

No. 10-17329

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

SHINGLE SPRINGS BAND OF MIWOK INDIANS,

Plaintiff-Appellee,

v.

CESAR CABALLERO,

Defendant-Appellant.

On Appeal from the Order of the
United States District Court for
the Eastern District of California
Honorable John A. Mendez
No. 08-CV-03133-JAM-DAD

REPLY BRIEF

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TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
I. INTRODUCTION.....	1
II. THE DISTRICT COURT’S ORDER OF SEPTEMBER 15, 2010 WAS AN ABUSE OF DISCRETION BECAUSE IT DOES NOT COMPLY WITH FEDERAL RULES OF CIVIL PROCEDURE 65(d) OR 52(a).....	2
III. THE PRELIMINARY INJUNCTION IS AN UNCONSTITUTIONAL PRIOR RESTRAINT OF SPEECH	7
IV. THE DISTRICT COURT ABUSED ITS DISCRETION BECAUSE APPELLEE DOES NOT HAVE A GENUINE CLAIM UNDER THE LANHAM ACT AND NO LIKELIHOOD OF SUCCESS ON THE MERITS.	13
A. The District Court’s Order Must be Reversed Because it Did not Apply the Commercial Use Requirement of the Lanham Act and There is no Potential for Consumer Confusion.	13
B. Plaintiff’s Activities do not Constitute ‘Services’ Under the Lanham Act Because They do not Include a Commercial Use.	17
C. The Parties do not Engage in Competing Services	19
D. Plaintiff Does Not Possess a Valid Trademark in the Name Shingle Springs Band of Miwok Indians	21
V. CONCLUSION	23
CERTIFICATE OF COMPLIANCE.....	25
CERTIFICATE OF SERVICE	26

TABLE OF AUTHORITIES

Cases

<i>Avery & Sons v. Meikle & Co.</i> , 81 Ky. 73 (1883)	18
<i>Bosley Medical Institute v. Kremer</i> , 403 F.3d 672 (9 th Cir. 2005).....	13, 14, 15, 17
<i>Committee for Idaho’s High Desert, Inc. v. Yost</i> , 92 F.3d 814 (9 th Cir. 1996).....	20, 21, 22
<i>Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.</i> , 109 F.3d 1394 (9 th Cir. 1997)	8
<i>Federal Trade Commission v. Enforma Natural Products, Inc.</i> , 362 F.3d 1204 (9 th Cir. 2004)	2,4, 6
<i>Freecycle Network, Inc. v. Oey</i> , 505 F.3d 898 (9th Cir. 2007).....	5, 14, 16, 17
<i>Hancock Park Homeowners Ass’n v. Hancock Park Homeowners Ass’n</i> , 2006 U.S. Dist. LEXIS 96211 (C.D. Cal. 2006).....	17
<i>Isuzu Motors Ltd. v. Consumers Union of the U.S.</i> , 12 F.Supp. 2d 1035 (C.D. Cal. 1998)	7
<i>J.K. Harris & Co. v. Kassel</i> , 253 F.Supp.2d 1120 (N.D. Cal. 2003)	7
<i>Lang v. Retirement Living Pub. Co., Inc.</i> , 949 F.2d 576 (2nd Cir. 1991).....	14
<i>Mattel, Inc. v. MCA Records, Inc.</i> , 296 F.3d 894 (9 th Cir. 2002)	14, 15
<i>Nebraska Press Association v. Stuart</i> , 427 U.S. 539 (1976)	7

<i>Nissan Motor Co. v. Nissan Computer Corp.</i> , 378 F.3d 1002 (9 th Cir. 2004)	9
<i>Pittsburgh Press Co. v. Pittsburgh Commission on Human Relations</i> , 413 U.S. 376 (1973)	7
<i>Stanislaus Custodial Deputy Sherriff's Ass'n v. Deputy Sherriff's Ass'n of Stanislaus County</i> , 2010 U.S. Dist. LEXIS 59177 (E.D. Cal. June 1, 2010).....	16, 17
<i>The Mohegan Tribe of Indians of Connecticut v. The Mohegan Tribe and Nation, Inc., et al.</i> , 255 Conn. 358 (S.Ct.Conn. 1999)	8, 10, 12, 21, 22
<i>United We Stand America, Inc. v. United We Stand America New York, Inc.</i> , 128 F.3d 86 (2nd Cir. 1997)	20
<i>Vance v. American Hawaii Cruises, Inc.</i> , 789 F.2d 790 (9 th Cir. 1986)	2
<i>Vance v. Universal Amusement Co.</i> 445 U.S. 308 (1980)	7
<i>Ward v. Rock Against Racism</i> , 491 U.S. 781 (1989)	12
<u>Statutes</u>	
15 U.S.C. §1111 to §1127, <i>Lanham Act</i>	passim
<u>Rules</u>	
Federal Rules of Civil Procedure 52(a)	passim
Federal Rules of Civil Procedure 65(d)	passim

I. INTRODUCTION

Appellant Caballero has been preliminarily enjoined by the District Court from identifying himself as Miwok and from the Shingle Springs area.

