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9 SHINGLE SPRINGS BAND OF MIWOK INDIANS

10 UNITED STATES DISTRICT COURT
11 EASTERN DISTRICT OF CALIFORNIA
12

13 SHINGLE SPRINGS BAND OF MIWOK
INDIANS,

14 Plaintiff,

15 v.

16 CESAR CABALLERO,

17 Defendant.
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CASE NO. 2:08-CV-03133-JAM-DAD

**MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF
SHINGLE SPRINGS BAND OF MIWOK
INDIANS' MOTION FOR PARTIAL
SUMMARY JUDGMENT AND ENTRY
OF PERMANENT INJUNCTION**

Date: February 6, 2013
Time: 9:30
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Judge: Hon. John A. Mendez

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. FACTUAL BACKGROUND.....	2
A. The Tribe’s Marks	2
B. Caballero’s Recent Infringement of the Tribe’s Marks	3
III. PROCEDURAL HISTORY	5
A. The Tribe’s And Caballero’s Earlier Pleadings.....	5
B. Preliminary Injunction.....	5
C. Contempt Proceedings Against Caballero	6
D. Criminal Proceedings.....	6
E. Third Amended Complaint	7
IV. ARGUMENT.....	7
A. Legal Standards For Motion For Summary Judgment	7
B. The Tribe Is Entitled To Summary Judgment On Its Infringement, Unfair Competition, And Declaratory Judgment Claims.	8
1. Elements Of Infringement And Unfair Competition Claims.....	8
2. The Tribe’s Use Predates Caballero’s.	9
3. The Tribe’s Marks Are Valid.	10
a) The Tribal Marks Have Acquired Secondary Meaning.....	10
b) Caballero’s Copying Is An Independent Basis Supporting A Finding Of Secondary Meaning.....	11
4. Likelihood of Confusion.....	12
a) Strength Of The Tribe’s Marks.....	13
b) Proximity Of The Parties’ Goods	14
c) Similarity Of The Marks And Caballero’s Intent	14
d) Evidence Of Actual Confusion.....	16
e) Marketing Channels Used.....	17
f) Likely Degree of Purchaser Care.....	18

1
2
3
4
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6
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C.	The Tribe Is Entitled To Summary Judgment On Its Declaratory Claim.....	18
D.	The Tribe Is Entitled To Summary Judgment On Its ACPA Claims.	18
1.	Caballero’s Illegal Domain Names Incorporate And Are Identical Or Confusingly Similar To The Tribe’s Marks.	19
2.	The Tribe’s Federally Registered Marks Were Distinctive When Caballero Registered His Illegal Domain Names.	20
3.	Caballero Registered These Illegal Domain Names With A Bad-Faith Intent To Profit From Them.	20
a)	Factors I-IV Demonstrate Bad Faith Intent to Profit	21
b)	Factor V: Caballero’s Intent To Divert And Deceive.....	22
c)	Factor VI: Caballero’s Intent To Profit	22
d)	Factor VII: Caballero’s False Contact Information	23
e)	Factor VIII: Caballero’s Pattern Of False Registration	23
f)	Factor IX: The Tribe’s Strong Marks	24
E.	Permanent Injunctive Relief In Favor Of The Tribe Is Appropriate.	24
F.	The Tribe Conditionally Requests Dismissal Of Remaining Claims.	25
V.	CONCLUSION.....	25

TABLE OF AUTHORITIES

Page(s)

FEDERAL CASES

<i>Accuride Int’l, Inc. v. Accuride Corp.</i>	
871 F.2d 1531 (9th Cir. 1989)	12
<i>AMF, Inc. v. Sleekcraft Boats</i>	
599 F.2d 341 (9th Cir. 1979)	passim
<i>Amoco Prod. Co. v. Gambell</i>	
480 U.S. 531 (1987).....	24
<i>Anderson v. Liberty Lobby, Inc.</i>	
477 U.S. 242 (1986).....	7, 8
<i>Angel Flight of Ga., Inc. v. Angel Flight Am., Inc.</i>	
522 F.3d 1200 (11th Cir. 2008)	24
<i>Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.</i>	
174 F.3d 1036 (9th Cir. 1999)	8, 10, 18
<i>Celotex Corp. v. Catrett</i>	
477 U.S. 317 (1986).....	7
<i>Coca-Cola Co. v. Purdy</i>	
382 F.3d 774 (8th Cir. 2004)	19, 20, 22
<i>Committee for Idaho’s High Desert v. Yost</i>	
92 F.3d 814 (9th Cir. 1996)	10, 11, 12
<i>Conversive, Inc. v. Conversagent, Inc.</i>	
433 F. Supp. 2d 1079 (C.D. Cal. 2006)	8
<i>DaimlerChrysler v. The Net Inc.</i>	
388 F.3d 201 (6th Cir. 2004)	19
<i>Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.</i>	
109 F.3d 1394 (9th Cir. 1997)	12
<i>Dream Marriage Group Inc. v. Anastasia Int’l, Inc.</i>	
CV 10-5034, 2010 U.S. Dist. LEXIS 120543 (C.D. Cal. Oct. 27, 2010).....	8
<i>DSPT Int’l, Inc. v. Nahum</i>	
624 F.3d 1213 (9th Cir. 2010)	22, 23
<i>Eclipse Assoc., Ltd. v. Data General Corp.</i>	
894 F.2d 1114 (9th Cir. 1990)	12

1	<i>Electropix v. Liberty Livewire Corp.</i>	
2	178 F. Supp. 2d 1125 (C.D. Cal. 2001)	14, 16, 20
3	<i>Faegre & Benson, LLP v. Purdy</i>	
4	447 F. Supp. 2d 1008 (D. Minn. 2006).....	25
5	<i>Golden Door, Inc. v. Odisho</i>	
6	646 F.2d 347 (9th Cir. 1980)	15, 16, 20
7	<i>GoPets Ltd. v. Hise</i>	
8	657 F.3d 1024 (9th Cir. 2011)	19
9	<i>Grupo Gigante SA de CV v. Dallo & Co., Inc.</i>	
10	391 F.3d 1088 (9th Cir. 2004)	9
11	<i>Guess?, Inc. v. Tres Hermanos</i>	
12	993 F. Supp. 1277 (C.D. Cal. 1997)	13, 14, 15
13	<i>Harper v. Wallingford</i>	
14	877 F. 2d 728 (9th Cir. 1987)	8
15	<i>HMH Pub. Co., Inc. v. Brincat</i>	
16	504 F.2d 713 (9th Cir. 1974)	15
17	<i>Lahoti v. VeriCheck, Inc.</i>	
18	586 F.3d 1190 (9th Cir. 2009)	20
19	<i>Lockwood v. Wolf Corp.</i>	
20	629 F.2d 603 (9th Cir. 1980)	7
21	<i>Matsushita Elec. Indus. Co. v. Zenith Radio Corp.</i>	
22	475 U.S. 574 (1986).....	7
23	<i>N. Cheyenne Tribe v. Norton</i>	
24	503 F.3d 836 (9th Cir. Mont. 2007).....	24
25	<i>N. Light Tech., Inc. v. N. Lights Club</i>	
26	236 F.3d 57 (1st Cir. 2001).....	23
27	<i>Nutri/System, Inc. v. Con-Stan Industries, Inc.</i>	
28	809 F.2d 601 (9th Cir. 1987)	17
	<i>Official Airline Guides, Inc. v. Goss</i>	
	6 F.3d 1385 (9th Cir. 1993)	14
	<i>Perfumebay.com Inc. v. eBay Inc.</i>	
	506 F.3d 1165 (9th Cir. 2007)	17
	<i>Playboy Enters. v. Chen</i>	
	No. CV 96-3417 DDP, 1997 U.S. Dist. LEXIS 21916 (C.D. Cal. Oct. 1, 1997).....	7

1	<i>Shields v. Zuccarini</i>	
2	254 F.3d 476 (3d Cir. 2001)	23
3	<i>Toyota Motor Sales, U.S.A., Inc. v. Tabari</i>	
4	610 F.3d 1171 (9th Cir. 2010)	8
5	<i>Transgo, Inc. v. Ajac Transmission Parts Corp.</i>	
6	768 F.2d 1001 (9th Cir. 1985)	11
7	<i>Transworld Airlines v. Am. Coupon Exch.</i>	
8	913 F.2d 676 (9th Cir. 1990)	8
9	<i>Two Pesos v. Taco Cabana</i>	
10	505 U.S. 763 (1992).....	10
11	<i>USA v. Caballero</i>	
12	2:11-mj-00035 (E.D. Cal).....	6
13	<i>USA v. Caballero</i>	
14	2:12-cr-00181 (E.D. Cal).....	7
15	<i>Zobmondo Entertainment, LLC v. Falls Media, LLC</i>	
16	602 F.3d 1108 (9th Cir. 2010)	10, 20

CALIFORNIA CASES

17	<i>Mallard Creek Indus. v. Morgan</i>	
18	56 Cal. App. 4th 426 (1997)	8

FEDERAL STATUTES

19	15 U.S.C. § 1057.....	10
20	15 U.S.C. § 1114.....	8
21	15 U.S.C. § 1125.....	passim
22	28 U.S.C. § 2201.....	18

OTHER AUTHORITIES

23	45 Fed. Reg. 27828, 27830 (April 24, 1980).....	2, 11, 13
24	77 Fed. Reg. 47868, 47871 (Aug. 10, 2012)	passim
25	Fed. R. Civ. P. 41(a)(2).....	25
26	Fed. R. Civ. P. 56.....	7

I. INTRODUCTION

The defendant in this case is an angry man and, perhaps, with good reason. His story echoes those of thousands of Indians across the state and the nation. By reason of hostile invaders and historic governmental policies calculated variously to eradicate, assimilate or dispossess native people, American Indians in California were long ago stripped of their lands, their traditional way of life, and their tribal identity. While Cesar Caballero may well be a victim of this history, his troubles with the law and this Court, as manifested in this case, are of his own making, and his anger about his situation is grossly misdirected.

