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

Proceeding	92048777
Party	Defendant Michael Calmese
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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

Pursuant to the Board’s December 23, 2010 Order, Trademark Rule § 2.117, and TBMP § 510.02(a), Registrant, Michael D. Calmese (“Calmese”), hereby amends his reply to Petitioner’s Response to Calmese’s Notice of Disposition of the Civil Action filed December 14, 2010 (and supplemented on December 28, 2010), and request that the Board take notice of a true and accurate copy of Exhibit A, from Petitioner’s Response. As grounds for Registrant’s request, Calmese states as follows:

1. On January 12, 2011, Petitioner did not provide this Board with a complete copy of Calmese’s Notice of Appeal.
2. On January 13, 2011, after Calmese filed his initial reply it was discovered that Petitioner’s Exhibit A, did not include the exhibits attached to Calmese Notice of Appeal.

3. Subsequently, Calmese is now filing a complete copy of Registrant's Notice of Appeal to the Ninth Circuit Court with its exhibits. Attached hereto as **Exhibit B**, is a true and complete copy of Calmese Notice of Appeal.
4. Accordingly, Calmese respectfully request that the Board view Petitioner's Exhibit A, in its entirety.

RESPECTFULLY SUBMITTED this 13th day of January, 2011.

s/Michael D. Calmese/
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above Amended Reply was forwarded on this the 13th day of January, 2011, addressed as follows:

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s/Michael D. Calmese/
Michael D. Calmese

EXHIBIT B.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON

ADIDAS AMERICA, INC.,

08-CV-91-ST

Plaintiff,

ORDER

v.

MICHAEL CALMESE,

Defendant.

DAVID K. FRIEDLAND

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Defendant, *Pro Se*

BROWN, Judge.

On July 8, 2009, Magistrate Judge Janice M. Stewart issued Amended Findings and Recommendation (#101) in which she recommended this Court (1) grant the Motion (#42) for Summary Judgment of Plaintiff adidas America, Inc., as to Plaintiff's First Cause of Action for a declaratory judgment for noninfringement of the registered trademark "prove it!"; (2) grant Plaintiff's Motion as to Defendant's Counterclaim for trademark infringement; (3) grant Plaintiff's Motion as to Defendant's Counterclaim for violations of Oregon Unlawful Trade Practices Act (OUTPA), Or. Rev. Stat. § 646.605, *et seq.*; (4) deny Plaintiff's Motion as to its affirmative defense of fair use to Defendant's Counterclaim; (5) deny Plaintiff's Motion as to its Second Cause of Action for a declaration that Plaintiff's use of the registered trademark "prove-it!" is not a false designation of origin; and (6) deny Plaintiff's Motion as to its Third Cause of Action for cancellation of trademark registration.

Both Plaintiff and Defendant filed Objections to the Magistrate Judge's Amended Findings and Recommendation.

On August 17, 2009, the Magistrate Judge also issued an Opinion and Order (#115), a nondispositive order, denying

Defendant's Motion (#103) for Leave to Amend Opposition and File Motion to Dismiss. The Court, as discussed below, construes Defendant's August 27, 2009, letter as a timely objection to the Magistrate Judge's Opinion and Order.

These matters are now before this Court pursuant to 28 U.S.C. § 636(b)(1) and Federal Rule of Civil Procedure 72 (a) and (b).

When any party objects to any portion of the Magistrate Judge's Findings and Recommendation or any portion of a Magistrate Judge's nondispositive Order, the district court must make a *de novo* determination of that portion of the Magistrate Judge's report or order. 28 U.S.C. § 636(b)(1). *See also United States v. Reyna-Tapia*, 328 F.3d 1114, 1121 (9th Cir. 2003)(*en banc*); *United States v. Bernhardt*, 840 F.2d 1441, 1444 (9th Cir. 1988).

This Court is relieved of its obligation to review the record *de novo* as to those portions of the Findings and Recommendations that were not objected to by the parties. *Britt v. Simi Valley Unified School Dist.*, 708 F.2d 452, 454 (9th Cir. 1983)(rev'd on other grounds). *See also Lorin Corp. v. Goto & Co.*, 700 F.2d 1202, 1206 (8th Cir. 1983). Having reviewed *de novo* the legal principles of those portions of the Findings and Recommendations that were not objected to by the parties, the Court does not find any error.

STANDARDS

I. Summary Judgment.

Federal Rule of Civil Procedure 56(c) authorizes summary judgment if no genuine issue exists regarding any material fact and the moving party is entitled to judgment as a matter of law. The moving party must show the absence of an issue of material fact. *Rivera v. Philip Morris, Inc.*, 395 F.3d 1142, 1146 (9th Cir. 2005). In response to a properly supported motion for summary judgment, the nonmoving party must go beyond the pleadings and show there is a genuine issue of material fact for trial. *Id.*

An issue of fact is genuine "'if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.'" *Villiarimo v. Aloha Island Air, Inc.*, 281 F.3d 1054, 1061 (9th Cir. 2002)(quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). The court must draw all reasonable inferences in favor of the nonmoving party. *Id.* "Summary judgment cannot be granted where contrary inferences may be drawn from the evidence as to material issues." *Easter v. Am. W. Fin.*, 381 F.3d 948, 957 (9th Cir. 2004)(citing *Sherman Oaks Med. Arts Ctr., Ltd. v. Carpenters Local Union No. 1936*, 680 F.2d 594, 598 (9th Cir. 1982)).

A mere disagreement about a material issue of fact, however, does not preclude summary judgment. *Jackson v. Bank of*

Haw., 902 F.2d 1385, 1389 (9th Cir. 1990). When the nonmoving party's claims are factually implausible, that party must "come forward with more persuasive evidence than otherwise would be necessary." *Wong v. Regents of Univ. of Cal.*, 379 F.3d 1097 (9th Cir. 2004), as amended by 410 F.3d 1052, 1055 (9th Cir. 2005)(citing *Blue Ridge Ins. Co. v. Stanewich*, 142 F.3d 1145, 1149 (9th Cir. 1998)).

The substantive law governing a claim or a defense determines whether a fact is material. *Miller v. Glenn Miller Prod., Inc.*, 454 F.3d 975, 987 (9th Cir. 2006). If the resolution of a factual dispute would not affect the outcome of the claim, the court may grant summary judgment. *Id.*

II. Trademark infringement.

"A successful trademark infringement claim . . . requires a showing that the claimant holds a protectable mark, and that the alleged infringer's imitating mark is similar enough to 'cause confusion, or to cause mistake, or to deceive.'" *Survivor Media, Inc. v. Survivor Prod.*, 406 F.3d 625, 630 (9th Cir. 2005)(quoting *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 116 (2004)). "The critical determination is 'whether an alleged trademark infringer's use of a mark creates a likelihood that the consuming public will be confused as to who makes what product.'" *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 632 (9th Cir. 2008)(quoting *Brother Records Inc. v. Jardine*,

318 F.3d 900, 908 (9th Cir. 2003)).

The Ninth Circuit employs the following eight-factor test (*Sleekcraft* factors) to determine the likelihood of confusion: "(1) strength of the mark; (2) proximity or relatedness of the goods; (3) similarity of sight, sound and meaning; (4) evidence of actual confusion; (5) marketing channels; (6) type of goods and purchaser care; (7) intent; and (8) likelihood of expansion." *Jada Toys*, 518 F.3d at 632 (quoting *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)). "The factors should not be rigidly weighed, but are only intended to guide the court." *Dreamwerks Prod. Group, Inc.*, 142 F.3d at 1129 (citing *Sleekcraft*, 599 F.2d at 348-49). In addition, "the test for likelihood of confusion is 'pliant,' and 'some factors are much more important than others.'" *Jada Toys*, 518 F.3d at 632 (quoting *Brookfield Commc'n, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1053-54 (9th Cir. 1999)).

DISCUSSION

I. Plaintiff's Objections to the Magistrate Judge's Findings and Recommendation.

Plaintiff contends the Magistrate Judge erred when she (1) recommended this Court deny summary judgment to Plaintiff as to its claim for a declaration of non-false designation of origin and (2) found two of the *Sleekcraft* factors favor Defendant.

A. Plaintiff's claim for non-false designation of origin.

Plaintiff contends the Magistrate Judge erred when she recommended this Court deny summary judgment to Plaintiff as to its claim for a declaration of non-false designation of origin on the ground that the recommendation is inconsistent with the Magistrate Judge's recommendation that this Court grant summary judgment to Plaintiff on its claim of trademark noninfringement.

15 U.S.C. § 1125(a) provides:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any . . . false designation of origin . . ., which . . . is likely to cause confusion . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

The test for whether trademark infringement has occurred is identical to the test for whether false designation of origin has occurred. *Jada Toys*, 518 F.3d at 632. *See also Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1178 (9th Cir. 1988); *Brookfield*, 174 F.3d at 1046.

Although the Magistrate Judge did not separately address Plaintiff's claim for a declaration of non-false designation of origin, she did address whether a likelihood of confusion existed between the use of the phrase "prove it" on Plaintiff's t-shirts and Defendant's "prove it!" trademark. As noted, after considering each of the *Sleekcraft* factors, the Magistrate Judge found two were neutral, four weighed in favor of Plaintiff, and

two weighed in favor of Defendant. The Magistrate Judge found the factors that were most important were the ones favoring Plaintiff; namely, lack of strength of Defendant's mark, the lack of relatedness of the goods, the lack of similarity of the marks, and the lack of evidence of actual confusion. Accordingly, the Magistrate Judge concluded there was not any triable issue of fact as to the likelihood of confusion between the two marks.

After reviewing the pertinent portions of the record *de novo* and Plaintiff's Objections, the Court notes the *Sleekcraft* factors found by the Magistrate Judge to favor Plaintiff also are at the heart of the test for non-false designation of origin, and, therefore, the Court finds the Magistrate Judge erred when she denied summary judgment to Plaintiff on its claim for a declaration of non-false designation of origin.