(Preliminary Injunction Order, EOR-2:21-23; Dckt #99) The Order should be vacated because it states no findings of fact and conclusions of law; violates Mr. Caballero's First Amendment rights and constitutes a prior restraint on his right to identify himself and his Tribe by their historic, ethnic, and geographic identity.

(Id.) The name "Shingle Springs Band of Miwok Indians" is a combination of the terms identifying the geographic location of Mr. Caballero's Tribe, located in Shingle Springs, and his Tribe's ethnic identification, Miwok. (EOR-12; Dckt#11-1). Thus, the Court's Order which the District Court characterizes as preventing Defendant from using "Plaintiff's identity" (Transcript - EOR-3, 16:18; Dckt#101) rather than "trademark" is incongruous because, as between Defendant and Plaintiff, only Defendant is Miwok and Indigenous to the Shingle Springs area. (EOR-11, 2; Dckt#19). Plaintiff cannot dispute that.

The District Court did not explicitly define the basis for its Order. If the Court based its Order on federal acknowledgement and tribal identity, that basis is controversial at best. If the District Court had some other basis, neither the record nor the Order itself reflect it. Mr. Caballero objects to having his Constitutional rights trampled without an explanation.

II. THE DISTRICT COURT’S ORDER OF SEPTEMBER 15, 2010 WAS AN ABUSE OF DISCRETION BECAUSE IT DOES NOT COMPLY WITH FEDERAL RULES OF CIVIL PROCEDURE 65(d) OR 52(a).

Plaintiff is incorrect that the District Court may simply recite factors for a preliminary injunction and summarily pronounce them all in favor of one side without any discussion of them at all. The Ninth Circuit requires that the District Courts do more than that. *Federal Trade Commission v. Enforma Natural Products, Inc.*, 362 F.3d 1204, 1215 (9th Cir. 2004); *Vance v. American Hawaii Cruises, Inc.*, 789 F.2d 790, 792 (9th Cir. 1986). The plain language of the Federal Rules of Civil Procedure (FRCP) and the cases interpreting them require more: FRCP 65(d) requires that “every order granting an injunction... shall set forth the reasons for its issuance; shall be specific in terms,” and reasonably detailed; FRCP 52(a) requires that “in granting or refusing interlocutory injunctions the court shall... set forth the findings of fact and conclusions of law which constitute the grounds of its action.” (Emphasis added.) The record before this Court demonstrates that the September 15, 2010 Order failed to meet the threshold requirements of these rules.

Reversal is required because the Court’s summary recitation of the elements truly leaves the parties to speculate on what the enjoined conduct encompassed or any basis for it whatsoever. Plaintiff was left to specify the word “trademark” for the word “this” when quoting the Court regarding what claim its Order concerned.

(Appellee's Answering Brief, p. 14, "...the plaintiff is likely to prevail on this [trademark] claim, on all the elements necessary.") The District Court's findings of fact and conclusions of law are adopted verbatim from Plaintiff's boilerplate order and are conclusory and inadequate for the parties' or this Court's review. *Federal Trade Commission v. Enforma Natural Products, Inc.*, supra, 1215.

The Transcript of the September 15th hearing does not specify what conduct is enjoined or what trademark(s) it determined is likely to exist. (EOR:3; Dckt#101). The Court did not state what name was to be enjoined but, instead, referenced only "this name." The Court stated no name whatsoever other than "this name" in referring to any trademark, including the name "Shingle Springs Band of Miwok Indians," at the entire hearing.

Although the Court never identified any trademark at the hearing, Plaintiff's Proposed Order (which the Court signed verbatim) includes an indeterminate number of names none of which are registered trademarks, i.e., "Shingle Springs Rancheria," "Shingle Springs Miwok Tribe," "Shingle Springs Band of Miwok Indians," "Shingle Springs Miwok Indians," and "any confusingly similar variation thereof." (Order - EOR-2, 2:20-23; Dckt#99). The Defendant is left with a nearly impossible task of attempting to identify himself or his Tribe without using any of the enjoined names.

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Worse yet, the Court gave no basis for the issuance of its Order, in factual or legal conclusions. The Plaintiff downplays these deficiencies and offers rebuttal to Defendant's arguments on this issue by the bare assertion that the cases cited by Defendant do not support his argument "in any way." (Answering Brief, p. 41.) Plaintiff is wrong.

