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UNITED STATES DISTRICT COURT

DISTRICT OF OREGON

PORTLAND DIVISION

ADIDAS AMERICA, INC., an Oregon corporation; and **ADIDAS AG**, a foreign entity,

Plaintiffs,

v.

HALL OF FAME SPORTS MEMORABILIA, Inc., a Delaware corporation,

Defendant.

Case No. 3:24-cv-02120 AR

**DEFENDANT’S MOTION TO DISMISS
AMENDED COMPLAINT FOR
FAILURE TO STATE A CLAIM UPON
WHICH RELIEF CAN BE GRANTED,
AND MEMORANDUM IN SUPPORT**

ORAL ARGUMENT REQUESTED

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

TABLE OF CONTENTS

LR 7.1(a) CERTIFICATION.....	1
MOTION TO DISMISS	1
MEMORANDUM IN SUPPORT OF MOTION	3
I. The First Claim, Based on Alleged Infringement of Registered Marks Under 15 U.S.C. §§ 1114 and 1125, Should be Dismissed for Failure to Plead any Registered Mark That HOFSM’s Products Could Be Found to Infringe or Basis for a Claim of Infringement of a Common Law Mark.	3
II. The Counterfeiting Claim Should Be Dismissed Under Rule 12(b)(6).....	12
A. Pleading a Counterfeiting Claim Under 15 U.S.C. § 1114.....	13
B. Plaintiff’s Pleadings Demonstrate There Is No Basis for a Counterfeiting Claim.	15
1. Plaintiff Does Not Allege That HOFSM’s Jerseys Use a Registered Mark Owned by Adidas That Covers HOFSM’s Accused Products.....	15
2. The Counterfeiting Claim Should Be Dismissed for the Separate Reason that Plaintiff Has Failed to Plausibly Plead Use of a Mark That is Identical to or Substantially Indistinguishable from Any Registered Mark.....	16
III. The Trade Dress Claims (Third and Sixth Claims) Should Be Dismissed.	24
A. Trade Dress Law	24
B. Plaintiff Fails to State a Trade Dress Claim.....	26
IV. Plaintiff’s Dilution Claims Should Be Dismissed for Failure to Meet Pleading Requirements.	30
CONCLUSION.....	31

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Adidas Am., Inc. v. Aviator Nation, Inc.</i> , 2020 WL 9594397 (D. Or. Aug. 5, 2020).....	13, 15, 16, 17
<i>Adobe Sys. Inc. v. A&S Elecs., Inc.</i> , 2015 WL 13022288 (N.D. Cal. Aug. 19, 2015)	31
<i>Advanced Hair Restoration LLC v. Bosley, Inc.</i> , 2025 WL 276269 at*2 (W.D. Wash. Jan. 23, 2025).....	13, 15, 16
<i>AMF, Inc. v. Sleekcraft Boats</i> , 599 F.2d 341 (9th Cir. 1979)	10
<i>Applied Information Sciences Corp. v. eBay, Inc.</i> , 511 F.3d 966 (9th Cir. 2007)	7
<i>Arcona, Inc. v. Farmacy Beauty, LLC</i> , 2019 WL 1260625 (C.D. Cal. 2019, Mar. 19, 2019), <i>aff'd</i> , 976 F.3d 1074 (9th Cir. 2020)	14
<i>Arcsoft, Inc. v. Cyberlink Corp.</i> , 153 F. Supp. 3d 1057 (N.D. Cal. 2015)	24, 26, 28
<i>Art Attacks Ink, LLC v. MGA Entm't Inc.</i> , 581 F.3d 1138 (9th Cir. 2009)	24
<i>Associated Gen. Contractors of Am. v. Stokes</i> , 2013 WL 1155512 (E.D. Va. March 19, 2013)	15
<i>Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.</i> , 457 F.3d 1062 (9th Cir. 2006)	25
<i>Audemars Piguet Holding S.A. v. Switch Watch Int'l, Inc.</i> , 2015 WL 150756 (S.D.N.Y. Jan. 12, 2015)	14, 15, 21
<i>Autodesk, Inc. v. Dassault Sys. SolidWorks Corp.</i> , No. 08-04397, 2008 WL 6742224 (N.D. Cal. Dec. 18, 2008).....	10
<i>Barron v. Reich</i> , 13 F.3d 1370 (9th Cir. 1994)	10

DEFENDANT'S MOTION TO DISMISS AMENDED COMPLAINT

Page -ii

<i>Blumenthal Distributing, Inc. v. Herman Miller, Inc.</i> , 963 F.3d 859 (9th Cir. 2020)	25, 26, 28
<i>Bratt v. Love Stories TV, Inc.</i> , 713 F. Supp. 3d 847 (S.D. Cal. 2024).....	15, 16
<i>In re Carlton Cellars, LLC</i> , 2020 USPQ2d 10150 (TTAB 2020)	7
<i>Cohen & Company, Ltd. v. Cohen Company, Inc.</i> , 2022 WL 5250271 (E.D. Pa. Oct. 6, 2022).....	14
<i>In re Cordua Rests., Inc.</i> , 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016)	7
<i>Crafty Prods., Inc. v. Michaels Co.</i> , 424 F.Supp.3d 983 (S.D. Cal. 2019), <i>aff'd</i> <i>Crafty Prods., Inc. v. Fuqing</i> <i>Sanxing Crafts Co.</i> , 839 Fed. Appx. 95 (9th Cir. 2020)	25, 27
<i>Deckers Outdoor Corp. v. Fortune Dynamic, Inc.</i> , 2015 WL 12731929 (C.D. Cal. May 8, 2015)	25, 27
<i>EVO Brands, LLC v. Al Khalifa Grp. LLC</i> , 657 F. Supp. 3d 1312 (C.D. Cal. 2023)	10
<i>Glob. Apogee v. Sugarfina, Inc.</i> , 2018 WL 4945305 (C.D. Cal. Oct. 10, 2018).....	31
<i>GoTo.com, Inc. v. Walt Disney Co.</i> , 202 F.3d 1199 (9th Cir. 2000)	16
<i>Grapery, Inc. v. Bloom Fresh Int'l Ltd.</i> , 2024 WL 3891032 (C.D. Cal., Aug. 19, 2024).....	30, 31
<i>Green Crush LLC v. Paradise Splash I, Inc.</i> 2018 WL 4940824 (C.D. Cal., Mar. 8, 2018).....	24
<i>GTFM, Inc. v. Solid Clothing Inc.</i> , 2002 WL 1933729 (S.D.N.Y. Aug. 21, 2002).....	14
<i>Gucci America, Inc. v. Duty Free Apparel, Ltd.</i> , 286 F.Supp.2d 284 (S.D.N.Y. 2003).....	15
<i>Hsiao & Montano, Inc. v. Xstatic Pro, Inc.</i> , 2023 WL 4205811 (C.D. Cal., May 18, 2023)	15

DEFENDANT'S MOTION TO DISMISS AMENDED COMPLAINT

Page -iii

<i>Illinois Tool Works, Inc. v. J-B Weld Co., LLC</i> , 469 F.Supp.3d 4 (D. Conn. 2020)	14, 15, 17, 23
<i>In re tapio GmbH</i> , 2020 USPQ2d 11387 (TTAB 2020)	7
<i>Jada Toys, Inc. v. Mattel, Inc.</i> , 518 F.3d 628 (9th Cir. 2008)	31
<i>Ketab Corp. v. Mesriani L. Grp.</i> , 2015 WL 12655670 (C.D. Cal. Feb. 6, 2015)	31
<i>Leatherman Tool Grp., Inc. v. Cooper Indus., Inc.</i> , 199 F.3d 1009 (9th Cir. 1999)	25
<i>Levi Strauss & Co. v. Blue Bell, Inc.</i> , 778 F.2d 1352 (9th Cir. 1985)	10, 11
<i>Lontex Corp. v. Nike, Inc.</i> , 384 F. Supp. 3d 546 (E.D. Pa. 2019), <i>aff'd</i> , 107 F.4th 139 (3d Cir. 2024)	13, 14
<i>Louis Vuitton Malletier & Oakley, Inc. v. Veit</i> , 211 F. Supp. 2d 567 (E.D. Pa. 2002)	15
<i>Louis Vuitton Malletier, S.A. v. Akanoc Sols., Inc.</i> , 658 F.3d 936 (9th Cir. 2011)	13, 16
<i>Mintz v. Subaru of Am., Inc.</i> , 716 F. App'x 618 (9th Cir. 2017)	31
<i>Montres Rolex, S.A. v. Snyder</i> , 718 F.2d 524 (2d Cir. 1983)	17
<i>Panavision Int'l, L.P. v. Toeppen</i> , 141 F.3d 1316 (9th Cir. 1998)	31
<i>Pendleton Woolen Mills, Inc. v. Round Up Ass'n.</i> , 2012 WL 2721856 (D. Or. July 9, 2012)	31
<i>Pennzoil-Quaker State Co. v. Smith</i> , 2008 WL 4107159 (W.D. Pa. Sept. 2, 2008)	14
<i>Playvision Labs, Inc. v. Nintendo of Am., Inc.</i> , 2015 WL 12941892 (N.D. Cal. May 18, 2015)	17
<i>Qualitex Co. v. Jacobson Prods. Co.</i> , 514 U.S. 159, 115 S.Ct. 1300, 131 L.Ed.2d 248 (1995)	25