B. *Sleekcraft* factors of similarity of marketing channels and good faith.

Plaintiff contends the Magistrate Judge erred when she found the *Sleekcraft* factors regarding similarity of marketing channels and good faith weighed in Defendant's favor even though the findings do not change the outcome of the Magistrate Judge's decision, because, as noted, the Magistrate Judge found the *Sleekcraft* factors in favor of Plaintiff outweighed the factors in favor of Defendant.

1. Similarity of marketing channels.

Although Plaintiff contends both parties rely on word-of-mouth, Internet sites, sports-related retail stores, and the sponsorship of professional athletes and teams, the only overlap that exists between its marketing channels and those of Defendant are primarily in the Phoenix, Arizona, area, and, therefore, Plaintiff contends this factor should weigh in its favor. Under *Surfvivor*, however, this factor weighs in favor of Defendant despite the fact that the geographic overlap in their marketing channels is minor. See 406 F.3d at 634 (factor weighed in favor of the party whose products were primarily marketed in a single state).

The Magistrate Judge, viewing all of the facts in the light most favorable to Defendant as the nonmoving party, noted the parties had achieved differing degrees of success in their marketing, but both parties were essentially operating within the same marketing channels, and, therefore, this factor weighs in Defendant's favor.

After reviewing the pertinent portions of the record *de novo* and Plaintiff's Objections, the Court agrees with the Magistrate Judge. Accordingly, the Court does not find any error in the Magistrate Judge's Amended Findings and Recommendation as to this factor.

2. Good faith.

This factor weighs against an alleged infringer who

employs a mark with actual or constructive knowledge of its trademarked status. *Surfvivor*, 406 F.3d at 634. Plaintiff contends there is not any evidence that it acted in bad faith when it used the phrase "prove it" on its merchandise. "'[W]here the alleged infringer[, however,] adopted his mark with knowledge, actual or constructive, that it was another's trademark,' resolution of this factor favors [the holder of the mark]." *Surfvivor*, 406 F.3d at 634 (quoting *Brookfield*, 174 F.3d at 1059).

The Magistrate Judge, viewing all of the facts in the light most favorable to Defendant as the nonmoving party, found Plaintiff acted with actual or constructive knowledge of the existence of Defendant's trademark when it used the "prove it" phrase on its merchandise because a simple trademark search would have revealed it was Defendant's trademark and because Defendant at one point contacted Plaintiff regarding a co-sponsorship with Reebok.

After reviewing the pertinent portions of the record *de novo* and Plaintiff's Objections, the Court agrees with the Magistrate Judge. Accordingly, the Court does not find any error in the Magistrate Judge's Amended Findings and Recommendation as to this factor.

II. Defendant's Objections to the Magistrate Judge's Amended Findings and Recommendation.

Defendant contends the Magistrate Judge erred by

(1) concluding certain *Skillcraft* factors did not weigh in Defendant's favor and, as a result, granting summary judgment to Plaintiff as to its claim for a declaration of trademark noninfringement and as to Defendant's Counterclaim of trademark infringement and (2) granting summary judgment to Plaintiff as to Defendant's Counterclaim for violations of OUTPA.

A. Timeliness of Defendant's Objections.

Plaintiff contends this Court should strike Defendant's Objections to the Magistrate Judge's Amended Findings and Recommendation because the Objections were not timely filed. Defendant, however, asserts he timely filed his Objections to the Amended Findings and Recommendation because he mailed them on July 20, 2009. Defendant has offered a photocopy of his receipt to demonstrate the date he mailed his Objections.

Unlike service on other parties, which may be effective upon placing the document in the mail, a filing with the Court does not occur until the document is received by the Clerk of Court. Fed. R. Civ. P. 5(d)(2). *See also Ordonez v. Johnson*, 254 F.3d 814, 816 (9th Cir. 2001)(a complaint is filed when it is received by the clerk); *McClellon v. Lone Star Gas Co.*, 66 F.3d 98, 101 (5th Cir. 1995)("[A] pleading is considered filed when placed in the possession of the clerk of court."). The court has discretion to strike a late filing. *Rodriguez v. West Publ'g Corp.*, 563 F.3d 948, 967 (9th Cir. 2009)(citing *United States v.*

W.R. Grace, 526 F.3d 499, 508-09 (9th Cir. 2008)(*en banc*)).

The record reflects Objections to the Amended Findings and Recommendation were due on July 20, 2009, but Defendant's Objections were not received by the Clerk of Court until July 22, 2009. Accordingly, Defendant's Objections to the Amended Findings and Recommendation were not timely.

Although the Court agrees Defendant's Objections, nevertheless, fail to provide a basis for not adopting the Magistrate Judge's Amended Findings and Recommendation as discussed below. Accordingly, in the exercise of its discretion, the Court concludes it is appropriate to consider the merits of Defendant's Objections.

B. The Magistrate Judge's findings as to the *Skillcraft* factors that were neutral or favored Plaintiff.

Defendant objects to the Magistrate Judge's findings that six of the *Skillcraft* factors were neutral or weighed in favor of Plaintiff on the ground that Defendant's attorney, who has since withdrawn, had an alleged conflict of interest that resulted in his failure to file several exhibits in response to Plaintiff's summary-judgment motion. Defendant asserts his attorney failed to file Exhibits A-J and Exhibits O and P, all of which are attached to Defendant's Objections. The Court notes, however, that Defendant's Exhibits B, D, E, F, G, O, and P are all attached to the Supplemental Declaration of Jaime S. Rich, which was part of the record before the Magistrate Judge. In addition,

Exhibits H and I are attached to Defendant's Answer. Thus, all of the exhibits with the exception of Exhibit A, part of Exhibit C, and Exhibit J were part of the record before the Magistrate Judge. Accordingly, any failure on the part of Defendant's attorney to refile those exhibits was harmless.

With respect to Exhibit A, the Court notes it consists of the Affidavits of Karen Maldonado, Susan Badger, and Ray Maxxy, who each state they experienced actual confusion with respect to the parties' products. As noted, Exhibit A was not part of the record before the Magistrate Judge on summary judgment.

Exhibit C, consisting of Bank of America Statements from September 2003 to December 2007 is only partly represented in the Supplemental Declaration of Jaime S. Rich, which includes only bank records from 2005. Defendant's Exhibit J is the Magistrate Judge's Order on the Motion to Withdraw as Counsel of Record, which the Court notes could not have been filed by Defendant's attorney or considered by the Magistrate Judge when resolving Plaintiff's summary-judgment motion because Defendant's counsel withdrew after Plaintiff's summary-judgment motion was fully briefed. In addition, Exhibit J does not address the *Skillcraft* factors.

Nevertheless, although Defendant contends the Magistrate Judge would have concluded all of the *Skillcraft* factors weighed in Defendant's favor if his attorney had filed the documents in

question, Defendant does not argue the Magistrate Judge's findings with respect to the *Skillcraft* factors were erroneous on the record that was before her.

Plaintiff, in turn, argues all of the documents produced by Defendant in discovery were included as attachments to the Supplemental Declaration of Jaime S. Rich. Plaintiff contends Exhibit A (the Affidavits of Maldenado, Badger, and Maxxy) and Exhibit C (the 2003-07 bank records) are inadmissible in any event because Defendant failed to produce them in discovery. In fact, Plaintiff maintains the first time it saw Exhibit A and all of Exhibit C is when it received Defendant's Objections to the Magistrate Judge's Amended Findings and Recommendation. Plaintiff points out that the Court may exclude evidence that a party failed to produce during discovery. *See Zhang v. Am. Gem Seafoods, Inc.*, 339 F.3d 1020, 1028 (9th Cir. 2003).

Defendant does not dispute Exhibits A and C were not produced during discovery. According to Defendant, however, he provided them to his attorney who, in turn, failed to disclose them because of the attorney's alleged conflict of interest with respect to Plaintiff. The conflict of interest allegedly arises from the fact that Defendant's former attorney had performed some legal work for Plaintiff on an unrelated matter about seven years earlier when he was part of another law firm.

1. Defendant's Exhibit A.

As noted, Exhibit A consists of three affidavits from individuals stating they experienced actual confusion between the parties' products. As noted, Defendant contends his attorney should have produced these documents to Plaintiff, but did not because of an alleged conflict of interest.

The three affidavits that make up Exhibit A, however, are not probative of whether a likelihood of confusion between the two marks exists because a "handful of declarations . . . submitted as evidence do not reliably indicate that [a product's] trade dress is likely to confuse 'an appreciable number of people.'" *Hansen Beverage Co. v. Nat'l Beverage Corp.* 493 F.3d 1074, 1080-81 (9th Cir. 2007) *vacated on other grounds* by 499 F.3d 923 (9th Cir. 2007)(citing *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1151 (9th Cir. 2002)(infringement exists only when a mark is likely to "confuse an appreciable number of people as to the source of the product").

Moreover, the record reflects that in its June 19, 2008, Interrogatory No. 11 and its June 19, 2008, Request for Production of Documents No. 18, Plaintiff requested Defendant, who was not represented at that time, to provide detailed descriptions of and any documents relating to any instances of actual confusion between Defendant's trademark and any of Plaintiff's goods or services. In his July 14, 2008, response to Plaintiff's Interrogatory No. 11, Defendant described one

instance of actual confusion between his trademark and Plaintiff's goods that occurred at a Dick's Sporting Goods store, and he stated he would submit "an appreciable number of affidavits from a number of individuals establishing actual confusion." Defendant, however, did not produce any affidavits or other responsive documents establishing actual confusion during the discovery period. The record reflects Defendant's attorney filed his Notice of Appearance on December 15, 2008, well after Defendant answered Plaintiff's Interrogatory and Request for Production. Accordingly, Defendant was at least as responsible as his counsel for providing Plaintiff with the material contained in Exhibit A, because the affidavits that make up Exhibit A are encompassed by Plaintiff's discovery requests.