This Court's decision in *FTC v. Enforma Natural Products, Inc.*, 362 F.3d 1204, *supra*, illustrates the rule that a court must make detailed findings sufficient to provide the factual basis for the court's decision. *Id.*, 1216; Fed.R.Civ.P. 52(a), 65(d). In *FTC* the district court signed the plaintiff's proposed injunction order verbatim, which included findings of fact and conclusions of law. The findings of fact and conclusions of law were conclusory and provided no details concerning alleged failure to comply by defendant with court orders. The day after the court signed the preliminary injunction order, defendant appealed. *Id.*, 1210. Five days after defendant filed its appeal, the district court held a telephonic status conference during which the court made additional oral findings in support of the preliminary injunction that had just been appealed. This Court held that the previous order combined with the supplemented facts provided by the court were insufficient because defendant's ability to contest the injunction and this Court's ability to review were "significantly hampered by the lack of detail in the district court's order. *Id.*, 1216.

In this case, the District Court (both at the hearing and in its Order) did not analyze nor even mention any factors relating to the likelihood of confusion or the validity of the claimed trademark at issue. In addition, the Court did not state any conclusions of fact or law whatsoever on the issue of commercial use, which Defendant briefed. Thus, the District Court took no notice of the issues in the case and its Order in effect is invalid. *Freecycle Network, Inc. v. Oey*, 505 F.3d 898 (9th Cir. 2007). In *Freecycle* the district court concluded that “(1) [plaintiff] appears to have a legitimate mark; (2) [defendant] at one time acknowledged [plaintiff’s] mark and sought to protect it; and (3) ‘after his separation from the organization, [defendant] began to publicly encourage the disparagement of the Freecycle trademark.’” *Freecycle*, supra, 903. This Court noted that even if those conclusions were true, they still do not demonstrate that plaintiff in that case was likely to succeed on its section 1125(a) infringement claim. *Freecycle*, supra, 903.

If the court’s limited findings of fact and conclusions of law in *Freecycle* “did not demonstrate... a likelihood of success on” the Lanham Act claims, the District Court’s bare recitation of elements in the case at bar is patently inadequate. *Freecycle*, supra, 903.

There was no basis for the District Court’s Order because the Court limited reference of “irreparable injury,” “balance of hardships,” and the “public interest” to one sentence:

In terms of the other factors for the injunction, the court does find that the plaintiffs are likely to suffer irreparable injury, that the balance of hardships favors the plaintiffs, and that it is in the public interest that this injunction issue.

(Transcript - EOR-3, 15-1-5; Dckt#101). With Defendant's First Amendment rights at stake the District Court gave no consideration to the balance of hardships. In this manner a district court could essentially grant a preliminary injunction by naming the factors and not discussing them. This methodology is not the correct procedure under Fed.R.Civ.P. 52(a) and 65(d) which requires explicit findings. This result is made more unacceptable because those rules require explicit findings of fact that are more stringent for preliminary injunctions than other types of orders. *Id. Federal Trade Commission v. Enforma Natural Products, Inc.*, supra, 1212.

The Court does not mention and discuss the elements of a Lanham Act claim; the District Court only repeats in different ways the Court is "certain" [Plaintiff] will succeed on "all the elements necessary." (Transcript - EOR-3,13:6-10, 14: 23-25, 15: 1-5; Dckt#101) This leaves nothing to review. Consequently, the District Court's Order must be reversed. *Federal Trade Commission v. Enforma Natural Products, Inc.*, supra, 1212.

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III. THE PRELIMINARY INJUNCTION IS AN UNCONSTITUTIONAL PRIOR RESTRAINT OF SPEECH.

The Order suppresses Defendant's communication on behalf of his Tribe without "an adequate determination that it is unprotected by the First Amendment." *Pittsburgh Press Co. v. Pittsburgh Commission on Human Relations*, 413 U.S. 376, 390 (1973). It is 'one of the most serious and least tolerable infringements of his First Amendment rights' because Appellant is prevented from identifying himself and his Tribe as either "Miwok" Indians or as being from the "Shingle Springs" area. *Nebraska Press Association v. Stuart*, 427 U.S. 539, 559 (1976). "Any system of prior restraint on expression" comes with a heavy presumption against its constitutional validity." *Vance v. Universal Amusement Co.* 445 U.S. 308, 317 (1980), (emphasis in original). Courts have followed this logic and refused to impose a preliminary injunction against speech in a number of contexts.

In *Isuzu Motors Ltd. v. Consumers Union of the U.S.*, 12 F.Supp.2d 1035 (C.D. Cal. 1998), the court dismissed a claim for an injunction against future product disparagement because "[s]uch an injunction would necessarily precede an adequate determination that a particular statement by defendant was... disparaging." *Id.*, 1049. In *J.K. Harris & Co. v. Kassel*, 253 F.Supp.2d 1120 (N.D. Cal. 2003), the Northern District of California applied the same reasoning to a false advertising claim under the Lanham Act. In *J.K. Harris* the plaintiff demonstrated

“a serious question going to the merits of whether the defendant violated section 43 of the Lanham Act;” however, the injunction could not stand “because enjoining [the] statements [of the defendant] prior to an adjudication of their truth or falsity would suppress arguably protected speech.” *Id.*, 1129.