DEFENDANT'S MOTION TO DISMISS AMENDED COMPLAINT

Page -iv

<i>Reyn’s Pasta Bella, LLC v. Visa USA, Inc.</i> , 442 F.3d 741 (9th Cir. 2006)	10
<i>Solar Sun Rings, Inc. v. P&P Imports, LLC</i> , 2024 WL 2869332 (C.D. Cal., May 7, 2024)	24
<i>State of Idaho Potato Comm’n v. G & T Terminal Packaging, Inc.</i> , 425 F.3d 708 (9th Cir. 2005)	13
<i>Tie Tech, Inc. v. Kinedyne Corp.</i> , 296 F.3d 778 (9th Cir. 2002)	26
<i>Traffix Devices, Inc. v. Marketing Displays, Inc.</i> , 532 U.S. 23 (2001)	25
<i>Virgin Scent, Inc. v. Bel Air Naturals Care Corp.</i> , 2018 WL 5264145 (C.D. Cal., Feb. 8, 2018)	24
<i>Y.Y.G.M. SA v. Redbubble, Inc.</i> , 75 F.4th 995 (9th Cir. 2023)	15, 16

Statutes

15 U.S.C. §1051(a)(2), (b)(2)	7
15 U.S.C. § 1057(b)	7
15 U.S.C. § 1114	2, 3, 11, 12, 13
15 U.S.C. §1114(1)(a)	3, 13, 16
15 U.S.C. § 1115(a)	7
15 U.S.C. § 1125(a)	2, 11, 12, 24
15 U.S.C. § 1127	13, 15
ORS 647.107	3, 30

Other Authorities

37 C.F.R. §2.32(a)(6)	7
37 C.F.R. § 2.51	8
BLACK’S LAW DICTIONARY (11 th ed. 2019) “Spurious”	14
Fed. R. Civ. P. 8(a)(2)	2, 11

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Page -v

Federal Rule of Civil Procedure 12(b)(6)	1, 12
2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:48 (5th ed. 2019).....	7
4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25.15.10 (5th ed. 2019).....	15

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Page -vi

LR 7.1(a) CERTIFICATION

In compliance with Local Rule 7-1(a), counsel for all parties conferred by phone about the matters in this Motion on March 13 and by email on March 28, 2025, and were not able to resolve the issues raised in the Motion.

MOTION TO DISMISS

Pursuant to Federal Rule of Civil Procedure 12(b)(6), Defendant Hall of Fame Sports Memorabilia, Inc., (“HOFSM” or “Defendant”) moves to dismiss Plaintiff’s Amended Complaint with prejudice for failure to state a claim upon which relief can be granted. As reasons for this Motion, Defendant states:

1. The Amended Complaint (Doc. 27) contains six claims.¹ All six claims rest upon a false foundation that Adidas owns a “Three-Stripe Mark.” But this “Three-Stripe Mark” is undefined, because it does not exist. Instead, in its Amended Complaint, Adidas refers to twenty-one (21) different registered trademarks for “stripes,” “bands,” and even “quadrilaterals,” of different lengths, configurations, orientations, and inconsistent versions of lines, used on various products in different positions. Adidas never identifies which, if any, of these marks HOFSM is alleged to have infringed.

¹ Plaintiff’s original Complaint contained seven claims, but Adidas dropped what had been its Sixth Claim – for alleged violation of state consumer fraud statute – the day after the original Motion to Dismiss was filed (Doc. 25). This motion does not address that claim.

This motion does, however, address Plaintiff’s First Claim. HOFSM’s first motion focused primarily on the counterfeiting, dilution, and trade dress claims, but upon further review, HOFSM realized that Adidas had *not* based its First Claim on registered trademarks that might conceivably apply to HOFSM’s accused jerseys after all. As explained herein, Adidas relies solely on registered marks that do not apply to HOFSM’s type of products (soccer jerseys) and/or that HOFSM’s jerseys simply do not use.

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Page -1

2. Plaintiff titles the First Claim “federal trademark infringement” and cites 15 U.S.C. §§ 1114 and 1125(a). Plaintiff’s § 1114 claim fails because Adidas has not pleaded, and indeed does not own, any registered trademark that applies to HOFSM’s products. Twenty of the twenty-one marks pleaded apply *not* to jerseys, but instead to hats, pants, shoe boxes, shorts, track suits, jackets, and long-sleeved shirts. And the only alleged registered mark that applies to jerseys does not appear on HOFSM’s collectible jerseys. As to Plaintiff’s 15 U.S.C. § 1125(a) claim, it too is insufficiently pleaded, fails to identify what claim Plaintiff is making, and relies on the misleading notion of a singular amalgamation of numerous inconsistent marks. *See* Fed. R. Civ. P. 8(a)(2).

3. The Second claim, titled Trademark Counterfeiting, also fails. Such a claim requires a factual allegation that Adidas owns a registered mark covering the goods on which HOFSM used that mark, but no such fact is alleged and, as shown above, no such mark exists. Further, the images contained in the Amended Complaint show that HOFSM’s jerseys were not nearly close enough to Adidas’ jerseys to be considered use of a “spurious” mark. The Amended Complaint also shows that HOFSM’s jerseys were not sold claiming to be Adidas’ products – HOFSM in fact expressly disclaimed any such affiliation – and that no reasonable consumer would be deceived into believing that the HOFSM collectible jerseys were Adidas jerseys.

4. The Third and Sixth claims, which allege infringement of Adidas’ trade dress, fail to plausibly allege facts (as opposed to conclusory allegations) from which one could conclude that Adidas has adequately described or claimed non-functional and source-identifying trade dress. Nor has Adidas plausibly alleged that a reasonable consumer, looking at an HOFSM collectible jersey, would believe it was an Adidas jersey. Most of the elements Adidas alleges to comprise its trade dress are ubiquitous and/or aesthetically or even utilitarian functional, and the others do not

appear on HOFSM's accused jerseys. Therefore, there can be no likelihood of confusion and no basis for trade dress liability.

5. The Fourth and Fifth claims, for trademark dilution under federal, Oregon, and New Jersey law, fail because Plaintiff has not plausibly pleaded facts for which one could conclude that HOFSM's sales of the accused collectible jerseys have tarnished or are likely to tarnish Adidas' reputation or dilute the distinctiveness of any Adidas mark. In addition, because it is undisputed that HOFSM has ceased advertising, offering for sale, or selling the accused products and has committed to destroy any remaining accused products, the Fifth claim based on Oregon law is moot as ORS 647.107 provides only for injunctive relief.

HOFSM's memorandum, below, explains in more detail why this motion should be granted.

MEMORANDUM IN SUPPORT OF MOTION

I. The First Claim, Based on Alleged Infringement of Registered Marks Under 15 U.S.C. §§ 1114 and 1125, Should be Dismissed for Failure to Plead any Registered Mark That HOFSM's Products Could Be Found to Infringe or Basis for a Claim of Infringement of a Common Law Mark.

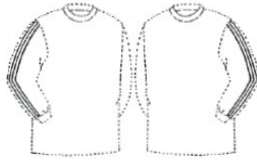
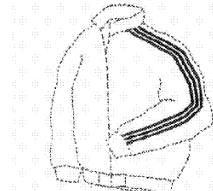
Plaintiff's First Claim is titled "Federal Trademark Infringement." (Doc. 27, pgs. 34-35). Plaintiff primarily invokes 15 U.S.C. § 1114, which provides a trademark registrant with a claim against any person who uses in commerce "any reproduction, counterfeit, copy, or colorable imitation of a registered mark" without consent. 15 U.S.C. §1114(1)(a).

