

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Adidas America, Inc., a Delaware Corporation,
Petitioner,
-against-
Michael D. Calmese, a resident of Arizona,
Respondent

Cancellation No.: 92048777
Registration No.: 2,202,454
Registration Date: November 10, 1998
Mark: **PROVE IT!**

75 145058

In compliance with the UNITED STATES PATENT AND TRADEMARK OFFICE Trademark Trial and Appeal Boards ORDER, Respondent respectfully submits a copy of the pleadings in ADIDAS AMERICA Inc., v. MICHAEL D. CALMESE Case No. CV-08-0091-ST UNITED STATES DISTRICT COURT District Of Oregon.

Attached hereto as Exhibit [1] is a true copy of the pleadings in civil action CV-08-0091 District Of Oregon.

Indeed, Respondent brought this matter to the Boards attention in paragraph one of Respondent's answer. Accordingly, the Board will be able to suspend this proceeding pending a final determination of civil action Case No. CV-08-0091 District Of Oregon.

Date: June 24, 2008

Respectfully submitted,



Michael D. Calmese
14666 N. 90th Lane
Peoria, Az 85381

Attorney Pro



06-26-2008

U.S. Patent & TMO/TM Mail Rpt. Dt. #54

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing RESPONDENT'S COMPLIANCE with the
Boards order was served upon the Petitioner via United States Postal Service Certified
delivery on June 24, 2008 as follows:

David K. Friedland
Jaime S. Rich
Loot & Friedland, P.A.
355 Alhambra Circle, Suite 1100
Coral Gables, FL 33134

Counsel for Petitioner

EXHIBIT [1]

United States District Court

DISTRICT OF OREGON

ADIDAS AMERICA, INC., a Delaware corporation,

Plaintiff,

v.

MICHAEL D. CALMESE, a resident of Arizona,

Defendant.

NO.

CV '08-0091- ST

SUMMONS IN A CIVIL ACTION

TO: Defendant Michael D. Calmese, 14666 N. 90th Lane, Peoria, Arizona 85381

YOU ARE HEREBY SUMMONED and required to serve upon PLAINTIFF'S ATTORNEYS:

Stephen M. Feldman, OSB No. 93267
PERKINS COIE LLP
1120 NW Couch Street, 10th Floor
Portland, OR 97209-4128
Telephone: (503) 727-2000
Facsimile: (503) 727-2222
Attorneys for Plaintiff

David K. Friedland
Jaime S. Rich
Lott & Friedland, P.A.
355 Alhambra Circle, Suite 1100
Coral Gables, FL 33134
Telephone: 305.448-7089
Facsimile: 305.446-6191
Of Counsel for Plaintiff

an answer to the complaint which is herewith served upon you, within 20 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint. You must also file your answer with the Clerk of this Court within a reasonable period of time after service.

JAN 18 2008

SHERYL S. McCONNELL

Clerk

(By)  Deputy Clerk

Date



Stephen M. Feldman, OSB No. 93267
SFeldman@perkinscoie.com
PERKINS COIE LLP
1120 N.W. Couch Street, Tenth Floor
Portland, OR 97209-4128
Telephone: 503.727.2000
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David K. Friedland
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Coral Gables, FL 33134
Telephone: 305.448-7089
Facsimile: 305.446-6191

Attorneys for Plaintiff

UNITED STATES DISTRICT COURT

DISTRICT OF OREGON

ADIDAS AMERICA, INC., a Delaware
corporation,

Plaintiff,

v.

MICHAEL D. CALMESE, a resident of
Arizona,

Defendant.

CV '08-0091- 31

No. _____

**COMPLAINT FOR DECLARATORY
JUDGMENT**

Plaintiff, adidas America, Inc. (hereinafter, "adidas"), hereby sues Defendant Michael D. Calmese (hereinafter, "Calmese") and alleges the following:

NATURE OF THE ACTION

1. This is an action seeking a declaratory judgment under 28 U.S.C. §§ 2201 and 2202 that adidas's use of the phrase "prove it" does not constitute trademark infringement under 15 U.S.C. § 1114, nor false designation of origin under 15 U.S.C. § 1125 of Calmese's purported trademark "PROVE IT!". In addition, adidas seeks the cancellation of Trademark Registration Number 2,202,454.

JURISDICTION AND VENUE

2. This Court has original jurisdiction over the subject matter of this action. Original jurisdiction for any civil action arising under 15 U.S.C. §§ 1114 or 1125 is conferred on this Court pursuant to 15 U.S.C. § 1121(a) and 28 U.S.C. § 1338(a).

3. This Court has *in personam* jurisdiction over Calmese because, on information and belief, Calmese regularly transacts business in the State of Oregon, and he specifically does so with respect to certain goods that are at issue in this matter. Personal jurisdiction over Calmese is therefore proper under Oregon's long-arm statute, ORCP 4L, and it comports with the requirements of due process under the United States Constitution.

4. In addition, Calmese and his counsel sent adidas and its counsel multiple letters dated March 2, 2007; March 30, 2007; May 8, 2007; May 10, 2007; and May 24, 2007 (hereinafter, the "Letters"), as well as a draft Complaint (on both May 21, 2007 and, again, on December 19, 2007), which alleges that adidas is infringing a trademark purportedly owned by Calmese. All of the referenced correspondence from Calmese to adidas was sent into the State of Oregon.

5. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b) and § 1391(c), because a substantial part of the events giving rise to the claims alleged herein occurred in this judicial district.

THE PARTIES

6. adidas is a Delaware corporation with its principal place of business located at 5055 North Greeley Avenue, Portland, Oregon 97217.

7. Upon information and belief, Calmese is a resident of the State of Arizona having an address at 14666 N. 90th Lane, Peoria, Arizona, 85381.

8. Upon information and belief, Calmese is the owner of United States Trademark Registration No. 2,202,454.

FACTUAL ALLEGATIONS

9. adidas is engaged in the business of designing, developing, manufacturing, marketing and selling athletic and sports equipment, footwear, apparel, and accessories, all of which prominently display one or more of its famous and internationally-recognized, federally-registered trademarks, such as "adidas" and the 3-Bars Logo.

10. Since 1952, the adidas-branded products have been widely advertised, offered for sale, sold and distributed throughout the United States. Thus, the consuming public has come to identify adidas as the source of its athletic products.

11. For its Spring 2007 Season, adidas manufactured and sold a limited quantity of adidas-branded t-shirts bearing the phrase "prove it" above an image of a basketball, football or baseball and its internationally-recognized and federally-registered word adidas®, Reg. No. 1,300,627, and 3-Bars Logo, Reg. No. 2,411,802.

12. adidas used the phrase "prove it" in its ordinary descriptive sense to convey a challenge to athletes to prove themselves on the basketball court, football field or baseball diamond, not to identify the source of the clothing item.

13. Further, adidas used the phrase "prove it" as decoration and ornamentation, and not as an identifier of source of origin of the t-shirts, which is evidenced by the inclusion on each of the t-shirts of adidas's internationally-famous trademarks as part of the design.

14. Upon information and belief, Calmese's PROVE IT! products are men's and women's shirts, sweatshirts, track suits, hats and golf accessories.

15. Upon information and belief, Calmese's PROVE IT! products are offered for sale throughout the United States via his website, www.proveitsportswear.com.

16. On or about May 21, 2007, Calmese threatened to initiate a lawsuit against adidas based on federal trademark infringement and unfair competition of his PROVE IT! trademark. Calmese's threat of a lawsuit was followed up by a May 24, 2007 letter from Calmese's then-attorney seeking to resolve the matter. adidas, through its counsel, advised Calmese that adidas did not believe it had violated his rights and considered the matter closed.

17. On or about December 19, 2007, after not having heard from Calmese in over six (6) months, adidas and its counsel each received another demand from Calmese, to which he again attached a proposed complaint to be filed against adidas.

18. Calmese claims that he is being damaged as a result of adidas's allegedly unauthorized use of the phrase "prove it" in connection with athletic apparel.

19. The Letters and draft complaint prepared by Calmese, alleging trademark infringement and false designation of origin by adidas, have created for adidas a reasonable apprehension that Calmese will file a lawsuit against adidas.

20. adidas firmly denies that its use of the phrase "prove it" infringes or unfairly competes with Calmese's PROVE IT! mark.

FIRST CAUSE OF ACTION
(Declaratory Judgment of Non-Infringement of Registered Trademark)

21. adidas incorporates paragraphs 1 through 20 inclusive as if set forth verbatim herein.

22. This is an action for a declaratory judgment and further relief against Calmese pursuant to 28 U.S.C. §§ 2201 and 2202.

31. The Letters and draft Complaint prepared by Calmese and forwarded to adidas create an actual controversy regarding the right of adidas to use the phrase "prove it" as ornamentation in connection with its products.

32. Calmese's allegations of false designation of origin and unfair competition adversely affect adidas and will continue to adversely affect adidas because, until the Court makes a determination of adidas's rights, adidas will be in doubt as to its right to continue to use the phrase "prove it" as part of its athletic wear designs.

