type of association upon which Bank's allegation of functionality is based, those symbols are, in fact, *non*-functional because "there is *no distinction* under U.S. trademark law between the NFL and its Member Clubs as what [Bank] defines as 'Primary Product Sources' or 'Product Sponsors' (i.e., *trademark holders*) and as *a football league and teams*," and, therefore, the FGM T-Shirts' NFL Principal Symbols, instead of being functional with respect to the type of association that Bank invokes, are, instead, "*source identifiers*" with respect to that association, *i.e.*, they denote "'the origin, sponsorship, or approval' of" the FGM T-Shirts; and, a trademark's role as a "source identifier" is "precisely what trademark law protects." [(emphases added)]

NFLP's argument is that trademark law entitles NFLP to prohibit Bank from selling the FGM T-Shirts because their NFL Principal Symbols would play the role of a trademark-law "source identifier" where a consumer associates one of those symbols with that symbol's trademark holder in a capacity other than *as* the trademark holder, *i.e.*, where a consumer would (naturally), for example, associate the NFL Principal Symbol on the New York Jets FGM T-Shirt (*see* Compl., Exh. "B," p.3) with the New York Jets in their *Team Capacity* as opposed to their trademark-holder capacity. Of course, a consumer might associate that symbol with the Jets in *each* of those capacities.

However: if the NFL Principal Symbol plays the first role, *i.e.*, the Team Capacity role (whether or not it *also* plays the second, *i.e.*, trademark-holder role), *and* if the first role is *not* equivalent to the second role, *i.e.*, the first role is *not* a trademark-law source-identification role, then the symbol would be functional and, therefore, NFLP would not be entitled to preclude Bank from selling the FGM T-Shirts (as further discussed in Point IV, *infra*). Thus, it must first be determined whether, as NFLP argues, the *first* role, like the *second* role, is a trademark-law *source-identification* role.

One federal circuit court has issued a ruling that is on point and in favor of NFLP, *i.e.*, "the seminal case" (John Grady, *Testing the Bounds of Universities Merchandising Rights in Light of Penn State v. Vintage Brand*, 33 J. Legal Aspects Sport 46, 50 (2023)) of *Boston Prof'l Hockey Assn v. Dallas Cap & Emblem Mfg. Corp.*, 510 F.2d 1004 (5th Cir. 1975). Precisely as NFLP argues, the court, in what it called a case of "first impression," *Boston Hockey*, 510 F.2d at 1008, found that a patch of a trademark of a National Hockey League team (*see id.* at 1008) played a trademark-law source-identification role solely because a consumer would associate such trademark with a team in its Team Capacity:

> The confusion or deceit requirement is met by the fact that the defendant duplicated the protected trademarks and sold them to the public knowing that the public would *identify them as being the teams' trademarks.* The certain knowledge of the buyer that the source and origin of the trademark symbols were *in plaintiffs* satisfies the requirement of the act. The argument that confusion must be as to the *source of the manufacture* of the emblem itself is unpersuasive, where the trademark, *originated by the team*, is the *triggering mechanism* for the sale of the emblem.

Boston Hockey, 510 F.2d at 1013 (emphases added). Notwithstanding that *Boston Hockey* held, precisely as NFLP argues, that a trademarked sports logo is solely a source identifier and thus non-functional, *see id.*, where a consumer associates such symbol with the corresponding team in its Team Capacity, *see id.*, NFLP cites *Boston Hockey* only once, describing it as "rejecting aesthetic[-]functionality defense [and] finding defendant infringed the National Hockey League and its member

hockey teams' trademarks." Def. Mem. at 15, citing *Boston Hockey*, 510 F.2d at 1013. The implication of NFLP's description is that *Boston Hockey* recognized that the aesthetic-functionality defense could apply to a trademark (or trademarked feature), but found that it did not apply to the facts at issue, *i.e.*, facts that are not distinguishable from the facts of the present case in any material way. However, this implication is false, *see Boston Hockey*, 510 F.2d at 1013, which is probably why NFLP did not even address the court's reasoning even though that reasoning is the same as NFLP's reasoning in opposing Bank's legal theory; that is, "[the Fifth] [C]ircuit has consistently rejected the concept of aesthetic functionality." *Bd. of Supervisors v. Smack Apparel Co.*, 550 F.3d 465, 487 (5th Cir. 2008), citing *Boston Hockey*; *see also Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.*, 696 F.3d 206, 221, n.17 (2d Cir. 2012) ("[t]he Fifth Circuit rejects the doctrine of aesthetic functionality entirely."). By contrast, the Second Circuit has *embraced* that concept (or doctrine). *See* Point IV, *infra*.

We turn now to the question of: what is source identification under trademark law? As will be made abundantly and undeniably clear, it is not what *Boston Hockey* said it is, and it is not, therefore, what NFLP says it is; that is, it is not the mere *association* of a trademark with its holder, *i.e.*, in the present case, a consumer's association of an NFL Principal Symbol with an NFL Team in its Team Capacity or the NFL in its League Capacity, as opposed to their capacities as Primary Product Sources or Product Sponsors.

As the Supreme Court reiterated only recently:

> A trademark has generally served two functions: indicating *ownership of the **goods** to which it is affixed*" and indicating the *source or origin of **manufacture***." Indicating ownership of a good was needed in part to "fi[x] responsibility for defective merchandise." Restatement [(Third) of Unfair Competition] § 9, C § 9, Comment b [(1993)]. And, indicating the source of the good helped "prospective purchasers ... make their selections based upon the reputation, not merely of the immediate *vendor*, but also of the *manufacturer*." *Ibid*. Both goals thus reflect that trademarks developed historically to identify for

> consumers who *sold* the goods (the *vendor*) and who *made* the goods (the *manufacturer*). *See ibid.* In that vein, a basic function of trademark law has always been to prohibit confusion as to the *source of good[s] or services*.

Vidal v. Elster, 602 U.S. 286, 299-300 (2024) (emphases added; additional citations, quotation marks, and footnote omitted). In another recent reiteration, the Court explained that a trademark "'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." *Jack Daniel's Properties, Inc. v. VIP Products LLC*, 599 U.S. 140, 146 (2023), quoting *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 164 (1995).

In *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003), the Court explained:

> We think the most natural understanding of the "origin" of "goods"—the source of wares—is the ***producer of the tangible product*** *sold in the marketplace* . . . . The concept *might be stretched* (as it was under the original version of § 43(a) [15 U.S.C. § 1114])[5] to include not only the actual producer, but also the trademark owner who *commissioned or assumed responsibility* for ("stood behind") *production of the physical product*. But *as used in the Lanham Act, the phrase "origin of goods" is in our view incapable of connoting the person or entity that originated the ideas or communications that "goods" embody or contain*. Such an extension would not only stretch the text, but it would be *out of accord with the history and purpose of the Lanham Act and inconsistent with precedent*.
>
> [5] Under the 1946 version of the Act, § 43(a) [15 U.S.C. § 1114] was read as providing a cause of action for trademark infringement even where *the trademark owner had not itself produced the goods* sold under its mark, but had *licensed others to sell under its name goods produced by them*—the typical franchise arrangement. This stretching of the concept "origin of goods" is seemingly no longer needed: The 1988 amendments to § 43(a) now expressly prohibit the use of any "word, term, name, symbol, or device," or "false or misleading description of fact" that is likely to cause confusion as to "affiliation, connection, or association ... with another person," or as to "sponsorship, or approval" *of goods*. 15 U.S.C. § 1125(a).

Id. at 31-32 (emphases added). *Accord*, *Enzo Biochem, Inc. v. Amersham PLC*, 981 F.Supp. 2d 217,

227-228 (S.D.N.Y.2013); *DJ Direct, Inc. v. Margaliot*, 512 F. Supp. 3d 396, 414-415 (E.D.N.Y. 2021); *I Candy by JW LLC v. Spin Master Ltd.*, No. 17-cv-3131, 2018 WL 11697440, *1 (E.D.N.Y. June 19, 2018); *Kehoe Component Sales Inc. v. Best Lighting Prods., Inc.*, 796 F. 3d 576, 586-587 (6th Cir. 2015); *Optimum Techs., Inc. v. Henkel Consumer Adhesives, Inc.*, 496 F. 3d 1231, 1248 (11th Cir. 2007); *Bretford Mfg., Inc. v. Smith Sys. Mfg. Corp.*, 419 F. 3d 576, 581 (7th Cir. 2005).

As the foregoing makes clear, source identification does not concern a consumer's mere association between a trademark holders and its trademark, but, rather, the association of a trademark-bearing product with the trademark holder in the latter's capacity as the trademark holder, *i.e.*, its capacity as the product's Primary Product Source or Product Sponsor. *See also Int'l Info. Systems Security Certification Consortium v. Security University LLC*, 823 F. 3d 153, 162 (2d Cir. 2016) ("customer 'confusion' need not be restricted to a mistake regarding the source of the goods; the court should also consider whether the customer would believe that the trademark owner sponsored, endorsed or was otherwise affiliated with *the product*" (emphasis added; citation and quotation marks omitted)). Of course, each type of association may occur, in which event, as further discussed in Point IV, *infra*, "functionality trumps confusion," Compl., ¶ 26; *see also* 1 J. Thomas McCarthy, *McCarthy on Trademarks*, § 7:63 (5th ed. 2017) ("[f]unctionality is a potent public policy, for it trumps all evidence of actual consumer identification of source and all evidence of actual consumer confusion caused by an imitator," and "no amount of evidence of . . . actual confusion will create a right to exclude."). That is why "[t]he Lanham Act . . . *does not protect* [a functional] trade[mark] . . . *simply because*," *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34-35 (2001) (emphasis added), as is the case regarding the NFL Principal Symbols, "an investment has been made to encourage the public to *associate* a particular *functional* feature with a *single manufacturer or seller*." *Id.* at 35 (emphases added).