The First Claim does not list the registered marks on which the claim is based, and none of the registered marks that Plaintiff identifies in its Amended Complaint covers three stripes that run the short distance between the neck collar and shoulder seam of a jersey, which is what appeared on HOFSM's accused products. In fact, of the twenty-one registered marks that Plaintiff references in its Amended Complaint, only one, Reg. No. 4,910,643, applies to "jerseys," and that mark does

DEFENDANT'S MOTION TO DISMISS AMENDED COMPLAINT

not appear on *any* of HOFSM's products. To try to overcome this pleading defect, Plaintiff asserts a general amalgamation of its registered marks containing three stripes (which are sometimes called "bands" or "quadrilaterals") that it attempts to morph into a singular "Three-Stripe Mark," regardless of whether they could plausibly apply to the accused collectible soccer jerseys.

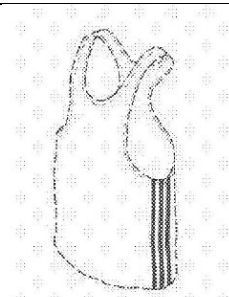
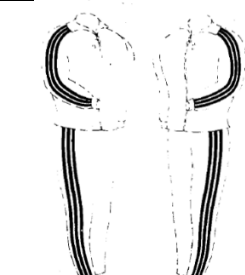
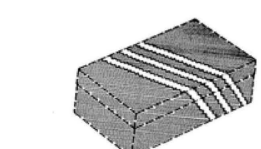
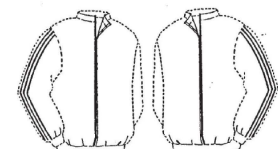
Plaintiff references in section IV. D. of its Amended Complaint the following registered marks:²

Am. Compl. Para. & Exhibit	Reg. No.	Description	Image/Drawing ³	Goods Covered	Jerseys ?
33, Ex. 4 (Doc. 27-4)	2,058,619	"Three parallel bands positioned along the length of each sleeve of a shirt"		Sports and leisure wear, namely shirts, Class 25	No
34, Ex. 5 (Doc. 27-5)	3,029,127	"Three parallel stripes running along the sleeve of a shirt, T-shirt, sweatshirt, jacket or coat"		Clothing, namely, T-shirts, sweatshirts, jackets, and coats, Class 25	No

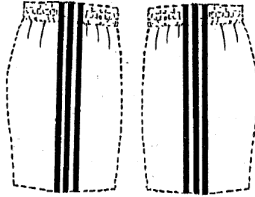
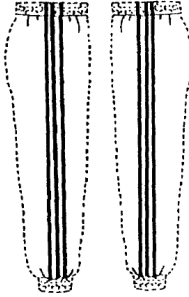
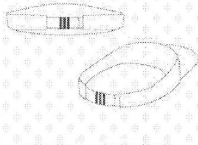
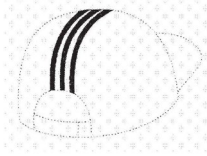
² Plaintiff also identified seven trademark registrations "covering footwear" (Am. Compl. ¶ 38) and two registrations for "word marks" (Am. Compl. ¶ 39). Because there is no allegation that the accused products are footwear or that they bear the referenced word marks, there would be no basis for a claim that HOFSM has infringed those marks, and HOFSM is assuming that Adidas does not contend otherwise.

³ The descriptions, images and drawings are contained within and taken from the referenced trademark registrations. The registrations were attached to the Amended Complaint as Exhibits 4-8 and are attached hereto using those same numbers for simplicity.

DEFENDANT'S MOTION TO DISMISS AMENDED COMPLAINT

Am. Compl. Para. & Exhibit	Reg. No.	Description	Image/Drawing³	Goods Covered	Jerseys ?
35, Ex. 6 (Doc. 27-6)	3,087,329	“Three parallel stripes running along the side of a shirt, T-shirt, sweatshirt, vest, jacket or coat”		Clothing, namely, shirts, T-shirts, sweatshirts, vests, jackets, and coats, Class 25	No
36, Ex. 7 (Doc. 27-7)	4,910,643	“Three diagonal quadrilaterals positioned parallel to each other upon a contrasting background”		Clothing, namely, shirts, T-shirts, sweatshirts, jerseys, pullovers, [and] tops..., Class 25	Yes
37, Ex. 8 (Doc. 27-8)	870,136	“Three parallel bands extending along the length of each sleeve...and of each leg...”		Athletic training suits, US Class 39, Int'l Class 25	No
37, Ex. 8 (Doc. 27-8)	961,353	“Three white stripes extending across the blue background of the box container”		Shoe box, Class 25	No
37, Ex. 8 (Doc. 27-8)	2,016,963	“Three parallel bands positioned along the length of each sleeve of a jacket”		Sports and leisure wear, namely jackets, Class 25	No

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Am. Compl. Para. & Exhibit	Reg. No.	Description	Image/Drawing ³	Goods Covered	Jerseys ?
37, Ex. 8 (Doc. 27-8)	2,278,591	“Three parallel bands extending along the length of each leg of the shorts”		Sports and leisure wear, namely, shorts, Class 25	No
37, Ex. 8 (Doc. 27-8)	2,284,308	“Three parallel bands extending along the length of each leg of the pants”		Sports and leisure wear, namely, pants, Class 25	No
37, Ex. 8 (Doc. 27-8)	3,183,656	“Three parallel stripes extending around the headwear”		Headwear, Class 25	No
37, Ex. 8 (Doc. 27-8)	3,183,663	“Three parallel stripes on a size adjusting bar at the rear of the headwear”		Headwear, Class 25	No
37, Ex. 8 (Doc. 27-8)	3,236,505	“Three parallel stripes extending from the rear of the headwear to the top of the headwear”	 RED GERMANY HINT THE MADE FOUND	Headwear, Class 25	No

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Plaintiff has no plausible claim against HOFSM for infringing any of these marks, for several reasons. First, registration “constitutes prima facie evidence of the registered mark and of [the registrant’s] exclusive right to use the mark *on the goods and services specified in the registration.*” *Applied Information Sciences Corp. v. eBay, Inc.*, 511 F.3d 966, 970 (9th Cir. 2007) (italics added). And “[a] registered trademark holder’s protectable interest is limited to those good or services described in its registration. *Id.*, 511 F.3d at 970; *see also*, 15 U.S.C. § 1057(b) (“A certificate of registration of a mark ... shall be prima facie evidence of ... the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate...”), 15 U.S.C. § 1115(a) (“Any registration issued ... shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration...”), and 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:48 (5th ed. 2019) (hereinafter, “MCCARTHY”) (“the prima facie and incontestable provisions of the Lanham Act apply only to the goods or services specified in the registration”).

Second, the description and drawings illustrating the registrants’ use of the marks matter. “A written application must specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. 15 U.S.C. §1051(a)(2), (b)(2); 37 C.F.R. §2.32(a)(6). To ‘specify’ means to name in an explicit manner.” USPTO Trademark Manual of Examining Procedure, § 1402.01. And, the TMEP continues, “the identification of goods and/or services must be specific, definite, clear, accurate, and concise.” *Id.*⁴

⁴ *Citing, In re Carlton Cellars, LLC*, 2020 USPQ2d 10150, at *3 (TTAB 2020); *see also, In re tapio GmbH*, 2020 USPQ2d 11387, at *6 (TTAB 2020) (quoting *In re Cordua Rests., Inc.*, 823 F.3d 594, 605, 118 USPQ2d 1632, 1639 (Fed. Cir. 2016)).

Similarly, a drawing “must be a substantially exact representation of the mark as used on or in connection with the goods...” 37 C.F.R. § 2.51. In other words, a trademark is “registered” only for the specific goods described, and only as shown on the drawings that are part of the registration.

The Adidas registrations listed in the Amended Complaint cover headwear, jackets, vests, shorts, training suits, shirts, and T-shirts, but *not*, with a single exception, “jerseys.” *See* Ex. 7 (Doc. 27-7), the ‘643 registration, which covers “shirts, T-shirts, sweatshirts, *jerseys*, pullovers, [and] tops..., (Compl. ¶ 36). “Jerseys” are, as Adidas’ ‘643 registration shows, distinct from “shirts,” “T-shirts,” “sweatshirts,” and the like. Plaintiff cannot plausibly claim that HOFSM’s collectible soccer jerseys infringe trademarks that are limited to hats, shorts, T-shirts, and other different types of apparel.