THIRD CAUSE OF ACTION
(Cancellation of Trademark Registration Pursuant to 15 U.S.C. § 1119)

33. adidas incorporates paragraphs 1 through 20 inclusive as if set forth verbatim herein.

34. Upon information and belief, Calmese submitted specimens to the United States Patent and Trademark Office on September 6, 2006, alleging continuous use of the PROVE IT! mark.

35. Upon information and belief, the specimens submitted by Calmese were date-stamped "MAY 18, 1998."

36. Upon information and belief, the specimens submitted by Calmese do not show current use of the mark in connection with the goods identified in Trademark Registration No. 2,202,454, in violation of 15 U.S.C. § 1058.

37. Upon information and belief, Calmese is not offering certain goods identified in the registration, namely "underwear" and/or "men's and women's shorts," for sale in connection with the PROVE IT! mark.

38. Upon information and belief, Calmese knowingly made verified statements alleging continuous use of the PROVE IT! mark at the time of filing his Section 8 and 15 Affidavits and in support of registration of the PROVE IT! mark which were false. In so doing,

Calmese committed fraud on the United States Patent and Trademark Office so that the resulting registration, i.e., Registration No. 2,202,454, should be cancelled.

39. Upon information and belief, Calmese knew or should have known that such misrepresentations of fact identified herein were false and/or misleading.

40. Upon information and belief, Calmese has committed fraud in procuring Registration No. 2,202,454 for PROVE IT!, thus making Calmese's registration of PROVE IT! *void ab initio*.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff, adidas America, Inc., prays for entry of a declaratory judgment against Defendant, Michael D. Calmese, as follows:

1. That the Court enter judgment declaring that adidas's use of the phrase "prove it" does not constitute trademark infringement under 15 U.S.C. § 1114;
2. That the Court enter judgment declaring that adidas's use of the phrase "prove it" does not constitute false designation of origin and unfair competition under 15 U.S.C. § 1125(a);
3. That the Court enter judgment declaring that Registration No. 2,202,454 shall be cancelled and removed from the Principal Register;
4. That Calmese be ordered to pay to adidas an award covering adidas's attorneys' fees, costs, and other expenses incurred as a result of this controversy; and

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Facsimile: 305.446-6191

Attorneys for Plaintiff

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UNITED STATES DISTRICT COURT
DISTRICT OF OREGON

ADIDAS AMERICA, INC., a Delaware
corporation,

Plaintiff,

v.

MICHAEL D. CALMESE, a resident of
Arizona,

Defendant.

CV 08-0091- 31

No. _____

**PLAINTIFF'S CORPORATE
DISCLOSURE STATEMENT**

Pursuant to Fed. R. Civ. P. 7.1

1- PLAINTIFF'S CORPORATE DISCLOSURE
STATEMENT

91004-1100/LEGAL13890213.1

Perkins Coie LLP
1120 N.W. Couch Street, Tenth Floor
Portland, OR 97209-4128
Phone: 503.727.2000
Fax: 503.727.2222

Pursuant to Fed. R. Civ. P. 7.1, counsel for plaintiff provides the following statement:

Plaintiff adidas America, Inc. is wholly owned by adidas North America, Inc., which is a non-public Delaware corporation.

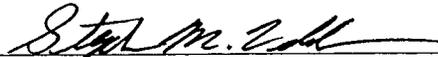
adidas North America, Inc. is wholly owned by adidas International Marketing BV, which is a foreign corporation.

adidas International Marketing BV is wholly owned by adidas AG, which is a foreign corporation.

adidas AG has no parent corporation. No publicly held company owns 10% or more of the stock of adidas AG.

DATED: January 18, 2008

PERKINS COIE LLP

By: 
Stephen M. Feldman, OSB No. 93267
SFeldman@perkinscoie.com
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Coral Gables, FL 33134
Telephone: 305.448-7089
Facsimile: 305.446-6191

Attorneys for Plaintiff

UNITED STATES DISTRICT COURT

District of Oregon

Adidas of America, Inc.,

Plaintiff(s)

vs.

Case No: 3:08-CV-08-91-ST

Michael D. Calmese,

Defendant(s).

Civil Case Assignment Order

(a) **Presiding Judge:** The above referenced case has been filed in this court and assigned for all further proceedings to:

Presiding Judge Hon. Janice M. Stewart

Presiding Judge's Suffix Code* ST

*These letters must follow the case number on all future filings.

(b) **Courtroom Deputy Clerk:** Questions about the status or scheduling of this case should be directed to Donna Ausbie at (503) 326-8057 or donna_ausbie@ord.uscourts.gov

(c) **Civil Docket Clerk:** Questions about CM/ECF filings or docket entries should be directed to Nicole Munoz at (503) 326-8014 or nicole_munoz@ord.uscourts.gov.

(d) **Place of Filing:** Pursuant to LR 3.4(b) all conventionally filed documents must be submitted to the Clerk of Court, Room 740, Mark O. Hatfield United States Courthouse, 1000 S.W. Third Avenue, Portland, Oregon 97204. (See also LR 100.4)

(e) **Jurisdictional Authority of Magistrate Judges:**

(1) **Pretrial Administration:** In accordance with LR 72, the assigned United States Magistrate Judge is authorized to conduct all pretrial proceedings contemplated by 28 U.S.C. § 646(b) and Fed. R. Civ. P. 72 without further designation of the court.

(2) **Trial by Consent and Appeal Options:** In accordance with LR 73, 28 U.S.C. § 646(b) and Fed. R. Civ. P. 73, all United States Magistrate Judges in this district are certified to exercise civil jurisdiction in assigned cases and, with the consent of the parties, enter final orders on dispositive motions, conduct trial, and enter final judgment which may be appealed directly to the Ninth Circuit Court of Appeals (instead of a district judge).

(f) **Consent to a Magistrate Judge:** In accordance with 28 U.S.C. Sec. 636(c) and Fed. R. Civ. P. 73, all United States Magistrate Judges in the District of Oregon are certified to exercise civil jurisdiction in assigned cases and, with the consent of the parties, may also enter final orders on dispositive motions, conduct trial, and enter final judgment which may be appealed directly to the Ninth Circuit Court of Appeals (instead of to a District Judge).

Parties are encouraged to consent to the jurisdiction of a Magistrate Judge by signing and filing the Consent to Jurisdiction by a United States Magistrate Judge (a copy of the consent form is included with this assignment order). There will be no adverse consequences if a party elects not to consent to a Magistrate Judge.

(g) **District Court Website:** Information about United States Magistrate Judges in the District of Oregon, local rules of practice; CM/ECF electronic filing requirements; responsibility to redact personal identifiers from pleadings, motions, and other papers; and other related court information can be accessed on the court's website at www.ord.uscourts.gov.

Dated: January 18, 2008

By: _____
K. Torres, Deputy Clerk

For: Sheryl S. McConnell, Clerk of Court

UNITED STATES DISTRICT COURT

District of Oregon

Adidas of America, Inc.,

Plaintiff(s)

vs.

Case No: 3:08-CV-08-91-ST

Michael D. Calmese,

Defendant(s).

Discovery and Pretrial Scheduling Order

In order to facilitate and expedite discovery and the effective management of this case, the Court orders that:

(a) **Corporate Disclosure Statement:** In accordance with Fed.R.Civ.P. 7.1, any non-governmental corporate party must file a corporate disclosure statement concurrently with the filing of a first appearance.

(b) **Initial Conference of Counsel for Discovery Planning:**

- (1) Except in cases exempted under Fed. R. Civ. 26(a)(1)(E), upon learning the identity of counsel for Defendant(s), counsel for the Plaintiff(s) shall initiate communications with counsel for Defendant(s).
- (2) All counsel shall then confer as required by Fed. R. Civ. P. 26(f) within thirty (30) days after all Defendants have been served (See LR 26.1).
- (3) In accordance with LR 16.2(b) and LR 16.4(c), counsel shall also discuss their client's positions regarding consent to a Magistrate Judge and Alternate Dispute Resolution options.
- (4) If counsel for all of the parties agree to forego the initial disclosures required by Fed. R. Civ. P. 26(a)(1), they can use the Court form issued with this order (See LR 26.2). Whether or not the parties agree to forego the initial disclosures, they may seek discovery once the initial conference of counsel for discovery planning contemplated by Fed. R. Civ. P. 26(f) has occurred (See LR 26.1).

(c) **Rule 16(b) Court Conference for Scheduling and Planning:** Counsel for Plaintiff(s) and for Defendant(s) shall, during or promptly after the conference of counsel referred to in the prior paragraph, contact the assigned judge's deputy clerk and schedule a LR 16.2 conference for scheduling and planning.

At the conference, the parties shall be prepared to discuss discovery, consent to a Magistrate Judge, scheduling and other issues presented by this action, including proposed modifications to the initial schedule set forth below (See LR 16.2).