Here, likewise, the Order was a prior restraint based on a claimed infringement on a non-existent trademark because Defendant cannot identify his Tribe to governmental entities. The Order was especially damaging because it suppresses Defendant’s ability to identify himself as a Miwok from Shingle Springs and works to “crush [Defendant’s] pride and dignity in [his] heritage.” *The Mohegan Tribe of Indians of Connecticut v. The Mohegan Tribe and Nation, Inc.*, 255 Conn. 358, 379 (2001). Therefore, the Order cannot stand.

Plaintiff’s entire argument regarding Defendant’s First Amendment rights is off base. First, Plaintiff’s argument concerning free speech must fail because the authorities it cites presuppose that the speech being restrained is commercial in nature. (Answering Brief, p. 52). As stated above, there is absolutely no commercial aspect in the speech being constrained. Second, Plaintiff misconstrues case law in a transparent effort to support its claim. To that end Plaintiff has incorrectly cited a footnote in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 (9th Cir. 1997) and altered the wording of the original text to read “an injunction against *trademark infringement*.” (*Emphasis*

added). (Answering Brief, p. 52.) In the unaltered text, *Dr. Seuss* actually uses the words “an injunction in *this case*.” (*Emphasis added*) 109 F.3d 1403. Plaintiff’s misquoting of the law on this point is a weak attempt to persuade this Court that *Dr. Seuss* broadly held that no preliminary injunction based on a trademark infringement claim can be classified as an unconstitutional prior restraint. Not only does Plaintiff’s argument fail because that is not the holding in *Dr. Seuss*, but even if it were the holding in *Dr. Seuss*, that holding would be facially incorrect in light of well established 9th Circuit and U.S. Supreme Court rulings as discussed herein. Relevant authorities have consistently held that a prior restraint in essentially any context is unconstitutional. (*Citations omitted*).

Even if this case involved commercial speech sufficient to fall under the auspices of the Lanham Act (which it does not) the Order of the District Court is unconstitutional because it regulates Appellant’s communicative message (i.e. content based speech) without providing a supporting strict scrutiny analysis. The First Amendment is implicated when an injunction constrains a communicative message. *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1016 (9th Cir. 2004). Here, the purpose of the Order is to control Appellant’s communicative message because it explicitly prevents him from communicating to government entities that he is Miwok and indigenous to Shingle Springs. The District Court further that the case was about preventing Appellant “from using a

name that [Appellant has] no right to use until and unless *the United States Agrees*. (Transcript - EOR-3, 14:1-4; Dckt#101.) The entire point of Plaintiff's position is that the right to use the name Shingle Springs Band of Miwok Indians should belong to him and his Tribe, and that Appellant does not have a registered trademark that should be afforded protection under the Lanham Act. The court indicates that "the name," (Transcript - EOR-3, 13:14-15, Dckt.#101) is a trademark because Plaintiff has been registered with the Bureau of Indian Affairs "for over thirty years." (Transcript - EOR-3, 13:14-15, Dckt.#101; Order - EOR-2, 1:13.) Plaintiff on this appeal acknowledges that the BIA does not confer trademarks (Answering Brief, p.16). Notwithstanding that fact, the District court stated that "[Plaintiff's] name deserves protection" because of its BIA registration. (Transcript - EOR-3, 13:12-15; Dckt.#101.) Of course as Plaintiff admits, this is not the law. (Answering Brief, p.16); *The Mohegan Tribe of Indians of Connecticut v. The Mohegan Tribe and Nation, Inc.*, supra, 372-373.

Plaintiff argues that Defendant is not afforded free speech protections because he is attempting to use their purported trademark as a "source identifier." Plaintiff's argument must fail for two reasons. First, Plaintiff does not have a registered trademark. Second, if the name Shingle Springs Band of Miwok Indians is to be construed as a "source identifier," Mr. Caballero's communicative message (which is restricted by the injunction) is that the "source identifier" is being

misused by Plaintiff. It is in that way that the name Shingle Springs Band of Miwok Indians takes on an expressive meaning apart from its purported source identifying function; and therefore, must have free speech protections. *Mattel, Inc.*, supra, 900.