Third, none of Adidas’ registrations covers what HOFSM used on its accused collectible jerseys. Only the ‘643 mark (Am. Compl. ¶ 36) applies to jerseys, but that mark is described as “three diagonal quadrilaterals positioned parallel to each other upon a contrasting background,” depicted in the registration as shown here:



The images of HOFSM’s jerseys in the Amended Complaint confirm that HOFSM’s collectible jerseys did not have the “three diagonal quadrilaterals” that the ‘643 registration claimed. *See, e.g.*, Am. Compl. ¶ 56.

And none of the other registered marks – even if they applied to jerseys – appear on HOFSM’s collectible jerseys:

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

- The HOFSM collectible jerseys did not have parallel bands or stripes running “along” or “the length of” sleeves, or on the side of the jerseys, which the descriptions and drawings in the ‘127, ‘619 and ‘927 registrations require. The stripes on HOFSM’s jerseys ran only from the neck collar to the shoulder seam.
- The HOFSM collectible jerseys did not have 3 stripes “running along *the side* of” the products, which the descriptions and drawings in the ‘329 mark require.
- And, of course, the HOFSM collectible jerseys did not have stripes down the legs, or on headwear, jackets, pants, shorts, or on a shoe box, which the other registrations require.

Adidas simply has not pleaded a registered mark that HOFSM’s jerseys could possibly infringe. In fact, according to the records of the United States Patent and Trademark Office, Adidas *tried unsuccessfully* to register a mark for three bands or stripes on the shoulder of a soccer jersey, but that application never resulted in a registration. In May 1995, Adidas attempted to register a mark, US Serial Number 74671982, for “shirts, namely, soccer jerseys.” It was described as “three parallel bands along a shoulder and adjoining sleeve of [a] soccer jersey.” The drawing in the application showed three such bands extending from the front to the back of each shoulder on the jersey, as shown in the illustration for the ‘982 application:



After the mark was published, it was opposed by a competitor, Fila Sports. In August 1999, Adidas abandoned the application. (See docket sheets attached as Exhibit A to the Declaration of

Russell S. Jones, Jr., filed herewith).⁵ So, not only is Adidas attempting to expand the reach of its active “three stripe” marks beyond what they properly cover, but it also is attempting an end run around its failed attempt to register the only mark that *might* have covered HOFSM’s jerseys. Adidas has quite simply failed to plead the existence of any registered “three-stripe” for soccer jerseys that HOFSM’s collectible jerseys could be said plausibly to infringe.

Essentially, Adidas is trying to do what the Ninth Circuit disallowed in *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352 (9th Cir. 1985). In that case, Strauss registered trademarks for a “pocket tab” for use on overalls, jackets, and “garments, particularly trousers.” *Id.* at 1354. Blue Bell began marketing a shirt with a pocket tab. Strauss sued for infringement under §§ 1114 and 1125(a). The district court found, at least in part, for Blue Bell, and Strauss appealed.

The Ninth Circuit found that the “pocket tab” mark was a “location specific” mark, *id.* at 1356, 1359, meaning it was registered for pants, jackets, and overalls, but that did not, provide Strauss with “a protected interest in a pocket tab on garments generally,” like shirts. *Id.* at 1354, 1359. Therefore, the Court found that Strauss had to establish validity and secondary meaning, as well as likelihood of confusion, to prevail. *Id.*⁶ In other words, ownership of a mark used elsewhere (on pants) did not establish that Strauss owned a valid and incontestable mark used on different items of apparel (there, shirts).

⁵ This Court may take judicial notice of these matters of public record on government websites. *EVO Brands, LLC v. Al Khalifa Grp. LLC*, 657 F. Supp. 3d 1312, 1321 (C.D. Cal. 2023), *citing*, *Reyn's Pasta Bella, LLC v. Visa USA, Inc.*, 442 F.3d 741, 746 n.6 (9th Cir. 2006); *Barron v. Reich*, 13 F.3d 1370, 1377 (9th Cir. 1994); *see also*, *Autodesk, Inc. v. Dassault Sys. SolidWorks Corp.*, No. 08-04397, 2008 WL 6742224, at *2 n.1 (N.D. Cal. Dec. 18, 2008) (taking judicial notice of trademark registrations and applications available on the USPTO website).

⁶ The Ninth Circuit also rejected Strauss’ “appeal to the ‘related goods’ doctrine, *see AMF, Inc. v. Sleekcraft Boats*, 599 F.2d. 341, 348 (9th Cir. 1979), which “serves largely to define the potential scope of secondary meaning,” or perhaps “as a manifestation of the ultimate test of likelihood of confusion.” *Id.* at 1359.

The present action is much like *Levi Strauss*. Adidas claims to own a “Three-Stripe Mark,” but, actually, it has registrations for three stripes (or “bands,” or “quadrilaterals”) used on hats, shoes, boxes, track suits, jackets and shirts, in various configurations, none of which are the configuration used on HOFSM’s collectible jerseys. And, for “jerseys,” it has one registration for three stripes in a distinct diagonal configuration that does not appear on HOFSM’s collectible jerseys. None of these registrations includes or even comes close to covering HOFSM’s collectible soccer jerseys. Consistent with *Levi Strauss*, this Court should reject Adidas’ impermissible attempt to extend its registered marks, which cover specific configurations on specific products, to *any* version of three stripes, in *any* configuration, on *any* products that might be said to compete with anything Adidas happens to sell. Adidas’ §1114 claim should be dismissed.

In passing, Plaintiff also invokes § 1125(a), which provides for a claim against: (1) “Any person who, on or in connection with any goods or services, ... , uses in commerce any word, term, name, symbol, or device, ... , or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which: (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities...”

Plaintiff does not, however, plead specifically what its claim is under § 1125(a). *See* Fed. R. Civ. P. 8(a)(2). It is unclear whether Plaintiff’s claim is under § 1125(a)(1)(A) based upon some unregistered version of “Three Stripes” on jerseys; or under § 1125(a)(1)(A) based upon purported

trade dress;⁷ or under 1125(a)(1)(B) based upon some unmentioned advertising or promotional practice. As it does with its §1114 claim, Plaintiff creates ambiguity by alleging all twenty-one of its “Three Stripes” options as a singular “Three-Stripe Mark,” again no doubt because it is unable to identify an actionable claim as to any of the marks.

If Plaintiff’s §1125(a) claim is brought under § 1125(a)(1)(A) and based upon HOFSM’s use of three stripes that run the short distance between the neck collar and the shoulder seam on jerseys, Plaintiff fails to give appropriate notice of that claim as there is no allegation in the Amended Complaint that HOFSM has infringed an unregistered mark, nor allegations of likely confusion with any specific mark as opposed to the misleading amalgamation of twenty-one inconsistent marks.

If Plaintiff’s §1125(a) claim is brought under § 1125(a)(1)(A) based upon Plaintiff’s claimed trade dress, then the claim is duplicative of Plaintiff’s Third and Sixth Claims and fails for the reasons those claims fail, as addressed below, and should be dismissed.

If Plaintiff’s §1125(a) claim is brought under 1125(a)(1)(B), then it fails because Plaintiff has failed to plead the commercial advertising or promotion that allegedly violates this section. In fact, HOFSM’s advertising and promotion specifically disclaim any connection, affiliation, or origin related to Adidas with the accused products; *see* discussion at pg. 22, below.

II. The Counterfeiting Claim Should Be Dismissed Under Rule 12(b)(6).

This is not a counterfeiting case. Even taking well-pleaded and plausible allegations as true, the Second Claim fails for two reasons. First, as established above, Plaintiff *does not plead* and as far as HOFSM can tell does not *have* a registered mark for three stripes on a jersey. Because

⁷ HOFSM assumes that Adidas’ trade dress claims are contained within its Third and Sixth claims, but that assumption has not been confirmed.

“counterfeiting” can only occur with respect to registered marks, this claim fails. Second, HOFSM’s use of three small stripes on the shoulders of the accused products did not amount to using a “spurious” mark, in that the facts and images alleged show that HOFSM’s collectible jerseys were substantially different from Adidas’ jerseys, that HOFSM did not suggest or claim that its jerseys were Adidas’ jerseys (in fact, HOFSM expressly disclaimed any such affiliation), and that no reasonable consumer would be deceived into believing that the HOFSM collectible jerseys were Adidas jerseys.