(d) **Pretrial and Discovery Deadlines:** Not later than 120 days from the date of this order, counsel for all parties shall:

- (1) File all pleadings pursuant to Fed. R. Civ. P. 7(a) and 15;
- (2) Join all claims, remedies and parties pursuant to Fed. R. Civ. P. 18 and 19;
- (3) File all pretrial, discovery and dispositive motions;
- (4) Complete all discovery; and
- (5) Confer as to Alternate Dispute Resolution pursuant to LR 16.4(c).

(e) **Pretrial Order Deadline:** Unless otherwise waived by the court, not later than 150 days from the date of this order, counsel shall lodge a Joint Pretrial Order (See LR 16.6), and file a Joint Alternate Dispute Resolution Report (See LR 16.4).

(f) **Service of this Order:** Counsel for the Plaintiff shall serve this order, and all attachments, upon all other parties to the action.

(g) **CM/ECF Electronic Filing Requirements:** Beginning September 1, 2006, all Registered CM/ECF users must electronically file pleadings, documents, and other papers (other than the initial complaint or removal papers), pursuant to LR 100.1(b). Prior to that date, electronic filing by registered CM/ECF users is authorized and encouraged, although not required. More information about CM/ECF and the Court's electronic filing requirements, including Local Rule 100, can be found on the court's website at www.ord.uscourts.gov

Dated: January 18, 2008

By: _____
K. Torres, Deputy Clerk

For: **Sheryl S. McConnell, Clerk of Court**

UNITED STATES DISTRICT COURT

District of Oregon

Adidas of America, Inc.,

Plaintiff(s)

vs.

Case No: 3:08-CV-08-91-ST

Michael D. Calmese,

Defendant(s).

Fed. R. Civ. P. 26(a)(1) Discovery Agreement

In accordance with LR 26.2, I state that the parties who have been served and who are not in default, have agreed to forego the disclosures required by Fed. R. Civ. P. 26(a)(1).

DATED:

Signature: _____

Name & OSB ID: _____

e-mail address: _____

Firm Name: _____

Mailing Address: _____

City, State, Zip: _____

Phone Number: _____

Parties Represented _____

cc: Counsel of Record

UNITED STATES DISTRICT COURT

District of Oregon

Adidas of America, Inc.,

Plaintiff(s)

vs.

Case No: 3:08-CV-08-91-ST

Michael D. Calmese,

Defendant(s).

**Consent to Jurisdiction by a Magistrate Judge
and Designation of the Normal Appeal Route**

In accordance with Fed. R. Civ. P 73(b), as counsel for the party (parties) identified below, I consent to have a United States Magistrate Judge conduct any and all proceedings in this case, including entry of orders on dispositive motions, trial, and entry of final judgment. I understand that withholding consent will not result in any adverse consequences. In accordance with Fed. R. Civ. P. 73(c), I agree that any appeal from a final order or judgment entered by a United States Magistrate Judge shall proceed directly to the United States Court of Appeals for the Ninth Circuit, and not to a District Judge of this Court.

DATED:

Signature: _____

Name & OSB ID: _____

e-mail address: _____

Firm Name: _____

Mailing Address: _____

City, State, Zip: _____

Phone Number: _____

Parties Represented _____

cc: Counsel of Record

**US District Court – Oregon
Civil Case Management Time Schedules**

Local Rule	Event or Requirement	Time Frame	Comment
LR 16.1(d)	Discovery and Pretrial Scheduling Order (with attachments)	Issued by the clerk's office at the time of filing, along with the summonses	Required to be served on all parties by the filing party
LR 26.1	Initial Conference for Discovery Planning	Within 30 days from service of the last defendant	Held between parties
LR 16.2(a)	Rule 16(b) Conference	Scheduled by the assigned judge after the required LR 26.1 Discovery Conference	Affirmative duty on all counsel to contact the assigned judge's courtroom deputy (See LR 16.2(a))
LR 16.4(c)	ADR Conference Requirements	Within 120 days from the date the discovery order is issued	Parties must confer with other attorneys and unrepresented parties to discuss ADR options
	Joint Status Report	Within 120 days from the date the discovery order is issued	Required in cases assigned to Judges Hogan and Aiken
LR 16.2(e)	Completion of Discovery	Unless otherwise ordered by the court, within 120 days from the date the discovery order is issued	Discovery deadlines are set forth in the Discovery and Pretrial Scheduling Order
LR 16.4(d)	Joint ADR Report	Within 150 days from the date the discovery order is issued	The parties must file a Joint ADR Report
LR 16.6	Joint Pretrial Order	Unless otherwise modified pursuant to LR 16.6(a), within 150 days from the date the discovery order is issued	PTO filing deadline is established in the Discovery and Pretrial Scheduling Order
LR 16.4(f)(1)(D)	Notice to the Court that the Parties Are Unable to Select a Volunteer Mediator	Within ten (10) days after entry of a court order directing reference to a volunteer mediation	Plaintiff's attorney is responsible for notifying the court
LR 16.4(h)(1)	Notification of Private ADR Results	Within seven (7) days after the conclusion of private ADR proceedings	Plaintiff's attorney is responsible for notifying the court
LR 16.4(h)(2)	Report of Court Appointed Private or Volunteer Mediation	Promptly if no settlement is achieved	Court appointed private or volunteer mediator is responsible for notifying the court

**UNITED STATES DISTRICT COURT
DISTRICT OF OREGON**

ADIDAS AMERICA, INC.,)	NO. CV 08-0091
)	
Plaintiff-Counter-Defendant)	Defendant's Answer
)	and Counterclaims
v.)	
)	
MICHAEL D. CALMESE)	
)	
Defendant-Counterclaimant)	
_____)	

Defendant Michael Calmese ("Calmese"), by himself, answer Plaintiff Adidas America, Inc's ("Adidas") Complaint as follows:

NATURE OF THE ACTION

1. Defendant admits that this is an action seeking a declaratory judgment that Adidas's use of the phrase "PROVE IT" does not constitute trademark infringement, nor false designation of origin of Defendant's purported trademark "PROVE IT!". In addition Defendant admits that Adidas seeks the cancellation of Trademark Registration Number 2,202,454. Defendant denies all other allegations embedded in paragraph 1 of the Complaint.

JURISDICTION AND VENUE

2. Defendant admits that the Court has subject matter jurisdiction over this action. Defendant denies all other allegations embedded in paragraph 2 of the Complaint.

3. Defendant admits that the Court has personal jurisdiction over Defendant and that venue is proper in this district. Defendant denies all other allegations embedded in paragraph 3 of the Complaint.

4. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 4 of the Complaint.
5. Defendant denies the allegations contained in paragraph 5 of the Complaint.

THE PARTIES

6. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 6 of the Complaint.
7. Defendant admits the allegations contained in paragraph 7 of the Complaint.
8. Defendant admits the allegations contained in paragraph 8 of the Complaint.

FACTUAL ALLEGATIONS

9. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 9 of the Complaint.
10. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 10 of the Complaint.
11. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 11 of the Complaint.
12. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 12 of the Complaint.
13. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 13 of the Complaint.
14. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 14 of the Complaint.
15. Defendant admits the allegations contained in paragraph 15 of the Complaint.
16. Defendant denies knowledge or information sufficient to form a belief as to the truth

or falsity of the allegations contained in paragraph 16 of the Complaint.

17. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 17 of the Complaint.

18. Defendant admits the allegations contained in paragraph 18 of the Complaint.

19. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 19 of the Complaint.

20. Defendant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 20 of the Complaint.

FIRST CAUSE OF ACTION
(Declaratory Judgment of Non-Infringement of Registered Trademark)

21. Defendant repeats and realleges each response contained in Paragraphs 1 through 20 of this Answer as if fully set forth herein.

22. Defendant denies the allegations contained in paragraph 22 of the Complaint.

23. Defendant denies the allegations contained in paragraph 23 of the Complaint.

24. Defendant denies the allegations contained in paragraph 24 of the Complaint.

25. Defendant denies the allegations contained in paragraph 25 of the Complaint.

26. Defendant denies the allegations contained in paragraph 26 of the Complaint.

SECOND CAUSE OF ACTION
(Declaratory Judgment of Non-False Designation of Origin)

27. Defendant repeats and realleges each response contained in Paragraphs 1 through 26 of this Answer as if fully set forth herein.

28. Defendant admits the allegations contained in paragraph 28 of the Complaint.

29. Defendant admits the allegations contained in paragraph 29 of the Complaint.

30. Defendant denies knowledge or information sufficient to form a belief as to the truth

or falsity of Adidas's "reasonable apprehension", as alleged in paragraph 30, but admits that he is, in this very document, filing claims against Adidas for violations of his well-established trademark rights in the mark "PROVE IT" for Adidas's use of the phrase on its clothing products in 2006 and 2007.

31. Defendant denies allegations contained in paragraph 31 of the Complaint.

32. Defendant denies allegations contained in paragraph 32 of the Complaint.

THIRD CAUSE OF ACTION
(Cancellation of Trademark Registration Pursuant to 15 U.S.C. §1119)

33. Defendant repeats and realleges each response contained in Paragraphs 1 through 32 of this Answer as if fully set forth herein.