Accordingly, even if Defendant's attorney could have or should have submitted Exhibit A in response to Plaintiff's Motion for Summary Judgment, such an error would be harmless because it would not have affected the outcome of the *Sleekcraft* analysis.

2. Defendant's Exhibit C.

As noted, Exhibit C, Defendant's 2000-07 bank records, was only partly represented in the record before the Magistrate Judge, who had Defendant's bank records from 2005.

With respect to the Magistrate Judge's analysis of the *Sleekcraft* factors, these additional bank records are relevant only to establish Defendant's sales from his trademark, a fact

that can be important to determine strength of a trademark under the *Sleekcraft* analysis. See *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1179 (9th Cir. 1988) (sales can help demonstrate trademark strength). The strength of a trademark determines the scope of protection to which it is entitled. *Entrepreneur Media*, 279 F.3d at 1141. "This 'strength' of the trademark is evaluated in terms of its conceptual strength and commercial strength." *Goto.com*, 202 F.3d at 1207. With respect to conceptual strength,

the strongest marks--that is, those which receive the maximum trademark protection--are "arbitrary" or "fanciful." The weakest marks, entitled to no trademark protection, are "generic." In between lie "suggestive" and "descriptive" marks; suggestive marks have the greater strength of the two.

Entrepreneur Media, 279 F.3d at 1141 (internal citations omitted). Commercial strength may be demonstrated by commercial success, extensive advertising, length of exclusive use, and public recognition. *M2 Software, Inc. v. Madacy Entm't, Inc.*, 421 F.3d 1073, 1081 (9th Cir. 2005). In addition, "a suggestive or descriptive mark, which is conceptually weak, can have its overall strength as a mark bolstered by its commercial success." *Id.* A "lack of commercial strength[, however,] cannot diminish the overall strength of a conceptually strong mark so as to render it undeserving of protection." *Id.*

"A suggestive mark conveys an impression of a good but

requires the exercise of some imagination and perception to reach a conclusion as to the product's nature." *Brookfield*, 174 F.3d at 1058 n.19 (citation omitted). "Arbitrary . . . marks have no intrinsic connection to the product with which the mark is used . . . [and] consist[] of words commonly used in the English language." *Id.* (citation omitted).

The Magistrate Judge concluded Defendant's trademark was either suggestive or arbitrary on the scale of conceptual strength, but was commercially weak, and, therefore, found this *Sleekcraft* factor weighed in favor of Plaintiff.

The Court concludes the Magistrate Judge did not err to the extent she found Defendant's mark was arbitrary. The Magistrate Judge correctly concluded Defendant's trademark does not have any intrinsic connection to the products Defendant sells and is made up of commonly used words that require an inferential step to associate it with Defendant's products. Accordingly, Defendant's mark is arbitrary, and, therefore, is a strong mark. *Id.*

The Magistrate Judge did err, however, when she found the commercial weakness of Defendant's trademark eroded its conceptual strength because although the commercial success of a trademark can bolster a trademark's strength, a lack of commercial success does not weaken a strong mark. See *M2 Software*, 421 F.3d at 1081. Accordingly, the commercial success

of Defendant's trademark is of little relevance in determining its overall strength because it is conceptually strong in any event. *Id.* Defendant's complete 2003-07 bank records, which impact the *Sleekcraft* analysis only in terms of showing trademark strength through commercial success, therefore, do not add anything to the analysis.

Accordingly, even if Defendant's attorney could or should have submitted Exhibit C in response to Plaintiff's Motion for Summary Judgment, such an error would be harmless.

Nonetheless, even though the Court has concluded the Magistrate Judge erred with respect to her finding as to the strength of Defendant's trademark and, therefore, also erred when she found this *Sleekcraft* factor weighed in Plaintiff's favor, the Court concludes this factor, although weighing in Defendant's favor, does not tip the overall balance of the *Sleekcraft* factors in Defendant's favor. The strength of the trademark is not as important as the other *Sleekcraft* factors in this context because even though Defendant's mark is conceptually strong, "the ultimate question posed by the *Sleekcraft* analysis [is] the likelihood of confusion as to the source of the the product." *M2 Software*, 421 F.3d at 1081. Here the Magistrate Judge concluded the respective market presence and trademark recognition of the parties greatly impaired any likelihood of confusion between the origin of the parties' products because Plaintiff always included

its own identifying trademarks to establish the source of its products. See *Walter v. Mattel, Inc.*, 210 F.3d 1108, 1111 (9th Cir. 2000)(similarity between marks negated when accompanied by distinctive logo); *M2 Software*, 421 f.3d at 1082 ("[S]imilarity of marks has always been considered a critical question in the likelihood-of-confusion analysis."). The Magistrate Judge also found any potential for Plaintiff to capitalize on Defendant's mark was small, a conclusion that is correct on this record.

Thus, after reviewing the pertinent portions of the record *de novo* and Defendant's Objections, the Court does not find any error in the Magistrate Judge's ultimate recommendation that the Court grant summary judgment to Plaintiff as to its claim for a declaration of noninfringement and as to Defendant's Counterclaim for infringement based on those factors.

C. The Magistrate Judge's finding that Defendant lacked standing to bring a Counterclaim under OUTPA.

Defendant contends the Magistrate Judge erred when she found Defendant lacked standing to bring a claim under OUTPA because Defendant was not a consumer of Plaintiff's products. The Magistrate Judge noted "[c]ourts interpreting [O]UTPA have almost uniformly recognized that it is first and foremost a consumer protection statute." *CollegeNet, Inc. v. Embark.Com, Inc.*, 230 F. Supp. 2d 1167, 1178 (D. Or. Apr. 4, 2001).

The Court notes Defendant asserts for the first time that he is a consumer of several of Plaintiff's products, an assertion he

did not make in his Counterclaim nor in his Response to Plaintiff's Motion for Summary Judgment. Regardless of the untimeliness of Defendant's assertion or whether Defendant has standing as a consumer of Plaintiff's products to bring a Counterclaim, the Court agrees with the Magistrate Judge that Defendant has not adequately stated claims for unfair competition in violation of OUTPA. The standard for analyzing such a claim is the same as that for analyzing a claim arising under § 1125(a) for infringement, and the gravamen of both is "whether the [plaintiff] has created a 'likelihood of confusion.'" *Shakey's Inc. v. Covalt*, 704 F.2d 426, 431 (9th Cir. 1983)(citing 15 U.S.C. § 1125(a) and Or. Rev. Stat. § 646.608, *et seq.*). See also *Starbucks Corp. v. Lundberg*, No. 02-CV-948, WL 3183858, at *13 (D. Or. Nov. 29, 2005)("Claims that arise under [§ 646.608, *et seq.*] for trademark infringement are analyzed using the same tests applied to trademark infringement claims under § 1125(a).").

This Court has already concluded the Magistrate Judge did not err when she found in her analysis of the *Sleekcraft* factors that there was no likelihood of confusion between Plaintiff's use of the phrase "prove it!" and Defendant's trademark and when she recommended this Court grant summary judgment to Plaintiff as to its claim for a declaration of noninfringement and as to Defendant's Counterclaim for infringement. Thus, based on the

same analysis and after reviewing the pertinent portions of the record *de novo* and Defendant's Objections, the Court does not find any error in the Magistrate Judge's findings as to Defendant's lack of standing to bring a claim under OUTPA and, therefore, as to her recommendation that this Court grant summary judgment to Plaintiff as to Defendant's Counterclaim under OUTPA.

III. Defendant's Objections to the Magistrate Judge's August 17, 2009, Opinion and Order.

On August 17, 2009, the Magistrate Judge issued an Opinion and Order in which she denied Defendant's Motion for Leave to Amend Opposition and File Motion to Dismiss.

A. Defendant's Motions to Strike.

On August 25, 2009, Defendant sent this Court a letter (#12) in which he stated he was "seeking clarification from the Court" and "objected to these findings" in the Magistrate Judge's August 17, 2009, Opinion and Order. Accordingly, the Court construed Defendant's August 25, 2009, letter as a timely Objection to the Magistrate Judge's August 17, 2009, Opinion and Order. In an August 28, 2009, Order, this Court directed the Clerk of Court to file Defendant's August 25, 2009, letter as an Objection and instructed Defendant to serve a copy of all filings on Plaintiff's counsel. The Court then received a second letter from Defendant dated August 27, 2009, in which Defendant requested this Court to disregard his August 25, 2009, letter. Defendant's August 27, 2009, letter did not include a certificate

of service.

On September 2, 2009, Defendant filed a Motion to Strike (#121) his August 25, 2009, letter in which he requested this Court to strike the August 25, 2009, letter and replace it with the August 27, 2009, letter. On September 9, 2009, Plaintiff indicated it did not object to Defendant's September 2, 2009, Motion to Strike.

On September 15, 2009, Defendant filed another Motion to Strike (#124) in which he requests this Court to strike all of the September 2, 2009, Motion to Strike except for Exhibit H attached thereto because the Court had filed an incomplete copy of his Motion that did not include Exhibit H. On September 22, 2009, Plaintiff indicated it did not object to Defendant's September 15, 2009, Motion to Strike to the extent Defendant was requesting the Court to strike a portion of its earlier Motion.

It appears to the Court that Defendant is requesting the Court to amend his September 2, 2009, Motion to Strike to include Exhibit H¹ because Exhibit H was inadvertently omitted and requests the Court to consider "all of the evidence in . . . his complete copy of his Motion (Doc. 121) [the September 2, 2009, Motion]." The Court notes, however, that Exhibit H was included with Defendant's September 2, 2009, Motion. To the extent

¹ The Court notes this Exhibit H is not the same document as Defendant's Exhibit H filed with his Objections to the Magistrate Judge's Findings and Recommendations.