NFLP might seek to distinguish *TrafFix Devices* because it concerned trade *dress* rather than

a customary trade*mark*, but the considerations that determine whether a trademark is functional do not change based upon whether the mark is a customary mark or a trade dress. *See Qualitex*, 514 U.S. at 162-165 (1995) (treating trademark as customary); *TrafFix Devices*, 532 U.S. at 32-33 (dealing with trade dress). Moreover, the legal treatment of a trade dress is the same as that of a customary trademark. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000) ("*Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996 (C.A.2 1995) . . . . *assumed* . . . that trade dress constitutes a 'symbol' or 'device' for purposes of the relevant sections," *i.e.*, "§ 2 [15 U.S.C. § 1052][,] [which contains] the definition of marks [that are] registrable[,] [and] § 43(a) [15 U.S.C. § 1125][,] [which lists] the confusion-producing elements [of trademark-infringement claim][,] . . . . and *we conclude likewise*" (emphases added)); *see also Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992); *Christian Louboutin*, 696 F.3d at 216; *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76, 78 (2d Cir.1990); *TBL Licensing, LLC v. Vidal*, 98 F.4th 500, 506 (4th Cir. 2024); *Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc.*, 270 F.3d 298, 308, n.2 (6th Cir. 2001); *D'Pergo Custom Guitars, Inc. v. Sweetwater Sound, Inc.*, 111 F.4th 125, 133 (1st Cir. 2024); *In re Forney Indus., Inc.*, 955 F.3d 940, 945 (Fed. Cir. 2020)); *adidas America, Inc. v. Skechers USA, Inc.*, 890 F.3d 747, 755 (9th Cir. 2018).

POINT IV

WITH RESPECT TO CONSUMERS' ASSOCIATING OF THE FGM T-SHIRTS' NFL PRINCIPAL SYMBOLS WITH AN NFL TEAM IN ITS TEAM CAPACITY, OR THE NFL IN ITS LEAGUE CAPACITY, THOSE SYMBOLS ARE FUNCTIONAL UNDER TRADEMARK LAW

We begin with two key facts. First NFLP has itself stated that, "[h]undreds of millions of fans have attended NFL games and related events, enjoyed television and radio broadcasts of NFL games and related events, and *purchased merchandise bearing NFL Trademarks to identify 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), ¶ 8 (emphasis added). Second, NFLP describes itself as "responsible for negotiating with and licensing vendors to create merchandise bearing the NFLP's and Member Clubs' marks," Def. Mem. at 2-3, citing Compl., ¶ 13, and states that, "[s]uch licensed merchandise must comply with NFLP's rigorous quality standards." *Id.* at 3.

The NFLP's role in ensuring the quality of licensed merchandise bearing an NFL Principal Symbol *is* a trademark-law role, *see Authentic Apparel Group, LLC v. United States*, 989 F.3d 1008, 1016 (Fed. Cir. 2021), and applies with respect to *all* of the NFL Principal Symbols. If this quality-assurance role were the *only* role that the NFL Principal Symbols played with respect to the resulting products ("NFLP-Licensed Products"), then consumers would be just as likely to purchase an NFLP-Licensed Product that bears one of those particular symbols as they would be to purchase one that bears any other of those symbols. According to NFLP (and common sense), however, this is not the case. Instead, consumers typically "purchase[] merchandise bearing [NFL Principal Symbols] to identify with their favorite Member Clubs." *Partnerships* AC, ¶ 8. Obviously, this is not because consumers believe (for they would, of course, have no reason to believe) that NFLP-Licensed Products that contain their favorite team's NFL Principal Symbol is of higher quality than NFLP-Licensed Products whose only difference is that they contain the NFL Principal Symbol of a different team. Thus, to whatever extent the purchaser of a product bearing an NFLP Principal Symbol considers the NFLP's trademark-law role with respect to that product, that role is obviously not the only significance of that symbol. *See* Compl., ¶¶ 75-83. That is why, as set forth below, those symbols are functional.

A. Utilitarian Functionality

"[A] product feature is considered to be 'functional' in the utilitarian sense if it is (1) 'essential to the use or purpose of the article,' or if it (2) 'affects the cost or quality of the article'[;] . . . [and,

a] feature is essential if [it] is dictated by the functions to be performed by the article." *Christian Louboutin*, 696 F.3d at 219, quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10 (1982) (additional citations and quotation marks omitted). NFLP contends that the NFL Principal Symbols "are not functional in a utilitarian way because they are not essential to the functioning or quality of the product. For instance, a knit hat made by an NFL licensee with or without an NFL Mark will equally keep a consumer's head warm." Def. Mem. at 12. However, this contention equates utilitarian functionality with 'technological' functionality; but, whereas the latter is one type, and, indeed, the *primary* type, of utilitarian functionality, it is not the *only* type.

In *Brunswick Corp. v. British Seagull*, 35 F.3d 1527, 1530 (Fed. Cir. 1994), the court found that the color black on an outboard motor was functional in the utilitarian sense even though 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," *id.* at 1531, but, "[r]ather, [because] the color black exhibits both color compatibility with a wide variety of boat colors and ability to make objects appear smaller," *id.*, as consumers "find it desirable under some circumstances to reduce the perception of the size of the motors in proportion to the boats." *Id.* at 1529 (citation and quotation marks omitted), The court further explained that, "we are presented not with a design or configuration which is ornamental or simply more beautiful." *Id.* at 1533. That is also true of the NFL Principal Symbols: insofar as consumers purchase products that contain one of those symbols in order to show their allegiance to their favorite team, the beauty of the symbol (*i.e.*, its beauty to the purchaser) is not the primary motive for the purchase. Thus, in the present case as in *Brunswick*, an aesthetic feature of a product can have utilitarian functionality even though it is not utilitarian in the traditional, *i.e.*, technological, sense.

In *Plasticolor Molded Products v. Ford Motor Co.*, 713 F. Supp. 1329 (C.D. Calif. 1989) (Kozinski, *Circuit Judge*), *vacated by consent judgment*, 767 F. Supp. 1036 (C.D. Calif. 1991),

which the Complaint addresses, *see* Compl., ¶¶ 49-63, Judge Kozinksi, who had a particular interest in trademark law in the sports-logo context, *see* Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. Rev. 960 (1993), explained that, "[w]hen sports fans wear jackets bearing the names of their favorite teams . . ., they are using . . . trademarks . . ., *but not to identify the source of the product*." *Id.* at 1332-1333 (emphasis added). Judge Kozinksi further observed: "[t]he wearer of a baseball jacket reading New York Mets *does not care whether the New York Mets manufactured the jacket, or authorized its production, or are in any way associated with it*. He wears it to *announce his allegiance*. New York Mets may well be a [trade]mark, but in this context it has *become a product as well*; it is a *functional component of the jacket as surely as the material from which the jacket is made*." *Id.* at 1333 (emphases added; footnote omitted).

According to NFLP, *Plasticolor* is "outdated" (Def. Mem. at 16) because it "addressed the functionality of trademarks for car floor mats over 35 years ago and adopted a novel 'mixed use' approach, resulting in the denial of summary judgment and the parties ultimately agreeing to have the decision vacated," Def. Mem. at 16-17, and, "[t]he court's dicta on which Bank relies about the potential dual role of a New York Mets trademark was unrelated to any facts or decision in the case and this Circuit has never adopted the California district court's 'mixed use' approach." *Id.* at 17. Leaving aside that NFLP relies upon cases well over 35 years old (*see* Def. Mem. at 3 [1975, 1982, and 1986], 7 [1979], and 15 [1975]), leaving aside that the court's New York Mets example was analogous to the facts at issue in *Plasticolor*, *see Plasticolor*, 713 F. Supp. at 1332-1333, and leaving aside that "dicta may be followed if sufficiently persuasive but is not binding," *Central Green Co. v. United States*, 531 U.S. 425, 431 (2001) (citation and quotation marks omitted), *i.e.*, just as the *non*-dicta of *Plasticolor* is not binding on this Court but could provide reasoning with which this Court might agree, NFLP makes a major misstep in claiming that "this Circuit has never adopted the California district court's 'mixed use' approach."

The "mixed use" to which NFLP refers occurs where "a copied product feature is partially functional but partially source-identifying," *Plasticolor*, 713 F. Supp. at 1337, about which the court found (in non-dicta) that, "[a]ffording the same degree of protection against mixed-use copying," *id.* at 1337, or "[t]reating mixed uses exactly like source-identifying uses as against purely source-identifying copying[,] would thus protect functional features [against copying], a result contrary to established principles of trademark law." *Id.* Far from "this Circuit ha[ving] never adopted the California district court's 'mixed use' approach," Def. Mem. at 17, that is *precisely* the approach that the Second Circuit has taken: "if a markholder has successfully demonstrated that its [trade]mark is valid and that the competitor's [use of that] mark is *likely to cause confusion*," *Christian Louboutin*, 696 F.3d at 217, *i.e.*, "confusion as to source," *id.* at 224 (citation and quotation marks omitted), "'the competitor can *nevertheless prevail* ... by showing that the [competitor's use of that] [trade]mark is *functional*'—a *traditional defense to the enforcement of a trademark*," *id.* at 217, quoting *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 974 (2d Cir.1987) (emphases added); *see also Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 116 (2d Cir. 2001) ("the nonfunctionality requirement protects competition *even at the cost of potential consumer confusion*" (emphasis added; citation and quotation marks omitted)). The Supreme Court has held the same. *See TrafFix Devices*, 532 U.S. at 34-35 ("[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" (emphases added)).

NFLP is also wrong in claiming, first, that the FGM T-Shirts' NFL Principal Symbols do not constitute a mixed use, *i.e.*, that their sole role is as source identifiers under trademark law, and, second, that, even if those symbols *did* constitute a mixed use, the non-trademark-law use, *i.e.*, their causing of consumers to associate them with an NFL Team in its Team Capacity or the NFL in its League Capacity, would be mooted by their source-identification role and thus entitle NFLP to

preclude Bank from selling the FGM T-Shirts, whereas the exact opposite is true.