34. Defendant admits the allegations contained in paragraph 34 of the Complaint.

35. Defendant admits the allegations contained in paragraph 35 of the Complaint.

36. Defendant vigorously denies the allegations contained in paragraph 36 of the Complaint.

37. Defendant vigorously denies the allegations contained in paragraph 37 of the Complaint.

38. Defendant vigorously denies the allegations contained in paragraph 38 of the Complaint.

39. Defendant vigorously denies the allegations contained in paragraph 39 of the Complaint.

40. Defendant vigorously denies the allegations contained in paragraph 40 of the Complaint.

AFFIRMATIVE DEFENSES

First affirmative Defense

41. The Complaint fails to state a cause of action upon which relief can be granted.

Second Affirmative Defense

42. Adidas lacks standing to bring the claims in this action.

Third Affirmative Defense

43. Adidas claims are barred because he appears before this Court with unclean hands.

Fourth Affirmative Defense

44. Adidas has acquiesced in Defendant's conduct.

Fifth Affirmative Defense

45. Adidas has waived its claims.

Sixth Affirmative Defense

46. Adidas is estopped from maintaining its claims.

COUNTERCLAIMS

Parties

1. Counterclaimant-Defendant Michael Calmese is an individual who resides at 14666 N. 90th Lane, Peoria, Arizona 85381.
2. Counter-Defendant/Plaintiff Adidas America, Inc., is a national sporting goods company, incorporated in Oregon, and with its principal place of business in Portland, Oregon.

Jurisdiction and Venue

3. This Court has subject matter jurisdiction over all the claims in this action pursuant to 28 U.S.C. §1331, §1338 and 15 U.S.C. §1221, and over the claims arising under Oregon State law additionally under 28 U.S.C. §1332 and §1367.
4. This Court has personal jurisdiction over Adidas America Inc., as it transacts substantial business in this District, committed the tortious acts alleged herein in this District, among others, and caused Counterclaimant Calmese harm in this District.
5. Venue is proper in this District pursuant to 28 U.S.C. §1391(b) and (c), as a substantial part of the events which gave rise to the harm to Calmese occurred in this District and Adidas America Inc., resides in this District.

Allegations Common to All Counterclaims

6. Calmese first used the trademark "Prove It!" in interstate commerce in November 1995.
7. Since that time, Calmese has used the mark "Prove It!" continually until today, and intends to continue to do so into the indefinite future, on a variety of articles of clothing, including but not limited to shirts, t-shirts, shorts, jackets men's and

women's shorts, underwear and hats, also see www.proveitsportwear.com.

Furthermore, he has established considerable goodwill in, and recognition of, the mark by the public.

8. In 1998, in the name of a company in which he was a principal, Prove It! Sportsgear, Calmese obtained a trademark registration for the mark "Prove It!", registration number 2,202,454, for use with "clothing, namely men's and women's shirts, men's and women's T-shirts, men's and women's shorts, baseball hats, men's and women's jackets, socks, underwear, and men's and women's sweatshirts." Shortly thereafter, Prove it! Sportsgear assigned its rights in that mark to its principal, Michael Calmese.
9. Adidas America Inc., is a national and international manufacture and retailer of athletic footwear and a variety of types of apparel, which it sells nation wide through several national retail outlets, including but not limited to, Dick's Sporting Goods and Academy Sports+Outdoors retail stores (SEE copy of Dick's Sporting Goods and Academy Sports+Outdoors sales receipt attached as Exhibit A). In January 2007, on the front of Adidas America Inc's t-shirts, in bold print, was emblazoned the mark "PROVE IT" (SEE copies of "PROVE IT" T-shirts produced by Adidas attached as Exhibit B). Furthermore, Adidas America Inc., used the mark "PROVE IT" in bold print, on hang tags and on the actual sales receipts (SEE copy of "Prove It" hang tags and receipts produced by Adidas attached as Exhibit C and A) and (SEE copy of prove it hangs tags and t-shirts produced by Michael Calmese attached as Exhibit D).
10. Adidas America Inc., never sought permission or any type of license from Calmese before duplicating his trademark on the front of t-shirts, hang tags and sales receipts (SEE copy of Calmese's "PROVE IT!®" T-shirts and hangs attached as Exhibit D).
11. In fact, beginning as early as April 1999, Calmese entered a dialogue with Reebok

International Ltd., which was purchased by Adidas a few years later, over the possibility of using the trademark "Prove It!". Calmese co-sponsored charity events with Reebok throughout the time leading up to January 2007 when Reebok's partner Adidas placed the mark "PROVE IT" on its t-shirts, hang tags and sales receipts.

12. Adidas America Inc., therefore was fully aware that Calmese was the bona fide owner of the mark at the time it used it without authorization. Adidas America Inc., then, intentionally, willfully and deliberately used Calmese's trademark in an effort to trade off the goodwill and reputation Calmese established in it through his hard work over the past 12 years.
13. After Adidas's unauthorized and unlawful use of the mark "PROVE IT", Calmese contacted Adidas to inform it that he was aware of its violation of his trademark rights, that he wanted the violation to cease immediately and that he wanted to be compensated for the damage done to him and his mark as a consequence. Adidas conceded to Calmese's cease and desist demand, in part. Adidas America Inc., also offered its assurance that it would never use Calmese's mark again to leave it alone, which Calmese rightfully refused. The Court should note Calmese is not offering evidence of settlement to prove liability for or invalidity of the claim or its amount.
14. Calmese had intended to file a lawsuit against Adidas America Inc., for its violation of his rights, but, before he could do so, Adidas America Inc., filed the instant declaratory action against him.
15. Calmese now files the claims he intended to file against Adidas America Inc., in the form of counterclaims.

First Counterclaim
Trademark Infringement – 15 U.S.C. §1114

16. Calmese repeats and re-alleges paragraphs 1 through 15 of his Counterclaims as if set forth fully herein.
17. Adidas America Inc., willfully and intentionally copied Calmese's federally registered trademark "Prove It!" on clothing, hang tags and receipts in a deliberate effort to confuse consumers into believing that Adidas is somehow sponsored by or associated with Calmese.
18. In doing so, Adidas attempted to trade and capitalize upon the goodwill and reputation that Calmese has spent 12 years developing.
19. Adidas's actions caused Calmese damages and losses in an amount to be determined at trial.

Second Counterclaim
Violation of Oregon Unlawful Business, Trade Practices Chapter 646.608

20. Calmese repeats and re-alleges paragraphs 1 through 19 of his Counterclaims as if set forth fully herein.
21. Adidas's actions constitute unlawful trade practices in the conduct of business, trade or commerce in the State of Oregon, in violation of Oregon Unlawful Business, Trade Practices 646.608.
22. Adidas engaged in the aforesaid unlawful trade practices willfully, intentionally and knowingly, thereby justifying the assessment of punitive damages in an amount to be determined at trial.

23. Adidas's action caused Calmese damages and losses in an amount to be determined at trial.

PRAYER FOR RELIEF

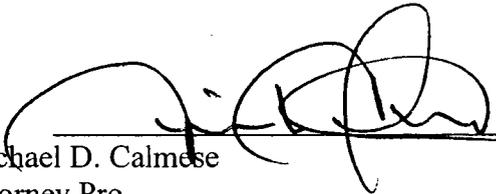
WHEREFORE Counterclaimant-Defendant prays for judgment against Adidas America Inc., as follow:

- A. an injunction prohibiting Adidas from any and all use of Calmese's federally registered trademark "Prove It!" at any time without the express authorization of Calmese;
- B. an assessment of damages against Adidas for the loss and harm sustained by Calmese as a consequence of Adidas's actions;
- C. an assessment of punitive damages against Adidas due to its unlawful trade practices in violation of Oregon State law;
- D. an award of costs and attorney fees to be determined at trial in accordance with 15 U.S.C. §1117.
- E. All such other relief as the Court may deem necessary, equitable and proper.

Jury Demand

Counter-Plaintiff-Defendant Calmese requests trial by jury of all issues in its
Counterclaims that are triable
before a jury.

Dated February 12, 2008



Michael D. Calmese
Attorney Pro
14666 N. 90th Lane
Peoria, Arizona 85381
Tel: (602)348-0964

Attorney Pro

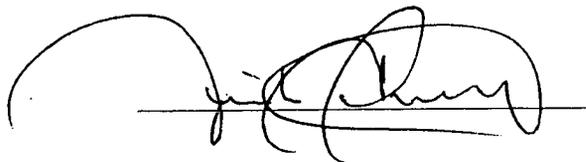
Certificate of Service

I, Michael D. Calmese under penalty of perjury, that on February 12, 2008, I served, via first class mail, the attached Defendant's Answer and Counterclaims, on counsel for Plaintiff:

Stephen M. Feldman, Esq.
Perkins Coie LLP
1120 N.W. Couch Street, Tenth Floor
Portland, OR 97209

David K. Friedland, Esq.
Jaime S. Rich, Esq.
Lott & Friedland, P.A.
355 Alhambra Circle, Suite 1100
Coral Gables, FL 33134

Dated: February 12, 2008

A handwritten signature in black ink, appearing to read "Michael D. Calmese", is written over a horizontal line. The signature is fluid and cursive, with a large loop at the end.