A. Pleading a Counterfeiting Claim Under 15 U.S.C. § 1114.

Section 1114 of the Lanham Act establishes the trademark counterfeiting cause of action. Section 1114(1)(a) prohibits the use of “any ... counterfeit, of a registered mark in connection with the sale ... of any goods ... [where] such use is likely to cause confusion ... or to deceive.” *Adidas Am., Inc. v. Aviator Nation, Inc.*, 2020 WL 9594397, at *5 (D. Or. Aug. 5, 2020) (motion to dismiss granted). A “counterfeit” is “a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.” *Id.*, quoting 15 U.S.C. § 1127; see also *Lontex Corp. v. Nike, Inc.*, 384 F. Supp. 3d 546, 554–55 (E.D. Pa. 2019), *aff’d*, 107 F.4th 139 (3d Cir. 2024).

To plead a counterfeiting claim, “a plaintiff must establish (1) a non-genuine mark identical to or substantially indistinguishable from the plaintiff’s registered, genuine mark, where (2) the plaintiff’s genuine mark was registered for use on the same goods to which the infringer applied the non-genuine mark.” *Advanced Hair Restoration*, 2025 WL 276269, at *2; see also *Louis Vuitton Malletier, S.A. v. Akanoc Sols., Inc.*, 658 F.3d 936, 945-946 (9th Cir. 2011) (requiring that plaintiff establish that “the genuine mark was registered for use on the same goods to which the infringer applied the mark”); *State of Idaho Potato Comm’n v. G & T Terminal Packaging, Inc.*, 425 F.3d 708, 721 (9th Cir. 2005) (same).

“For counterfeiting purposes, spurious means more than unauthorized; it means ‘[d]eceptively suggesting an erroneous origin; fake.’” *Cohen & Company, Ltd. v. Cohen Company, Inc.*, 2022 WL 5250271 at *3 (E.D. Pa. Oct. 6, 2022), *quoting* BLACK’S LAW DICTIONARY (11th ed. 2019). There must be a plausible allegation of knowledge and intent, *i.e.*, that the defendant “intentionally used the trademark knowing that i[t] was a counterfeit or was willfully blind to such use.” *Pennzoil-Quaker State Co. v. Smith*, 2008 WL 4107159, at *20 (W.D. Pa. Sept. 2, 2008).

Most courts require heightened pleading, not just a conclusory allegation, that the marks are identical or almost identical (meaning only “minor differences that would not be apparent to the typical consumer”). *Lontex, supra*, 384 F. Supp. 3d at 556. “This test of ‘identical with, or substantially indistinguishable from’ requires a closer degree of similarity than is required for traditional trademark infringement or unfair competition.” 4 MCCARTHY, § 25.10.

And while Professor McCarthy does not necessarily agree, several courts have held that counterfeiting requires “viewing the products as a whole” in determining whether there is a “stitch-for-stitch copy ... to render the use of the indistinguishable marks spurious.” *Illinois Tool Works, Inc. v. J-B Weld Co., LLC*, 469 F.Supp.3d 4, 11 (D. Conn. 2020), *citing* *Gucci America, Inc. v. Guess?, Inc.*, 868 F.Supp.2d 207, 253 (S.D.N.Y. 2012) *see also* *Arcona, Inc. v. Farmacy Beauty, LLC*, 2019 WL 1260625 at *3 (C.D. Cal. 2019, Mar. 19, 2019), *aff’d*, 976 F.3d 1074, 1080-81 (9th Cir. 2020).⁸

⁸ *See also* *Audemars Piguet Holding S.A. v. Switch Watch Int’l, Inc.*, 2015 WL 150756 at *2 (S.D.N.Y. Jan. 12, 2015) (no counterfeiting found based on the “context of the entire [product]”); *GTFM, Inc. v. Solid Clothing Inc.*, 2002 WL 1933729 at *2 (S.D.N.Y. Aug. 21, 2002).

Counterfeiting is defined as “the act of producing or selling a product with a sham trademark that is an intentional and calculated reproduction of the genuine trademark.” *Louis Vuitton Malletier & Oakley, Inc. v. Veit*, 211 F. Supp. 2d 567, 581 (E.D. Pa. 2002); *see also* 4 MCCARTHY § 25:15.10 (same). Counterfeiting does not exist where, as here, the accused products are “accompanied by a distinct company name.” *Audemars Piguet, supra*, 2015 WL 150756 at *2, *citing Associated Gen. Contractors of Am. v. Stokes*, 2013 WL 1155512 (E.D. Va. March 19, 2013) (fact that the mark was accompanied by a distinct company name precluded [a] finding of counterfeiting). “Counterfeiting is ‘the “hard core” or ‘first degree’ of trademark infringement that seeks to trick the consumer into believing he or she is getting the genuine article, rather than a ‘colorable imitation.’” *Hsiao & Montano, Inc. v. Xstatic Pro, Inc.*, 2023 WL 4205811 (C.D. Cal., May 18, 2023); *see also, Illinois Tool Works*, 469 F.Supp.3d at 6, *quoting Gucci America*, 868 F.Supp.2d at 242; *Advanced Hair Restoration LLC v. Bosley, Inc.*, 2025 WL 276269 at*2 (W.D. Wash. Jan. 23, 2025). And “one who counterfeits necessarily infringes a trademark, but one who merely infringes a trademark may not have counterfeited. *Illinois Tool Works*, 469 F.Supp.3d at 6, *citing Gucci America, Inc. v. Duty Free Apparel, Ltd.*, 286 F.Supp.2d 284, 287 (S.D.N.Y. 2003).

B. Plaintiff’s Pleadings Demonstrate There Is No Basis for a Counterfeiting Claim.

1. Plaintiff Does Not Allege That HOFSM’s Jerseys Use a Registered Mark Owned by Adidas That Covers HOFSM’s Accused Products.

A counterfeiting claim requires pleading and ultimately proof that a defendant is using a “mark which is identical with, or substantially indistinguishable from, a registered mark.” *Adidas v. Aviator Nation, supra*, 2020 WL 9594397 at *5, 15 U.S.C. § 1127. A counterfeiting claim requires “imitation of a registered mark in connection with the sale ... of any goods or services.” *Bratt v. Love Stories TV, Inc.*, 713 F. Supp. 3d 847, 861 (S.D. Cal. 2024), *citing Y.Y.G.M. SA v.*

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Redbubble, Inc., 75 F.4th 995, 1000 (9th Cir. 2023) (quoting 15 U.S.C. § 1114(1)(a)); *see also GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1205 (9th Cir. 2000) (noting “§ 32 of the Lanham Act covers only registered marks”). And the mark at issue must be “registered for use on the same goods to which the infringer applied the non-genuine mark.” *Advanced Hair Restoration*, 2025 WL 276269 at *2; *Louis Vuitton*, 658 F.3d at 945-46.

Here, of course, Plaintiff *does not plead* and does not appear to have a *registered mark* for three stripes on the shoulder of a jersey. As shown above, only one of the twenty-one registered marks identified in the Amended Complaint – the ‘643 mark -- applies to “jerseys,” and it is undeniable that HOFSM’s jerseys do not contain or use “three diagonal quadrilaterals positioned parallel to each other upon a contrasting background.” Adidas abandoned the only mark for which it ever applied covering three stripes on a jersey. *See* Ex. A to Jones Declaration. Adidas simply does not have and has not pleaded a registered mark that could plausibly cover the short three stripes appearing on the shoulders of HOFSM’s collectible jerseys.

This fact alone defeats the counterfeiting claim, which requires a “counterfeit...of a registered mark.” *Adidas America v. Aviator Nation*, *supra*, 2020 WL 9594397 at *5; *Bratt v. Love Stories*, *supra*, 713 F. Supp. 3d at 861; *Y.Y.G.M. SA v. Redbubble, Inc.*, 75 F.4th at 1000. Quite simply, Adidas’ failure to allege that HOFSM has used a *registered* mark for three stripes on the shoulders of a jersey, defeats not only its infringement claim, but also its counterfeiting claim.

2. The Counterfeiting Claim Should Be Dismissed for the Separate Reason that Plaintiff Has Failed to Plausibly Plead Use of a Mark That is Identical to or Substantially Indistinguishable from Any Registered Mark.

District courts dismiss counterfeiting claims at the pleading stage – often with prejudice -- where the complaint shows that the product or packaging bearing the alleged infringing mark is not identical to or substantially indistinguishable from the at-issue registered marks. *See e.g.*,

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Adidas Am. v. Aviator Nation, 2020 WL 9594397 at *5; *Playvision Labs, Inc. v. Nintendo of Am., Inc.*, 2015 WL 12941892 (N.D. Cal. May 18, 2015); *Illinois Tool Works*, 469 F.Supp.3d at 12.