Plaintiff's September 15, 2009, Motion to Strike is a request to add Exhibit H, therefore, the Court concludes it is moot.

Because Plaintiff does not object to Defendant's September 2, 2009, Motion to Strike and because Defendant's August 25, 2009, letter is substantially the same as his August 27, 2009, letter, the Court grants Plaintiff's September 2, 2009, Motion to Strike and will construe Plaintiff's August 27, 2009, letter as Plaintiff's Objections to the Magistrate Judge's August 17, 2009, Opinion and Order.

B. Defendant's August 27, 2009, Objections.

Defendant's Motion for Leave to Amend Opposition and File Motion to Dismiss and his Objections to the Magistrate Judge's August 17, 2009, Opinion and Order were premised on the same grounds as his Objections to the Magistrate Judge's Findings and Recommendation: that his former attorney had a conflict of interest that resulted in his failure to file certain evidence. The Magistrate Judge denied Defendant's Motion on the ground that Defendant had not shown any conflict of interest existed. Moreover, the Magistrate Judge noted any conflict of interest on the part of Defendant's former attorney was more likely to be prejudicial to Plaintiff because the attorney could have gained access to information that was prejudicial to Plaintiff in this matter during the course of his prior representation of Plaintiff. As noted, the Magistrate Judge also concluded part of

the evidence identified by Defendant was before the Magistrate Judge when she considered Plaintiff's Motion for Summary Judgment and Defendant's Counterclaim and part of the evidence was not produced in discovery and, therefore, was inadmissible in any event.

As already discussed by this Court with respect to Defendant's Objection to the Magistrate Judge's Amended Findings and Recommendation and after reviewing the pertinent portions of the record *de novo* and Defendant's Objections, the Court does not find any error in the Magistrate Judge's Opinion and Order issued August 17, 2009.

CONCLUSION

For these reasons, the Court **ADOPTS as modified** Magistrate Judge Stewart's Amended Findings and Recommendations (#101). Accordingly, the Court **GRANTS in part** and **DENIES in part** Plaintiff's Motion (#42) for Summary Judgment as follows:

1. **GRANTS** Plaintiff's Motion as to its First Cause of Action for a declaration of noninfringement of a registered trademark;
2. **GRANTS** Plaintiff's Motion as to its Second Cause of Action for a declaration of non-false designation of origin;
3. **DENIES** Plaintiff's Motion as to its Third Cause of Action for cancellation of trademark registration;

4. **GRANTS** Plaintiff's Motion as to Defendant's First Counterclaim for trademark infringement;

5. **GRANTS** Plaintiff's Motion as to Defendant's Second Counterclaim for violations of OUTPA; and

6. **DENIES as moot** Plaintiff's Motion as to its fair use defense.

In addition, the Court **AFFIRMS** Magistrate Judge Stewart's August 17, 2009, Opinion and Order (#115).

IT IS SO ORDERED.

DATED this 7th day of October, 2009.

/s/ Anna J. Brown

ANNA J. BROWN
United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON

ADIDAS AMERICA, INC., a Delaware
corporation,

Civil No. CV-08-91-ST

Plaintiff and Counterclaim
Defendant,

OPINION AND ORDER

v.

MICHAEL D. CALMESE, a resident of
Arizona,

Defendant and Counterclaimant.

STEWART, Magistrate Judge:

For the second time, defendant, Michael Calmese (“Calmese”), seeks to supplement the summary judgment record. On August 17, 2009, this court denied Calmese’s request to reopen the summary judgment motion in order to present more evidence, consisting of affidavits of actual confusion, nearly 10 years of sales accounting and a judgment for lost sales. This court

concluded that all of the documents that Calmese produced to plaintiff, adidas America, Inc. (“adidas”), during discovery were, in fact, made part of the summary judgment record by adidas, and that it was too late for Calmese to supplement the summary judgment record with documents not produced or disclosed in response to adidas’ discovery requests. In addition, any new affidavits of consumer confusion would not have changed this court’s conclusion that Calmese failed to create an issue of fact as to a likelihood of confusion between adidas’s use of the phrase “prove it” in its t-shirt design and Calmese’s PROVE IT! trademark.

Calmese now seeks to supplement the record with his income tax returns for the years 2002 through 2007 to confirm already produced evidence that he received income from sales of his products. He explains his delay by the fact that he only recently obtained these tax returns from his tax preparer. Although he first contacted his tax preparer on or about September 5, 2008, to prepare these tax returns, he did not make final arrangements until August 2009 to pay for its services due to the financial strain of litigating this matter. On or about September 5, 2009, Calmese forwarded his Bank of America accounting information, and the tax returns were completed and delivered to him on or about September 10, 2009.

For the reasons stated in its prior Order, this request comes much too late. On August 28, 2008, this court ordered Calmese to produce all responsive documents to adidas’ discovery requests, including tax returns, by September 28, 2008 (docket # 28). If Calmese needed or desired additional time to produce any of his tax returns, he should have moved the court for an extension of that deadline long ago. Furthermore, adidas received copies of Calmese’s 2006 and 2007 tax returns on August 13, 2009, as exhibits attached to Calmese’ Declaration (docket #114). Calmese does not explain how he obtained these two tax returns before September 10, 2009, the

date when he now claims that he first obtained the 2002 through 2007 tax returns. This discrepancy casts doubt on Calmese's credibility.

In any event, Calmese argues only that his tax returns will confirm evidence that was already filed in connection with the summary judgment motion. If so, then they are duplicative and not material. Moreover, it appears that Calmese primarily wants them as part of the record because of the proceedings pending before the Trademark Trial and Appeal Board ("TTAB") which have been suspended for this litigation. This court perceives no reason why Calmese cannot submit this evidence directly to the TTAB as and when appropriate.

Asserting that Calmese's motion is yet another baseless filing, adidas requests that the court require Calmese to seek and obtain court authorization before filing anything further in this action and also to award sanctions in the form of an award of attorney fees incurred to respond to the motion. That request is denied. This court does not view Calmese's motion as constituting the type of inappropriate behavior in his communications with adidas that requires the imposition of sanctions.

ORDER

Defendant's Opposed Motion for Leave to File Federal Taxes (docket #126) is DENIED without any imposition of sanctions.

DATED October 7, 2009.

/s/ Janice M. Stewart
JANICE M. STEWART
United States Magistrate Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON

ADIDAS AMERICA, INC., a Delaware
corporation,

Civil No. CV-08-91-ST

Plaintiff and Counterclaim
Defendant,

OPINION AND ORDER

v.

MICHAEL D. CALMESE, a resident of
Arizona,

Defendant and Counterclaimant.

STEWART, Magistrate Judge:

Plaintiff, Adidas America, Inc. (“adidas”), filed this action on January 18, 2008, against Michael Calmese (“Calmese”), the owner of United States Trademark Registration No. 2,202,454 for the mark PROVE IT!. The dispute centers on adidas’s use of the phrase “prove it” on adidas-branded t-shirts that allegedly infringe on Calmese’s PROVE IT! mark.

On July 2, 2009, this court issued its original Findings and Recommendation (docket

#97) (later amended on July 8 to correct an error (docket #101)), that adidas's Motion for Summary Judgment (docket #42) should be granted on its First Cause of Action for non-infringement of a registered trademark and against Calmese's two counterclaims, denied as moot as to its affirmative defense of fair use, and denied as to its Second and Third Causes of Action for non-false designation of origin and cancellation of trademark registration.

A few days later, Calmese's attorney, Andrew McNamer ("McNamer"), filed an Ex Parte Motion to Withdraw as Counsel of Record (docket #98), which was granted on July 7, 2009 (docket #100). Appearing *pro se*, Calmese filed objections to the Findings and Recommendation on July 22, 2009 (docket #106).

On July 19, 2009, Calmese filed a motion for leave to amend his opposition to adidas's Motion for Summary Judgment and to file a motion to dismiss (docket #103). In essence, Calmese seeks permission to reopen the summary judgment motion in order to present more evidence. For the reasons set forth below, that motion is denied.

DISCUSSION

Calmese's motion is premised on two allegations: (1) his former attorney had a conflict of interest because he previously represented adidas and did not disclose that conflict to Calmese; and (2) his former attorney failed to file certain evidence in opposition to adidas's motion for summary judgment.

I. Conflict of Interest

After filing this action *pro se* and advising the court on several occasions that he was trying to find counsel, Calmese finally was successful. McNamer filed his formal notice of appearance on December 15, 2008 (docket #60), almost a year after commencement of this

action and about one month after adidas had filed its motion for summary judgment. One day later on December 16, 2008, counsel for adidas sent an email to McNamer advising him of an apparent conflict of interest. Friedland Decl., ¶ 2, Ex. A. In that email, adidas's counsel explained that McNamer had previously worked at the law firm of Davis Wright Tremaine ("DWT") where he apparently had represented adidas in connection with trademark and litigation matters. Counsel for adidas further advised that grounds for disqualification existed because McNamer may have obtained confidential information regarding adidas's "litigation strategy" that now could be used by McNamer and Calmese to the detriment of adidas. Accordingly, adidas's counsel demanded that McNamer voluntarily withdraw from his representation of Calmese or, alternatively, face a motion to disqualify.

McNamer responded with two emails that same day, explaining that his prior work at DWT on behalf of adidas occurred six to seven years ago and consisted only of some preliminary research regarding a potential claim related to a distributor for adidas that had not paid a license fee. *Id.*, ¶¶ 3-4, Exs. B & C. Since his limited work had nothing to do with adidas's trademark or "litigation strategy," he advised adidas that any motion to disqualify would be baseless. *Id.*, Ex. C. After confirming the accuracy of McNamer's statements, adidas concluded that McNamer did not have an actual conflict of interest that required his disqualification from representing Calmese. *Id.*, ¶ 5, Ex. D. On January 6, 2009, adidas's counsel advised McNamer by email that adidas would not seek his disqualification. *Id.*, ¶ 6, Ex. E.