DICKS SPORTING GOODS
HENDERSON, NV
(702) 855-5000

SALE 440 005 68601 02/20/07
0317 02:46 PM

PROVE IT
098096913434 14.98
CURRENT: \$14.99
SALE NEW \$14.98 -0.01

PROVE IT
098096913441 14.98
CURRENT: \$14.99
SALE NEW \$14.98 -0.01

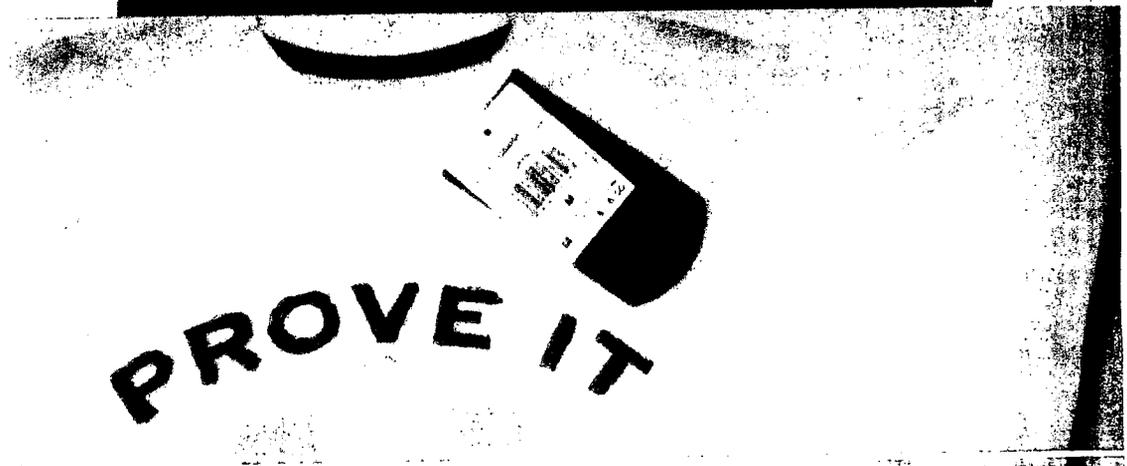
2 ITEMS	SUBTOTAL	29.96
	TOTAL TAX	2.32
	TOTAL	\$32.28
	CASH	40.00
	CHANGE	-7.72

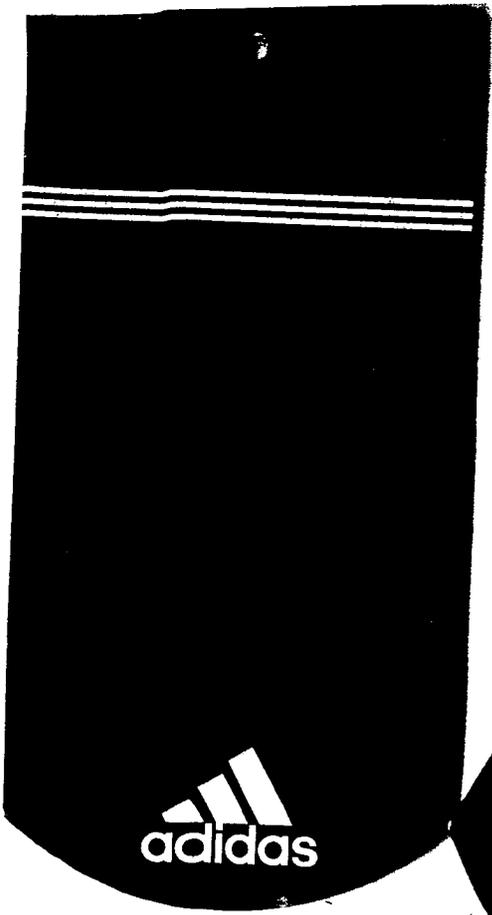
REGULAR PRICE 29.98
YOU SAVED \$0.02

THANK YOU FOR SHOPPING AT DICK'S
SHOP www.DicksSportingGoods.com

Manage your ScoreCard Rewards Account at
www.MyDicksSportingGoods.com

Complete our online Customer Survey at
www.DicksSportingGoods.com/feedback
for \$10 off your next purchase of \$50.
Survey must be completed within
48 hours of store visit.





Prove It FB
UNIVRED/WHITE 242700
893367001



CHUSMRSP 0102.V01

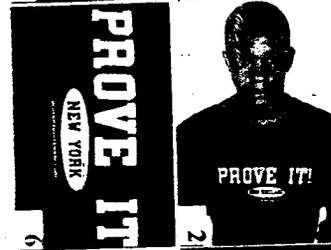
M
Prc **66.71%** 242700
M UNIVRED/WHITE
\$ 18.00

Prove It FB
UNIVRED/WHITE 242700
893367001



CHUSMRSP 0102.V01

L P. **\$14.99** 242700
UNIVRED/WHITE
\$ 18.00



Feb 02, 2008



- Honda
- Yamaha
- Suzuki
- Kawasaki
- Bombardier
- Seadoo
- Polaris

METRO MOTORSPORTS

Part#: 101-1
 Desc: FULL FRONT BLACK TEE-PROVE IT
 Bins: TS Source: PI
 Retail: 10.00 Sale: 10.00



- Honda
- Yamaha
- Suzuki
- Kawasaki
- Bombardier
- Seadoo
- Polaris

METRO MOTORSPORTS

Part#: 101-2
 Desc: FULL FRONT WHITE TEE-PROVE IT
 Bins: TS Source: PI
 Retail: 10.00 Sale: 10.00

**UNITED STATES DISTRICT COURT
DISTRICT OF OREGON**

ADIDAS AMERICA, INC.,)	NO. CV 08-0091
)	
Plaintiff-Counter-Defendant)	Defendant-Counterclaimant
)	Rule 26(a) Initial Disclosure Statement
v.)	
)	
MICHAEL D. CALMESE)	
)	
Defendant-Counterclaimant)	
)	

Pursuant to Federal Rules of Civil Procedure, Rule 26(a), Defendant-Counterclaimant Michael Calmese. (hereafter Defendant-Counterclaimant) hereby submits its Initial Disclosure Statement, and reserves the right to supplement this Disclosure Statement, as necessary:

RULE 26(a)(1)(A) Individuals Likely To Have Discoverable Information Relevant To
The Disputed Facts.

1. Michael Calmese, Owner, Prove It! Trademark, 14666 North 90th Lane, Peoria, Arizona 85381. Mr. Calmese is expected to testify on the formation of various entities to do business with the trademark Prove It!, negotiations with Adidas, and all discussions he had with Adidas, all facts contained in the complaint based on his own knowledge, various phone conversations he had with Adidas, all operations and sales of Prove It! branded merchandise, all facts concerning the registration of the PROVE IT! mark, all payments he made on and for the application that matured into the PROVE IT! mark, and all other matters between Prove It! and third parties, and between Mr. Calmese and Plaintiff, and

promises made by Adidas to PROVE IT! to never use Defendant's trademark PROVE IT in the future.

2. Attorney Scot L. Clause, MARISCAL, WEEKS, McINTYRE & FRIEDLANDER, P.A., 2901 North Central Avenue, Suite 200, Phoenix, Arizona 85012, (602)285-5000. Mr. Scot Claus is expected to testify on the specifics of filing the application for the PROVE IT! mark.
3. Attorney Jordan M. Meschkow, MESCHKOW & GRESHAM, P.L.C., 5727 North Seventh Street, Suite 409, Phoenix, Arizona 85014, (602)274-6996. Mr. Meschkow is expected to testify on the specifics of filing the §8 and §15 Affidavit on behalf of the registered trademark PROVE IT! and that this affidavit attest that the mark is still in use and has been continuously used for at least five years from registration.
4. Attorney Dennis E. Sheehan, Footlocker, Inc., 112 West 34th Street, New York, New York 10120 (telephone to be supplemented). Mr. Sheehan is expected to testify that on September 9, 2005 he represented Eastbay Inc., in the Eastbay Inc., v. Michael Calmese matter in a New York District Court and consented to having Michael Calmese's approval for future use of the mark "Prove It".
5. The documents produced by or to Plaintiff-Counter-Defendant may also disclose the identities of individuals having discoverable information relevant to disputed facts alleged with particularity in the pleadings.
6. Defendant-Counterclaimant reserves the right to supplement this disclosure after further discovery.

RULE 26(a)(1)(B) Documents.