The Shingle Springs Band of Miwok Indians (hereinafter “Tribe”) is a federally recognized Indian tribe comprised of Miwok, Maidu, and Nisenan Indians that the United States settled on the Shingle Springs Rancheria long ago. (Declaration of Nicholas Fonseca (“Fonseca Dec.”) ¶ 2; Declaration of Ian Barker (“Barker Dec.”) ¶ 19, Ex. U at 6.) Like so many California Indians, the Tribe has struggled against forces endeavoring to deprive its people of their lands, their economic opportunities, and even their lives. Having survived through generations of struggle, the Tribe has managed to build a strong and stable tribal government that provides for the health and welfare of over 500 citizens and their families. The Tribe owns and operates a community health clinic that serves the indigent (both Indian and non-Indian), it has forged ties with federal, state and local governments and surrounding communities, it has built and improved infrastructure on and off the reservation for the public benefit, and it has even established economic development through the construction of a gaming facility that provides jobs for both tribal and non-tribal citizens, and that generates limited revenues for its government (not to mention the State and County).

Rather than applauding the Tribe’s hard-fought achievements, Caballero appears consumed with the misguided belief that the Tribe’s success should be his own. To that end, he has embarked on an unprecedented crusade to usurp the Tribe’s identity, apparently in an effort to claim rights to its federal recognition and its corresponding right to own and operate a gaming facility. He so proceeds on the apparent theory that he is more authentically Miwok than most

1 or all of the Tribe's own members. Even if true, the assertion is irrelevant here, and has nothing
2 to do with his right to usurp the name of a political entity recognized by the United States.¹

3 Of course, by now, the Court is all too familiar with Caballero's campaign of
4 infringement, having issued a preliminary injunction and contempt orders based on the Tribe's
5 prior evidentiary showings and briefings. But Caballero's disregard for the sanctity of the law
6 and this Court's Orders apparently knows no bounds. Indeed, the Tribe recently discovered
7 Caballero has opened at least three bank accounts in the Tribe's name, one of which he used as
8 recently as September 2012, *two years after* this Court ordered Caballero to cease using the
9 Tribe's names and representing that he is affiliated with the Tribe.

10 In the end, Caballero's conduct has burdened the Tribe's limited sovereign resources,
11 injured the Tribe's goodwill, and it threatens to irreparably harm the Tribe. Putting aside the
12 strength of Caballero's misplaced conviction that his rights to recognition are somehow
13 exclusive of the Tribe's, Caballero's "battle is with the United States, not with this tribe," as this
14 Court has aptly observed. (Barker Dec. ¶ 18, Ex. T at 13:22-23.) Thus, to put an end to
15 Caballero's misconduct and a case that has lasted too long and consumed too many resources,
16 the Tribe seeks summary judgment and a permanent injunction prohibiting Caballero's
17 infringement, and requiring the transfer of his illegally held domains to the Tribe. If the Court
18 grants the requested injunction, the Tribe requests that the Court dismiss the Tribe's remaining
19 claims, without prejudice, and enter judgment for the Tribe.

20 **II. FACTUAL BACKGROUND**

21 **A. The Tribe's Marks**

22 The United States has recognized the Tribe as the "Shingle Springs Band of Miwok
23 Indians, Shingle Springs Rancheria (Verona Tract), California," and the Tribe has provided
24 services under that name, for decades. 45 Fed. Reg. 27828, 27830 (April 24, 1980); 77 Fed.
25 Reg. 47868, 47871 (August 10, 2012). For decades, the Tribe has consistently used, and come

26
27 ¹ His theory is actually misplaced, but equally irrelevant to his claim to federal recognition,
28 which, if meritorious, is hardly exclusive of the Tribe's right to federal recognition.

to be well-known by, the names “Shingle Springs Band of Miwok Indians” and “Shingle Springs Rancheria”² (collectively, the “Tribal Marks”) in various dealings with the United States, the State of California, local government entities, the Tribe’s citizens, and the public in connection with promoting its interests and those of its members. (Fonseca Dec. ¶¶ 3-6, 7, Exs. A-G, I.) The Tribe applied to federally register its Tribal Marks, which remain before the United States Patent and Trademark Office, but are held in abeyance pending resolution of this case. (*Id.*, ¶ 2.)

The Tribe is the registered owner of the “Red Hawk Casino” mark, Reg. No. 3,886,697 (Dec. 7, 2010). (Barker Dec. ¶ 27, Ex. GG.) The Red Hawk Casino, a full-scale tribal gaming facility owned and operated by the Tribe, opened in December 2008. (Declaration of Mark Ward (“Ward Dec.”) ¶ 2; Fonseca Dec. ¶ 6.) Before and since, the Tribe has used the “Red Hawk Casino” mark extensively in the operation of its gaming facility, and in advertising and marketing through various media, including the Internet, magazines, newspapers, billboards, television, and the radio. (Ward Dec. ¶¶ 2-6, Exs. A-D.) As a result of the Tribe’s use and marketing efforts, the “Red Hawk Casino” mark has become well-known, distinctive and famous, and the public associates the Tribe with the mark. (*Id.*) Indeed, Caballero admits the Tribe has superior rights to the “Red Hawk Casino” mark. (Barker Dec. ¶ 2, Ex. A at 213:3-21.)

B. Caballero’s Recent Infringement of the Tribe’s Marks

The Court is well aware of Caballero’s infringing activities, coming decades after the Tribe’s first use, all of which were detailed in filings in support of, and to enforce, the Court’s preliminary injunction order. In deference to the Court’s recent order denying the Tribe’s request to exceed page limits (Doc. 233), the Tribe incorporates by reference prior briefing and evidence cited therein showing Mr. Caballero’s infringing conduct, including his:

- filing of a Fictitious Business Name Statement and procurement of a business license in the Tribe’s name (Doc. 126-1 at 8:19-9:2);

² The “Shingle Springs Rancheria” mark has been used interchangeably, both to as a Mark for the tribal entity itself, as well as the lands held in trust by the United States for the Tribe’s benefit. (Fonseca Dec. ¶ 2.)

- 1 • obtaining and displaying to third parties an Employer Identification Number from the
- 2 Internal Revenue Service bearing the Tribe's name (Doc.94-1, ¶ 4, Ex. B);
- 3 • holding himself out at a public rally and to a local newspaper reporter as a spokesman for
- 4 the Tribe (Doc. 90-1 at 4:24-5:2.)
- 5 • submitting fraudulent "Change of Address" forms with the United States Postal Service
- 6 ("USPS") to divert the Tribe's mail to his own address (Doc. 90-1 at 5:14-20); *see also*
- 7 Barker Dec. ¶¶ 2, 19, Ex. A at 623:6-624:5 (interposing self-incrimination objection),
- 8 Ex. U at 10 (admitting filing of change of address forms);
- 9 • using the Internet and social media websites, including Myspace, Twitter, Facebook, and
- 10 YouTube, to infringe the Tribe's marks (Doc. 126-1 at 10:12-11:4, 11:24-13:5; Doc.
- 11 129; Doc. 132 at 7:18-8:1; Doc. 147 at 4:19-22; *see also* Barker Dec. ¶ 2, Ex. A at 579:4-
- 12 584:18); and
- 13 • impersonating the Tribe in communications with the University of California's Phoebe
- 14 A. Hearst Museum of Anthropology in an attempt to derail the delivery of human
- 15 remains for which the Tribe long sought repatriation (Doc. 161 at 6:8-7:5).