B. Aesthetic Functionality

As explained in *Sulzer Mixpac AG v. A&N Trading Co.*, 988 F.3d 174 (2d Cir. 2021):

> A [product] feature can still be functional *even if* it is not essential to a product's use or purpose and does not affect a product's cost or operation. This is referred to as *aesthetic functionality*, where "the *aesthetic design* of a product is *itself* the mark for which protection is sought." [*Christian Louboutin*, 696 F.3d] at 219-20 (emphasis in original). In such instances, [a] [c]ourt considers whether "giving the markholder the right to use it exclusively would put competitors at a *significant non-reputation-related disadvantage*.'" *Id.* at 220 (internal quotation marks omitted).

Id. at 182 (emphases added). Although the term "aesthetic functionality" obviously applies to with respect to aesthetic appeal, the term applies more broadly, as "[a]esthetic functionality [is] the central question . . . [where there is] no indication that the [trademark] ha[s] any bearing on the [utilitarian] use or purpose of the product or its cost or quality." *TrafFix Devices*, 532 U.S. at 33.

Unlike utilitarian functionality, the doctrine of aesthetic functionality requires that a trademark holder's would-be competitor may copy the mark only if the competitor would otherwise be put at a "'significant non-reputation-related disadvantage.'" *Christian Louboutin*, 696 F.3d at 220, quoting *Qualitex*, 514 U.S. at 165, *i.e.*, "in the relevant market." *Id.* at 221.

NFLP contends: "Bank is free to sell football-related merchandise provided he does not use or infringe any of the NFL Marks, which confirms that the NFL Marks are not aesthetically functional." Def. Mem. at 16. It is not clear whether NFLP is suggesting that the relevant market consists of *all* football-related merchandise. In any event, the relevant market is obviously "merchandise bearing NFL Trademarks ('NFL Merchandise')," Compl., ¶ 2; *see also id.*, ¶¶ 86, 88 ("Bank, if unable to sell NFL Merchandise, would be at a significant disadvantage in the market of NFL Fans"); *id.*, ¶¶ 73-85, 87, 89-99. In *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76 (2d Cir. 1990), the relevant market was precisely of the products that the trademark

holder's competitor wished to sell, *i.e.*, "baroque silverware," *id.* at 80, 81, even though most silverware is surely not baroque. Likewise, in *Bubble Genius LLC v. Smith*, 239 F. Supp. 3d 586, 597 (E.D.N.Y. 2017), in which the parties were "both in the business of producing novelty soaps," *id.* at 591, the relevant market was based upon *the products at issue*, which were "soaps that utilized periodic tables in the public domain," *id.*, notwithstanding that the plaintiff, which asserted a claim for trademark infringement (*see id.*), had "argue[d] that the appropriate market is the novelty[-]soap market." *Id.* at 595. *See also Dippin' Dots, Inc. v. Frosty Bites Distribution, LLC*, 369 F.3d 1197, 1203, n.7 (l1th Cir. 2004) (finding that the relevant market was for flash-frozen ice cream, as the markholder's competitor "[did] not want to compete in the ice[-]cream business; it want[ed] to compete in the flash-frozen ice[-]cream business, which is [ ] a different market from more traditional forms of ice cream," and quoting as follows from 3 Louis Altman & Malla Pollack, *Callmann on Unfair Competition, Trademarks and Monopolies*, § 19:7 (4th ed. 2003) ("'functionality ... is not to be determined within the broad compass of different but interchangeable products; the doctrine of functionality is intended to preserve competition within the narrow bounds of each *individual* product market.'" *Id.* (emphasis by *Dippin' Dots*)). Indeed, Bank could have sought to enter the market of Jets merchandise only, or merchandise pertaining to only one NFL division, etc.

It is only by erroneously re-defining the relevant market that NFLP is able to contend that "there is nothing about the NFL Marks that would significantly hinder competition by limiting the range of adequate alternative designs." Def. Mem. at 16 (citation and quotation marks omitted). It is not even clear whether, factually, this assertion is correct; but it is obviously *incorrect* with respect to the *relevant* market. Indeed, with respect to that market, NFLP does not dispute paragraphs "86" and "88" of the Complaint, which allege: "[b]ecause the appeal, to NFL Fans, of NFL-Related Merchandise that does not bear any NFL Trademarks pales in comparison to NFL-Related Merchandise that bears at least one NFL Trademark, *i.e.*, NFL Merchandise, Bank, if unable to sell

NFL Merchandise, would be at a significant disadvantage in the market of NFL Fans."

NFLP comes up with another incorrect notion regarding trademark-law fundamentals, contending that "the NFL Marks [are not] aesthetically functional," Def. Mem. at 13, because "'[a] feature is ornamental if it is added purely for aesthetic reasons and serves *no* source-identifying purpose.'" *Id.*, quoting *Gucci America, Inc. v. Guess?, Inc.*, 868 F. Supp. 2d 207, 246 (S.D.N.Y. 2012) (emphasis by NFLP). However, *Gucci America* cited, for this never-repeated quotation, *Knitwaves Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1009 (2d Cir. 1995), but *Knitwaves* did not say that. Rather, *Knitwaves* stated: "[a]s Knitwaves' objective in the two sweater designs was primarily aesthetic, the designs were not primarily intended as source identification. Those sweater designs therefore fail to qualify for protection of trade dress inherent in product design." *Knitwaves*, 71 F.3d at 1009. Thus, *Knitwaves* might well be understood as saying that a design may be trademarked it if is primarily intended as source identification. However, assuming that this is so, and assuming that the NFL Principal Symbols are primarily intended as source identifiers (an assumption that Bank doubts, as their primary significance appears to be their identification of NFL Teams in their Team Capacity and the NFL in its League Capacity), or even intended as source identifiers to a degree (an assumption with which Bank easily agrees), we are simply brought back to the effect that the NFL Principal Symbols, as mixed-use marks, have on this case. Indeed, NFLP does not deny (how could it?) that those symbols, whatever their role is in trademark-law *source identification*, also identify the NFL Teams in their Team Capacity and the NFL in its League Capacity (instead, NFLP, knowing that this is undeniable, incorrectly claims that the latter is the same as the former for trademark-law purposes, *see* Point III, *supra*).

C. Expressive and Communicative Functionality

Notably, NFLP does not address Bank's allegations of expressive and communicative functionality (*see* Compl., ¶¶ 28, 31-34, 87, 88) other than to state that, "Bank's so-called expressive

and communicative functionality, however, is just a type of aesthetic functionality." Def. Mem. at 12, n.3, citing *Who Dat Yat Chat, LLC v. Who Dat, Inc.*, No. 10-cv-1333, 2012 WL 1118602, *13-*15 (E.D. La. Apr. 3, 2012). Although this is not necessarily so, *i.e.*, although Bank is unaware of any case law, other than *Who Dat Yat Chat*, to address the question of whether expressive and communicative functionality, like aesthetic functionality, contains the "significant non-reputation-related disadvantage" requirement (which the court suggested to be so, see *Who Dat Yat Chat*, 2012 WL 1118602 at *13) or whether, like utilitarian functionality, it does not, Bank believes that expressive and communicative functionality is more closely related to aesthetic functionality than to (at least traditional) utilitarian functionality, and, accordingly, has treated it that way. *See* Compl., ¶¶ 86, 88.

NFLP does not deny the NFL Principal Symbols' role in enabling consumers to express or communicate their feelings for "their favorite Member Clubs," *Partnerships* AC, ¶ 8, in their Team Capacities, or the NFL in its League Capacity, but, given NFLP's argument that expressive and communicative functionality is "just a type of aesthetic functionality," NFLP implicitly argues that this role is indistinguishable from those symbols' trademark-law source-identification role. To be sure, it seems preposterous to Bank to argue that a person, in purchasing, for example, a Jets t-shirt in order to express himself in the most typical way, *i.e.*, "I love the Jets and root for them to win their football games," is thereby expressing the equivalent of, "I love this t-shirt's Jets logo because the licensing agreement between NFLP and the manufacturer of the shirt assures me that it 'compl[ies] with NFLP's rigorous quality standards.'" Def. Mem. at 3. Of course, the fan who buys that shirt might view the Jets logo in *each* of those ways, which, yet again, brings us back to the mixed-use scenario; and, in the Second Circuit, such mixed use points to one result only: the denial of NFLP's motion.

D. NFLP Relies on Numerous Cases in which Functionality was Not at Issue

As stated above, Bank agrees that the NFLP Principal Symbols are trademark-law source identifiers, but predicates his entitlement to use those symbols on the grounds that they are also functional. Thus, Bank's arguments are not undermined by cases that: (i) find that a trademark (or trademarked feature) on a product is a trademark-law source identifier; but (ii) do not address the question of functionality. However, it is precisely such uncontroversial cases upon NFLP repeatedly relies. *See* Def. Mem. at 7, citing *Nat'l Football League v. Coors Brewing Co.*, 205 F.3d 1324 (2d Cir. 1999), *Indianapolis Colts Inc. v. Metro. Baltimore Football Club Ltd.*, 34 F.3d. 410 (7th Cir. 1994), *NBA Props. v. Dahlonega Mint*, 41 F. Supp. 2d 1341 (N.D. Ga. 1998), *NFL Props. v. N.J. Giants, Inc.*, 637 F. Supp. 507 (D. N.J. 1986), *NFL Props., Inc. v. Consumer Enters.*, 26 Ill. App. 3d 814, 327 N.E. 2d. 242 (1975); *see also* Def. Mem. at 13, citing *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125 (2d Cir. 2023).