This case is analogous to *Freecycle* (supra.) wherein the defendant was preliminarily enjoined from expressing his opinion that the purported mark at issue was a generic term and encouraging others to agree with that opinion. *Freecycle*, supra, 901. The *Freecycle* Court reversed the preliminary injunction against the defendant because his speech was content based, non-commercial, and not likely to create confusion. *Freecycle*, supra, 903. Similarly, Defendant's message here is that he and his Tribe should have the sole right to use the name Shingle Springs Band of Miwoks Indians, and to that end he has attempted to register the name as a trademark. Defendant's message is that Plaintiff has usurped that name, and he is working to find likeminded individuals to, including the United States Government, to agree with him. In that respect, the right to use the purported "source identifier" (i.e. the name Shingle Springs Band of Miwok Indians) is precisely the message Defendant is communicating. And most importantly Defendant is trying to gain benefits for his Tribe in the form of TANF services, housing benefits, educational benefits, and others to which he is entitled under his identity for members of his Tribe. (EOR-7; Dckt#94-1, 5:6-7). His speech

therefore depends on the meaning and substance of his use of his identity as Miwok and from Shingle Springs.

Moreover, even if this Court found that the District Court's order was content-neutral (which it is not), the Order must still be overturned.

Content-neutral restrictions must "leave open ample alternative channels for communication of the information." *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989). Here, the preliminary injunction completely restrains Mr. Caballero from identifying himself as Miwok indigenous to the Shingle Springs area to government entities. First, government entities are the only channels for Mr. Caballero to petition for redress of his grievances. Second the Order prohibits Mr. Caballero from using "any similarly confusing variation" of the name (EOR 2:Dckt. 99). Not only is it impossible to determine what a similarly confusing variation may be, that restriction essentially eliminates the possibility of Mr. Caballero petitioning the government at all; thus, the restriction closes all alternative channels through which the information may be communicated. The District Court had no basis to in effect conclude that "[Appellant] may not refer to [himself] as what [he] claims to be, namely, a [Miwok Tribe]." *The Mohegan Tribe of Indians of Connecticut v. The Mohegan Tribe and Nation, Inc.*, *supra*, 374. The injunction here is unconstitutional and must be reversed.

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IV. THE DISTRICT COURT ABUSED ITS DISCRETION BECAUSE APPELLEE DOES NOT HAVE A GENUINE CLAIM UNDER THE LANHAM ACT AND NO LIKELIHOOD OF SUCCESS ON THE MERITS

Plaintiff's new arguments on this appeal with regard to 'competing services' under the Lanham Act must fail because they are not Miwok Indians and are not indigenous to the Shingle Springs area, Defendant is.

Plaintiff admits that their Indian Tribe has been known as the Sacramento Verona Band of Indians and that they are an Indian Tribe composed primarily of Maidu Indians and persons of Hawaiian decent. (EOR-11, 2; Dckt#19) Thus, Plaintiff's allegations that Defendant's use of the name Shingle Springs Brand of Miwok Indians creates "consumer confusion" with respect to their efforts to "educate the public" on their "history and culture" are of no consequence because their history and culture are distinguishable from Defendant and both groups would be educating on different backgrounds. (Answering Brief, p. 15.) Neither Plaintiff's arguments to the District Court nor their new arguments to this Court constitute a valid claim under the Lanham Act.

A. The District Court's Order Must be Reversed Because it Did not Apply the Commercial Use Requirement of the Lanham Act and There is no Potential for Consumer Confusion.

The Ninth Circuit explicitly held that "infringement claims are subject to a commercial use requirement." *Bosley Medical Institute v. Kremer*, 403 F.3d 672,

676 (9th Cir. 2005). The District Court did not apply the commercial use requirement and thus made a reversible error.

The Ninth Circuit has consistently held that the commercial use requirement means to use a famous and distinctive mark to sell goods or services other than those produced or authorized by the mark's owner. *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 903 (9th Cir. 2007) quoting *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 903 (9th Cir. 2002); *Bosley Medical Institute v. Kremer*, 403 F.3d 672, 676 (9th Cir. 2005); see also *Lang v. Retirement Living Pub. Co., Inc.*, 949 F.2d 576, 582-83 (2nd Cir. 1991) (the Lanham Act seeks to prevent consumer confusion that enables a seller to pass off his goods as the goods of another... Trademark infringement protects only against mistaken purchasing decisions and not against confusion generally.). The purpose of the commercial use requirement is to “avoid[ing] confusion in the market place.” *Mattel, Inc. v. MCA Records, Inc.*, *supra*, 900.

“Trademark infringement law prevents only unauthorized uses of a trademark in connection with a commercial transaction in which the trademark is being used to confuse potential customers.” *Bosley Medical Institute v. Kremer*, *supra*, 676. Thus, the Lanham Act protects only commercial uses of a trademark when such a use would cause consumer confusion.