16 Despite the imposition of fines and Caballero's imprisonment for civil contempt on two

17 separate occasions (Docs. 165, 173, 175, 189, 193, 196, 199), the Tribal Marks, along with

18 Caballero's name and voice, still appear on the Miwok Promotions YouTube Channel in

19 violation of this Court's preliminary injunction. (Barker Dec. ¶ 28, Ex. HH.) Additionally,

20 Caballero's @championindian Twitter page still displays the URL

21 "www.shinglespringsreservation.info," in violation of the injunction. (Barker Dec. ¶ 29, Ex. II.)

22 More recently, the Tribe has discovered other ongoing infringement, in that Caballero

23 has used the Tribal Marks to open three bank accounts in the Tribe's name, conduct to which he

24 admitted under oath. (Barker Dec. ¶ 2, Ex. A at 694:20-23, 774:20-775:16.) Specifically,

25 Caballero opened (1) a bank account with Washington Mutual Bank (now JP Morgan Chase

26 Bank, N.A.), under the name "Shingle Springs Miwok Tribe" (Barker Dec. ¶¶ 2, 15, Ex. A at

27 694:20-695:1, Ex. O.); (2) an account with El Dorado Savings Bank, under the name "Shingle

28 Springs Band of Miwok Indians"; and (3) a third account as to which he claimed to have

1 forgotten the details. (Barker Dec. ¶ 2, 16, Ex. A at 695:2-5, 739:25-740:20, 774:16-775:7, Ex.
 2 Q). With respect to those accounts he could remember, Caballero testified he used one as
 3 recently as this past September 2012, **long after the Court enjoined Mr. Caballero from**
 4 **using the Tribe's marks.** (Barker Dec. ¶ 2, Ex. A at 768:2-10.) Caballero testified he uses
 5 these accounts for personal activities, including to pay for groceries, reference materials, vehicle
 6 registration, graphic arts, and for his daughter's daycare expenses. (Barker Dec. ¶ 2, 15-16, Ex.
 7 A at 704:23-707:21, 757:7-758:-4, 760:11-761:13, 768:2-10, 766:5-16, 768:24-769:22, Exs. P
 8 and R.) Despite the otherwise frequent use of the account, no purchases or deposits were made
 9 to these accounts during the periods when Caballero was incarcerated. (Barker Dec. ¶ 2, 15, Ex.
 10 A at 702:11-704:11, 704:23-707:22, Ex. P at P-003, P-006, P-008, P-010.)

11 **III. PROCEDURAL HISTORY**

12 **A. The Tribe's And Caballero's Earlier Pleadings**

13 On December 23, 2008, the Tribe sued Caballero for federal trademark infringement and
 14 various state law claims based on Caballero's fraudulent use of "Shingle Springs Band of
 15 Miwok Indians." (Docket # ("Doc.") 1.) With his answer, Caballero filed counterclaims (styled
 16 a "Cross-Complaint"), which were essentially a mirror image of the Tribe's claims, and various
 17 state law claims. (Doc. 11.) On May 20, 2009, the District Court dismissed the counterclaims
 18 with prejudice. (Doc. 33.) Caballero prematurely appealed that order and the Ninth Circuit
 19 dismissed the appeal. (Docs. 40, 66.) On November 23, 2009, and August 20, 2010, with leave
 20 of the Court, the Tribe amended its complaints based on newly discovered conduct, including
 21 Caballero's use of additional infringing marks and websites. (Docs. 69, 88.)

22 **B. Preliminary Injunction**

23 On September 3, 2010, based on evidence that Caballero diverted the Tribe's mail and
 24 engaged in other harmful infringing conduct, this Court granted the Tribe's application for a
 25 temporary restraining order and set a hearing on the Tribe's application for a preliminary
 26 injunction. (Doc. 91.) At the hearing, the Court found "there's no question in my mind based
 27 on the evidence before the Court, that the plaintiff is likely to prevail on this [trademark] claim,
 28 on all the elements necessary." (Barker Dec. ¶ 18, Ex. T at 13:6-10.) Specifically, this Court

found that, within the meaning of the Lanham Act, the Tribe was likely to prevail in showing it has “a valid and protectable trademark,” and that Caballero has used marks that are identical, or nearly identical, to the Tribe’s. (Barker Dec. ¶ 18, Ex. T at 12:23-13:10.) This Court also found the Tribe would likely prevail in showing Caballero’s use “presents a likelihood of confusion” under the Lanham Act. (*Id.*) Finding for the Tribe on each relevant factor (Barker Dec. ¶ 18, Ex. T at 15:1-5), this Court enjoined Caballero from using trademarks confusingly similar to the Tribe’s trademarks and required him to immediately return all mail he diverted. (Doc. 99 at 2:14-3:6.) Caballero appealed the injunction, and the Ninth Circuit affirmed. (Docs. 109, 122.)

C. Contempt Proceedings Against Caballero

The Tribe then sought contempt sanctions based on evidence Caballero continued to infringe. (Doc. 126.) This Court found Caballero in contempt, and ordered him to pay \$500 per day until he complied. (Doc. 140.) When the monetary sanctions failed to secure Caballero’s compliance, the Tribe asked the Court to imprison him pending his compliance. (Doc. 146.) At the ensuing hearing, the Court directed Caballero to purge his contempt no later than November 14, 2011, or surrender. (Docs. 162, 165.) Caballero failed to comply and was imprisoned until this Court temporarily released him from custody on January 4, 2012, emphasizing that Caballero “remain[ed] in contempt of the Court.” (Docs. 173, 175.) When Caballero still failed to comply, the Court issued a bench warrant, and Caballero was rearrested on March 5, 2012, and detained in custody until April 3, 2012, at which point Caballero submitted documents showing that he had complied with the Court’s contempt orders. (Docs. 189, 193, 196, 199.)

D. Criminal Proceedings

On November 2, 2010, the Tribe and Caballero agreed to continue this litigation based on Caballero’s representation that he potentially faced criminal charges for obstructing the Tribe’s mail and that he would invoke the self-incrimination privilege in this case. (Doc. 117.) On February 2, 2011, Caballero was charged with three counts of obstructing the Tribe’s mail. (*USA v. Caballero*, 2:11-mj-00035 (E.D. Cal), Doc. 1.) On April 30, 2012, Magistrate Judge Brennan convicted Caballero on all three counts, sentencing him to 90 days imprisonment. (*Id.*,

Doc. 25.) District Judge Garland E. Burrell, Jr., affirmed (*USA v. Caballero*, 2:12-cr-00181 (E.D. Cal), Docs. 52, 55), and Caballero has appealed to the Ninth Circuit. (*Id.*, Doc. 53.)

E. Third Amended Complaint

The Tribe filed its third amended complaint on July 25, 2012. (Doc. 220.) Caballero filed a response 11 days after his time to plead expired. (Doc. 222.) Because his response included “Affirmative Answers” and a “Prayer” for affirmative relief that this Court had already dismissed (Doc. 33), the Tribe timely moved to dismiss, or strike, that portion of his response. (Doc. 226.) Discovery closed October 26, 2012, and the Tribe timely filed this motion for partial summary judgment and permanent injunctive relief. (Doc. 225.)

IV. ARGUMENT

A. Legal Standards For Motion For Summary Judgment

The Tribe is entitled to summary judgment if no genuine issue of material fact exists and the Tribe is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56. Whether a fact is “material” turns on the substantive law governing the claims. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute over a material fact is genuine only if the evidence in the summary judgment record permits a reasonable fact finder to return a verdict for the nonmoving party. *Id.* at 249. The inquiry is whether the evidence disclosed in the summary judgment record “presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law.” *Id.* at 251-52.

Under Rule 56(c) of the Federal Rules of Civil Procedure, the Tribe bears the initial burden of “informing the district court of the basis for its motion, and identifying those portions of [the record] which it believes demonstrate the absence of a genuine issue of material fact.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). However, an “admission by [Caballero] satisfies [the Tribe]’s burden on summary judgment to demonstrate elements of cause of action.” *Playboy Enters. v. Chen*, No. CV 96-3417 DDP, 1997 U.S. Dist. LEXIS 21916, at *20-22 (C.D. Cal. Oct. 1, 1997) (citing *Lockwood v. Wolf Corp.*, 629 F.2d 603, 611 (9th Cir. 1980)).

After the Tribe has met its initial burden, Caballero then bears the burden to come forward with specific facts showing that there is a genuine issue for trial. *Matsushita Elec.*

1 *Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). “[M]ere disagreement or bald
 2 assertion that a genuine issue of material fact exists” will not preclude summary judgment.
 3 *Harper v. Wallingford*, 877 F. 2d 728, 731 (9th Cir. 1987). “Factual disputes that are irrelevant
 4 or unnecessary will not be counted.” *Anderson*, 477 U.S. at 248 (1986). The mere existence of
 5 a scintilla of evidence supporting Caballero’s position is insufficient. *Id.* at 252.