NFLP also cites *Nat'l Football League Props., Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651 (W.D. Wash. 1982), *see* Def. Mem. at 3, which *did* mention functionality and *does* support NFLP, yet NFLP cites it only once, and without any discussion of it. Perhaps this is because, as NFLP surely knows, the court's mixed-use rationale prompted the court to rule in favor if NFLP's predecessor, whereas a mixed use dictates the opposite result in the Second Circuit (and, perhaps, also because *Wichita Falls Sportswear* preceded the Supreme Court cases of *Qualitex* and *Traffix Devices*). *Wichita Falls Sportswear*, which concerned replica NFL-team jerseys, *see id.* at 654, reasoned as follows: "[e]ven assuming the marks are functional does not, however, preclude trademark protection. A functional feature may additionally serve as a trademark and be protected as such." *Id.* at 663. On the contrary, "[t]reating mixed uses exactly like source-identifying uses would thus protect functional features [against copying], a result contrary to established principles of trademark law," *Plasticolor*, 713 F. Supp. at 1337, just as the Second Circuit recognizes, and,

therefore, "[t]he reasoning of [*Wichita Falls Sportswear*] flies in the face of this authority." *Id.*

NFLP relies on *Chicago Bears Football Club, Inc. v. 12th Man/Tenn. LLC*, Oppn. No. 91150925, 2007 WL 683778 (T.T.A.B. 2007), *see* Def. Mem. at 14, but the Board merely relied on *University Book Store v. Univ. of Wisc. Bd. of Regents*, Oppn. No. 84,223, 1994 WL 747886 (T.T.A.B. 1994), which adopted the *Boston Hockey* view, *see Univ. Book Store*, 1994 WL 747886 at *22, and, two cases that did not address functionality, *i.e.*, *Indianapolis Colts*, *supra*, *see Chi. Bears Football Club*., 2007 WL 683778 at *5, *14, and *In re Paramount Pictures Corp.*, 217 USPQ 292, 1983 WL 51777 (TTAB 1983). *See Chi. Bears Football Club*., 2007 WL 683778 at *14.

E. NFLP Relies on Several Additional Cases That Do Not Support NFLP

NFLP relies on *Ohio State Univ. v. Skreened Ltd.*, 16 F. Supp. 3d 905 (S.D. Ohio 2014), *see* Def. Mem. at 14, which reasoned:

> The Sixth Circuit expressly has not adopted the concept of aesthetic functionality and has questioned its validity. Second, as Plaintiff correctly points out, the aesthetic functionality doctrine is potentially relevant only in the context of trade dress infringement, which is simply not the context at issue here. The claims in this case involve trademarks and not the design of the products on which those trademarks are presented.

Id. at 919-920 (citations and quotation marks omitted). First, the Second Circuit *has* adopted the concept of aesthetic functionality and has *not* questioned its validity. Second, the legal treatment of trade dress, which is merely a type of trademark, is the same as the treatment of customary trademarks. *See* Point III, *supra*.

NFLP relies on *Savannah College of Art and Design* [("*SCAD*")], *Inc. v. Sportswear, Inc.*, 872 F.3d 1256 (11th Cir. 2017), *see* Def. Mem. at 14, and immediately thereafter provides its sole citation to *Boston Hockey*. *See* Def. Mem. at 14-15. Given that *SCAD* is, of course, not binding on this Court, one would assume that NFLP cites it for what NFLP believes (or hopes this Court will believe) is its persuasive reasoning; and, indeed, NFLP includes a quotation from *SCAD*. *See* Def.

Mem. at 14-15. However, insofar as NFLP would have one think that the court, in reversing "the district court's grant of summary judgment in favor of Sportswear," *SCAD*, 872 F.3d at 1258 (*see id.*), *i.e.*, the trademark holder's competitor, *see id.*, reasoned its way to that result, that is the precise opposite of what happened. The court unhappily ruled in favor of the trademark holder in spite of what the court actually believed; but, first, a preliminary note: *SCAD*, *supra*, involved service marks, *see id.* at 1258, but, as *SCAD* noted, a service mark is merely a type of trademark. *See id.* at 1261, n.3 ("[s]ervice marks and trademarks are governed by identical standards" (citations and quotation marks omitted)); *see also Restatement (Third) of Unfair Competition*, § 9 (Am. Law Inst. 1993) ("[a] service mark is a trademark that is used in connection with services,"); *Patsy's Italian Restaurant, Inc. v. Banas*, 658 F.3d 254, 259, n.1 (2d Cir. 2011) ("trademarks and service marks are generally protected by the same standards," citing 15 U.S.C. § 1053).

So why did *SCAD* reach the result upon which NFLP relies? The answer: (i) "[i]n *Bonner v. City of Prichard*, 661 F.2d 1206, 1209 (11th Cir. 1981) (en banc), [the court] adopted as binding precedent all Fifth Circuit decisions issued before October 1, 1981," *United States v. Ostrander*, 114 F.4th 1348, 1369, n.5 (11th Cir. 2024), on which date the Eleventh Circuit was created from the Fifth Circuit; and (ii): "[o]ne of our older trademark cases, *Boston* [] *Hockey* [], controls . . . . Although *Boston Hockey* does not explain how or why this is so, it constitutes binding precedent that we are bound to follow." *SCAD*, 872 F.3d at 1258-1259.

The court's opening salvo against *Boston Hockey* was only the beginning of the court's expression of distaste over that half-century-old Fifth/Eleventh Circuit albatross:

> In the end, the *Boston Hockey* panel rejected the [competitor]'s argument that consumer confusion must derive from the "source of the manufacture" of the mark because the mark, "originated by the team, [was] the *triggering mechanism for the sale* of the [patch]." [*Boston Hockey*, 510 F.2d] at 1012. In other words, "[t]he confusion ... requirement [wa]s met by the fact that the [manufacturer] duplicated the protected trademarks and sold them to

> the public knowing that the public would *identify them as being the teams' trademarks*." *Id.* [¶] *Boston Hockey*, .. . in our view[,] lack[ed] critical analysis . . . . *** We add one final note about the confusion analysis. The confusion discussion in *Boston Hockey*, 510 F.2d at 1012, came under strong criticism because it "did not require proof of a likelihood that customers would be confused as to the source or affiliation or sponsorship of [the] defendant's product," and instead only asked whether "customers *recognized the products as bearing a mark of the plaintiff[s]*." 4 McCarthy on Trademarks § 24:10 (describing the "heresies" of *Boston Hockey* and concluding that its "attempt to stretch trademark law failed"). *See also* Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory L.J. 461, 474 (2005) ("The court . . . presumed actionable confusion based solely on the consumer's mental association between the trademark and the trademark holder.").

Id. at 1264, 1264-1265 (emphases added). *Boston Hockey* , in addition to being non-binding on this Court, is irrelevant because: (i) unlike the Fifth Circuit, the doctrine of aesthetic functionality has been recognized by the Supreme Court and the Second Circuit; and (ii) functionality trumps confusion.

NFLP relies on *City of New York v. Blue Rage, Inc.*, 435 F. Supp. 3d 472 (E.D.N.Y 2020), *see* Def. Mem. at 15, in which the defendants "ma[d]e and [sold] a wide variety of unlicensed merchandise bearing the NYPD and FDNY trademarks," *id.* at 482, and in which the court ruled as follows with respect to the question of aesthetic functionality:

> [T]he marks do not have aesthetic functionality. 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." By Defendants' reasoning, any logo or emblem would be precluded from trademark protection once it was used to "decorate" or provide "ornamentation" to an item of merchandise. They provide no case law to support such an expansive interpretation of aesthetic functionality. Moreover, Defendants have not argued, let alone established, that they are unable to fairly compete with the City in the market for this merchandise. . . . There is ample room for Defendants to compete in the market without using the City's marks simply by showing some creativity or inventiveness in their designs. For example, the registration for the NYPD Shield expressly states that "no claim is made to the exclusive right to use 'City of New York' and "Police Department' apart from the Mark as shown,"leaving avenues using these phrases for Defendants to explore.

Blue Rage, 435 F. Supp. 3d at 491. First, *Blue Rage* concerned a motion for *summary judgment*, *see id.* at 477, not a *dismissal* motion. By contrast:

> Because the determination of whether or not the exclusive use of a design stifles competition *requires factual development*, it is *not grounds for dismissal* of the complaint under Rule 12(c). RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c [(AM. LAW INST. 1995)] ("Because of the difficulties inherent in evaluating the aesthetic superiority of a particular design, a finding of aesthetic functionality ordinarily will be made only when objective evidence indicates a lack of adequate alternative designs.").

Hillside Plastics, Inc. v. Dominion & Grimm U.S.A., Inc., No. 17-cv-30037, 2018 WL 4537205, *10 (D. Mass. Aug. 6, 2018) (emphases added). Obviously, the same rationale applies to a Rule 12(b)(6) motion. In 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 for "football-related merchandise," Def. Mem. at 16, much less in the market that this case concerns, *i.e.*, the market for "merchandise bearing NFL Trademarks ('NFL Merchandise')," Compl., ¶ 2; *see also id.*, ¶¶ 86, 88 ("Bank, if unable to sell NFL Merchandise, would be at a significant disadvantage in the market of NFL Fans"). Indeed, Bank, in the event that NFLP were to assert, in its Answer, that Bank would be able to adequately compete (in the relevant market) without the NFL Principal Symbols, would not be entitled to judgment on a Rule 12(c) motion. This remains so no matter how obvious it might seem that "the appeal, to NFL Fans, of NFL-Related Merchandise that does not bear any NFL Trademarks pales in comparison to NFL-Related Merchandise that bears at least one NFL Trademark, *i.e.*, NFL Merchandise, [and, therefore][,] Bank, if unable to sell NFL Merchandise, would be at a significant disadvantage in the market of NFL Fans," Compl., ¶¶ 86, 88; *see also id.*, ¶¶ 75-80; Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 Emory Law Journal 461 (2005):

> Unlike the ordinary trademark case, in which an infringing defendant can simply choose another mark and compete fairly in the relevant

> market, a defendant enjoined from using a well-known insignia on T-shirts or caps is effectively excluded from the market. It can sell to no one, including those who care not the slightest whether their Boston Red Sox cap is licensed or approved.