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The commercial use requirement balances the need to protect non-commercial free speech under the First Amendment with the need to protect trademarks in commercial speech. Trademark law imposes a commercial use requirement because use outside of the commercial context is entitled to full First Amendment protection. *Mattel, Inc. v. MCA Records, Inc.*, supra, 906. The commercial use and non-commercial use framework is a categorical approach that reflects underlying and controlling First Amendment rights. *Id.*, 900 ("[t]rademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view." [citations omitted.]); *Bosley Medical Institute v. Kremer*, supra, 677 (As a matter of First Amendment Law, commercial speech may be regulated in ways that would be impermissible if the same regulation were applied to noncommercial expressions. [citations omitted.])

Not only did the District Court fail to apply the requirement of commercial use to its review of this case, but Plaintiff makes no allegation of consumer confusion sufficient to prove the potential for consumer confusion. Plaintiff generally has renounced that any commercial use or commercial benefit requirement exists. (see generally Answering Brief, pp. 15-21.) Plaintiff claims use the name Shingle Springs Band of Miwok Indians only in conjunction with operating a tribal government, and educating the public about the Tribe's culture,

government, and history. (EOR-10, 10; Dckt#90-1; Answering Brief, p. 22).

Plaintiff falsely attributes consumer confusion to the circumstances where a postal employee, when presented with government identification and other documentation, determines that the Appellant has an identity that corresponds with an intended receiver for mail. (Answering Brief, p. 24.) Under no reading of the Lanham Act is this a commercial use or even a competing service as discussed further below. Moreover, a postal employee acting in her role as a postal clerk cannot be considered a consumer of Appellee's purported 'services.' (Answering Brief, p. 24.)

Plaintiff cites to the district court opinion in *Stanislaus Custodial Deputy Sheriff's Association v. Deputy Sheriff's Association of Stanislaus County*, 2010 U.S. Dist. LEXIS 59177 (E.D. Cal. 2010) (*Stanislaus II*), which also recognizes a commercial use requirement. The Court cited to *Freecycle Network, Inc. v. Oey*, for the rule that to state a claim under the Lanham Act "a threshold matter is showing a competing service for a commercial benefit." *Stanislaus II*, supra, 20, citing *Freecycle Network, Inc. v. Oey*, supra, 903. Partly relying on the *Freecycle* decision, the District Court denied defendant's motion to dismiss the plaintiff's second amended complaint because plaintiff alleged defendant had "competed with [plaintiff] and reaped a commercial benefit from the use of the name. *Id.*, 27. To the extent the *Stanislaus II* court included language to suggest a "profit motive" is

not necessary, the case is inapplicable under the circumstances because here neither Plaintiff nor Defendant are non-profit organizations.

The *Stanislaus II* court appears to contradict its own cited authorities because the court appears to limit the holdings of both *Freecycle* and *Bosley* to the single factor of whether the parties in those cases competed with one another. *Stanislaus II*, supra, 26 (In neither *Bosley* nor *Freecycle* did the court find the use of the name in a “competitive context,” and therefore, did not find trademark infringement.). To the extent the *Stanislaus II* court sought to apply the Lanham Act outside of the commercial use context this court should decline to follow that opinion.

B. Plaintiff’s Activities do not Constitute ‘Services’ Under the Lanham Act Because They do not Include a Commercial Use.

Plaintiff’s activities are not ‘services’ under the Lanham Act because they are not ‘commercial.’ In *Hancock Park Homeowners Association v. Hancock Park Homeowners Association*, 2006 U.S. Dist. LEXIS 96211 (C.D. Cal. 2006) the Court held that activities such as assisting the community by opposing the building of the Beverly Hills Freeway; participating in filming regulation with the City of Los Angeles; participating in land use planning with the City of Los Angeles; assisting in developing community safety standards; assisting in developing community traffic management and calming measures; generally participating in regular government proceedings; and being vital to a historic preservation overlay

zone; were not ‘services’ under the Lanham Act. *Id.*, 3. Because the Court held that the activities at issue in *Hancock* were not commercial uses under the Lanham Act, it dismissed the case. *Id.*, 14.

Like the activities at issue in *Hancock*, Plaintiff’s activities herein do not constitute commercial uses. Plaintiff claims to use the name Shingle Springs Band of Miwok Indians in operation of a tribal government, and education of the public about the Tribe’s culture, government, and history. (EOR-10, 10; Dckt#90-1, 10). These activities like those at issue in *Hancock*, do not involve commercial transactions in any sense. Further, Plaintiff does not allege a profit motive or commerce of any sort in conjunction with their usage of the name Shingle Springs Band of Miwok Indians. The activities of the Plaintiff here, like the activities in *Hancock* are not “services” under the Lanham Act, nor should they be. The cases cited above indicate that the purpose of Trademark Law is to prevent ‘consumer confusion’ of a type that involves a ‘commercial use.’ Trademark law has always sought to prevent monopolies in language. Considering such concerns, one court stated that:

The alphabet, English vocabulary, and Arabic numerals, are to man, in conveying his thoughts, feelings, and the truth, what air, light, and water are to him in the enjoyment of his physical being. Neither can be taken from him. They are the common property of mankind, in which all have an equal share and character of interest. From these fountains whosoever will may drink, but an exclusive right to do so cannot be acquired by any.