Illinois Tool Works is instructive. Plaintiff owned the mark “MUFFLER WELD,” and sued defendant for using “MufflerWeld” on its product label. The district court compared images of the two products bearing the respective marks and concluded that “[i]t is obvious that they don’t look like one another, except, of course, for their near-identical name.” 469 F.Supp.3d at 7. The court noted that “it is the appearance of the mark on the ‘actual merchandise,’ rather than comparison of the marks in the abstract, that matters.” *Id.* at 9 (citing *Montres Rolex, S.A. v. Snyder*, 718 F.2d 524, 532-33 (2d Cir. 1983)). The district court stated that “[g]iven the dramatic differences in the products’ appearance, from their distinct house marks, differing color schemes, differing sizes, and, above all, very different dispensing mechanisms, it is not plausible to conclude that average consumers would buy J-B Weld’s product and think they got ITW’s product.” *Id.* at 10.

The jerseys at-issue in the present action are no more alike than the two products at-issue in *Illinois Tool Works* and the other cited cases. First, the HOFSM collectible jerseys did not include significant features of Adidas’ jerseys, *e.g.*, the triangle-shaped Adidas mark or the trademarks or logos of a team or sponsor. Here are the Adidas “Real Madrid” jerseys from Plaintiff’s Complaint, pgs. 3-4:



DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

By contrast, here are examples of the HOFSM accused “Real Madrid” collectible jerseys (Complaint, p. 6):



The front of the Adidas jerseys has the Adidas triangle logo, the Real Madrid logo, and the Emirates sponsor logo. None of those appear on the HOFSM jerseys. The HOFSM jerseys have the uniform number on the front, while the Adidas jerseys do not. The Adidas jerseys’ stripes continue well down the jersey’s sleeves, while the HOFSM stripes are short, ending at the shoulder seam. A side-by-side comparison illustrates the differences:

Adidas



Adidas

HOFSM



HOFSM

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT



Further, what Adidas calls its “Argentina” jerseys, shown here and on page 5 of the Complaint --



-are materially different from the HOFSM “Messi” collectible jerseys, shown here:



DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

(Complaint, p. 7)

The HOFSM collectible “Messi” jersey lacked the Adidas triangle logo and the Argentina Football Club logo on the front. The HOFSM “Messi” collectible jersey also used a noticeably different *dark* blue color scheme on both the front and back. The HOFSM collectible jersey has the uniform number 10 on the front and back, while the Adidas’ jersey has the number only on the back. And again, the shoulder stripes on the Adidas jersey extend well down the sleeve, while the HOFSM stripes are shorter and end at the shoulder seam. *See* Compl. at ¶¶ 6-8.

Again, a side-by-side comparison of images in the Complaint illustrates the differences:

Adidas



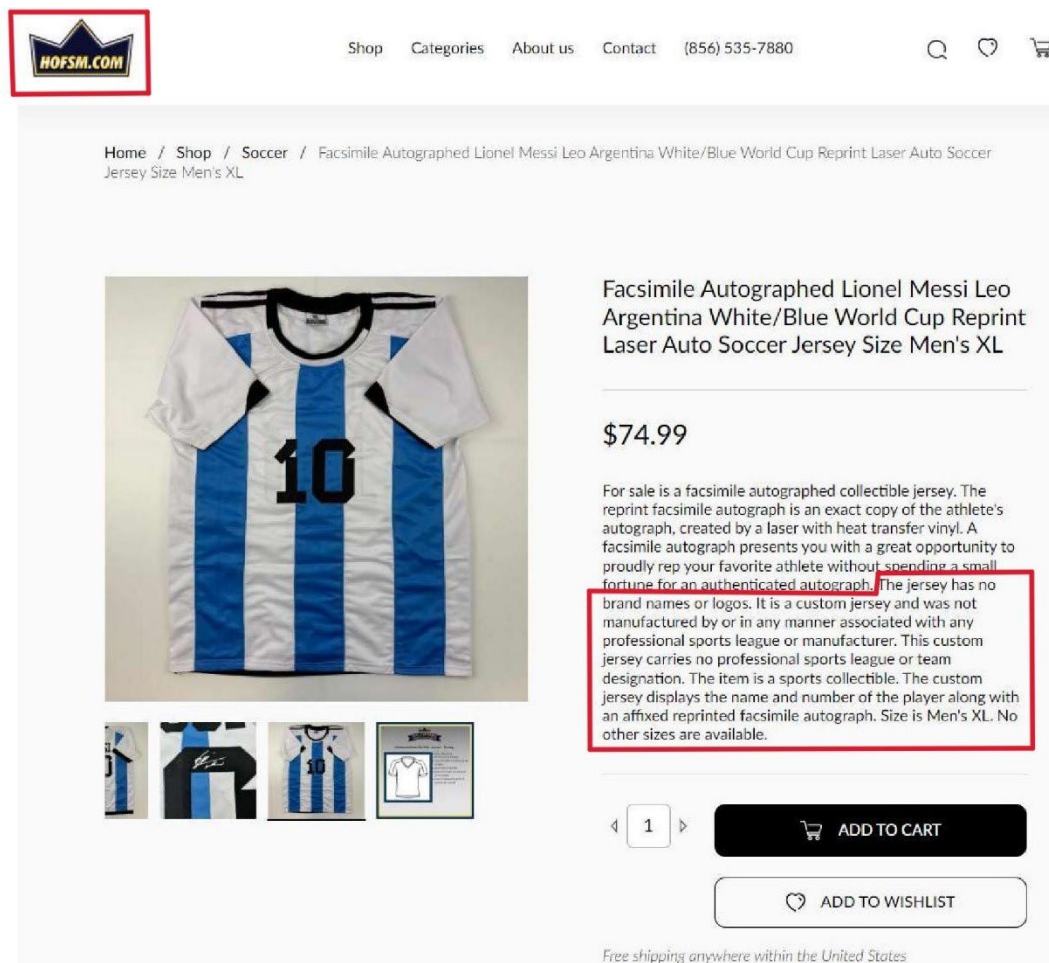
HOFSM



DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Here again, these have a different shape, different color, different logos, different stripe treatment on the shoulders, and different banding at the bottom of the sleeves.

Second, the Complaint establishes that HOFSM marketed its collectible jerseys using and prominently displaying *HOFSM's* name and logo, not Adidas.' *Audemars Piguet, supra*. See the following image from HOFSM's website, taken from ¶ 59 of the Amended Complaint:

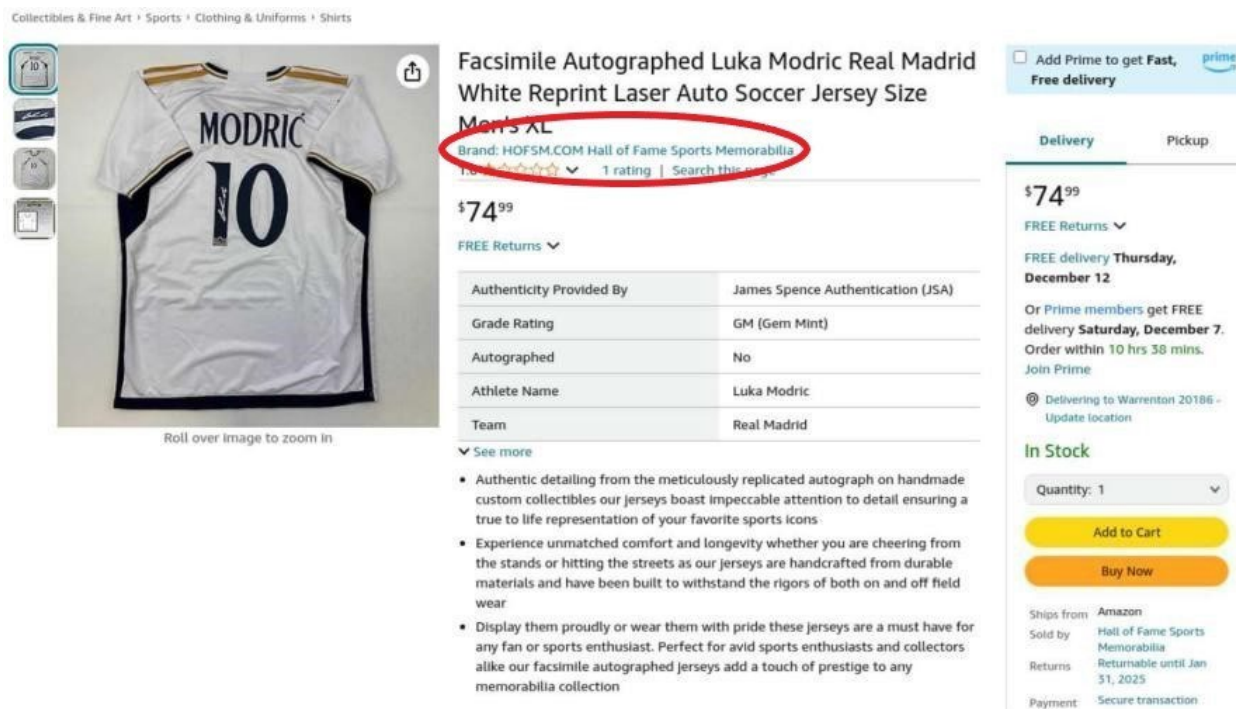


The only company name used on the website listing is HOFSM, whose logo appears prominently at the upper left. The word “Adidas” does not appear anywhere.