1. All records of Attorney Scot L. Claus's documents relating to the application for the PROVE IT! mark, maintained by Mr. Claus at MARISCAL, WEEKS, McINTYRE & FRIEDLANDER, P.A., 2901 North Central Avenue, Suite 200, Phoenix, Arizona 85012, (602)285-5000.
2. All records of Attorney Jordan Meschkow's documents relating to the specifics of filing the §8 and §15 Affidavit on behalf of the registered trademark PROVE IT!, maintained by Mr. Meschkow at MESCHKOW & GRESHAM, P.L.C., 5727 North Seventh Street, Suite 409, Phoenix, Arizona 85014, (602)274-6996.
3. Plaintiff reserves the right to supplement this disclosure after further discovery.

RULE 26(a)(1)(C) Damages.

Plaintiff-Counter-Defendant's actions have caused Defendant-Counterclaimant irreparable harm, as well as economic damages, however the amount of damages has not yet been ascertained. Moreover, since part of damages are based on Plaintiff-Counter-Defendant's profits and/or Defendant-Counterclaimant's lost profits, these amount of damages have not yet been ascertained either. Further, in addition to seeking elevated damages due to Plaintiff-Counter-Defendant's willful misconduct, Defendant-Counterclaimant will seek reasonable attorneys' fees and costs incurred in litigating this suit. The amount of attorneys' fees and cost are unknown at this time, but will continue to accumulate.

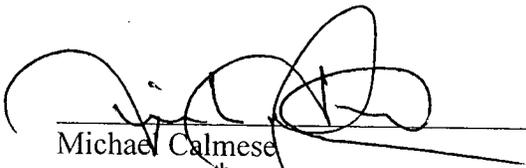
RULE 26(a)(1)(D) Insurance.

Defendant-Counterclaimant has no general commercial liability insurance policy and no coverage applies to this matter.

RULE 26(a)(2) Experts.

Defendant-Counterclaimant plans on calling one or more experts on trademark ownership and infringement issues, and on damages, but no such experts have been selected or retained as yet.

Respectfully submitted this 12th day of February, 2008,



Michael Calmese
14666 N. 90th Lane
Peoria, Arizona 85381
Telephone(602) 348-0964
ATTORNEY PRO SE

Copy mailed this 12th February 2008 to:

Stephen M. Feldman, Esq.
Perkins Coie LLP
1120 N.W. Couch Street, Tenth Floor
Portland, OR 97209

David K. Friedland, Esq.
Jaime S. Rich, Esq.
Lott & Friedland, P.A.
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jrich@lfiplaw.com
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Telephone: 305.448-7089
Facsimile: 305.446-6191

Attorneys for Plaintiff and Counterclaim Defendant

UNITED STATES DISTRICT COURT
DISTRICT OF OREGON

ADIDAS AMERICA, INC., a Delaware
corporation,

Plaintiff and Counterclaim
Defendant,

v.

MICHAEL D. CALMESE, a resident of
Arizona,

Defendant and
Counterclaimant.

No. CV08-0091 ST

REPLY TO COUNTERCLAIMS

By Plaintiff/Counter-Defendant adidas
America, Inc.

1- REPLY TO COUNTERCLAIMS

Plaintiff/Counter-Defendant, adidas America, Inc. ("adidas"), hereby replies to the Counterclaims of Defendant/Counter-Plaintiff, Michael D. Calmese ("Calmese"), as follows:

PARTIES

1. adidas is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 and therefore denies same.

2. adidas denies that it is incorporated in Oregon. adidas admits the remaining allegations contained in Paragraph 2.

JURISDICTION AND VENUE

3. adidas admits the allegations contained in Paragraph 3.

4. adidas admits that this Court has jurisdiction over adidas because adidas transacts substantial business in this District. adidas denies the remaining allegations contained in Paragraph 4.

5. adidas admits that Venue is proper in this District. adidas denies the remaining allegations contained in Paragraph 5.

ALLEGATIONS COMMON TO ALL COUNTERCLAIMS

6. adidas is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 and therefore denies same.

7. adidas denies the allegations contained in Paragraph 7.

8. adidas admits that the United States Patent and Trademark Office registered the mark **PROVE IT!** (Reg. No. 2,202,454), in favor of Prove It! Sportsgear, for use with "clothing, namely, men's and women's shirts, men's and women's T-shirts, men's and women's shorts, baseball hats, men's and women's jackets, socks, underwear and men's and women's sweatshirts," in International Class 25. adidas denies all remaining or different allegations contained in Paragraph 8.

9. In response to Paragraph 9, adidas avers that within the United States it is an authorized distributor of ADIDAS brand merchandise, and that within the United States adidas

sells, *inter alia*, athletic footwear and a variety of types of apparel through various channels of trade, including, but not limited to, certain retail chains, such as Dick's Sporting Goods and Academy Sports + Outdoors. adidas admits that it used the phrase "prove it" in its ordinary descriptive sense in connection with certain t-shirts. adidas denies all remaining or different allegations contained in Paragraph 9.

10. adidas denies the allegations contained in Paragraph 10.

11. adidas is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 11 and therefore denies same.

12. adidas denies the allegations contained in Paragraph 12.

13. adidas denies the allegation that adidas unlawfully used the phrase "prove it." adidas admits that Calmese contacted adidas regarding the alleged violation of Calmese's purported trademark rights, but adidas denies that it conceded to Calmese's cease and desist demands. adidas denies all remaining or different allegations contained in Paragraph 13.

14. adidas is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 14 and therefore denies same.

15. adidas is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 15 and therefore denies same.

FIRST COUNTERCLAIM

16. adidas repeats and re-alleges its responses to Paragraphs 1 through 15 above, as if fully set forth herein.

17. adidas denies the allegations contained in Paragraph 17.

18. adidas denies the allegations contained in Paragraph 18.

19. adidas denies the allegations contained in Paragraph 19.

SECOND COUNTERCLAIM

20. adidas repeats and re-alleges its responses to Paragraphs 1 through 15 above, as if fully set forth herein.

21. adidas denies the allegations contained in Paragraph 21.
22. adidas denies the allegations contained in Paragraph 22.
23. adidas denies the allegations contained in Paragraph 23.

PRAYER FOR RELIEF

24. adidas denies that Calmese is entitled to any relief in connection with the allegations of his Counterclaims, including, without limitation, the allegations of Paragraphs A through E of his prayer for relief.

25. All allegations contained in Calmese's Counterclaims that are not specifically admitted by adidas are hereby denied. adidas denies that Calmese is entitled to judgment in his favor or to the relief requested in his Counterclaims.

AFFIRMATIVE DEFENSES

adidas asserts the following Affirmative Defenses:

First Affirmative Defense

As a first, separate and distinct affirmative defense, adidas asserts that Calmese's Counterclaims are barred because Calmese abandoned the PROVE IT! mark and therefore cannot state a claim upon which relief can be granted.

Second Affirmative Defense

As a second, separate and distinct affirmative defense, adidas asserts that Calmese's Counterclaims are barred, in whole or in part, by the doctrine of unclean hands. Calmese has unclean hands because Calmese committed fraud on the United States Patent and Trademark Office in procuring the trademark registration for PROVE IT!.

Third Affirmative Defense

As a third, separate and distinct affirmative defense, adidas asserts that Calmese's Counterclaims are barred, in whole or in substantial part, by laches because Calmese had prior knowledge of adidas's usage of the phrase "prove it" and failed to object to this usage and unreasonably delayed in bringing claims against adidas.

Fourth Affirmative Defense

As a fourth, separate and distinct affirmative defense, adidas asserts that Calmese's Counterclaims are barred, in whole or in substantial part, by estoppel because Calmese's delay in bringing claims against adidas caused and is causing prejudice to adidas.

Fifth Affirmative Defense

As a fifth, separate and distinct affirmative defense, adidas asserts that Calmese's Counterclaims are barred by acquiescence.

Sixth Affirmative Defense

As a sixth, separate and distinct affirmative defense, adidas asserts that Calmese's Counterclaims are barred because Calmese does not have priority of use of any mark containing the phrase "prove it" for the relevant goods and services.

Seventh Affirmative Defense

As a seventh, separate and distinct affirmative defense, adidas asserts that any use it made of the phrase "prove it" was not trademark usage and therefore did not violate any of Calmese's purported rights.

Eighth Affirmative Defense

As an eighth, separate and distinct affirmative defense, adidas asserts that there has been no actual confusion or confusion of any type or quality during a substantial period of concurrent use and therefore no likelihood of confusion exists.

Ninth Affirmative Defense

As a ninth, separate and distinct affirmative defense, adidas asserts that even assuming infringement, unfair competition or any other allegedly improper activity is proven by Calmese, which adidas specifically denies, Calmese cannot establish that he has or will suffer any damages as a result thereof.

Tenth Affirmative Defense

As a tenth, separate and distinct affirmative defense, adidas asserts that Calmese's Counterclaims are barred by his failure to mitigate damages, if any.

Eleventh Affirmative Defense

As an eleventh, separate and distinct affirmative defense, adidas asserts that Calmese's Counterclaims are barred, in whole or in part, by his own bad faith acts because Calmese threatened to file suit against adidas and subsequently asserted his Counterclaims for the purpose of harassment.