Id. at 485 (citation and quotation marks omitted). Does NFLP really expect the Court, in resolving NFLP's Rule 12(b)(6) motion, to rule, as a matter of law and without evidence, that Bank would be able to *adequately* compete in the relevant market because NFLPs counsel said so (albeit without referring to the relevant market)?

Back to *Blue Rage*: the court's assertion that, "[b]y Defendants' reasoning, any logo or emblem would be precluded from trademark protection once it was used to 'decorate' or provide 'ornamentation' to an item of merchandise," *Blue Rage*, 435 F. Supp. 3d at 491, in inapplicable here. A similar concern was expressed in *Au-Tomotive Gold, Inc. v. Volkswagen of Amercica, Inc.*, 457 F.3d 1062 (9th Cir. 2006), which stated that, "[t]aken to its limits, . . . [the] doctrine [of aesthetic functionality] would permit a competitor to trade on any mark simply because there is *some* 'aesthetic' value to the mark that consumers desire," *id.* at 1064 (emphasis added), and noted that, in *Vuitton et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769 (9th Cir. 1981), the court had "emphatically rejected the notion that 'any feature of a product which contributes to the consumer appeal and saleability of the product is, as a matter of law, a functional element of that product,'" *Au-Tomotive Gold*, 457 F.3d at 1069, quoting *Vuitton*, 644 F.2d at 773 (emphasis added), such that, "'a trademark which identifies the source of goods and *incidentally serv[es] another function* may still be entitled to protection.'" *Id.*, quoting *Vuitton*, 644 F.2d at 775 (emphasis added). The NFL Principal Symbols, of course, do not merely have *some*, or *incidental*, non-source-identifying functionality; rather, such functionality is a (and, really, the) central aspect of those symbols, *i.e.*, by enabling fans "to identify with their favorite Member Clubs." *Partnerships* AC, ¶ 8. Indeed, no matter how well-established NFLP's licensing program might be (and Bank does not dispute that it well

established), the raison d'être for purchases of merchandise containing an NFL Principal Symbol is exactly what NFLP said it is: "to identify with [the purchaser's] favorite Member Club[]."

The relevance (indeed, the obvious purpose) of NFLP-licensing is not to sway consumers to purchase NFL Merchandise versus other merchandise, but to sway (or, rather, force) consumers who wish to purchase such merchandise to purchase only that which is NFLP-licensed. However, it remains (and, it seems to Bank, obviously so) that: (I) "[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," Compl., ¶ 82 (emphasis added), *i.e.*, "(i) expressing and communicating (A) allegiance to an NFL Team or the League, or (B) fondness, enthusiasm, or love for an NFL Team or the League, or (ii) identifying with an NFL Team or the League, . . . with respect to an NFL Team in its . . . Team Capacity or with respect to the League in its . . . League Capacity, as opposed to their capacities as Primary Product Sources or Product Sponsors[,]" *id.*, ¶ 76, "the importance of [such trademark rights] 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," *id.*, ¶ 82, and (II) "[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. NFLP's assertion that "[m]erely because consumers *may* purchase products bearing NFL Marks to communicate allegiance to the league or a team does not make the trademarks aesthetically functional under the law," Def. Mem. at 15 (emphasis added), suggests that "communicat[ing] allegiance to the league or a team" is *incidental* to such purchases, but this suggestion is obviously incorrect, as NFLP knows. *See Partnerships* AC, ¶ 8.

As with its "consumers *may* purchase" suggestion, NFLP, in quoting *Christian Louboutin*,

supra, in support of NFLP's contention that "Bank's allegation that certain consumers find merchandise bearing NFL Marks more desirable does not, under applicable law, make such marks functional," Def. Mem. at 16, is misleading. First, the full quotation is:

> 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 [101] at 115 [(2d Cir. 2001)] (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). Second, insofar as NFLP might (again) be suggesting that "certain consumers find merchandise bearing NFL Marks more desirable" in order "to identify with their favorite Member Clubs," *Partnerships* AC, ¶ 8, as if such "identify[ing] with their favorite Member Clubs" were merely incidental to those marks' source-identification role, NFLP has the matter backwards (as shown by common sense, and as alleged, *see* Compl., ¶¶ 75-83).

NFLP notes that *Qualitex* states: "'[trademark] law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.'" Def. Mem. at 16, quoting *Qualitex*, 514 at 164. First, the Court was discussing (genuine) source identification. *See Qualitex*, 514 at 163-164. Second, in *Traffix Devices*, the Court made it clear that functionality trumps source identification: "[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*, 532 U.S. at 34-35 (emphases added). Likewise, *Christian Louboutin*, after itself quoting the NFLP's *Qualitex* quotation, explained: "[n]evertheless, trademark law is not intended to protect innovation by giving the innovator a monopoly over a useful product feature. . . . Such a monopoly is the realm of patent

law or copyright law, which seek to encourage innovation, and not of trademark law, which seeks to preserve a 'vigorously competitive market' for the benefit of consumers." *Christian Louboutin*, 696 F.3d at 216, quoting *Yurman Design*, 262 F.3d at 115 (emphases added; additional citation and quotation marks omitted).

NFLP notes that, in *Who Dat Yat Chat*, *supra*, "[t]he court declined to find the . . . . 'Who Dat' . . . . mark functional, . . . as it was 'bound by precedent suggesting that a consumer's desire to express his identity with a mark does not make it functional.'" Def. Mem. at 17, quoting *Who Dat, Inc.*, 2012 WL 1118602 at *15. That is correct: the court was bound by the *Boston Hockey* case law. *See Who Dat, Inc.*, 2012 WL 1118602 at *14-*15. However, as in *SCAD*, the court did not seem happy about it:

> "Who Dat" on a t-shirt is a necessary design component of apparel sold in the New Orleans market—so the argument would go. Any significance of that phrase to indicate the source of the underlying good may pale in comparison with that design element's value in offering consumers the opportunity *to identify with an idea or movement with which they wish to associate*.[17]
>
> [17] There is support for such an analysis of the functionality defense in the context of *purchases driven by consumers' desire to associate with expressions that may serve as trademarks*. *See* Gerald T. Tschura, *Likelihood of Confusion and Expressive Functionality: A Fresh Look at the Ornamental Use of Institutional Colors, Names and Emblems on Apparel and Other Goods*, 53 WAYNE L.REV. 873 (2007). Tschura takes the view that *especially in the context of sports-branded apparel*, "*the expression of the wearer's allegiance to the team described by the trademark is the essential function*." *Id.* at 874. He argues that *in the context of clothing with sports team names*, such putative trademarks serve a *small source-identification function that is outweighed by the* "*expressive or communicative function of the ornamentation*." *Id.* at 893–94.

Who Dat, Inc., 2012 WL 1118602 at *13 (emphases added).

NFLP contends that *Pennsylvania State Univ. v. Vintage Brand, LLC*, 614 F. Supp. 3d 101, 114 (M.D. Pa. 2022) ("*Penn State I*"), which the Complaint addresses, *see* Compl., ¶¶ 67-69, "merely

declined to decide at that time whether the Penn State trademarks in that case were source identifiers (*id*. at 111-12), which the jury ultimately decided in rejecting the aesthetic[-]functionality defense." Def. Mem. at 17. First, the very fact that the question was assigned to a jury shows, of course, that the court recognized that *evidence*, not allegations by the competitor or denials in the trademark holder's brief, determines the issue. Again, NFLP asks this Court to decide this issue as a matter of law (and, to be sure, common sense, if applicable without evidence, would clearly favor Bank), *i.e.*, the opposite of what *Penn State I* did.

Second, the court, rather than suggesting that the issues of source identification and functionality presented an either-or question, clearly recognized that a trademark can play both roles, as the questions of source identification, *i.e.*, its implication in the question of whether there had been trademark infringement, and the question of aesthetic functionality, were *separately* decided by the jury. *See Penn State* verdict form (a copy of which is attached as Exhibit "B" to the Declaration of Todd C. Bank), p.6, Question Ten.

NFLP claims that "[*Penn State I*]'s reasoning is also squarely at odds with cases such as *Blue Rage* finding that trademarks for such institutions do necessarily serve as source identifiers." Def. Mem. at 17. Again, the question is not whether the NFL Principal Symbols serve as source identifiers, which they certainly do to a degree, but whether they are functional; for, if they are, NFLP's motion must be denied because: (i) functionality trumps confusion; and (ii) such functionality would not, and is alleged not to, be merely "incidental" to the symbols' source-identification role.

NFLP contends that, *Pennsylvania State Univ. v. Vintage Brand, LLC*, 715 F. Supp. 3d 602 (M.D. Pa. 2024) ("*Penn State II*"), which the Complaint addresses, *see* Compl., ¶¶ 70-72, "supports NFLP's position," Def. Mem. at 18, because "[t]he court held that '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.'" *Id.*, quoting *Penn State II*, 715 F. Supp. 3d at 647. This

quotation does not help NFLP: the court simply did not find *one way or the other* on the reputation issue, but ruled, instead, that "there remains a genuine issue of material fact as to *whether the marks are aesthetically functional*, and [Vintage Brand's request for] summary judgment on that ground [(*see id.* at 638)] will be denied." *Penn State II*, 715 F. Supp. 3d at 648. Bank, of course, is not asking this Court to find functionality as a matter of law; rather, NFLP is asking this Court to find *against* functionality as a matter of law. Again, this Court is not in a position to do either on a Rule 12(b)(6) motion.