Based on the email exchange between McNamer and adidas, it is clear that adidas, not Calmese, was the party who potentially could have been harmed if McNamer actually had a

conflict. In any event, McNamer was correct that his limited representation of adidas did not present an actual conflict that would require his disqualification. After raising the potential conflict of interest issue, adidas wisely concluded that no actual conflict existed that required McNamer's disqualification.

Calnese states that he just recently learned that McNamer had previously represented adidas. Even if McNamer failed to promptly inform Calnese of those communications, adidas bears no responsibility for that failure. Ethically, adidas's counsel could not communicate directly with Calnese and instead properly communicated with McNamer about this issue. To the extent that McNamer failed to promptly inform Calnese of the communications with adidas concerning the alleged conflict of interest, that is entirely a matter between Calnese and McNamer. This court cannot resolve such attorney/client disputes, and perceives no reason why that dispute should allow Calnese to file additional pleadings and motions.

Calnese seems to believe that due to his prior representation of adidas, McNamer somehow conspired with adidas against him. This belief is based on McNamer offering his services for free which persuaded Calnese to drop representation by other attorneys that he claims would have properly represented him. This belief lacks any objective evidence and defies common sense. adidas threatened to disqualify McNamer after Calnese hired him. The tenor of the email exchange reveals a clear lack of mutual affection between McNamer and adidas's counsel. Furthermore, McNamer zealously represented Calnese by filing several pleadings on his behalf: (1) an opposition to adidas's summary judgment motion, supported by ten declarations; (2) an opposition to adidas's subsequent motion to strike the third-party declarations and portions of Calnese's declarations; and (3) a supplemental declaration in

opposition to adidas's summary judgment motion. He also appeared at the summary judgment hearing, vigorously argued on behalf of Calmese, and later filed a response to adidas's supplemental filings. Simply because adidas prevailed on one of its claims does not mean that McNamer's representation was inadequate.

II. Failure to File Evidence

Calmese also complains that McNamer failed to file certain evidence in opposition to adidas's summary judgment motion. Specifically, he states that McNamer "did not file important Discovery into evidence," as he requested, consisting of "affidavits of actual confusion from 3 different states, nearly 10 years of sales accounting and a judgment in the Court of law for lost sales." According to Calmese, this "absent evidence" is "some of the same evidence provided to adidas during discovery" in this case. Calmese argues that he will be prejudiced "if the absent evidence from Calmese's discovery is not added to this action," whereas adidas will not be prejudiced by allowing Calmese to amend his opposition to adidas's motion by including as part of that opposition "documents already provided to [adidas] during discovery."

The primary problem with Calmese's argument is that *all* of the documents that Calmese produced to adidas during discovery were, in fact, made part of the summary judgment record by adidas. *See* Supplemental Declaration of Jaime S. Rich (docket # 82), Exs. A & B. Calmese has no need to supplement the summary judgment record to add this evidence.

Instead, Calmese seeks to supplement the summary judgment record with some documents not produced or disclosed to adidas during discovery. These documents consist of "affidavits of actual confusion from 3 different states." adidas first saw those affidavits when it received Exhibit A to Calmese's objection to the Findings and Recommendation (docket #106).

Feldman Decl., ¶ 7. Those documents should have been produced much earlier by Calmese in response to both adidas's Interrogatory No. 11, which requested a detailed description of all instances of confusion, and Request for Production of Documents No. 18, which requested all documents of consumer inquiries evidencing confusion. *Id.*, ¶¶ 4-5, Ex. C, p. 11, & Ex. D., p. 7. Calmese's interrogatory response listed only one instance of confusion and further stated: "This is only one instance of confusion and [Calmese] will submit an appreciable number of affidavits from a number of individuals establishing actual confusion." *Id.*, Ex. C, p. 22. However, he did not produce any such affidavits during the discovery period. *Id.*, ¶ 7. He also failed to produce any other responsive documents revealing customer confusion. *Id.*, Ex. D, p. 20.

Thus, Calmese, not McNamer, failed to produce the affidavits of actual confusion to adidas in response to adidas's discovery requests. Under FRCP 37(c)(1), the court may not allow a party to use documents not properly produced or disclosed during discovery to supply evidence on a motion. Thus, even if McNamer then failed to file the affidavits in opposition to adidas's summary judgment motion, his error may have been harmless.

More importantly, any such affidavits of consumer confusion would not have changed this court's conclusion that Calmese failed to create an issue of fact as to a likelihood of confusion between adidas's use of the phrase "prove it" in its t-shirt design and Calmese's PROVE IT! trademark. That conclusion was based on an analysis of all eight relevant factors under *AMF, Inc. v. Sleekcraft Boats*, 599 F2d 341, 348-49 (9th Cir 1979). As set forth in the Findings and Recommendation, two of the *Sleekcraft* factors are neutral, two favor Calmese, and the remaining four favor adidas. Evidence of actual confusion is one of the four factors favoring adidas due to lack of any such evidence in the record. Such evidence must be more than

affidavits from a few consumers, especially those with a connection to the alleged infringer, like those Calmese now seeks to introduce. To carry any appreciable weight, evidence of actual confusion should be in the form of some sort of statistically significant consumer survey.

Calmese admitted that he did not have the financial resources to provide that type of evidence.

III. adidas's Request for Sanctions

Asserting that Calmese's motion is frivolous, adidas requests sanctions in the form of an award of attorney fees incurred to respond to the motion. That request is denied. Given that Calmese claims he only recently learned of the conflict of interest issue involving McNamer's prior representation of adidas, it is not surprising that he developed a suspicion. Due to adidas's response, that suspicion has now been put to rest. Moreover, it is understandable why Calmese would be unhappy at the result on summary judgment and seek to supplement the record. Trying to do so through this motion is not inherently unreasonable. Thus, this court does not view Calmese's motion as constituting the type of inappropriate behavior in his communications with adidas that requires the imposition of sanctions.

ORDER

Defendant's Motion for Leave to Amend Opposition and File Motion to Dismiss (docket #103) is DENIED without any imposition of sanctions.

DATED August 17, 2009.

s/ Janice M. Stewart

JANICE M. STEWART
United States Magistrate Judge

FILED*10 FEB 22 16 08 USDC-ORP

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
PORTLAND DIVISION**

ADIDAS AMERICA, INC.,

08-CV-91-ST

Plaintiff,

ORDER

v.

MICHAEL CALMESE,

Defendant.

DAVID K. FRIEDLAND

JAIME S. RICH

Lott & Freidland, P.A.

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Attorneys for Plaintiff

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Defendant, *Pro Se*

BROWN, Judge.

This matter comes before the Court on Defendant Michael Calmese's Second Opposed Motion (#160) for Reconsideration of this Court's Order (#155) issued November 16, 2009, in which the Court affirmed Magistrate Judge Janice M. Stewart's October 7, 2009, nondispositive Opinion and Order (#134); granted Defendant's first Motion (#145) for Reconsideration; and adhered to the Court's Order (#136) of October 8, 2009.

For the reasons that follow, the Court **DENIES** Defendant's Second Opposed Motion (#160) for Reconsideration.

I. Defendant's Second Motion for Reconsideration.

Defendant requests the Court to reconsider its November 16, 2009, Order on three grounds: (1) the Court failed to consider the Order of October 16, 2008, issued by the District Court for the District of Arizona in *Calmese v. Nike, Inc.*, No. CV-06-01959-PHX-ROS; (2) the Court erred when it concluded Defendant

had not produced certain bank records during discovery; and (3) the Court improperly determined Defendant does not have standing to bring a counterclaim against Plaintiff under Oregon Uniform Trade Practices Act (OUTPA), Oregon Revised Statute § 646.608, *et seq.*

The determination of a motion for reconsideration is within the district court's discretion. See *Bliesner v. Comm'n Workers of Am.*, 464 F.3d 910, 915 (9th Cir. 2006). Reconsideration is appropriate when: (1) there has been an intervening change in controlling law, (2) a party presents newly discovered evidence, or (3) it is necessary to correct clear error or manifest injustice. *Nunes v. Ashcroft*, 375 F.3d 805, 807 (9th Cir. 2004).

In his Second Opposed Motion for Reconsideration, Defendant merely reiterates arguments he made in his initial Opposed Motion for Reconsideration. The Court has thoroughly addressed these arguments in its prior Orders issued October 8, 2009, and November 16, 2009. The Court, therefore, denies Defendant's Motion. The Court directs Defendant not to file any additional motions for reconsideration without leave of the Court.

II. Plaintiff's Request for Sanctions.

In its Response, Plaintiff contends because Defendant's Second Opposed Motion to Reconsider merely repeats arguments already ruled on by this Court, the Court should sanction Defendant for filing a frivolous Motion and award Plaintiff

attorneys' fees incurred to respond to Defendant's Motion or impose such other sanction as the Court deems appropriate.

With respect to frivolous filings, Federal Rule of Civil Procedure 11(b)(2) and (3) provide:

(b) Representations to the Court. By presenting to the court a pleading, written motion, or other paper - whether by signing, filing, submitting, or later advocating it - an . . . unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

* * *

(2) the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;

(3) the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery.

Rule 11(c)(1) also provides when a court "determines that Rule 11(b) has been violated, the court may impose an appropriate sanction on any . . . party that violated the rule or is responsible for the violation."

As noted, Defendant's Motion is wholly repetitive of the first Motion for Reconsideration. Nonetheless, having herein ordered Defendant not to file any additional motions for reconsideration without first obtaining leave of Court to do so,

the Court, in the exercise of its discretion, declines to sanction Defendant for filing this Motion.