DATED: March 6, 2008

PERKINS COIE LLP

By: /s/ Stephen M. Feldman

Stephen M. Feldman, OSB No. 93267
SFeldman@perkinscoie.com
1120 N.W. Couch Street, Tenth Floor
Portland, OR 97209-4128
Telephone: 503.727.2000
Facsimile: 503.727.2222

David K. Friedland (admitted *pro hac vice*)
dkfriedland@lfiplaw.com
Jaime S. Rich (admitted *pro hac vice*)
jrich@lfiplaw.com
Lott & Friedland, P.A.
355 Alhambra Circle, Suite 1100
Coral Gables, FL 33134
Telephone: 305.448-7089
Facsimile: 305.446-6191

Attorneys for Plaintiff and Counterclaim Defendant

Other Answers

3:08-cv-00091-ST Adidas America, Inc. v. Calmese

U.S. District Court

District of Oregon

Notice of Electronic Filing

The following transaction was entered by Feldman, Stephen on 3/6/2008 at 1:42 PM PST and filed on 3/6/2008

Case Name: Adidas America, Inc. v. Calmese

Case Number: 3:08-cv-91

Filer: Adidas America, Inc.

Document Number: 8

Docket Text:

Reply to *Counterclaims*. Filed by all plaintiffs. (Related document(s): Answer to Complaint, Counterclaim [6].) (Feldman, Stephen)

3:08-cv-91 Notice has been electronically mailed to:

Stephen M. Feldman feldm@perkinscoie.com, docketpor@perkinscoie.com, gillj@perkinscoie.com, skroberts@perkinscoie.com

David K. Friedland dkfriedland@lfiplaw.com, krivera@lfiplaw.com, kruiz@lfiplaw.com

Jaime S. Rich jrich@lfiplaw.com

3:08-cv-91 Notice will not be electronically mailed to:

The following document(s) are associated with this transaction:

Document description:Main Document

Original filename:Not Available

Electronic document Stamp:

[STAMP ordStamp_ID=875559790 [Date=3/6/2008] [FileNumber=2392884-0] [6447a2967b7565cf490e700403f417a767c89d9017603d6793243e2878b12d1557f5147f3ec3ea23c75c5ee0da8eba0f06fd47e1756c1ab4e61e0a77c41aedd3]]

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing **REPLY TO COUNTERCLAIMS** on:

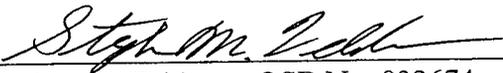
Michael D. Calmese
14666 N. 90th Lane
Peoria, AZ 85381
Attorney Pro Se

by causing a full, true, and correct copy thereof, addressed to the last-known office address of the attorney or registered agent, to be sent by the following indicated method or methods (unless indicated otherwise above), on the date set forth below:

- By **mailing** in a sealed, first-class postage-prepaid envelope and deposited with the U. S. Postal Service at Portland, Oregon.
- By **email transmission**.
- By **hand delivery**.

DATED: March 6, 2008

PERKINS COIE LLP

By 
Stephen M. Feldman, OSB No. 932674
Telephone: (503) 727-2000

Attorneys for Plaintiff and Counterclaim Defendant

Stephen M. Feldman, OSB No. 932674
SFeldman@perkinscoie.com
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Facsimile: 305.446-6191

Attorneys for Plaintiff and Counterclaim Defendant

UNITED STATES DISTRICT COURT
DISTRICT OF OREGON

ADIDAS AMERICA, INC., a Delaware
corporation,

Plaintiff and Counterclaim
Defendant,

v.

MICHAEL D. CALMESE, a resident of
Arizona,

Defendant and
Counterclaimant.

No. CV08-0091 ST

**PLAINTIFF'S INITIAL DISCLOSURES
PURSUANT TO FED. R. CIV. P. 26(a)(1)**

1- PLAINTIFF'S INITIAL DISCLOSURES
PURSUANT TO FED. R. CIV. P. 26(A)(1)

21184-0068/LEGAL13979629.1

Perkins Coie LLP
1120 N.W. Couch Street, Tenth Floor
Portland, OR 97209-4128
Phone: 503.727.2000
Fax: 503.727.2222

Pursuant to Federal Rule of Civil Procedure 26(a)(1), Plaintiff and Counterclaim Defendant, adidas America, Inc. ("adidas"), makes the following initial disclosures:

(A) the name and, if known, the address and telephone number of each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses, unless solely for impeachment, identifying the subjects of the information:

At this time, without having conducted discovery, adidas is not aware of all persons who may have discoverable information. While adidas may supplement its disclosure as investigation and discovery proceed, adidas has identified the individuals listed below as persons who may have knowledge or information of facts or circumstances regarding the claims, events or transactions forming the subject matter of this action, each of which may be contacted through counsel for adidas located at Lott & Friedland, P.A., 355 Alhambra Circle, Suite 1100, Coral Gables, FL 33134, (305) 448-7089:

1. Stephen Pierpoint (brand marketing and strength of adidas's trademarks);
2. Jon Sinko (creation and development of t-shirts bearing the descriptive phrase "prove it");
3. Dave Trowbridge (sales of t-shirts bearing the descriptive phrase "prove it"); and
4. Vanessa Backman (ownership and enforcement of adidas's trademarks; communications with Defendant and Counterclaimant, Michael D. Calmese).

(B) a copy of, or a description by category and location of, all documents, data compilations, and tangible things that are in the possession, custody, or control of the party and that the disclosing party may use to support its claims or defenses, unless solely for impeachment:

At this time, without having conducted discovery, adidas is not aware of all documents, data compilations, and tangible things within its possession, custody, or control that adidas may use to support its claims or defenses. In fact, adidas anticipates that many of the documents it

may use to support its claims or defenses are within the possession, custody, or control of Defendant and Counterclaimant, Michael D. Calmese ("Defendant"). While adidas may supplement its disclosure as investigation and discovery proceed, adidas has at this time identified the documents listed below, all of which are located at either (1) Perkins Coie LLP, 1120 NW Couch Street, 10th Floor, Portland, Oregon 97209-4128, or (2) adidas's headquarters at 5055 N. Greeley Avenue, Portland, Oregon 97217:

1. Trademark registration certificates for adidas's federally-registered trademarks;
2. Representative samples of advertising, promotion, and marketing materials featuring adidas's trademarks;
3. Summaries of advertising, promotion, and marketing expenditures;
4. Representative catalogs showing use of adidas's trademarks;
5. Summaries of sales revenue from products bearing adidas's trademarks;
6. Evidence of adidas's trademark enforcement efforts; and
7. Copies of written communications with Defendant.

(C) a computation of any category of damages claimed by the disclosing party, making available for inspection and copying as under Rule 34 the documents or other evidentiary material, not privileged or protected from disclosure, on which such computation is based, including materials bearing on the nature and extent of injuries suffered:

At this time, adidas is not seeking recovery of any monetary damages other than reimbursement of the attorneys' fees and other litigation costs and expenses that it incurs in this action. As set forth in its Complaint, adidas seeks various forms of declaratory relief. In the event that adidas amends its claims and later seeks the recovery of any monetary damages in this action, it will promptly supplement its disclosures.

(D) for inspection and copying as under Rule 34 any insurance agreement under which any person carrying on an insurance business may be liable to satisfy part or all of a

judgment which may be entered in the action or to indemnify or reimburse for payments made to satisfy the judgment:

adidas does not believe that there are any applicable insurance agreements. adidas may supplement its disclosures from time to time as investigation and discovery proceed, and will produce any insurance agreement that is applicable.

DATED: March 14, 2008

PERKINS COIE LLP

By: /s/ Stephen M. Feldman

Stephen M. Feldman, OSB No. 932674
SFeldman@perkinscoie.com
1120 N.W. Couch Street, Tenth Floor
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Telephone: 503.727.2000
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David K. Friedland (admitted *pro hac vice*)
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355 Alhambra Circle, Suite 1100
Coral Gables, FL 33134
Telephone: 305.448-7089
Facsimile: 305.446-6191

Attorneys for Plaintiff and Counterclaim Defendant

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing **PLAINTIFF'S INITIAL DISCLOSURES**
PURSUANT TO FED. R. CIV. P. 26(a)(1) on:

Michael D. Calmese
14666 N. 90th Lane
Peoria, AZ 85381
Attorney Pro Se

by causing a full, true, and correct copy thereof, addressed to the last-known office address of the attorney or registered agent, to be sent by the following indicated method or methods (unless indicated otherwise above), on the date set forth below:

- By **mailing** in a sealed, first-class postage-prepaid envelope and deposited with the U. S. Postal Service at Portland, Oregon.
- By **email transmission**.
- By **hand delivery**.

DATED: March 14, 2008

PERKINS COIE LLP

By /s/ Stephen M. Feldman
Stephen M. Feldman, OSB No. 932674
Telephone: (503) 727-2000

Attorneys for Plaintiff and Counterclaim Defendant

Discovery Documents

3:08-cv-00091-ST Adidas America, Inc. v. Calmese

U.S. District Court

District of Oregon

Notice of Electronic Filing

The following transaction was entered by Feldman, Stephen on 3/14/2008 at 4:30 PM PDT and filed on 3/14/2008

Case Name: Adidas America, Inc. v. Calmese

Case Number: 3:08-cv-91

Filer: Adidas America, Inc.