6 Moreover, as the Tribe seeks summary judgment only on issues in equity properly tried
 7 by the Court, not a jury (*Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1183-84
 8 (9th Cir. 2010)), the Court may decide issues of fact at this stage—even if genuine issues exist—
 9 if the Court determines that, as trier of fact, it would so rule at trial. *See Transworld Airlines v.*
 10 *Am. Coupon Exch.*, 913 F.2d 676, 684 (9th Cir. 1990) (where Court will act as trier of fact, it
 11 may decide factual issues if given a sufficient record).

12 **B. The Tribe Is Entitled To Summary Judgment On Its Infringement,**
 13 **Unfair Competition, And Declaratory Judgment Claims.**

14 Facts not subject to genuine dispute show the Tribe is entitled to summary judgment on
 15 its federal and state trademark infringement claims, state unfair competition claim, and
 16 declaratory relief claim (First, Second, Third, and Fourth Causes of Action).

17 **1. Elements Of Infringement And Unfair Competition Claims.**

18 To prevail on its claim of trademark infringement of its registered marks under 15 U.S.C.
 19 § 1114, and its marks for which registration is pending under 15 U.S.C. § 1125(a), the Tribe
 20 must establish that: (a) the Tribe is the senior mark holder, (b) the marks are valid, and
 21 (c) Caballero’s use of the marks is likely to cause confusion in the marketplace. *See Conversive,*
 22 *Inc. v. Conversagent, Inc.*, 433 F. Supp. 2d 1079, 1087 (C.D. Cal. 2006) (citing *Brookfield*
 23 *Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1046 (9th Cir. 1999)). These same
 24 elements must be established to prevail on claims of infringement or unfair competition under
 25 California law. *Mallard Creek Indus. v. Morgan*, 56 Cal. App. 4th 426, 434-35 (1997); *Dream*
 26 *Marriage Group Inc. v. Anastasia Int’l, Inc.*, CV 10-5034 RSWL, 2010 U.S. Dist. LEXIS
 27 120543, *3-4 (C.D. Cal. Oct. 27, 2010).
 28

2. The Tribe's Use Predates Caballero's.

Caballero's recent attempts to capitalize on the Tribe's federally recognized name, and usurp the Tribe's property and sabotage its government operations, impart to him absolutely no rights in the name that the Tribe has used and owned for decades. "A fundamental principle of trademark law is first in time equals first in right." *Grupo Gigante SA de CV v. Dallo & Co., Inc.*, 391 F.3d 1088, 1093 (9th Cir. 2004). This means that whoever first uses a mark has a right superior to any subsequent user. *Id.*

Continuously since 1980, the Tribe has conducted a government-to-government relationship with the United States under the name "Shingle Springs Band of Miwok Indians, Shingle Springs Rancheria." 45 Fed. Reg. 27828, 27830 (April 24, 1980); 77 Fed. Reg. 47868, 47871 (Aug. 10, 2012) (*See also* Tribe's Request for Judicial Notice ("RFJN"), Exs. 1-13 (showing recognition from 1980 to present).) Indeed, Caballero admits the Tribe has used the Tribal Marks for decades. (Barker Dec. ¶ 19, Ex. U at 6; Doc. 11, Class Action Cross-Complaint [*sic*] ("Cross-Complaint"), ¶¶ 16-17, 83-84.) The Tribe has also used its names extensively in connection with promoting its governmental interests and the interests of its members for decades. (Fonseca Dec. ¶¶ 3, 6, Exs. A-C, E-G; Declaration of Elaine Whitehurst ("Whitehurst Dec.") ¶¶ 2-5, Exs. A-D.)

Caballero, on the other hand, waited until the Tribe had made its tribal name famous to misappropriate the Tribe's marks for his own purposes. It was not until August 19, 2008, after the Tribe had defeated the last of the public lawsuits challenging its gaming facility and was in the midst of construction, that Caballero filed a fictitious business name statement and business license with the County of El Dorado, purporting to do business as the "Shingle Springs Band of Miwok Indians," the exact same name as the Tribe. (Fonseca Dec. ¶¶ 1, 6, Ex. H; Barker Dec. ¶¶ 2-3, 17, Ex. A at 389:23-390:23, Ex. C at 3:5-8, Ex. S.)

The Tribe applied to register its "Red Hawk Casino" mark on February 29, 2008, and without opposition, the USPTO registered the mark on December 7, 2010, based on the Tribe's first use in commerce on or before December 31, 2008. (Barker Dec. ¶ 27, Ex. GG.) Caballero

admits the Tribe's use of "Red Hawk Casino" predates his use of that mark, and admits the Tribe has superior rights to the mark. (Barker Dec. ¶¶ 2-3, Ex. A at 213:3-21, Ex. C at 2:20-22.) Caballero's recent and unauthorized usage of the marks, which violates this Court's injunction, in no way undermines the Tribe's exclusive trademark rights.

3. The Tribe's Marks Are Valid.

Federal registration of the Tribe's "Red Hawk Casino" mark is prima facie evidence that the registrant is the owner of the mark and that the registrant has the exclusive right to use the mark on the goods and services specified in the registration. (Barker Dec. ¶ 27, Ex. GG.) *See* 15 U.S.C. § 1057(b); *Brookfield Commc'ns*, 174 F.3d at 1047.

The Tribe's Tribal Marks are valid and distinctive, as they have acquired secondary meaning in the mind of the public, and officials of federal, state and local governments with whom the Tribe has relationships, as an identifier for the Tribe and its services.³ "Secondary meaning is used generally to indicate that a mark . . . 'has come through use to be uniquely associated with a specific source.'" *Two Pesos v. Taco Cabana*, 505 U.S. 763, 766 n.4 (1992). "Factors considered in determining whether a secondary meaning has been achieved include: (1) whether actual purchasers of the product bearing the claimed trademark associate the trademark with the producer, (2) the degree and manner of advertising under the claimed trademark, (3) the length and manner of use of the claimed trademark, and (4) whether use of the claimed trademark has been exclusive." *Committee for Idaho's High Desert v. Yost*, 92 F.3d 814, 822 (9th Cir. 1996). Where the trademark is connected to political advocacy, the focus is nevertheless on the "relevant 'consumer' group": those to whom the message is directed. *Id.*

a) The Tribal Marks Have Acquired Secondary Meaning.

The Tribal Marks have acquired secondary meaning among the relevant consumer groups. Specifically, the Tribe's government has functioned under its name, and used that name

³ Although the Tribe's "Red Hawk Casino" mark is strongly associated in the mind of the public with the Tribe's Casino (Ward Dec. ¶¶ 2-6, Exs. A-D.), a showing of secondary meaning of that registered mark is not necessary, as it is inherently distinctive. (*See* section IV.D.2 *infra*.) *See Zobmondo Entertainment, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113-14 (9th Cir. 2010).

1 in its dealings with the United States, for over thirty years. (*See* 45 Fed. Reg. 27828, 27830
 2 (April 24, 1980); 77 Fed. Reg. 47868, 47871 (Aug. 10, 2012)). The Tribe has used and
 3 advertised its Tribal Marks extensively in connection with governmental services it provides on
 4 behalf of its members and educational services it provides to the public. (Fonseca Dec. ¶¶ 3-4,
 5 7, Exs. A-C, I; Whitehurst Dec. ¶¶ 2-5, Exs. A-D.) The state, local governments, and public
 6 associate the Tribe's government operations with its Tribal Marks. (Fonseca Dec. ¶ 6-7, Exs. A-
 7 G, I; Barker Dec. ¶ 20, Exs. V-Z.) In fact, as Caballero's own counterclaims admitted, through
 8 "systematic" use and advertising, "the Bureau of Indians [sic] Affairs, The County of El Dorado,
 9 The State of California, Local Agency Formation Commission, El Dorado Irrigation, investors
 10 or bond holders and the public" have come to associate the Tribe's governmental operations
 11 with the Tribe's federally recognized name. (Doc. 11, Cross-Complaint, ¶¶ 16-17, 22, 83-84.)

12 The Tribe's use was exclusive for decades until Caballero just recently began to use the
 13 marks. (Fonseca Dec. ¶ 7, Ex. H; RFJN, Exs. 1-13; Barker Dec. ¶ 3, 20(c), Ex. C at 3:5-8, Ex.
 14 X.) Indeed, the Court specifically found that, although the Tribe used its name "for over 30
 15 years," "[i]t is of no coincidence . . . that Mr. Caballero was nowhere to be found until [the
 16 Tribe's] casino was built, and suddenly he declared himself to be the true owner of the name
 17 [and] the head of this tribe." (Barker Dec. ¶ 18, Ex. T at 13:14-19.) Moreover, Caballero
 18 himself attempted to register "Shingle Springs Band of Miwok Indians," asserting under penalty
 19 of perjury that the mark "has become distinctive" as a mark for "[a]ssociation services, namely,
 20 organizing chapters of a fraternity and promoting the interests of the members thereof" and
 21 providing "[i]nformation in the field of government affairs." (Barker Dec. ¶ 6, Ex. F at 2, 4.)