Avery & Sons v. Meikle & Co., 81 Ky. 73, 90 (1883).

The statement above is particularly appropriate here because the words Plaintiff claims to have trademarked are not only the sole words that can be used by Appellant to identify his ethnic and geographic identity, (as opposed to Plaintiff who is not Miwok nor indigenous to the Shingle Springs area) they are Defendant's very identity. The principal of preventing the monopoly of language is the basis for the Lanham Act's 'commercial use' requirement. Plaintiff has failed to prove and has consistently admitted to the fact that they do not use the name Shingle Springs Band of Miwoks in any commercial services.

C. The Parties do not Engage in Competing Services.

In all of Plaintiff's moving papers before the District Court the words 'competing services' appear only once as a footnote. (EOR-5, 7:25-26; Dckt#95). Notwithstanding that fact, Plaintiff now claims to this Court that they offer a 'competing service,' with respect to Appellant's use of the name Shingle Springs Band of Miwoks Indians. (Answering Brief, p. 15.) However, Plaintiff's argument is fundamentally flawed because Plaintiff's Tribe is not Miwok and is not indigenous to the Shingle Springs area. Defendant is actually Miwok and indigenous to the Shingle Springs area. (EOR-12; Dckt#11-1). Whereas Plaintiff is a Band of Indians primarily of Maidu and Hawaiian decent relocated from the Sacramento area. (EOR-11; Dckt#11-2). Therefore, Plaintiff's argument that Defendant's use of the name "Shingle Springs Band of Miwok Indians" somehow

creates confusion when the parties provide services which “educate the public” about their history and culture is inherently false. Both Tribes educate the public about manifestly different histories and cultures. Under any reading of the Lanham Act there is no issue of competing services.

Defendant plainly does not engage in a ‘competing service’ to Plaintiff. Contrary to Plaintiff’s assertion that “Mr. Caballero also acknowledges that the Tribe and Mr. Caballero use the Mark “in connection with virtually identical services” citing to Defendant’s Opening Brief at page 32-33, Defendant made no such assertion. In fact the actual text refers only to Plaintiff’s own statements, which constitute their acknowledgement of lack of commercial use. (EOR-10, 10:18-20; Dckt#90-1).

In fact the evidence demonstrates Defendant does not engage in identical “tribal government services and educational services” as Plaintiff claims. (Answering Brief, 15, 22.) Rather Defendant engages primarily in the Tribe’s businesses of herding goats and maintaining grasslands, and designing and maintaining signs. Neither enterprise operates under the name Shingle Springs Band of Miwok Indians. (Opening Brief, p.7)

Plaintiff is misguided in its reference to both *Committee for Idaho’s High Dessert v. Yost*, 92 F.3d 672 (9th Cir. 1996) and *United We Stand America, Inc. v. United We Stand America New York, Inc.*, 128 F.3d 86 (2nd Cir. 1997), in that

neither case supports their claim that they offer ‘competing services’ to Defendant. The plaintiffs in both *Committee for Idaho* and *United We Stand*, were non-profit organizations possessing registered trademarks. (citations omitted). Plaintiff is not a non-profit organization, and the name Shingle Springs Band of Miwok Indians has not been registered as a trademark by either Defendant or Plaintiff. Therefore those two cases are distinguishable and simply not applicable to the circumstances herein.

For these reasons, there is no merit to Plaintiff’s claim that the parties are engaged in “competing services.”

D. Plaintiff Does Not Possess a Valid Trademark in the Name Shingle Springs Band of Miwok Indians.

Plaintiff has not registered the name Shingle Springs Band of Miwok Indians as a trademark. Moreover, the name is not ‘distinct’ within the meaning of the Lanham Act, and Plaintiff has not demonstrated a secondary meaning.

The Mohegan Tribe of Indians of Connecticut v. The Mohegan Tribe and Nation, Inc., et al., 255 Conn. 358 (S.Ct.Conn. 1999) (*Mohegan*) presents facts nearly identical to the present case. The Mohegan Tribe of Connecticut (plaintiff) was a group of Native Americans residing in Southeastern Connecticut. Plaintiff in that case was formally acknowledged by the federal government in 1994 as a sovereign American Indian nation. In 1996 plaintiff constructed a casino, the Mohegan Sun Casino, which at the time of the lawsuit was a thriving operation.