NFLP contends that "[*Penn State II*] found that the use of the trademarks was not necessary for Vintage Brand to 'compete in the athletics apparel marketplace or even the Penn State apparel marketplace' and Vintage Brand could instead compete in other ways that do not involve the use of Penn State trademarks." Def. Mem. at 17, quoting *Penn State II*, 715 F. Supp. 3d at 647. In full, the court stated:

> It is not necessary for Vintage Brand to use the specific Penn State Marks to compete in the athletics[-]apparel marketplace or even the Penn State[-]apparel marketplace. For example, Vintage Brand could use *non-trademarked Penn State historical images* that omit the Penn State Marks. Or Vintage Brand could use *its own creative language* to attempt to entice Penn State supporters to purchase its goods. Vintage Brand could even seek to use *non-protected color schemes* to invoke Penn State in the minds of consumers without infringing upon any trademark. For instance, many alumni and supporters or Syracuse University or Bucknell University would undoubtedly associate a bright orange and navy blue necktie with their favored [sic] university—and likely purchase such goods—even if that tie *lacked any marks that explicitly associated it with those universities*.

Id. at 647-648 (emphases added). *See also id.* at 647, n.308 ("companies are prohibited from using the term 'Super Bowl' without authorization; many creative companies skirt this prohibition by using terms such as 'the Big Game'—a reference that any fan of the National Football League instantly recognizes."). First, the court was not saying that Vintage Brand could *adequately* compete, which would be required to show an absence of non-utilitarian functionality. This is perfectly, and

necessarily, shown by the fact, conveniently omitted by NFLP, that the court concluded:

> Although prohibiting Vintage Brand from using the Penn State Marks would *undoubtedly place Vintage Brand at a disadvantage* in trying to win over Penn State supporters, the evidence is *simply insufficient at this stage* to describe that disadvantage as *significant*. Consequently, there remains a genuine issue of material fact as to *whether the marks are aesthetically functional*, and [Vintage Brand's request for] summary judgment on that ground will be denied.

Penn State II, 715 F. Supp. 3d at 648 (emphases added). That is why the case went to trial.

Second, Bank is not seeking the enter the historical-images market in any event.

NFLP states: "Bank also cites *Bd. of Governors of the Univ. of N.C. v. Helpingstine*, 714 F. Supp. 167 (M.D.N.C. 1989) [(*see* Compl., ¶¶ 64-66)], to support his argument that the NFL's trademarks are functional. That case, however, did not address functionality and instead involved a likelihood of confusion analysis for non-competitive goods, which is inapplicable here." Def. Mem. at 18. NFLP is correct insofar as *Helpingstine* should have been addressed elsewhere in the Complaint, *i.e.*, not under the Section II(D) heading of "Judicial Recognition of Functionality Based Upon Reasoning That is Applicable to NFL Merchandise." Compl., p.15. However, *Helpingstine*, as the Complaint shows, is yet another case that rejected the *Boston Hockey* association rationale, *i.e.*, the NFLP's rationale for arguing that consumers' mere association of the NFLP Principal Symbols with NFL Teams in their Team Capacity, or the NFL in its League Capacity, shows that those symbols are solely source-identifying and thus non-functional.

NFLP attempts to distinguish *University of Pittsburgh v. Champion Prods. Inc.*, 566 F. Supp. 711 (W.D. Pa. 1983), *see* Def. Mem. at 17, which the Complaint addresses. *See* Compl., ¶¶ 46-48. However, the reason why *Univ. of Pittsburgh* is relevant is that the court found that the Pitt insignia, just like the NFL Principal Symbols, is "essential to the use or purpose of the articles," *id.* at 716, because "'[t]he entire impetus for the sale is the consumer's desire to *identify with Pitt* or, perhaps more realistically, *with Pitt's athletic programs*.'" *Id.*, quoting *University of Pittsburgh v. Champion*

Products Inc., 686 F.2d 1040, 1047 (3d Cir. 1982) (emphases added). Thus, the court explicitly found that the Pitt insignia was functional:

> The Pitt insignia, as used by Champion prominently emblazoned on soft goods, are functional. These insignia perform the function of allowing the wearer to express identity, affiliation, or allegiance to Pitt. This functional feature is an essential feature of the product. The product could not perform this function unless it bore the Pitt insignia. The Pitt insignia prominently emblazoned on the Champion Pitt-insignia soft goods is therefore essential to the use or purpose of the articles.

Id. at 716. Accordingly, "Pitt's claims would fail even if the University could show a likelihood of confusion." *Id.* at 720, citing *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964), and *Bose Corp. v. Linear Design Labs, Inc.*, 467 F.2d 304 (2d Cir.1972).

NFLP states: "the NFL Marks are not merely stylistic aspects of a branded product designed to make the product more appealing. Rather, *they are the brand itself*." Def. Mem. at 13 (emphasis by NFLP). Whether or not the NFLP Principal Symbols are characterized as trademarks or "the brand itself," it is beyond doubt that NFLP has not shown that, as a matter of law, they are purely non-functional; indeed, they clearly are, as alleged, functional and therefore open to competition.

CONCLUSION

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

Dated: June 24, 2025

Respectfully submitted,

s/ Todd C. Bank
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Counsel to Plaintiff

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CERTIFICATE OF COMPLIANCE WITH REQUIREMENT OF LENGTH

This memorandum of law complies with the Order dated June 20, 2025 (Doc. 26).

Dated: June 24, 2025

s/ Todd C. Bank
Todd C. Bank

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CERTIFICATE OF SERVICE

I hereby certify that on June 24, 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: June 24, 2025

s/ Todd C. Bank
Todd C. Bank

SA-51

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

TODD C. BANK, *Plaintiff*, -against- NFL PROPERTIES LLC, *Defendant*.	1:25-cv-03981-CM

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

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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 refiling 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 recission 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

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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

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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

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

TODD C. BANK, *Plaintiff*, -against- NFL PROPERTIES LLC, *Defendant*.	1:25-cv-03981-CM

PLAINTIFF'S MEMORANDUM OF LAW IN SUPPORT OF MOTION FOR SANCTIONS AGAINST DEFENDANT AND/OR ITS COUNSEL PURSUANT TO RULE 11 OF THE FEDERAL RULES OF CIVIL PROCEDURE

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ARGUMENT

POINT I

DEFENDANT, IN MOVING FOR COSTS AND ATTORNEYS' FEES PURSUANT TO RULE 41(d) OF THE FEDERAL RULES OF CIVIL PROCEDURE, PLAINLY SOUGHT TO MISLEAD THE COURT WITH RESPECT TO THE APPLICABLE LAW AND PLAINLY SOUGHT TO PREJUDICE THE COURT AGAINST PLAINTIFF BY CALLING ATTENTION TO IRRELEVANT MATTERS

A. Defendant Plainly Sought to Mislead the Court with Respect to the Applicable Law

Defendant, NFL Properties LLC ("NFLP"), in its motion pursuant to Rule 41(d) of the Federal Rules of Civil Procedure (the "NFLP Motion"; Doc. 29), asserted that the Court should award, to NFLP, costs and attorneys' fees because "[t]he content of the . . . complaint demonstrates," on the part of Plaintiff, Todd C. Bank ("Bank"), "[an] attempt to manipulate the litigation process to his benefit." Defendant's memorandum of law in chief in support of NFLP Motion ("Def. Ch. Mem."; Doc. 30) at 5. That the present action ("*Bank II*") constituted "procedural gamesmanship [that] should be discouraged," *id.* at 6, such as to warrant the granting of the requested costs and attorneys' fees was, according to NFLP, shown by three assertions: first, Bank, instead of commencing *Bank II*, should have submitted "opposition to NFLP's motion to dismiss the amended complaint" in *Bank v. NFL Properties LLC*, No. 1:24-cv-08814-CM ("*Bank I*"), *id.* at 5; second, alternatively, Bank should have "sought leave to further amend his amended complaint to add the factual allegations he made in *Bank II*," *id.*; and, third, "the content added to the *Bank II* complaint consists predominantly of legal, not factual, assertions," *id.*; *see also id.* at 5 ("Bank's bad faith is also apparent on the face of his complaint in *Bank II*, which remains legally deficient. The complaint contains thirty pages of improper legal argument that Bank filed in avoidance of the page limit and due date applicable to an opposition brief"). Based upon these three factors, Bank, according to NFLP, engaged in a "protracted and vexatious litigation strategy." *Id.* at 6.

In *Bank I*, NFLP, in moving to dismiss the amended complaint, argued that Bank did not have

standing, and that the 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.*, the alternative of seeking "leave to further amend his amended complaint to add the factual allegations he made in *Bank II*," Def. Mem. at 5, NFLP sought to disavow the argument that it had previously, and correctly, made, which showed that this option could not have been chosen. That argument, which NFLP made in *Bank I* and *again in its pending dismissal motion*, is that the determination of subject-matter jurisdiction "must be made considering *only the facts and circumstances at the time the suit was filed*." Def. Dismissal Mem. (Doc. 17) at 8, citing *Fed. Defs. of N.Y., Inc. v. Fed. Bureau of Prisons*, 954 F.3d 118, 126 (2d Cir. 2020) (emphasis added); *see also Bank I*, Defendant's memorandum of law in support of motion to dismiss amended complaint (Doc. 23) at 7 (same). Therefore, Bank could not have relied upon the "add[itional] . . . factual allegations he made in *Bank II* to seek leave to amend," Def. Ch. Mem. at 5, as those additional facts, *see Bank II* Compl., ¶¶ 89-99, did not exist at the time that *Bank I* was commenced.

NFLP, in trying to convince the Court that Bank should be required to pay NFLP's costs and attorneys' fees incurred in *Bank I*, had an interest in backtracking from its correct argument regarding the determination of subject-matter jurisdiction. Accordingly, given NFLP's repeatedly demonstrated

penchant for making dishonest win-at-all-costs arguments, it backtracked exactly as might have been expected. Thus, its pending dismissal-motion argument notwithstanding, NFLP contended, in its reply memorandum of law in support of the NFLP Motion ("Def. Reply Mem."; Doc. 37), that, perhaps after all, the determination of subject-matter jurisdiction need *not* "be made considering only the facts and circumstances at the time the suit was filed." That is, NFLP contended that, "[Bank] could have petitioned the court for leave to file a supplemental complaint," Def. Reply Mem. at 4, because, in *Duffy v. Illinois Tool Works, Inc.*, No. 15-cv-7407, 2021 WL 9471902 (E.D.N.Y. Sept. 30, 2021), the court "suggest[ed] that Second Circuit authority permits plaintiffs to cure standing defects by filing supplemental pleadings pursuant to Rule 15." Def. Reply Mem. at 4, citing *Duffy*, 2021 WL 9471902 at *3, n.2. However, NFLP, aside from not addressing how this argument fits in with its still-pending one, omitted all relevant context (insofar as NFLP might claim that Bank is using the instant motion as a sur-reply, the instant motion does, in effect, unavoidably constitute a part sur-reply; however, Bank's intent is based upon the nature of the motion, *i.e.*, seeking sanctions not for mere disagreements between the parties but for NFLP's statements that are false, misleading, or prejudicial).