22 **b) Caballero's Copying Is An Independent Basis Supporting**
 23 **A Finding Of Secondary Meaning.**

24 In fact, "[p]roof of exact copying, without any opposing proof, can be sufficient to
 25 establish a secondary meaning." *Committee for Idaho's High Desert*, 92 F.3d at 823. The
 26 rationale is that "[t]here is no logical reason for the precise copying save an attempt to realize
 27 upon a secondary meaning that is in existence." *Transgo, Inc. v. Ajac Transmission Parts Corp.*,
 28 768 F.2d 1001, 1016 (9th Cir. 1985). Here, Caballero intentionally adopted marks identical to

the Tribe's. (*See, e.g.*, Fonseca Dec. ¶ 7, Ex. I; Barker Dec. ¶¶ 2-4, 19, Ex. A at 214:5-215:14, 218:7-20, Ex. C at 3:5-8, Ex. D, Ex. U at 8; Chavez Dec. ¶ 4, Ex. A.)

Indeed, as the Court has recognized, Caballero's campaign of infringement coincided with an explosion of the fame of the Tribe's marks due to publicity from the Tribe's well-publicized gaming venture. (Fonseca Dec. ¶¶ 6-7, Exs. D, H; Barker Dec. ¶¶ 3, 18, 20(b) and 20(c), Ex. C at 3:5-8, Ex. T at 13:14-19; Exs. W-X.) Caballero sought to usurp the value of the Tribe's marks out of an expressed belief that the Tribe should not have been recognized by the United States and thus should not have the right to operate a casino. (Doc. 11, Cross-Complaint, ¶¶ 50-52, 71-72.) That Caballero admittedly adopted the Tribe's exact marks is sufficient by itself, apart from the direct evidence of acquired distinctiveness, to establish secondary meaning. *Committee for Idaho's High Desert*, 92 F.3d at 823.

4. Likelihood of Confusion

The Ninth Circuit uses an eight factor test for determining the likelihood of confusion caused by infringement, as enunciated in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979): "(1) strength of the plaintiff's mark/name; (2) proximity of the parties' goods; (3) similarity of the marks/names; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant's intent in selecting the mark/name; and (8) likelihood of expansion of product lines." *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1534 (9th Cir. 1989) (citing *Sleekcraft*, 599 F.2d at 348-49). This list not a rigid set of requirements, but "a non-exclusive series of factors that are helpful in making the ultimate factual determination." *Eclipse Assoc., Ltd. v. Data General Corp.*, 894 F.2d 1114, 1118 (9th Cir. 1990). Any doubts about likelihood of confusion are resolved in favor of the party who first used the mark. *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1404 n.14 (9th Cir. 1997). Each of the relevant factors demonstrates a likelihood of confusion.⁴

⁴ The "likelihood of expansion" of the parties' use is not relevant here, as Caballero already uses of the marks in connection with the same services as the Tribe. *See* section IV.B.4.b *infra*; *see also Sleekcraft*, 599 F.2d at 354.

a) Strength Of The Tribe's Marks

The Tribe's Tribal Marks have become well known and synonymous with the Tribe's government operations and related services in El Dorado County and beyond. (Fonseca Dec. ¶¶ 2-6, Exs. A-G; Barker Dec. ¶¶ 20(b)-20(c), Exs. W-X.) Indeed, according to Caballero's Cross-Complaint, it appears to be the very value of the Tribe's identity—its goodwill, undeserved in Caballero's eyes, forged through relationships with the federal, state and local governments—that led Caballero to copy the Tribe's names and use its reputation for his own ends. (*See* Doc. 11, Cross-Complaint, ¶¶ 16-17, 22, 83-85.)

The strength of a mark is further amplified by the mark’s “extensive advertising, length of time in business, public recognition and uniqueness.” *Guess?, Inc. v. Tres Hermanos*, 993 F. Supp. 1277, 1280 (C.D. Cal. 1997). Here, the Tribe’s government has functioned under the Tribal Marks, and been associated with such marks by the United States, for over 30 years. 45 Fed. Reg. 27828, 27830 (April 24, 1980); 77 Fed. Reg. 47868, 47871 (Aug. 10, 2012). In granting the Tribe’s motion to dismiss Caballero’s counterclaims, this Court has already recognized the significance of the Tribe’s federal registration in establishing the respective rights of the Tribe and Caballero, holding that “a federally-recognized Indian tribe cannot be enjoined from using its own federally-recognized name” and that a federal court cannot entertain a collateral challenge to such a federal designation. (Doc. 33 at 2:10-15, 2:23-24.) As Caballero admits, the State of California and local governments also associate the Tribe and its operations with its Tribal Marks. (Doc. 11, Cross-Complaint, ¶¶ 16-17, 22, 83-84; Fonseca Dec., ¶¶ 2-3, 6, Exs. B, D-G; Barker Dec. ¶ 20(e), Ex. Z.) Through media coverage and the Tribe’s advertising and web presence, the public also associates the Tribe with its Tribal Marks, a fact Caballero admits. (Fonseca Dec. ¶¶ 4, 6, Exs. C and D; Whitehurst Dec. ¶¶ 2-5, Exs. A-D; Doc. 11 at ¶¶ 16-17, 22, 83-84; Barker Dec. ¶ 19, Ex. U at 6.) The Tribe’s extensive advertising and marketing have likewise made the “Red Hawk Casino” mark famous. (Ward Dec. ¶¶ 2-6, Exs. A-D.) The strength of the Tribe’s long-held marks confirms Caballero’s infringement is likely to confuse.

b) Proximity Of The Parties' Goods

“Related goods are more likely to cause confusion than unrelated goods, and therefore the Ninth Circuit has held that a diminished standard of similarity is applied when comparing the marks of closely related goods.” *Guess?, Inc.*, 993 F. Supp. at 1280; *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1392 (9th Cir. 1993). Here, Caballero has purported to operate a tribal government and act as a “Tribal Historian” under the marks. (Barker Dec. ¶ 2, Ex. A at 214:5-215:14, 343:20-345:16, 617:16-618:3, Ex. B at 4:13-18, B-014, Ex. C at 4:15-17, Ex. H; Chavez Dec. ¶¶ 4, 7, Exs. A-B.) The Tribe uses the Tribal Marks in connection with virtually identical services: operating a Tribal government and educating the public about the Tribe’s culture, government, and history. (Whitehurst Dec. ¶¶ 2-5, Exs. A-D.) Although Caballero does not operate a casino under the “Red Hawk Casino” mark, he has used the mark to create confusion about the Tribe’s history and the legitimacy of its right to operate its Red Hawk Casino gambling facility, which is not separately incorporated, but wholly owned by the Tribe. (Barker Dec. ¶¶ 2, 12, Ex. A at 528:2-534:2, Ex. L; Fonseca Dec. ¶ 6.) Indeed, Caballero’s very purpose is apparently to defraud the public—and government officials—into believing that, despite his complete lack of federal recognition or tribal status, he is the chief of the actual Indian tribal entity recognized as the “Shingle Springs Band of Miwok Indians, Shingle Springs Rancheria.” (Doc. 11, Cross-Complaint, ¶¶ 50-52, 71-72; *see* 77 Fed. Reg. 47868, 47871 (Aug. 10, 2012).)

c) Similarity Of The Marks And Caballero's Intent

The related inquiries into the similarity of the marks and Caballero’s intent in selecting the Tribe’s marks both support a finding of likelihood of confusion. *See Sleekcraft*, 599 F.2d at 354. The greater the similarity between the senior mark and the infringing mark, the greater the likelihood of confusion. *Electropix v. Liberty Livewire Corp.*, 178 F. Supp. 2d 1125, 1131 (C.D. Cal. 2001). “Similarity is determined by the appearance, sound and meaning of the marks when considered in their entirety and as they appear in the marketplace.” *Id.* “The similarities of the marks are weighed more heavily than the differences.” *Id.* at 1131-32 (use of the marks “Livewire Studios,” “Livewire Media,” and “Livewire Network Services” infringed the mark

1 “Live Wire” and were preliminarily enjoined); *Golden Door, Inc. v. Odisho*, 646 F.2d 347, 350
 2 (9th Cir. 1980) (“Defendant’s attempt to distinguish the names on the grounds that he used the
 3 terms ‘Golden Door Coiffeur’ and ‘Golden Door for Hair’ is unpersuasive.”). If product type is
 4 identical, less similarity in the marks is necessary. *Guess?, Inc.*, 993 F. Supp. at 1281, 1283.