CONCLUSION

For these reasons, the Court **DENIES** Defendant's Second Opposed Motion (#160) for Reconsideration.

IT IS SO ORDERED.

DATED this 22nd day of February, 2010.



ANNA J. BROWN
United States District Judge

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*Attorneys for Defendant
and Counterclaimant Michael D. Calmese*

IN THE UNITED STATES DISTRICT COURT
DISTRICT OF OREGON

<p>ADIDAS AMERICA, INC., a Delaware corporation, Plaintiff and Counterclaim Defendant,</p> <p>v.</p> <p>MICHAEL D. CALMESE, a resident of Arizona, Defendant and Counterclaimant.</p>	<p>Case No. CV08-0091 ST</p> <p>[PROPOSED] ORDER ON MOTION TO WITHDRAW AS COUNSEL OF RECORD</p>
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IT IS HEREBY ORDERED that McNamer and Company PC, and its attorneys, are withdrawn as counsel for Defendant/Counterclaimant Michael Calmese.

DATED: July __, 2009

U.S. DISTRICT COURT JUDGE

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing has been served upon counsel of record for all parties to this proceeding via the Court's electronic filing system on all parties registered to receive notice via that system on July 6, 2009.

/s/ Anthony McNamer

Anthony E. McNamer
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**UNITED STATES DISTRICT COURT
DISTRICT OF OREGON**

CIVIL MINUTES

Case No. **CV 08-91-BR**

Date of Proceeding: **August 10, 2010**

Case Title: **Adidas America, Inc. v Calmese**

Presiding Judge: **Anna J. Brown**

Courtroom Deputy: **Bonnie Boyer**

Tele: (503) 326-8053

e-mail: Bonnie_Boyer@ord.uscourts.gov

Reporter:

PLAINTIFF'S COUNSEL

DEFENDANT'S COUNSEL

DOCKET ENTRY: Minute Order

Having fully considered Plaintiff's Response (#210) to Court's July 29, 2010, Minute Order as well as Defendant's Reply (#212), thereto, the Court makes the following additional Order:

1. Plaintiff shall ensure West Coast Court Reporting Services receives a copy of this Order and shall file no later than August 16, 2010, an appropriate pleading confirming West Coast Court Reporting Services acknowledges its responsibilities as provided in this Order.
2. West Coast Court Reporting Services shall maintain custody of the original video recording of the Calmese deposition and shall make the original video recording available for inspection by Defendant Calmese and/or his designated expert at its San Francisco offices, 221 Main Street, San Francisco CA, at a date and time before August 31, 2010, mutually agreeable to West Coast Court Reporting Services, Defendant Calmese and/or his designated expert, and Plaintiff and/or its counsel.
3. Representatives of West Coast Court Reporting Services, Plaintiff, and/or Plaintiff's counsel may observe any such inspection.
4. Defendant and/or his designated expert may not alter, destroy or otherwise impair the original video recording in the course of any such inspection.
5. To the extent Defendant wishes to offer expert testimony at trial concerning the video recording of his deposition, he must make all required expert witness disclosures about this subject to Plaintiff, including a complete statement of the expert's opinions and the bases for such opinions, no later than September 10, 2010. If Plaintiff wishes to offer responsive expert analysis at trial, Plaintiff must provide its similar disclosures to Defendant no later than September 24, 2010.
6. All other previously imposed case management dates remain in effect.

IT IS SO ORDERED.

cc: () All counsel

DOCUMENT NO: _____

Civil Minutes
Hon. Anna J. Brown

(Civil CaseMgt MO.wpd)

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
PORTLAND DIVISION

ADIDAS AMERICA, INC.,

08-CV-91-BR

Plaintiff,

ORDER

v.

MICHAEL CALMESE,

Defendant.

DAVID K. FRIEDLAND

JAIME S. RICH

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Attorneys for Plaintiff

MICHAEL CALMESE

3046 N. 32nd Street, Unit 321
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Defendant, *Pro Se*

BROWN, Judge.

This matter comes before the Court on Defendant Michael Calmese's Objection (#239) to the August 30, 2010, Order (#229) in which the Court, *inter alia*, ordered Defendant to pay sanctions to Plaintiff in an amount to be determined by the Court. After consideration of Defendant's Objections, the Court **ADHERES** to its Order (#229) issued August 30, 2010, and **DIRECTS** Defendant to pay to Plaintiff **no later than Noon, Pacific Time, on October 20, 2010**, Plaintiff's attorneys' fees in the sum of **\$9,106.50** as herein provided.

BACKGROUND

In its Order (#229) issued on August 30, 2010, the Court provided a detailed factual background relating the lengthy procedural and factual history that led the Court to impose sanctions on Defendant. The Court need not repeat that background here but incorporates it by reference.

On August 24, 2010, the Court issued the following Order (#226):

The Court acknowledges receipt of Defendant Calmese's Motion (#217) for Leave to File Third Motion for Reconsideration of February 22, 2010 Order and Plaintiff adidas's Memorandum in Opposition (#221). The Court construes Plaintiff's Opposition (#221) as, in part, a Motion for Sanctions, and,

therefore, grants Defendant Calmese until Friday, September 3, 2010, to file a response to the request for sanctions that is strictly limited to responding to Plaintiff's request that the Court sanction Defendant's unauthorized filing of his Third Motion for Reconsideration by striking all of Defendant's still-pending pleadings, entering a default judgment against Defendant, and concluding this litigation on that basis. The Court will not accept any other filings from either party with respect to Defendant's Motion (#217) or Plaintiff's Memorandum in Opposition/Motion for Sanctions and will take these matters under advisement upon receipt of Defendant's response or on September 3, 2010, whichever occurs first.

Also on August 24, 2010, Defendant filed a Voluntary Motion (#227) to Strike Third Motion for Reconsideration in which Defendant alleged he was unaware of the Court's Order prohibiting Defendant from filing any more motions. Defendant's Motion, however, lacked a Local Rule 7-1 certification despite the Court's repeated reminders that adherence to this Rule is mandatory. In his Voluntary Motion to Strike, Defendant also stated:

Because Plaintiffs have unrightfully been burned by having to respond to this motion Defendant understands why this Court may imposes [*sic*] sanctions while at the same time considering a much more serious punishment. In light of the honest mistake Defendant and the fact that Trial has been set for November 2, 2010, Defendant prays this Court will have mercy on him and allow him to Voluntary Strike his Third Motion For Reconsideration.

On August 26, 2010, Plaintiff filed its Response (#228) to Defendant's Voluntary Motion to Strike.

In its Order (#229) imposing sanctions on Defendant, the Court construed Defendant's Voluntary Motion to Strike as a responsive pleading to Plaintiff's request for sanctions in light of Defendant's apparent concessions. Ultimately the Court concluded Defendant's explanation that he made an "honest mistake" by filing the motion was not credible.

In his Response (#230) to Plaintiff's Motion for Sanctions, Defendant goes to great lengths to show that he filed his Voluntary Motion to Strike before the Court issued its Order on August 24, 2010, setting a deadline for Defendant to respond to Plaintiff's Motion for Sanctions. Thus, Defendant argues the Court should not have construed his Voluntary Motion to Strike as his response to Plaintiff's Motion for Sanctions and repeats his argument that he made an honest mistake when he filed his third Motion for Leave to File a Third Motion for Reconsideration.

On September 3, 2010, Plaintiff filed its Statement of Attorneys' Fees (#237) as directed by the Court. Plaintiff attests its fees incurred to respond to Defendant's Motion for Leave to File a Third Motion for Reconsideration and Defendant's Voluntary Motion to Strike were a total of \$9,106.50.

On September 8, 2010, Defendant filed an Objection to the Court's August 30, 2010, Order in which he again states his

Voluntary Motion to Strike should not have been considered a responsive pleading because he filed it before the Court issued its Order on August 24, 2010, setting a deadline for him to respond to Plaintiff's Motion for Sanctions. Defendant also contends his Third Motion for Leave to File a Third Motion for Reconsideration was justified because he offered new evidence in support of that Motion.

DISCUSSION

In his Response to Plaintiff's Motion for Sanctions and his Objection to the Court's August 30, 2010, Order, Defendant objects to the Court's Order (#229) on the following grounds:

(1) Defendant made an "honest mistake" when he filed his third Motion (#217) for Leave to File a Third Motion for Reconsideration, (2) the Court improperly construed Defendant's Voluntary Motion (#227) to Strike Third Motion for Reconsideration as his response to Plaintiff's Motion for Sanctions, and (3) the Court improperly denied Defendant's third Motion (#217) for Leave to File a Third Motion for Reconsideration.

With respect to Defendant's contention that he made an honest mistake by filing the third Motion for Leave to File Third Motion for Reconsideration, the Court is not persuaded. In its Order (#229) and in light of Defendant's persistent history of

filing repetitive challenges to the Court's orders herein, including those related to summary-judgment rulings, the Court ordered Defendant not to file any motion specifically related to the summary-judgment rulings in this matter and not to file any other motions as the parties prepared for trial. Defendant's explanation that he somehow misunderstood the clear and unequivocal language in the Court's April 20, 2010, Order (#181) that Defendant was not to "make, file, or seek leave to file any additional motions with respect to any of the rulings, opinions, or orders addressed in this Order or related to the Court's adoption of Magistrate Judge Stewart's Amended Findings and Recommendation (#101) in this matter and ORDERS Defendant not to file any motion to reconsider this Opinion and Order" is not credible. Furthermore, even if Defendant had a credible excuse for not adhering to that Order, the Court also issued an Order on July 20, 2010, in which it stated the Court "has previously directed the parties not to file any more motions so that the parties focus their efforts on preparing for trial."