First, *Duffy* cited *Fund Liquidation Holdings LLC v. Bank of America Corp.*, 991 F.3d 370, 390-391 (2d Cir. 2021), wherein the court stated that, "it is plainly the more practical approach to permit parties to circumvent the needless formality and expense of instituting a new action simply to correct a technical error in the original pleading's caption," *Fund Liquidation*, 991 F.3d at 391, specifically, "where an assignee with standing seeks to join an action under Rule 17." *Id.* Clearly, NFLP's argument in *Bank I* regarding standing did not concern a mere "technical error"; and, is there any doubt that, if Bank had invoked *Duffy* (or *Fund Liquidation*) in order to try to overcome the principal that the determination of subject-matter jurisdiction "must be made considering only the facts and circumstances at the time the suit was filed," NFLP would have argued not only that Bank's

attempt must fail, but that it was frivolous?

Second, NFLP, which is apt to note when it believes that Bank is relying on *dicta*, *see*, *e.g.*, Def. Dismissal Mem. (Doc. 17) at 17, and Def. Dismissal Reply Mem. (Doc. 31) at 6, declined to note that it cited *Duffy* for *dicta*. That is, in *Duffy*, the court found that the plaintiff had had standing at the time that the action was commenced even though the plaintiff "filed the original complaint before incurring out-of-pocket costs to repair [the item at issue]," *Duffy*, 2021 WL 9471902 at *3, explaining, "Defendants' argument conjures a pecuniary harm element not required by Article III standing." *Id.* In the cited footnote, the court prefaced its discussion of whether an amended pleading may cure a lack of standing by noting that, "[i]n his amended complaint, Plaintiff alleges a monetary harm of $[] resulting from his . . . repair." *Id.* at 3, n.2, but, because the court had already found that the plaintiff already had had standing without this allegation, the court's discussion is a perfect example of *dicta*.

Third, just as NFLP surely knew of, but kept quiet about, the fact that it was citing *Duffy* for *dicta* (apparently, it is only worth knowing that a party is citing *dicta* when that party is Bank), it is difficult to believe that NFLP, in its preparation of the NFLP Motion, did not come across the post-*Duffy*, and post-*Fund Liquidation*, case of *Carlone v. Lamont*, No. 21-871, 2021 WL 5049455 (2d Cir. Nov. 1, 2021), wherein the court reiterated: "'we evaluate whether the party invoking jurisdiction had the requisite stake in the outcome when the suit was filed.' *Fed. Defs. of New York*[], 954 F.3d [at] 126 []; *see also City of Hartford v. Towns of Glastonbury*, 561 F.2d 1032, 1051 n.3 (2d Cir. 1976) (*en banc*) ('Events occurring after the filing of the complaint cannot operate so as to create standing where none previously existed.')," *id.* at *3, n.3; *see also Sookul v. Fresh Clean Threads, Inc.*, 754 F. Supp. 3d 395, 403, n.5 (S.D.N.Y. 2024) ("standing is based on 'whether the party invoking jurisdiction had the requisite stake in the outcome *when the suit was filed*.' *Fed. Defs. of New York, Inc.*[], 954 F.3d [at] 126 [] (emphasis in original); *see also Sharehold Representative*

Servs. LLC v. Sandoz Inc., No. 12 CIV. 6154 DLC, 2013 WL 4015901, at *7–*8 (S.D.N.Y. Aug. 7, 2013) (explaining that amended complaint could not cure standing defects in existence when suit was filed).”). Again, it is not difficult to imagine NFLP’s reaction if Bank had sought to file a second amended Complaint in *Bank I* and argued that standing could arise *after* the commencement of an action; but, why be consistent or straightforward when going to the ends of the earth to avoid a ruling on the merits?

Insofar as NFLP contended that the *Bank II* Complaint improperly contained legal argument, *see* Def. Ch. Mem. at 4-5, that contention should be addressed with respect to the Complaint on its own terms, rather than in relation to *Bank I*; and, indeed, NFLP has done so. *See* Def. Dismissal Mem (Doc. 17) at 5-6; Bank’s memorandum of law in opposition to NFLP’s motion to dismiss the Complaint (“Pl. Opp. Dismissal Mem.”; Doc. 28), Point I.

NFLP stated: “[r]egardless, what Bank *did* do—withdraw his amended complaint and refile it while adding 30 pages of legal argument—amplifies the impropriety of his initial course of conduct and underscores the need for an award of costs here.” Def. Reply Mem. at 4 (emphasis by NFLP). If, by “his initial course of conduct,” NFLP is referring to *Bank I*, how does the *Bank II* Complaint’s inclusion of legal explanations retroactively “amplif[y] the impropriety” of anything Bank did in *Bank I*? Obviously, NFLP was not suggesting that Bank should have included “30 pages of legal argument” in *Bank I*, so what does NFLP mean by its assertion? Instead, it seems that NFLP is yet again carefully employing language to mislead the Court rather than to make a logical point.

NFLP did much the same in stating: “Bank, in fact, is personally familiar with the standing requirements in trademark cases because he was ordered to pay the defendant’s costs and fees the last time he sought to invalidate a trademark where he lacked standing,” Def. Reply Mem. at 5, citing *Bank v. Al Johnson’s Swedish Rest. & Butik, Inc.*, 795 F. App’x. 822, 823-25 (Fed. Cir. 2019). Leaving aside the objective nature of bad faith under Rule 41(d), *see Ortega v. American Honda*

Motor Co., Inc., No. 22-cv-04276, 2023 WL 5207504, *2 (C.D. Calif. Mar. 24, 2023), NFLP did not explain how the issue of standing in *Al Johnson's* was related to the issue of standing in *Bank I*; and, indeed, it was not. Instead, NFLP was clearly hoping to play on the emotions of the Court, *i.e.*, "Bank was sanctioned once in a trademark case, so the Court should really stick it to him."

NFLP stated that Bank "invented" an "incorrect standard" in stating that "'[t]he question . . . is whether, following the plaintiff's voluntarily dismissal of a prior action . . ., the plaintiff brings a second action that, *vis-à-vis* the first action, is brought improperly,'" Def. Reply Mem. at 1, quoting Bank's memorandum of law in opposition to NFLP Motion ("Pl. Opp. Mem."; Doc. 36) at 1 (ellipses by NFLP), and that, "Bank cites no case law that supports the application of this made-up test." *Id.* In support of this critique, NFLP contended that *Advanced Video Technologies LLC v. HTC Corp.*, No. 11-cv-06604, 2019 WL 13214942 (S.D.N.Y. Jan. 31, 2019) (McMahon, *J.*), upon which Bank relied, *see* Pl. Opp. Mem. at 1, "does not say this. In that case, this Court determined that an award under Rule 41(d) was not available where the earlier-filed action had been dismissed by the Court, rather than voluntarily by the plaintiff." However, the Court *did* say that. *See Advanced Video Tech.*, 2019 WL 13214942 at *4 ("[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*" (emphasis added) (NFLP itself quoted this, *see* Def. Reply Mem. at 4); *see also id.* at *5 ("if Rule 41(d) applied only where the prior action was voluntarily dismissed, it would not allow a court to award costs against a plaintiff whose first action was involuntarily dismissed and yet, despite this clear adjudication of her claim, *nonetheless filed a second unmeritorious action against the same defendant*" (emphasis added; citation and quotation marks omitted)); *id.* ("[t]he Second Actions were certainly not brought in bad faith – AVT went to great lengths to right the wrong that caused the dismissal of the First Actions the year earlier. Nor did AVT engage in forum shopping, negating Rule 41(d)'s other rationale").

NFLP also contended, in regard to a case that Bank did not cite, that, "*Loubier* [*v. Mod. Acoustics*, 178 F.R.D. 17 (D. Conn. 1998)] [does not]—nor [does] any case Bank cites—appl[y] Bank's invented standard for assessing the applicability of Rule 41(d)." Def. Reply Mem. at 3. Rather, *Loubier* did not address that issue one way or another. As for the cases that Bank cited (none of which NFLP identifies), he did so accurately.

NFLP contended: "in *Loubier* [], the plaintiffs voluntarily dismissed a suit based on lack of standing upon realizing they inadvertently failed to add all necessary parties to the suit. Much like Bank, the plaintiffs argued that 'they should be "applauded" for voluntarily dismissing the prior action, thus promoting the interests of judicial economy.'" Def. Reply Mem. at 2, quoting *Loubier*, 178 F.R.D. at 22. However, Bank never stated that he should be "applauded" for dismissing *Bank I* (nor did Bank use any similar term). Rather, Bank merely, and accurately, explained that the options that NFLP claimed to have preferred, *i.e.*, opposing NFLP's dismissal motion or seeking leave to replead, would have been improper; but, why should Bank make a fuss about NFLP's dishonesty when NFLP is simply trying to win at all costs? (naturally, NFLP omitted to note that *Loubier* began by noting that, "[t]he instant case is the fifth in a succession of lawsuits," *Loubier*, 178 F.R.D. at 18).