5 Here, Caballero used marks identical to the Tribe’s in connection with offering
 6 association services and historian services. (Barker Dec. ¶¶ 2-4, 8, Ex. A at 214:5-215:14, Ex. B
 7 at 4:13-18, B-014, Ex. C at 4:15-17, Ex. D, Ex. H; Chavez Dec. ¶¶ 4, 7, Ex. A, B.) *See* section
 8 IV.B.3.b *supra*. The Tribe offers identical services. (Whitehurst Dec. ¶¶ 2-5, Exs. A-D.)
 9 Indeed, the entire theory behind Caballero’s failed counterclaims is that he and his purported
 10 “tribe” intentionally adopted the Tribe’s identity because, Caballero contends, the Tribe should
 11 not have been recognized by the United States and permitted to operate a casino. (Doc. 11,
 12 ¶¶ 50-52, 71-72.) “When the alleged infringer knowingly adopts a mark similar to another’s,
 13 reviewing courts presume that the defendant can accomplish his purpose: that is, that the public
 14 will be deceived.” *Sleekcraft*, 599 F.2d at 354. “In effect, such a finding shifts the burden to the
 15 defendant to show that his efforts have proven unsuccessful.” *HMH Pub. Co., Inc. v. Brincat*,
 16 504 F.2d 713, 720 (9th Cir. 1974). Having intentionally adopted the Tribe’s senior marks,
 17 including the names it has used with the imprimatur of the United States for decades, the burden
 18 is on Caballero to show that his use is not likely to deceive the public. As the record shows,
 19 Caballero’s use of the Tribe’s name has already deceived the public, the United States’
 20 government, and other entities.

21 In addition to using the Tribe’s exact marks, Caballero has also used confusingly similar
 22 marks involving slight variations on the Tribe’s marks. Caballero’s use of the confusingly
 23 similar term “Shingle Springs Miwok Tribe” on a fraudulent mail hold form, and in conjunction
 24 with tribal and business enterprises, also infringes the Tribe’s Mark and gives rise to a
 25 presumption of confusion. (Chavez Dec. ¶ 7, Ex. B (*see* “EXHIBIT K” therein); Barker Dec.
 26 ¶¶ 2, 7, 14, Ex. A at 339:8-343:12, 611:5-612:3, 613:5-614:2, 619:5-7, Ex. G at 5, Ex. N at I-15,
 27 I-18.) That term shares three of the major terms with the Tribe’s Mark, and substitutes “Tribe,”
 28 a generic term referring to a group of Indians, in the place of the synonymous phrase “Band of

1 . . . Indians.” *See Electropix*, 178 F. Supp. 2d at 1131-32; *Golden Door, Inc.*, 646 F.2d at 350.
 2 In any event, Caballero left no doubt as to his intent to deceive the USPS, by listing the address
 3 of the Tribe’s government as his own. (Fonseca Dec. ¶ 8, Ex. J; Chavez Dec. ¶ 4, Ex. A.)

4 Caballero’s use of “Shingle Springs Miwok Chief” similarly replaces “Band of . . .
 5 Indians” with a generic name for an Indian leader. (Barker Dec. ¶ 2, 10, Ex. A at 453:18-
 6 454:17, 603:13-603:16, Ex. J.) *See Electropix*, 178 F. Supp. 2d at 1131-32. Caballero’s use of
 7 “Shingle Springs Reservation” and “Shingle Springs Indian Reservation” is likely to cause
 8 confusion with the Tribe’s “Shingle Springs Rancheria” marks because Caballero’s fraudulent
 9 terms simply replace the word “Rancheria” with generic terms for Indian land. (Barker Dec.
 10 ¶¶ 2, 8, 11, Ex. A at 351:9-23, 455:10-12, 465:11-466:2, Ex. B at 4:13-18, B-014, Ex. C at 4:15-
 11 17, Ex. H, Ex. K at K-004 - K-008; *see* Barker Dec. ¶ 2, Ex. A at 434:1-12 (“Rancheria” and
 12 “Reservation” are “used interchangeably”).)

13 It is beyond dispute that Caballero has used the Tribe’s exact marks, and confusingly
 14 similar terms, with the intent to deceive others into concluding he is affiliated with the Tribe.

15 **d) Evidence Of Actual Confusion**

16 Although evidence of actual confusion is not necessary for the Tribe to prevail,
 17 “[e]vidence that use of the two marks has already led to confusion is persuasive proof that future
 18 confusion is likely.” *Sleekcraft*, 599 F.2d at 352. Here, Caballero previously convinced El
 19 Dorado County officials to lodge a fictitious business statement under the Tribe’s name and to
 20 issue him a business license under that name. (Fonseca Dec. ¶ 7, Ex. H; Barker Dec. ¶¶ 3, 17,
 21 Ex. C at 3:5-8, 3:19-21, Ex. S.) Additionally, Caballero’s deception caused a reporter for the
 22 *Lake County News* to report erroneously that Caballero was a guest speaker “of the Shingle
 23 Springs Band of Miwok” at a rally regarding tribal corruption. (Barker Dec. ¶ 2, 22-23, Ex. A at
 24 365:3-369:15, 375:15-376:6, Ex. C at 4:7-11, Exs. BB and CC.)

25 Caballero successfully convinced the USPS to divert the Tribe’s mail to himself by
 26 impersonating the Tribe and submitting a phony change of address and mail hold forms under
 27 the names “Shingle Springs Band of Miwok Indians,” “Shingle Springs Rancheria,” and
 28 “Shingle Springs Miwok Tribe.” (Fonseca Dec. ¶ 8, Ex. J; Chavez Dec. ¶¶ 3-4, 6-7, Ex. A, Ex. B

(see “EXHIBIT K” therein); Barker Dec. ¶ 19, Ex. U at 10.) Additionally, the Internal Revenue Service issued an Employer Identification Number in the Tribe’s name that Caballero displayed to a USPS employee to mislead her into diverting the Tribe’s mail. (Doc. 94-1, ¶ 4, Ex. B; Doc. 196-1.) Caballero also nearly derailed the Tribe’s efforts to repatriate affiliated human remains from UC Berkeley’s Museum, by leading Museum staff to believe that he was the “chief” of the Tribe (at least until Museum staff became aware of this litigation). (Declaration of Anthony Garcia (“Garcia Dec.”) ¶¶ 3-6, 8.)

Caballero’s 2008 fraudulent fictitious business statement filing created an inaccuracy in the databases of Experian, one of the three major credit reporting agencies. (Declaration of Brian Poteraj (“Poteraj Dec.”) ¶ 3.) Specifically, Caballero’s fraudulent filing caused actual confusion, resulting in Experian reporting to third parties, until August 2012, when the Tribe discovered and corrected the misstatement that Caballero was the “Owner” of the “Shingle Springs Band of Miwok Indians.” (*Id.*, ¶¶ 2-4, Ex. A at 4.) Caballero’s success in defrauding government officials and the public into believing that he is affiliated with, or acts on behalf of, the Tribe is “persuasive proof that future confusion is likely.” *Sleekcraft*, 599 F.2d at 352.

e) Marketing Channels Used

Convergent marketing channels, including similarity in advertising, increase the likelihood of confusion. *Nutri/System, Inc. v. Con-Stan Industries, Inc.*, 809 F.2d 601, 606 (9th Cir. 1987). “[T]he Web, as a marketing channel, is particularly susceptible to a likelihood of confusion since, as it did in this case, it allows for competing marks to be encountered at the same time, on the same screen.” *Perfumebay.com Inc. v. eBay Inc.*, 506 F.3d 1165, 1174 (9th Cir. 2007) (considering common use of the Internet as a marketing channel in upholding injunction against use of “Perfumebay” as infringing “eBay”).

Here, Caballero has used various website and web platforms to fraudulently offer services as a “Tribal Historian” and entertain “Enrollment Questions,” and to otherwise falsely assert his affiliation with the Tribe. (Barker Dec. ¶¶ 3, 8, Ex. B at B-005:13-18, B-014, Ex. C at 4:15-17, Ex. H.) Similarly, the Tribe’s website provides information about the services provided by the Tribe’s government, as well as information about the Tribal community’s history,

government and society. (Whitehurst Dec. ¶¶ 2, 4-5, Exs. A, C-D.) The common use of the Internet as a marketing channel enhances the likelihood of confusion, and in turn, reinforces the likelihood of the Tribe prevailing on its trademark claims.