In short, as set out in its Order (#229), the Court took measured steps to prevent Defendant's repeated frivolous filings and clearly instructed Defendant not to file the very motion that Defendant filed on August 19, 2010. It is instructive that in his Objection (#239), Defendant abandons his argument that he made a mistake by filing his third Motion for Leave to File Third

Motion for Reconsideration and instead defends the merits of that Motion. On this record, the Court concludes Defendant did not make an "honest mistake."

Defendant also objects to the Court's Order (#229) on the ground that the Court improperly construed his Voluntary Motion to Strike as a response to Plaintiff's Motion for Sanctions. This argument is without merit. In fact, Defendant's Voluntary Motion to Strike referenced Plaintiff's Response and its request for sanctions. Defendant even acknowledged the Court would likely sanction him and sought the Court's lenience. Although Defendant attempts to support his argument by pointing out that he filed his Voluntary Motion to Strike before the Court's Order issued on August 24, 2010 (#226), setting a deadline for Defendant to respond to Plaintiff's Motion for Sanctions, the timing of Defendant's filing is not determinative. The Court also concludes its Order (#229) sanctioning Defendant was appropriate on the then-existing record, particularly in light of Defendant's seeming concession in his Voluntary Motion to Strike that Plaintiff had "unrightfully been burned by having to respond to this motion Defendant understands why this Court may imposes [sic] sanctions while at the same time considering a much more serious punishment."

In any event, the Court has reviewed the entire record anew and has considered Defendant's responsive filings despite the

fact that they were not authorized. The Court concludes even after consideration of Defendant's most recent filings that sanctions are warranted under the standards set out in the Court's August 30, 2010, Order (#229).

Finally, Defendant argues the Court improperly denied his third Motion (#217) for Leave to File a Third Motion for Reconsideration and contends his Motion was meritorious because he presented the Court with new evidence in support of his Motion. The Court, however, did not reach the merits of the Motion. Instead the Court denied Plaintiff's request for leave to file a third motion for reconsideration.

As noted, Defendant was subject to this Court's Order not to file any additional motions challenging the Court's rulings with respect to summary judgment, and his third Motion for Leave violated that Order. Moreover, the parties were in preparation for trial and the time to file any additional dispositive motions had long passed. In addition, the Court notes Defendant filed no fewer than ten pleadings in this Court and an appeal to the Ninth Circuit challenging the Court's October 2009 rulings on summary judgment. The Court cannot permit a party to waste the time of the Court and the opposing party by perpetually challenging an order of the Court on the same grounds. The Court's restriction of Defendant's filings was reasonable under the circumstances and was necessary to move this matter (which has been pending since

January 2008) to trial.

The Court has reviewed Plaintiff's Statement of Attorneys' Fees (#237) to which Defendant did not file any opposition. The Court concludes Plaintiff's fees are reasonable. Based on the time the Court has had to give to the numerous frivolous filings made by Defendant, Plaintiff's time is likely underestimated. In any event, the Court has "broad discretion in fashioning sanctions." *Molski v. Evergreen Dynasty Corp.*, 500 F.3d 1047, 1065 n.8 (citing *Leon v. IDX Sys. Corp.*, 464 F.3d 951, 961 (9th Cir. 2006), and *Ritchie v. United States*, 451 F.3d 1019, 1026 (9th Cir. 2006)). When encountering vexatious litigants, the Ninth Circuit has held appropriate sanctions

may include not only a pre-filing order, but also monetary sanctions or even the ultimate sanction of dismissal of claims. We do not here hold that, if a court encounters vexatious litigation, a pre-filing order is the only permissible form of sanction. Rather, the district court may exercise its sound discretion under the facts presented to choose any appropriate sanction that will punish the past misconduct and prevent the future misconduct of the lawyer or party at issue.

Molski, 500 F.3d at 1065 n.8.

The Court concludes, in the exercise of its discretion, that the monetary sanction of \$9,106.50, representing Plaintiff's attorneys' fees incurred in responding to Defendant's third Motion for Leave to File a Third Motion for Reconsideration and Voluntary Motion to Strike, is necessary to sanction Defendant

for violating this Court's Orders and to deter any such future violations. If this sanction is not successful in deterring future violations, the Court will have no other recourse but to strike Defendant's pleadings altogether and to allow Plaintiff to pursue this matter to its conclusion on the basis of a default judgment against Defendant.

CONCLUSION

For these reasons, the Court **ADHERES** to its Order (#229) issued August 30, 2010, and **DIRECTS** Defendant to pay **no later than Noon, Pacific Time, on October 20, 2010**, attorneys' fees to Plaintiff in the sum of **\$9,106.50**. Defendant shall make the payment by way of certified check made to the order of adidas America, Inc., and delivered to the Portland, Oregon offices of Plaintiff's counsel by the deadline herein stated. If Defendant does not timely pay this amount in full, the Court will strike Defendant's pleadings and allow Plaintiff to pursue this matter accordingly.

In light of this Order, the Court suspends the pending deadlines, including those for filing other trial papers on October 8, 2010. The Court **DIRECTS** Plaintiff to notify the Court on the earlier of Plaintiff's receipt of the payment ordered herein, or October 21, 2010, whichever occurs earlier, after which the Court will issue an updated scheduling order. The

November 2, 2010, trial remains in effect.

IT IS SO ORDERED.

DATED this 1st day of October, 2010.

/s/ Anna J. Brown

ANNA J. BROWN
United States District Judge

FILED 10 APR 20 11:27 USDC-ORP

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
PORTLAND DIVISION

ADIDAS AMERICA, INC.,

08-CV-91-ST

Plaintiff,

OPINION AND ORDER

v.

MICHAEL CALMESE,

Defendant.

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Defendant, *Pro Se*

BROWN, Judge.

This matter comes before the Court on Defendant Michael Calmese's Second Motion (#175) for Leave to File a Third Motion for Reconsideration of this Court's Order (#173) issued March 9, 2009, denying Defendant's first Motion (#170) for Leave to File Motion for Reconsideration of February 22, 2010, Order.

For the reasons that follow, the Court **DENIES** Defendant's Second Motion (#175) for Leave to File a Third Motion for Reconsideration and further **ORDERS** Defendant not to make, file, or seek leave to file any additional motions with respect to any of the rulings, opinions, or orders addressed in this Order or related to the Court's adoption of Magistrate Judge Stewart's Amended Findings and Recommendation (#101) in this matter and **ORDERS** Defendant not to file any motion to reconsider this Opinion and Order.

BACKGROUND

Defendant seeks leave a second time to file a third motion requesting the Court to reconsider its October 8, 2009, Order adopting as modified Magistrate Judge Stewart's Amended Findings and Recommendation issued on July 9, 2009.

On October 28, 2009, Defendant filed his original Motion for Reconsideration in which he requested this Court to reconsider

its Order of October 8, 2009. Defendant maintained a decision by the District Court for the District of Arizona in an unrelated litigation between Nike, Inc., and Calmese was binding on Magistrate Judge Stewart's determination of the *Sleekcraft* factor of "relatedness of goods":

Defendant Calmese believes this Oregon should have come to the same legal conclusion as did the Honorable Judge Roslyn O. Silver in the Arizona District because just as wine complements cheese and salami, a common-sensical complementary relationship exists between adidas' sports garments and Calmese's sports garments. In fact Plaintiff and Defendant both use sports garments with identical "PROVE IT" marks in all capital letters on clothing and also on hang tags and receipts with out the world famous adidas logo or trademark. How much more related can these goods get given both adidas and calmese admittedly are using sports garments with the mark "PROVE IT"?¹

On November 16, 2009, the Court denied Defendant's Motion for Reconsideration. The Court held in relevant part:

Defendant contends this Court did not conduct a *de novo* review of the record with respect to his Objections as required by 28 U.S.C. § 636(b)(1) on the ground that the United States District Court for the District of Arizona in its October 16, 2008, Opinion and Order in *Calmese v. Nike, Inc.*, No. 06-CV-1959, decided on the same record that the "relatedness of the goods" *Sleekcraft* factor weighed in Defendant's favor. The Court notes Plaintiff was not a party to the

¹ Although the Arizona District Court found the goods related, it ultimately concluded no infringement took place and granted Nike's Motion for Summary Judgment as to Calmese's claims against Nike.

Arizona proceedings, and, therefore, the likelihood of confusion between the products of Plaintiff and Defendant was not at issue in that matter. The Court has reviewed the record de novo and adheres to its October 8, 2009, Order with respect to this *Sleekcraft* factor.

The Court also noted:

Defendant states the Arizona Opinion and Order was attached as Exhibit E to his Response to Opposition to Defendant's Motion for Leave to File Federal Taxes (#133). Exhibit E to that document, however, is a September 8, 2009, Order in the *Calnese v. Nike* matter in which the Arizona District Court denied Defendant's Motion for Reconsideration (Defendant was the plaintiff in the Arizona case). In that Motion, Defendant requested the Arizona court to reconsider its ruling to dismiss his Complaint against Nike for trademark infringement.

On November 25, 2009, Defendant filed his second Motion for Reconsideration in which he repeated his request that the Court reconsider its decision to uphold Magistrate Judge Stewart's Findings and Recommendation:

Just as wine complements cheese and salami, a commonsensical complementary relationship exist between adidas's sports garments and Calnese's sports garments. Vendors often sell sports clothing and sports garments in the same stores and customers consume the products simultaneously, i.e. while playing sports. This factor should have never had to be reconsidered and should have weighed in favor of Defendant long ago as confirmed by the Honorable Judge Roslyn O. Silver, United States District Judge, on October 16, 2008.