Document Number: 10

Docket Text:

Fed. R. Civ. P. 26(a)(1) Agreement *Plaintiff's Initial Disclosures Pursuant to Fed. R. Civ. P. 26(a)(1)*.
Filed by Adidas America, Inc.. (Feldman, Stephen)

3:08-cv-91 Notice has been electronically mailed to:

Stephen M. Feldman feldm@perkinscoie.com, docketpor@perkinscoie.com, gillj@perkinscoie.com, skroberts@perkinscoie.com

David K. Friedland dkfriedland@lfiplaw.com, krivera@lfiplaw.com, kruiz@lfiplaw.com

Jaime S. Rich jrich@lfiplaw.com

3:08-cv-91 Notice will not be electronically mailed to:

The following document(s) are associated with this transaction:

Document description:Main Document

Original filename:Not Available

Electronic document Stamp:

[STAMP ordStamp_ID=875559790 [Date=3/14/2008] [FileNumber=2402257-0] [0cbd7709348a3de9465aeb29478cf400767cce70d11caa7ce00ad2a6cd1e6a1d73170731cff0b2ce0e168bfff383a6e0161e783a9e6b8787c18ea69d6b3b74]]

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Adidas America, Inc., a Delaware Corporation, Petitioner,)	Cancellation No.: 92048777
)	Registration No.: 2,202,454
)	Registration Date: November 10, 1998
-against-)	Mark: PROVE IT!
)	
Michael D. Calmese, a resident of Arizona, Respondent)	
_____)	

ANSWER TO PETITION TO CANCEL

Respondent Michael D. Calmese ("Calmese"), by its undersigned, as and for its Answer to the Petition to Cancel alleges as follows:

1. With regard to the introductory paragraph, Respondent admits Petitioner, Adidas America, Inc., is a Delaware corporation, located and doing business at 5055 N. Greeley Avenue, Portland, Oregon, but vigorously denies all other allegations contained in the introductory paragraph. The Trademark Trial And Appeal Board should note that there have been two **IDENTICAL** actions filed against Respondent seeking a declaratory judgment in federal court. Respondent has successfully defended its mark against cancellation in EASTBAY INC., v. MICHAEL D. CALMESE Case No. CV-06-0162 in United States District Court, Southern District Of New York and NOW Respondent is currently defending its mark against cancellation in ADIDAS AMERICA INC., v. MICHAEL D. CALMESE Case No.

CV-08-0091 in United States District Court, District Of Oregon. It should also be noted that the declaratory suits filed by Adidas America Inc., and Eastbay Inc., seeking cancellation of Michael D. Calmese's PROVE IT! trademark are based on the same frivolous foundation.

2. Respondent admits the allegations contained in paragraph 1 of the Petition To Cancel.
3. Respondent admits the allegations contained in paragraph 2 of the Petition To Cancel.
4. Respondent vigorously denies the allegations contained in paragraph 3 of the Petition To Cancel.
5. Respondent vigorously denies the allegations contained in paragraph 4 of the Petition To Cancel.
6. Respondent denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 5 of the Petition To Cancel.
7. Respondent denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 6 of the Petition To Cancel.
8. Respondent vigorously denies the allegations contained in paragraph 7 of the Petition To Cancel. Current use of the PROVE IT! mark in connection with ALL of the goods identified in Trademark Registration 2,202,454 can be confirmed at www.proveitsportswear.com .
9. Respondent vigorously denies the allegations contained in paragraph 8 of the Petition To Cancel.
10. Respondent vigorously denies the allegations contained in paragraph 9 of the Petition To Cancel. Current use of the PROVE IT! mark in connection with "underwear" and/or "men's and women's shorts" can be confirmed at www.proveitsportswear.com and

www.usaproveit.com and also in Respondent's mail order PROVE IT!® catalogs.

11. Respondent vigorously denies the allegations contained in paragraph 10 of the Petition To Cancel.
12. Respondent vigorously denies the allegations contained in paragraph 11 of the Petition To Cancel.
13. Respondent vigorously denies the allegations contained in paragraph 12 of the Petition To Cancel.
14. Respondent vigorously denies the allegations contained in paragraph 13 of the Petition To Cancel. Again, current use of the PROVE IT! mark in connection with ALL of the goods identified in Trademark Registration 2,202,454 can be confirmed at www.proveitsportswear.com AND www.usaproveit.com and also in Respondent's mail order PROVE IT!® catalogs.

**AS AND FOR A
FIRST AFFIRMATIVE DEFENSE**

15. Petitioner's Petition to Cancel fails to state any claim upon which relief may be granted.

**AS AND FOR A
SECOND AFFIRMATIVE DEFENSE**

16. Petitioner's claims are barred by doctrines of waiver and estoppel.

**AS AND FOR A
THIRD AFFIRMATIVE DEFENSE**

17. Petitioner's claims are barred because he appears before this Board with unclean

hands.

**AS AND FOR A
FOURTH AFFIRMATIVE DEFENSE**

18. As Respondent's registration for the mark PROVE IT! has been in effect for over five(5) years, it has reached "incontestable status" and is consequently not subject to third party challenges other than on very limited valid grounds.

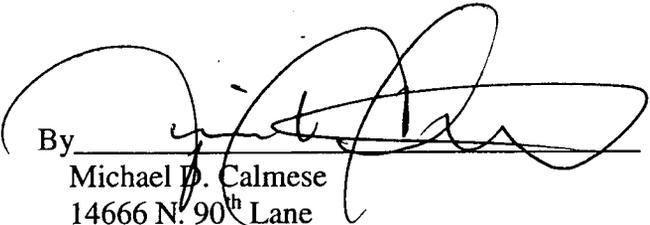
**AS FOR A
FIFTH AFFIRMATIVE DEFENSE**

19. Petitioner lacks standing to initiate the cancellation proceeding, as Petitioner does not have ANY rights in and to the mark PROVE IT!, has not made any continued use of the mark PROVE IT, and/or did not and/or does not now have a bona fide intent to use the mark PROVE IT! in commerce.

WHEREFORE, Respondent respectfully requests that the Board dismiss this cancellation proceeding in it entirely.

Date: February 25, 2008

By _____


Michael D. Calmese
14666 N. 90th Lane
Peoria, Arizona 85301
(602)348-0964 telephone
proveit@excite.com

Attorney Pro

Certificate of Service

I, Michael D. Calmese under penalty of perjury, that on February 26, 2008, I served, via first class mail, the attached Respondent's Answer, on counsel for Plaintiff:

David K. Friedland, Esq.
Jaime S. Rich, Esq.
Lott & Friedland, P.A.
355 Alhambra Circle, Suite 1100
Coral Gables, FL 33134

Dated: February 26, 2008

A handwritten signature in black ink, appearing to read "Michael D. Calmese", is written over a horizontal line. The signature is stylized and cursive.

Minutes of Proceedings3:08-cv-00091-ST Adidas America, Inc. v. Calmese

U.S. District Court

District of Oregon

Notice of Electronic Filing

The following transaction was entered on 4/14/2008 at 4:26 PM PDT and filed on 4/14/2008

Case Name: Adidas America, Inc. v. Calmese**Case Number:** 3:08-cv-91**Filer:****Document Number:** 12(No document attached)**Docket Text:**

Minutes of telephone Rule 16 Conference. ORDER: Striking the case schedule and deadlines and setting the following new case schedule and deadlines: Joint Alternate Dispute Resolution Report and written consents to proceed before a Magistrate Judge (if any) due by 9/10/2008. Discovery is to be completed and dispositive motions are due by 12/10/2008. Exchange of Expert Witness Statements must be completed and the Pretrial Order is due by 4/14/2009. ORDER: Waiving Local Rule 56.1(a)(2) requiring a Concise Statement of Material Facts supporting a motion for summary judgment. However, if the moving party elects to file a Concise Statement of Material Facts, then the responding party will have to comply with LR 56.1 (b) & (c) or risk having the moving party's material facts deemed admitted under LR 56.1(f). Jaime Rich and Stephen Feldman present as counsel for plaintiff(s). Michael Calmese, pro se present as counsel for defendant(s). Court Reporter: none. Tape No: none. Janice M. Stewart presiding. (Related document(s): Scheduling,, [11].) (stewart1,)

3:08-cv-91 Notice has been electronically mailed to:

Stephen M. Feldman feldm@perkinscoie.com, docketpor@perkinscoie.com, gillj@perkinscoie.com, skroberts@perkinscoie.com

David K. Friedland dkfriedland@lfiplaw.com, kriviera@lfiplaw.com, kruiz@lfiplaw.com

Jaime S. Rich jrich@lfiplaw.com

3:08-cv-91 Notice will not be electronically mailed to:Michael Calmese
14666 N. 90th Lane
Peoria, AZ 85381

#12