Caballero has also used the U.S. Mail and the El Dorado County Recorder's office to perpetrate his fraudulent theft of the Tribe's identity. (Fonseca Dec. ¶¶ 7-8, Exs. H and J; Chavez Dec. ¶¶ 3-4, 6-7, Ex. A, Ex. B (see "EXHIBIT K" therein); Barker Dec. ¶¶ 3, 17, 19, Ex. C at 3:5-8, 3:19-21, Ex. S, Ex. U at 10.) The Tribe's government has likewise used the U.S. Mail and the El Dorado County Recorder's office as part of its legitimate government operations using its marks. (Fonseca Dec. ¶¶ 7, 9, Exs. I and J.)

f) Likely Degree of Purchaser Care

Where the defendant offers his product or services for free, confusion is likely as consumers are not likely to exercise a high degree of care. *Brookfield Commc'ns, Inc.*, 174 F.3d at 1046, 57. Here, because Caballero offers his tribal historian and association services for free, including over the Internet and in public places, consumers are unlikely to exercise care in considering the source of those services. (Barker Dec. ¶¶ 3, 8, 22-23, Ex. A at 375:15-376:6, Ex. B at B-005:13-18, B-014, Ex. C at 3:27-4:3, 4:15-17, Exs. H, BB, CC).

As no genuine issue exists that each relevant factor shows a likelihood of confusion, the Tribe is entitled to summary judgment on its infringement and unfair competition claims.

C. The Tribe Is Entitled To Summary Judgment On Its Declaratory Claim.

Establishment of the elements of infringement and unfair competition also supports a declaratory judgment for the Tribe, as Caballero admits an actual controversy between he and the Tribe supports declaratory relief. (Doc. 222 at 8:13-14.) *See* 28 U.S.C. § 2201.

D. The Tribe Is Entitled To Summary Judgment On Its ACPA Claims.

A person is liable under the Anticybersquatting Consumer Protection Act ("ACPA") to the owner of a protected mark if he (1) registers, traffics in, or uses a domain name that is identical or confusingly similar to the mark, (2) the mark is distinctive at the time of registration of the domain name, and (3) he acts with a bad faith intent to profit from that mark. *See* 15 U.S.C. § 1125(d)(1)(A).

1. Caballero's Illegal Domain Names Incorporate And Are Identical Or Confusingly Similar To The Tribe's Marks.

"A domain name typically consists of a top level domain extension, such as .com, .org, or .net, and a second level domain name, such as pepsi in pepsi.com." *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 783 (8th Cir. 2004). Courts properly ignore the top-level domain extension (e.g., the .com, .org, or .net) in evaluating whether a domain is confusingly similar to a mark under the ACPA. *Id.* at 783-84; *GoPets Ltd. v. Hise*, 657 F.3d 1024, 1032 (9th Cir. 2011) (holding domains similar to "GoPets" mark, including "gopet.org," "gopet.tv," and "egopets.com" violated ACPA). "[S]light differences between domain names and registered marks, such as the addition of minor or generic words to the disputed domain names are irrelevant" under the ACPA. *DaimlerChrysler v. The Net Inc.*, 388 F.3d 201, 206 (6th Cir. 2004) ("foradodge.com" confusingly similar to "Dodge") (citations omitted); *Coca-Cola Co.*, 382 F.3d at 784.

Caballero has admitted he "has registered several URLs that contain configurations of the disputed name, including: <shinglespringsmiwoktribe.com>, <shinglespringsreservation.com>, <shinglespringsreservation.org>, <shinglespringsrancheria.org>, <shinglespringsmiwoktribe.org>, <shinglespringsindianreservation.com>, <redhawkcasino.info>, <redhawkcasino.net> and <redhawkcasino.org>." (Barker Dec. ¶ 19, Ex. U at 8; *see also* Doc. 103 at 4:3-5 (admitting involvement in registration of six of the above domains); Doc. 88 at 5:4-7 (listing six admitted domains); Barker Dec. ¶ 2, Ex A at 235:17-237:5.) Indeed, Caballero listed his own name, as well as the address he provided the Court in this action, as the contact information for all but one of these domains, as well as three additional domains: <shinglespringsreservation.info>, <shinglespringsreservation.biz>, and <shinglespringsmiwoktribe.info>. (Barker Dec. ¶¶ 2, 11, Ex. A at 495:12-22, Ex. K; *see* Doc. 222 at 1:1-2.)

Caballero's domains containing "RedHawkCasino" are identical to the Tribe's registered "Red Hawk Casino" mark, simply adding a top-level domain extension ".org," ".info," and ".net." (Barker Dec. ¶¶ 5, 27, Exs. E and GG.) "ShingleSpringsRancheria.org" is likewise exact mark the Tribe owns (*see* section IV.B.1 *supra*), plus the extension ".org." (Barker Dec. ¶ 11,

Ex. K at K-003.) The “ShingleSpringsReservation” and “ShingleSpringsIndianReservation” domains simply replace the word “Rancheria” with generic terms for Indian land. (Barker Dec. ¶ 11, Ex. K at K-004 - K-008.) *See Golden Door, Inc.*, 646 F.2d at 350; *Electropix*, 178 F. Supp. 2d at 1131-32. By the same token, the “ShingleSpringsMiwokTribe” domains are confusingly similar because they share three of the major terms of the Tribe’s mark, and simply substitute the word “Tribe,” a generic term referring to a group of Indians, in the place of “Band of . . . Indians.” (Barker Dec. ¶ 11, Ex. K at K-001, K-002, K-009.) Indeed, Caballero’s intentional adoption of domains similar to the Tribe’s marks (*see* section IV.B.3.b *supra*) creates a presumption that Internet users are likely to be confused. *Coca-Cola Co.*, 382 F.3d at 784; *see Sleekcraft*, 599 F.2d at 354.

2. The Tribe’s Federally Registered Marks Were Distinctive When Caballero Registered His Illegal Domain Names.

The “distinctiveness” inquiry under the ACPA is identical to that for trademark infringement claims, and is satisfied by a showing that the mark has secondary meaning. 15 U.S.C. § 1125(d)(1)(A)(ii); *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1197 (9th Cir. 2009). As set forth above, the Tribe’s Tribal Marks have had secondary meaning since long before Caballero’s opportunistic infringement. *See* sections IV.B.2 and IV.B.3.a *supra*.

The Tribe’s “Red Hawk Casino” mark, which the Patent and Trademark Office registered without requiring any showing of secondary meaning, is presumed inherently distinctive. (Barker Dec. ¶ 27, Ex. GG.) *See Zobmondo Entertainment, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113-14 (9th Cir. 2010). Indeed, Caballero sought to register domains infringing the Tribe’s “Red Hawk Casino” mark precisely because it was, and is, a distinctive mark for the Tribe’s gaming operations. *See* section IV.B.3.b *supra*.

3. Caballero Registered These Illegal Domain Names With A Bad-Faith Intent To Profit From Them.

The ACPA lists nine non-exclusive factors that “a court may consider” when determining whether a person has acted with a bad faith intent to profit. 15 U.S.C. § 1125(d)(1)(B)(i)(I)-(IX). Each factor demonstrates bad faith intent to profit here.

Caballero registered domain names infringing the Tribe's well-known marks in bad faith as part of an ill-conceived scheme to profit from the Tribe's goodwill and federally recognized status: He purported to declare himself "Chief" of an entity he named "Shingle Springs Band of Miwok Indians," which he believed could usurp the Tribe's federal benefits and casino revenue.

a) Factors I-IV Demonstrate Bad Faith Intent to Profit

As shown above (*see* section IV.B *supra*), Caballero, having copied marks the Tribe owns, has no trademark or other intellectual property rights in the domain names at issue. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(I). Of course, none of the domain names consists of a legal name or nickname by which Caballero, a natural person, is known. (Doc. 222 at 1:1.) *See* 15 U.S.C. § 1125(d)(1)(B)(i)(II).