And on the Amazon listings (Amended Complaint at ¶ 60), the seller listed is *not* Adidas, but “HOFSM.com Hall of Fame Sports Memorabilia.” As with the website listings, nowhere on

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

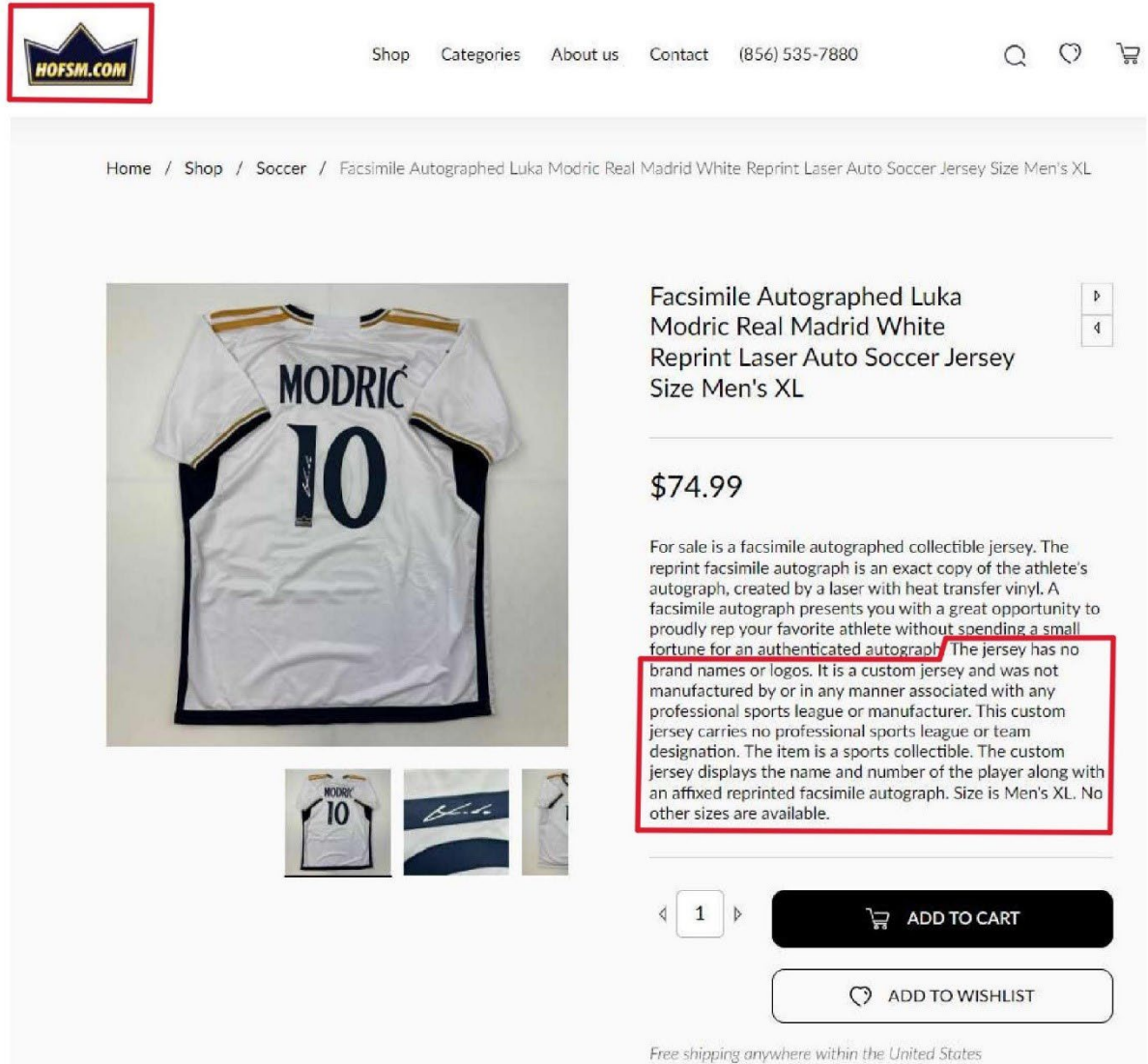
the Amazon listings does the name “Adidas” appear. *See* Amended Complaint at ¶ 60 and images on p. 30-31, an example of which is shown below:



In addition, the Amended Complaint establishes that the product listings on HOFISM's website included disclaimer language advising consumers that HOFISM, and only HOFISM, is responsible for the products:

The jersey has no brand names or logos. It is a custom jersey and was not manufactured by or in any manner associated with any professional sports league or manufacturer. This custom jersey carries no professional sports league or team designation. The item is a sports collectible. The custom jersey displays the name and number of the player along with an affixed reprinted facsimile autograph. Size is Men's XL. No other sizes are available.

See Am. Compl. at ¶ 59 and images on pp. 27-29, a sample of which is reproduced below:



Home / Shop / Soccer / Facsimile Autographed Luka Modric Real Madrid White Reprint Laser Auto Soccer Jersey Size Men's XL

Facsimile Autographed Luka Modric Real Madrid White Reprint Laser Auto Soccer Jersey Size Men's XL

\$74.99

For sale is a facsimile autographed collectible jersey. The reprint facsimile autograph is an exact copy of the athlete's autograph, created by a laser with heat transfer vinyl. A facsimile autograph presents you with a great opportunity to proudly rep your favorite athlete without spending a small fortune for an authenticated autograph. The jersey has no brand names or logos. It is a custom jersey and was not manufactured by or in any manner associated with any professional sports league or manufacturer. This custom jersey carries no professional sports league or team designation. The item is a sports collectible. The custom jersey displays the name and number of the player along with an affixed reprinted facsimile autograph. Size is Men's XL. No other sizes are available.

1

ADD TO CART

ADD TO WISHLIST

Free shipping anywhere within the United States

The Complaint therefore shows conclusively that the accused HOFSM jerseys are far from “stitch-for-stich” copies of Adidas jerseys. The accused jerseys do not bear the Adidas name, nor its triangle mark, nor the logos of any team or sponsor. HOFSM (and Amazon) advertise that the jerseys are made and sold by HOFSM under HOFSM’s logo/mark, and the HOFSM website states plainly that they are not affiliated with any league, team, or manufacturer. As was the case in *Illinois Tool Works*, “it is not plausible to conclude that average consumers would buy [HOFSM’s]

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Page -23

product and think they got [Adidas'] product.” For this second reason, this Court should dismiss the counterfeiting claim with prejudice.

III. The Trade Dress Claims (Third and Sixth Claims) Should Be Dismissed.

The Third and Sixth claims generally allege that HOFSM’s collectible jerseys infringe Adidas’ trade dress in violation of 15 U.S.C. § 1125(a) and the common law. But these claims fail to plausibly allege facts from which one could conclude that Adidas has adequately described or claimed non-functional and source-identifying trade dress, nor has it plausibly alleged that a reasonable consumer, looking at an HOFSM collectible jersey, would be confused into believing it was an Adidas jersey.