Judge Anna Brown commits a plain error were she erroneously states that because Plaintiff

adidas was not a party to the Arizona proceedings, therefore, the likelihood of confusion between the products of Plaintiff adidas and Defendant Calmese was not at issue in that matter. Because the Plaintiff adidas and Defendant Calmese's dispute did not surface until well after the Arizona proceedings started, gives rise to the fact that there could be not issue given that there was no dispute yet. This Courts review fails here because in the Arizona proceedings the likelihood of confusion was between Calmese's t-shirts vs. Nike's shoes and Calmese still won this factor. Here the likelihood of confusion is even greater because the likelihood of confusion is between adidas's t-shirt vs. Calmese's t-shirts, a perfect t-shirt match. Therefore, how can Defendant Calmese lose this factor in the Oregon District Court when Calmese won this very same *Sleekcraft* Factor in the Arizona District Court based on the very same "law" that should be applied in this matter? Defendant Calmese should rightfully and legally be awarded the *Sleekcraft* Factor for Relatedness of Goods as a matter of law simply because the same laws apply to all of the District Courts throughout the entire United States of America.

On February 22, 2010, the Court issued an Order denying Defendant's Second Motion for Reconsideration and instructed Defendant to seek leave of Court before filing any additional motions for reconsideration. The Court also denied Plaintiff's request that the Court sanction Defendant for a frivolous filing.

On March 3, 2010, Defendant filed a Motion for Leave to File a Third Motion for Reconsideration. In his Motion, Defendant repeats his argument that the decision by the District Court of Arizona controls this Court's determination of the "relatedness

of goods" factor:

By repeatedly not considering the fact that Calmese has presented evidence that proves Calmese has already won a *Sleekcraft* factor test for Relatedness of Goods test in the matter Michael D. Calmese v. Nike Inc. Case No. 06-cv-1959, a previously litigated matter in the Arizona District Court, deprives Calmese of the justice that he is entitled to by law. It was and should be the same law that awarded Calmese a favorable ruling on this one point of Relatedness of Goods in Honorable Judge Rosyln O. Silver's October 16, 2008 ORDER. This Court should note that Calmese won the Relatedness of Goods factor and he did not even file an answer to Nike's "second" motion for summary judgment which subsequently allowed them to prevail on their motion but not before awarding Calmese several *Sleekcraft* factors, specifically Relatedness of Goods.

On March 9, 2010, the Court issued the following minute order denying Defendant's First Motion for Leave to File a Third Motion for Reconsideration:

In its Order issued February 22, 2010, the Court prohibited Defendant from filing any additional motions for reconsideration without leave of Court. On March 3, 2010, Defendant Michael D. Calmese filed a Motion (#170) for Leave to File Motion for Reconsideration of February 22, 2010, Order. In his pending Motion, Defendant reiterates the arguments he made in his previous Second Opposed Motion for Reconsideration and asserts a decision by the United States District Court for the District of Arizona in a matter involving Defendant and a company unrelated to Plaintiff binds the Court's determination of the facts and law as to the "relatedness of goods" between Defendant and Plaintiff adidas America, Inc. In its February 22, 2010, Order, the Court concluded the issues and facts before this Court were

not in dispute in the District Court of Arizona and that Defendant did not show any error of fact or change in controlling law that compelled further consideration. The Court, therefore, adheres to its previous ruling. Accordingly the Court DENIES Defendant's Motion (#170) for Leave to File Motion for Reconsideration and, for the same reasons set out in Order issued February 22, 2010, DENIES Plaintiff's request for the Court to sanction Defendant. IT IS SO ORDERED.

DISCUSSION

On March 29, 2010, Defendant filed this Second Motion for Leave to File a Third Motion for Reconsideration. On April 2, 2010, Plaintiff filed its brief in opposition. In his Motion, Defendant once again contends he has already won the "relatedness of goods" *Sleekcraft* factor on the basis of the Arizona District Court's decision and that basis is sufficient to permit his filing of a Third Motion for Reconsideration. Defendant also asserts the Court has allowed Plaintiff, but not Defendant, to rely on the decision by the Arizona District Court.

In her Amended Findings and Recommendation, Magistrate Judge Stewart found:

The standard for deciding whether the parties' goods or services are 'related' is whether customers are 'likely to associate' the two product lines." *Surfvivor Media, Inc.*, 406 F3d at 633. The court also must consider whether the buying public could reasonably conclude that the products came from the same source. *Sleekcraft Boats*, 599 F2d at 348 n10. If the marks are identical and used with identical goods or services,

then "likelihood of confusion would follow as a matter of course." *Brookfield*, 174 F3d at 1056.

In this case, both Calmese and adidas sold the same goods, namely t-shirts, with the same "prove it" phrase. However, adidas argues that the buying public could not reasonably conclude that its t-shirts came from Calmese. To identify the origin and source of its t-shirts, adidas placed two adidas trademarks just below the phrase "PROVE IT:" the word mark "adidas" and adidas's 3-Bars Logo. Backman Decl. ¶¶ 4-5, Ex. A. In addition, all of the adidas t-shirts place these same trademarks on both the inside of the shirt's collar and on the hang tag affixed to the shirt. *Id.* Because of the prominent display of the adidas trademarks, it is unlikely that consumers who saw the adidas t-shirts were confused as to the source or origin of the products. Thus, this factor also weighs against a finding of likelihood of confusion and, thus, in favor of adidas.

In the long line of Defendant's argument on this factor, he misses the thrust of the Magistrate Judge's reasoning with respect to the "relatedness of goods" factor that is at the heart of her ultimate conclusion on Summary Judgment: Plaintiff's use of multiple adidas logos in combination with the "Prove It" mark make the likelihood of confusion with Defendant's mark minimal. In addition, Defendant stubbornly continues to maintain the decision of the Arizona District Court is binding on this Court. The Court, however, has already pointed out that the Arizona decision is not binding on this Court as a matter of law nor is it determinative of the facts in this case. Ultimately Defendant

has not cited any change in controlling law nor shown clear errors of fact that would provide adequate grounds for the Court to modify or to overturn the its Order adopting the Magistrate Judge's Amended Findings and Recommendation. Although Defendant spends the bulk of his Motion lamenting a perceived double standard by which the Court has allowed Plaintiff but has prevented Defendant from relying on the decision by the Arizona District Court, Defendant's argument fails. The Court has not made any ruling with respect to a party's ability to cite or to argue analogous aspects of that decision. In fact, the Court has merely concluded Defendant's reliance on that decision is misplaced and is not grounds for altering the Court's rulings in this matter.

Defendant also makes a cursory request that Plaintiff should be sanctioned for emailing the Court's March 9, 2010, order "(15) days after it was signed[,] [which] was very disingenuous by adidas." Defendant does not otherwise explain his request for sanctions.

Plaintiff counters Defendant's request for sanctions by asserting that counsel for Plaintiff only sent a copy of the Court's Order to Plaintiff when it became apparent during a telephone conversation that Defendant was not aware his motion for leave had been denied. Plaintiff contends its counsel was being courteous, and Defendant's request for sanctions is

baseless. The Court agrees.

Finally, Plaintiff in its Response once again seeks sanctions against Defendant:

Here we go again. Calmese has added yet another frivolous filing to his already impressive collection and, in the process, he has once again forced adidas to waste its time and resources preparing a response (and, just as unfairly, Calmese has once again forced the Court to waste its time and resources considering a frivolous motion). The title of Calmese's latest motion speaks volumes: a Second Motion for Leave to File a Third Motion for Reconsideration. While it would be bad enough if Calmese's latest motion was accurately titled, the fact of the matter is that the present motion is at least the seventh attempt by Calmese to object to and/or seek reconsideration of this Court's entry of summary judgment in adidas's favor on the issues of trademark infringement and unfair competition. The time has come to put a stop to Calmese's incessant filing of frivolous motions. adidas has previously explained that, in its view, the only way to effectively put a stop to Calmese's incessant filing of frivolous motions is to impose a monetary sanction against him.

For the reasons stated in the Court's February 22, 2010, Order, the Court, in the exercise of its discretion, declines to sanction Defendant for filing this Motion. As noted below, Defendant runs the risk of the Court striking all of his pleadings, however, finding him in default, and allowing plaintiff to pursue the relief it seeks without Defendant having any additional opportunity to defend himself in this matter if Defendant does not now comply with this Opinion and Order.

CONCLUSION

For these reasons, the Court **DENIES** Defendant's Second Motion (#175) for Leave to File a Third Motion for Reconsideration. The Court also **DENIES** the request of both Plaintiff and Defendant for sanctions.

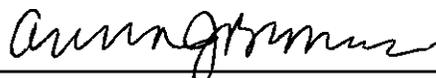
The Court notes there is "strong precedent establishing the inherent power of federal courts to regulate the activities of abusive litigants by imposing carefully tailored restrictions under the appropriate circumstances." *Tripati v. Beaman*, 878 F.2d 351, 352 (10th Cir. 1989). "Under the power of 28 U.S.C. § 1651(a) (1988), enjoining litigants with abusive and lengthy histories is one such form of restriction that the district court may take." *De Long v. Hennessey*, 912 F.2d 1144, 1147 (9th Cir. 1990) (citing *Tripati*, 878 F.2d at 352).

Accordingly, in the exercise of its discretion and pursuant to the Court's inherent authority, the Court further **ORDERS** Defendant not to make, file, or seek leave to file any additional motions with respect to any of the rulings, opinions, or orders addressed in this Order or related to the Court's adoption of Magistrate Judge Stewart's Amended Findings and Recommendation (#101) in this matter and **ORDERS** Defendant not to file any motion to reconsider this Opinion and Order.

If Defendant violates this Order by making, filing, or seeking leave to file prohibited motions, the Court will impose sanctions, potentially including the striking of his pleadings and an entry of an order of default against Defendant thereby permitting Plaintiff to conclude this matter in its favor without any opportunity for Defendant to oppose the relief Plaintiff seeks.

IT IS SO ORDERED.

DATED this 19th day of April, 2010.



ANNA J. BROWN
United States District Judge