Caballero has not used any of the illegal domains in connection with the bona fide offering of any goods or services or for bona fide noncommercial or fair use of the Tribe's marks. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(III), (IV). Rather, learning of the Tribe's plans to open a gaming facility on its reservation, Caballero has used the domains as part of his campaign of infringement of the Tribe's trademarks in an attempt to usurp the benefits of the Tribe's federally recognized status. (*See* Doc. 11, Cross-Complaint, at 27:24-27 (counterclaim seeking payment of "all gains, profits, and advantages derived by Casino Indians," *i.e.*, the Tribe, from their "economic relations with the United States of America").) While all of the domains are currently unoccupied (Barker Dec. ¶ 30), when Caballero has used them, they have been used purely for artifice and fraud, never for bona fide commercial or noncommercial purposes. Specifically, Caballero has used the domains to fraudulently purport to act as the "Tribal Historian" to solicit "Enrollment Questions" regarding the "Shingle Springs Band of Miwok Indians." (Barker Dec. ¶¶ 3-4, Ex. B at 4:13-18, B-014, Ex. C at 4:15-17, Ex. D.) At other times Caballero's websites at the domains have fraudulently displayed logos, names, and URLs infringing the Tribe's marks and purporting to speak on behalf of the Tribe. (Barker Dec. ¶¶ 2, 8, 12, Ex. A at 351:9-23, Exs. H and L.) And of course, the mere fact that Caballero has exclusive registration of domain names that contain the Tribe's marks means the Tribe itself cannot use them.

b) Factor V: Caballero's Intent To Divert And Deceive

Caballero intended to divert visitors from the Tribe's websites to his own for financial gain and with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(V). Caballero's domain names, by co-opting the Tribe's marks, were calculated to identify the material he placed on his websites as belonging to the Tribe or its Casino. Indeed, Caballero admitted his desire to propagate his view of the history of the Shingle Springs Band of Miwok Indians to people seeking to contact the Tribe so that they would not be, in his words, "duped or tricked" by information from the Tribe. (Barker Dec. ¶¶ 2, 12, Ex. A at 528:2-534:2, 536:5-537:18, Ex. L.) *See Coca-Cola Co.*, 382 F.3d at 786 (holding defendant's intent "to divert Internet users to websites . . . implying that their owners have taken positions on a hotly contested issue" demonstrated bad faith intent to profit). Caballero's use of the Tribe's marks as his domain name directly created confusion concerning the course, sponsorship, affiliation, and endorsement of the sites he has placed there. (Barker Dec. ¶¶ 2-4, 8, Ex. A at 351:9-23, Ex. B at 4:13-18, B-014, Ex. C at 4:15-17, Ex. H.)

Caballero admitted that his infringing Internet activity caused website visitors, including those trying to reach the Tribe, to contact him about his services. (Barker Dec. ¶¶ 2, 6, 9, Ex. A at 275:4-276:20, 357:4-359:7, Ex. F, at F-011, Ex. I.) Caballero's intent in perpetrating the scheme was to create confusion as to whether the Tribe or Caballero's entity is the federally recognized "Shingle Springs Band of Miwok Indians," thereby furthering Caballero's quixotic quest to reap "all gains, profits, and advantages" he perceives to be associated with the Tribe's status. (*See* Doc. 11 at 27:24-27.)

c) Factor VI: Caballero's Intent To Profit

Caballero sought to profit from his illegal domains. 15 U.S.C. § 1125(d)(1)(B)(i)(VI). This factor is satisfied because Caballero registered and used the domains in "an attempt to procure an advantageous gain or return." *DSPT Int'l, Inc. v. Nahum*, 624 F.3d 1213, 1220-21 (9th Cir. 2010). Caballero tried not only to profit by diverting traffic to perpetuate his fraudulent attempt to usurp the Tribe's identity and the benefits of its federal recognition (Doc. 11 at 27:24-

27), but he also has expressly endorsed using multiple domains as bargaining chips to leverage the Tribe into relinquishing its federally recognized name to Caballero's group. (Barker Dec. ¶ 2, Ex. A at 522:24-523:17.) See *DSPT Int'l, Inc.*, 624 F.3d at 1219-21 (defendant violated ACPA by using domains as "leverage" in underlying dispute, regardless of whether his position in the underlying dispute had merit).

d) Factor VII: Caballero's False Contact Information

Caballero has provided material and misleading false contact information when applying for the registration of his illegal domains and has failed to maintain accurate contact information. 15 U.S.C. § 1125(d)(1)(B)(i)(VII). All but one of the illegal domain registrations lists a false telephone number for "Cesar Caballero": a number that Caballero claims was at one time—but that he admits is no longer—"an office number" for his "tribe." (Barker Dec. ¶¶ 2, 11, Ex. A at 360:25-361:18, Ex. K.) Each of these registrations lists Cesar Caballero's address as "6368 Pleasant Valley Rd.," even though Caballero has since denied it is his address, contending it is the mailing address of his "tribe," and then testifying he does not know who lives there. (Barker Dec. ¶¶ 2, 6, 11, Ex. A at 593:16-594:1, 594:15-595:9, 756:14-21, Exs. E and K.) The remaining registration, for <shinglespringsmiwoktribe.org>, bears no specific mailing or street address at all, simply listing the contact address as "Shingle Springs Miwok Tribe, Shingle Springs Indian Reservation," and thereby falsely suggesting the Tribe is affiliated with the registration. (Barker Dec. ¶ 11, Ex. K at K-009.)

e) Factor VIII: Caballero's Pattern Of False Registration

Caballero's pattern of registering of multiple domain names that are identical or confusingly similar to the Tribe's marks is "highly relevant" to determining whether he acted with a "bad faith intent to profit." *N. Light Tech., Inc. v. N. Lights Club*, 236 F.3d 57, 64-65 (1st Cir. 2001); see 15 U.S.C. § 1125(d)(1)(B)(i)(VIII). Not only did Caballero register the 12 domain names at issue infringing the Tribe's marks, but in November 2007, when the Tribe's then-proposed casino project was named "Foothill Oaks Casino," he also registered the slightly misspelled domain "FoothillsOakCasino.com." (Barker Dec. ¶ 2, Ex. A at 539:4-541:1.) See *Shields v. Zuccarini*, 254 F.3d 476, 483-84 (3d Cir. 2001).

f) Factor IX: The Tribe's Strong Marks

As discussed above (see sections IV.B.3 and IV.B.4.a supra), the Tribe's marks are highly distinctive. *See* 15 U.S.C. § 1125(d)(1)(B)(i)(IX). Indeed, it is precisely the strength of the Tribe's marks, and the Tribe's extensive goodwill, that led Caballero to seek to steal the Tribe's identity. (Barker Dec. Ex A at 236:23-237:5; Doc. 11, ¶¶ 16-17, 22, 83-84.)

Because there is no genuine dispute that each of the statutory factors demonstrates Caballero had a bad faith intent to profit from registration and use of the illegal domains, summary judgment for the Tribe, and an order transferring the domains to the Tribe, is appropriate.

E. Permanent Injunctive Relief In Favor Of The Tribe Is Appropriate.

This Court has already enjoined Caballero from infringing the Tribal Marks, finding that all requirements for a preliminary injunction were met. (Barker Dec. ¶ 17, Ex. T at 15:1-5.) The Ninth Circuit affirmed. (Doc. 122.) "The standard for a preliminary injunction is essentially the same as for a permanent injunction with the exception that the plaintiff must show a likelihood of success on the merits rather than actual success." *Amoco Prod. Co. v. Gambell*, 480 U.S. 531, 546 n.12 (1987). In deference to the Court's ruling on its page-limits application (Doc. 233), the Tribe incorporates by reference its preliminary injunction papers (*see, e.g.*, Doc. 90-1 at 13:12-17:20), which, along with the record on this Motion, demonstrate:

(1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction"

N. Cheyenne Tribe v. Norton, 503 F.3d 836, 843 (9th Cir. Mont. 2007). *See* Undisputed Material Facts Nos. 71-77. Indeed, "in 'ordinary trademark infringement actions . . . complete injunctions against the infringing party are the order of the day.'" *Angel Flight of Ga., Inc. v. Angel Flight Am., Inc.*, 522 F.3d 1200, 1209 (11th Cir. 2008) (citation omitted).

Caballero's conduct since the Court issued the preliminary injunction only confirms the need for permanent injunctive relief. (*See* Docs. 126, 129, 140, 147, 161, 162, 165, 173, 175, 189.) As such, there is no genuine issue as to the Tribe's right to a permanent injunction.

F. The Tribe Conditionally Requests Dismissal Of Remaining Claims.

The Tribe is primarily interested in permanent prospective protection for its marks. To that end, if the Court grants the requested permanent injunction, the Tribe moves for an order (1) dismissing the Tribe's remaining claims, including all claims for compensatory and punitive damages, without prejudice, and (2) preserving the Tribe's right to reassert those claims within thirty-six months after entry of judgment (relating back to the date of the original complaint) if Caballero appeals the judgment or fails to comply with the Court's injunction. Fed. R. Civ. P. 41(a)(2); *Faegre & Benson, LLP v. Purdy*, 447 F. Supp. 2d 1008, 1020, 1022 (D. Minn. 2006).

V. CONCLUSION

There is no question the law protects the Tribe's valuable marks, and the goodwill it has achieved through decades of building its brand and forging relationships with the public and other governments. Misguided as it is, Caballero's unlawful campaign against the Tribe has taken its toll. Accordingly, it is time to put this case to rest, and having demonstrated its entitlement to judgment, the Tribe respectfully asks that the Court grant this motion, enter a permanent injunction, and put an end to Caballero's destructive actions once and for all.

Respectfully submitted,

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