Mohegan, supra, 362. The Mohegan Tribe and Nation (defendant) was also located in Southeastern Connecticut. Defendant's Tribe consisted of Mohegan Indians by virtue of ancestry and was incorporated in 1992. *Id.*, 363. The defendant did not operate a casino and derived income primarily from the sale of arts and crafts and from Federal grants and Membership dues. *Id.* Defendant did not have federal recognition. *Id.*

In *Mohegan*, the plaintiff brought Lanham Act claims seeking to enjoin the defendant from using the names "Mohegan," "Mohegan Tribe," "Mohegan Tribe and Nation," "The Mohegan Tribe and Nation, Inc.," and "The Confederation of the Mohegan-Pequot American Indian Nation and Affiliated Tribes, Inc." *Id.*, 363-364. Plaintiff alleged that "if the [defendant is] allowed to continue to... [use those names, the plaintiff's efforts] to operate the Mohegan [Sun] Casino and related facilities, to preserve the culture, heritage and traditions of, and to promote the general welfare of... the Mohegan People shall continue to be harmed, all to the detriment of the plaintiff." *Id.*, 363. Notwithstanding the plaintiff's claims, the Supreme Court of Connecticut held that the name '[t]he Mohegan Tribe of Indians of Connecticut' was a generic name. Citing *Committee for Idaho's High Desert, Inc. v. Yost*, 92 F.3d 814 (9th Cir. 1996), the Mohegan Court held that the name Mohegan Tribe, like its component parts, was generic because it denotes a distinctive and identifiable group of Native Americans of Mohegan ancestry.

Mohegan, 371-372. Further, the *Mohegan* court found there was no risk of confusion and that the Tribe did not prove that it possessed a legally protectable interest in the names plaintiff sought to be enjoined. *Id.*, 365. Simply stated, an Indian Tribe must be permitted to describe itself by such names because “that is what it is.” *Id.*, 372.

Plaintiff is not permitted to legally prohibit Caballero from identifying himself and his Tribe to the government because Plaintiff is federally acknowledged. *Mohegan*, 372-373. As Plaintiff concedes, the Bureau of Indian Affairs does not confer trademarks. (Answering Brief, p. 16.) (the Tribe did not contend before the District Court, nor did the District Court hold, that the Bureau of Indian Affairs “confers trademarks” or that the BIA’s listing of Indian entities is tantamount to trademark registration.) The fact that Plaintiff already has received federal acknowledgement does not preclude Defendant from doing so. Such a result would be especially inequitable where as in this case, unlike *Mohegan*, Plaintiff does not possess the ethnic, historic, or geographic background identified in the name Shingle Springs Band of Miwok Indians.

V. CONCLUSION

The order of the District Court must be reversed, the findings supporting the Order are insufficient, and the Order is unconstitutionally overbroad. Plaintiff’s do not have a registered trademark and have not proved the existence of a commercial

use. Additionally, the Order affects a prior restraint on the free speech of Defendant. Defendant seeks to petition the United States Government for recognition of his Tribe as a Miwok Indians indigenous to Shingle Springs. Plaintiff does not offer a competing product or service under the name “the Shingle Springs Band of Miwoks Indians” or any variation of those terms. Defendant simply strives to gain “TANF services, housing services, educational benefits, and other benefits to which we are entitled under our identification.” (EOR-7, 5:5-7; Dckt#94-1.) Defendant uses the name Shingle Springs Band of Miwok Indians in conjunction with his historical and geographical identity and *based on that identity* seeks to obtain benefits and recognition from government entities. To censure Defendant’s use of the name Miwok and Shingle Springs would cut off his ethnic, historical and geographical message. There is no other way for Defendant to identify himself than through the ‘usage’ of the cultural and geographic terms identifying his Tribe’s authentic heritage. For these reasons and those stated above, this Court should reverse the preliminary injunction.

DATED this 23rd day of December, 2010.

Respectfully submitted,

/s/ Brad Clark

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Cesar Caballero

CERTIFICATE OF COMPLIANCE

The undersigned certifies that, according to the word count provided by Microsoft Word 2007, the body of the foregoing brief contains 5,525 words, exclusive of those parts excluded by Fed. R. App. P. 32(a)(7)(B)(iii), which is less than the 7,000 words permitted by Fed. R. App. P. 32(a)(7)(B)(ii). The text of the brief is in 14-point Times New Roman, which is proportionally spaced Fed. R. App. P. 32(a)(5), (6).

DATED this 23rd day of December, 2010.

s/ Brad Clark
Brad Clark (CSB#248658)

CERTIFICATE OF SERVICE

The undersigned certifies:

1. That I electronically filed the foregoing Appellant's Reply Brief with the Clerk of the Court for the United States Court of Appeals for the Ninth Circuit on December 23, 2010, by using the Appellate CM/ECF System.

2. That all counsel of record in this case are registered CM/ECF users and that service was accomplished by the Appellate Court's CM/ECF system.

DATED this 23rd day of December, 2010.

/s/ Brad Clark
Brad Clark (CSB#248658)