NFLP stated: "[s]imilarly, *Horowitz v. 148 S. Emerson Assocs. LLC*, 888 F.3d 13 (2d Cir. 2018), does not utilize Bank's proposed test for Rule 41(d) either, and the factual distinctions he raises between this case and *Horowitz* are irrelevant. " Def. Reply Mem. at 3. First, NFLP did not explain why the factual distinctions, *see* Pl. Opp. Mem. at 3-5, are irrelevant. Second, *Horowitz* made perfectly clear that "Bank's proposed test for Rule 41(d)" is not a "proposed" test at all, but, rather, the standard that applies to Rule 41(d):

> [The plaintiff] *could have asserted a Lanham Act violation in the Georgia state action by simply amending its complaint*. *Rather*, [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. *See Andrews v. America's Living Ctrs., LLC*, 827 F.3d 306, 309 (4th Cir. 2016) ("[T]he purpose of Rule 41(d) is to serve as a deterrent to forum shopping and vexatious litigation."

Horowitz, 888 F.3d at 23 (emphases added). *See also Advanced Video Tech.*, 2019 WL 13214942 at *3-*5; *Iberia Foods Corp. v. Latinfood U.S. Corp.*, No. 20-cv-300, 2021 WL 1616916, *3 (E.D.N.Y. Apr. 26, 2021). Thus, NFLP's statement that, "[Bank] does not dispute that Rule 41(d) allows an award of fees even where bad faith or vexatious litigation is not present," Def. Reply Mem. at 1, did not reflect the case law.

NFLP also claimed that, "[Bank] also does not dispute that an award of costs includes attorneys' fees in the Second Circuit," Def. Reply Mem. at 1, and thus falsely implied that where a court awards costs under Rule 41(d), attorneys fees are automatically included. NFLP would undoubtedly deny that this statement was intended to be misleading, but, as NFLP has shown throughout this litigation, it chooses its words with care and deliberation.

As set forth herein and in Bank's opposition to NFLP's dismissal motion, it has been NFLP's *modus operandi* to mislead the Court, which, as Bank sees it, is due to NFLP's implicit recognition that Bank clearly has standing and is right on the merits. If Bank had truly lacked standing and had been wrong on the merits, not only would NFLP surely not feel the need to make one misleading assertion after another, but would surely have refrained from doing so lest it raise the ire of the Court. NFLP is free to try to write off Bank's foregoing assertions as "bluster," as it did in its reply memorandum of law in support of its dismissal motion (*see* Doc. 31 at 5), but the indisputable facts are that Bank, gadfly that he is according to NFLP (a pejorative but not unreasonable description given that Bank has brought this action as a matter of principle), has been honest and straightforward with the Court in the various motion papers and that NFLP has been the opposite.

B. Defendant Plainly Sought to Prejudice the Court Against Plaintiff by Calling Attention to Irrelevant Matters

NFLP stated:

> On January 6, 2025, the parties sought an extension of the response and briefing deadlines due to health issues experienced by NFLP's counsel. [*Bank I*], ECF 14. The Court granted the request. ECF 15. In its order doing so, the Court noted that, after reading the complaint, it "assume[d] the response will be a motion to dismiss, and possibly for sanctions[.]" *Id.*, ECF 15. It also suspended the initial conference until after the motion to dismiss was decided, "if at that point any conference is necessary." *Id.*
>
> Bank responded via letter the next day, January 8, 2025, admonishing the Court for "giving legal advice to a party," accusing it of partiality, and demanding recission of its suggestion regarding sanctions. *Id.*, ECF No. 16. The Court acknowledged receipt of the letter that same day, and assured Bank of its competency to evaluate the complaint impartially. *Id.*, ECF No. 17.

Def. Ch. Mem. at 2. NFLP did not explain how this exchange had anything to do with the NFLP Motion. Instead, as is plainly transparent, NFLP was 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 not the other way around. NFLP did not address this exchange in its reply, but stated, more generally:

> Bank also accuses NFLP of citing to his prior conduct and legal actions to "prejudice the court against Bank." Opp. at 8. NFLP raised these points to identify Bank's pattern of filing meritless, frivolous suits that waste courts' and parties' time and resources. Preventing vexatious litigation is a core purpose of Rule 41(d). *Horowitz*, 888 F.3d at 23. Therefore, although a showing of bad faith is not required, understanding Bank's prior acts is relevant to the Court's analysis of whether it should exercise its discretion to award costs. The *Bank I* case history and the other Bank cases NFLP has cited show the time, money, and effort that parties, including NFLP, have unnecessarily expended in responding to blatantly deficient claims put forth by Bank—which he now concedes.

Def. Reply Mem. at 6. First, NFLP did not even attempt to explain how the exchange between Bank and the Court bears on the NFLP Motion.

Second, NFLP, in referring to "[t]he *Bank I* case history *and the other Bank cases NFLP has cited*," Def. Reply Mem. at 6 (emphasis added), apparently was making an inadvertent allusion to its dismissal motion, in which it sought to prejudice this Court by referring to other cases. *See* Pl. Opp. Dismissal Mem. at 1-2.

NFLP stated 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. Ch. Mem. at 1-2, citing *Bank I* Compl., Exh. "A." NFLP did not explain how this had anything to do with the NFLP Motion.

NFLP stated 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. Ch. Mem. at 2, but did not explain how this had anything to do with the NFLP Motion (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 noted that the parties had entered into a briefing schedule in *Bank I*, *see* Def. Ch. Mem. at 2, but did not explain how this had anything to do with the NFLP Motion.

NFLP stated: "Bank's vexatious approach to litigation is further apparent from his recent 40-page opposition brief, his denied request for a 27-page sur-reply, and the multiple letters he has sent NFLP's counsel and the Court [sic (one letter to the Court (Doc. 35))] in just the last two weeks—after the Court denied his sur-reply request—seeking further submissions [sic] in addition to his prior three complaints and 40-page opposition." Def. Reply Mem. at 5-6. However, *Bank II* is relevant to the NFLP Motion only with respect to its commencement. In any event, NFLP's accusation is wrong. First, the Court *granted* Bank's request to submit a 40-page brief. *See* Order

dated June 20, 2025 (Doc. 26).

Second, why is it vexatious merely to request permission to submit a sur-reply? Moreover, how could NFLP claim that this was "vexatious" without having read the proposed sur-reply?

Third, as to the "multiple letters" and Bank's request to make "further submissions [sic] in addition to his prior three complaints and 40-page opposition," NFLP again implied that merely asking to make a submission, without considering the reason for the request or the contents of the submission, is somehow "vexatious." In any event, Bank, as NFLP knows, had a very good reason for making his request, in which the "multiple letters" are quoted. *See* Letter Request dated July 11, 2025 (Doc. 35 (pending)). Bank could have made the requested submission along with his opposition to NFLP's dismissal motion. However, he had not anticipated the depths to which NFLP would go in its reply to try to mislead the Court, and thus had not anticipated the need for that submission. That is: per the very nature of this case, Bank, of course, is not currently selling the FGM T-Shirts. However, NFLP, to Bank's surprise, sought to use this fact *against* Bank, even though NFLP would obviously have claimed trademark infringement if Bank *had* been selling the shirts. Specifically, NFLP described "the uniform resource locator and domain name of www.fairgamemerch.com (the 'FGM Website')," Compl., ¶ 92, as a "password-protected, non-functioning website." Def. Dismissal Reply Mem. (Doc. 31) at 2, citing Pl. Dismissal Opp. Mem. (Doc. 28) at 6. However, 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 meant by describing the website as "non-functioning." *Id.* at 2.

Whereas NFLP stated that "[t]he remainder of the website is similarly underdeveloped," Def. Dismissal Reply Mem. at 4, this claim is simply boilerplate falsity. *See* www.fairgamemerch.com using, for the commercial pages, the password "fgmprivateview," which would show that the website is functioning in all respects but one: per the very nature of this case, it does not currently accept

orders.

NFLP stated: "[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. Of course, this was 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.

In sum, Bank's request to submit evidence showing that the FGM Website is capable of processing orders, far from having been made in bad faith, was the result of *NFLP*'s bad-faith argument that the site's current inability to sell the FGM T-Shirts undermine's Bank's standing.

[continued on next page]

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CONCLUSION

Plaintiff respectfully requests that this Court issue an order: (i) imposing sanctions on NFLP and/or NFLP's counsel under Rule 11 of the Federal Rules of Civil Procedure; and (ii) grant, to Plaintiff, any lawful and proper relief.

Dated: July 22, 2025

Respectfully submitted,

s/ Todd C. Bank
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Counsel to Plaintiff

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CERTIFICATE OF COMPLIANCE WITH LOCAL RULE 7.1(c)

This memorandum of law contains 4,288 words.

Dated: July 22, 2025

s/ Todd C. Bank
Todd C. Bank

CERTIFICATE OF SERVICE

I hereby certify that on July 22, 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 22, 2025

s/ Todd C. Bank
Todd C. Bank

STATE OF NEW YORK)		**AFFIDAVIT OF SERVICE**
)	ss.:	**BY OVERNIGHT FEDERAL**
COUNTY OF NEW YORK)		**EXPRESS NEXT DAY AIR**

I, Tyrone Heath, 1702 Clay Avenue, Apt 11, Bronx, New York 10457, being duly sworn, depose and say that deponent is not a party to the action, is over 18 years of age and resides at the address shown above or at

On March 11, 2026

deponent served the within: **Supplemental Appendix**

upon:

Todd C. Bank, Esq.
Plaintiff-Appellant Pro Se
119-40 Union Turnpike
Kew Gardens, New York 11415
(718) 520-7125

the address(es) designated by said attorney(s) for that purpose by depositing **1** true copy(ies) of same, enclosed in a properly addressed wrapper in an Overnight Next Day Air Federal Express Official Depository, under the exclusive custody and care of Federal Express, within the State of New York. This document was also served via the court's filing system.

Sworn to before me on March 11, 2026

Mariana Braylovskiy

MARIANA BRAYLOVSKIY
Notary Public State of New York
No. 01BR6004935
Qualified in Richmond County
Commission Expires March 30, 2030

T. Heath

Job# 389826