A. Trade Dress Law

Trade dress refers to “a combination of any elements in which a product is presented to a buyer, including the shape and design of a product.” *Arcsoft, Inc. v. Cyberlink Corp.*, 153 F. Supp. 3d 1057, 1067 (N.D. Cal. 2015), *quoting Art Attacks Ink, LLC v. MGA Entm’t Inc.*, 581 F.3d 1138, 1145 (9th Cir. 2009). “To prove trade dress infringement, a plaintiff must demonstrate that (1) the trade dress is nonfunctional, (2) the trade dress has acquired secondary meaning, and (3) there is a substantial likelihood of confusion between the plaintiff’s and defendant’s products.” *Id.* (*quoting Art Attacks*, 581 F.3d at 1145). Plaintiff bears the burden of pleading and proving non-functionality. *Solar Sun Rings, Inc. v. P&P Imports, LLC*, 2024 WL 2869332, at *5 (C.D. Cal., May 7, 2024) (*citing Virgin Scent, Inc. v. Bel Air Naturals Care Corp.*, 2018 WL 5264145, at *4 (C.D. Cal., Feb. 8, 2018)); *Arcsoft*, 153 F.Supp.3d at 1068-69.

A conclusory statement of non-functionality, even with a list of allegedly non-functional elements, is not enough. *Green Crush LLC v. Paradise Splash I, Inc.* 2018 WL 4940824, at *4 (C.D. Cal., Mar. 8, 2018). A plaintiff must also allege at the very least “*how* a trade dress is non-

functional.” *Deckers Outdoor Corp. v. Fortune Dynamic, Inc.*, 2015 WL 12731929, at *4-5 (C.D. Cal. May 8, 2015) (granting motion to dismiss trade dress claim, with leave to amend); *see also*, *Crafty Prods., Inc. v. Michaels Co.*, 424 F.Supp.3d 983, 993 (S.D. Cal. 2019), *aff’d* *Crafty Prods., Inc. v. Fuqing Sanxing Crafts Co.*, 839 Fed. Appx. 95, at *98 (9th Cir. 2020) (affirming dismissal of a trade dress claim relying on conclusory allegations of non-functionality).

As the Ninth Circuit has stated, there is a sound policy reason that trade dress plaintiffs must plead and ultimately prove that the alleged trade dress is nonfunctional: it “makes it very difficult for sellers to use trademark rights to monopolize designs of products.” *See Leatherman Tool Grp., Inc. v. Cooper Indus., Inc.*, 199 F.3d 1009, 1012–13 & n. 6 (9th Cir. 1999). “It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164, 115 S.Ct. 1300, 131 L.Ed.2d 248 (1995); *Blumenthal Distributing, Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 864-65 (9th Cir. 2020).

Functionality may be either utilitarian or “aesthetic.” *Blumenthal*, 963 F.3d at 865 (citing *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32-33 (2001) and *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1073-74 (9th Cir. 2006) (“aesthetic functionality is based on ‘intrinsic aesthetic appeal’”). “A claimed trade dress has aesthetic functionality if it serves ‘an aesthetic purpose wholly independent of any source identifying function,’ such that the trade dress’s protection under trademark law ‘would impose a significant non-reputation-related competitive disadvantage’ on its owner’s competitors.... Thus, the inquiry is whether, if one seller were given exclusive rights to use the claimed trade dress, other sellers would be forced to use alternative designs that make their products more costly to sell, or for which consumers’ willingness to pay would be lower for reasons having nothing to do with the reputation

of any source.” *Blumenthal*, 963 F.3d at 865. If such competitive disadvantages would be significant, then this second requirement for aesthetic functionality is satisfied. *Id.* If alternative designs would not have as much intrinsic aesthetic appeal – in other words, if alternative designs would make the product less attractive to potential customers – the alleged dress is functional and not protectible.

And, while a plaintiff may “define its claimed dress as the ‘overall appearance’ of its product,” the *Blumenthal* court warned that “when the claimed trade dress is an ‘overall appearance,’ these tests must be applied with extra care to prevent ‘semantic trickery’ from obscuring the functionality of the design the plaintiff seeks to monopolize.” 963 F.3d at 866 (citations omitted). “For example, if a particular combination of functional features is itself functional, referring to that layout of features as the “overall appearance” of a product does not render it nonfunctional.” *Id.* at 865-66; *see also Arcsoft*, 153 F.Supp.3d at 1068 (*citing Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 786 (9th Cir. 2002) (“where the plaintiff only offers evidence that the whole is nothing other than the assemblage of functional parts, ... it is semantic trickery to say that there is still some sort of separate overall appearance which is nonfunctional”)). As the Ninth Circuit held in *Blumenthal*, 963 F.3d at 866, “a product’s ‘overall appearance’ is functional, and thus unprotectable, where the whole product is nothing other than the assemblage of functional parts,’ and ‘even the arrangement and combination’ of those parts is designed to make the product more functional.”

B. Plaintiff Fails to State a Trade Dress Claim.

Here, Adidas pleads that its alleged trade dress consists generally of two parts: first, ubiquitous or aesthetically functional elements that exist on virtually any soccer jersey and that are

in no way source-identifying and, *second*, elements that are both specific to Adidas *and* notably *absent* from HOFSM's jerseys. Paragraph 5 of the original Complaint stated:

The Real Madrid jersey trade dress at issue is comprised of: (a) a white soccer jersey, (b) featuring the Three-Stripe Mark in gold or black extending from the collar across each shoulder, (c) the player name printed horizontally in black on the back of the jersey below the collar, (d) the jersey number below the player name, and (e) trademarks from adidas, Real Madrid CF, and the club's sponsor printed on the chest.⁹

This definition does not omit any material features of the jersey, so Adidas is essentially claiming the "overall appearance" as its trade dress.

Here, subparts (a) a white jersey, (c) the player's name printed on the back, (d) the player's number printed on the back, and most of (e) – the Real Madrid logo and the club's sponsor's logo – are functional in either or both the utilitarian or aesthetic sense. The color of the "Real Madrid" jersey is there to match the color of *actual* Real Madrid home jerseys. One could not make "Real Madrid" home jersey in a different color, any more than one could credibly make and sell a *red* "Seattle Seahawks" jersey.

And having the team's name and logo and a player's name and number on the replica or collectible jersey is equally functional – virtually *every* team-replica sports jersey includes a player's name and number and the team's and perhaps a sponsor's logos – in other words, the features found on actual team jerseys. These features are, again, functional for utilitarian or aesthetic reasons and are, simply put, not source identifying. Indeed, most any Internet search for "replica soccer jerseys" will display dozens of such soccer jerseys – some from Adidas, others

⁹ Plaintiff's Amended Complaint added the words "the distinctive and non-functional combination of" to this definition. These are mere conclusory allegations, not facts the Court must take as true, and these add nothing substantive to the Amended Complaint. *Deckers Outdoor Corp. v. Fortune Dynamic, Inc.*, *supra*, 2015 WL 12731929 at *4-5; *Crafty Prods., Inc. v. Michaels Co.*, 424 F.Supp.3d at 993, *aff'd.*, 839 Fed. Appx. at *98.

from Nike or Puma, others from custom jersey makers, and others from Wal-Mart and other retailers – that include a player’s name and number, a team’s colors, name and/or logo, and a sponsor’s name or logo; in other words, all of Adidas’ claimed trade dress except the triangle logo and three stripes on the sleeve. These features are functional in either or both the aesthetic and utilitarian senses.

The analysis for the “Argentina” trade dress is similar. Plaintiff claims that the trade dress is comprised of (a) a white jersey, (b) three *light blue* stripes running vertically on the front of the jersey, (c) an adidas triangle trademark and Argentine Football Association (AFA) crest on the chest, (d) four *light blue* vertical stripes appearing on the back of the jersey with two middle stripes that are thinner than the two outer stripes, (e) the Three-Stripe Mark in black extending from the collar across each shoulder, (f) the player name printed horizontally on the back of the jersey below the collar, and (g) the jersey number printed in black below the player name. Compl. at ¶ 6.¹⁰

Again, the alleged trade dress consists mainly of purely functional elements (a white jersey, blue vertical stripes, player name and uniform number, team and sponsor logos), plus specific nonfunctional elements (three stripes on the shoulders and the Adidas triangle mark). What Adidas is claiming here is just the sort of “semantic trickery” that was condemned in *Blumenthal*, *Arcsoft*, and other cases.

The only features of the claimed “Real Madrid” trade dress that are *not* functional are those described in parts (b) and some of part (c) of Plaintiff’s definition: the Adidas triangle logo – missing from the HOFSM collectible jerseys – and the three-stripe mark. Nor does the accused HOFSM “Argentina” jersey contain most of the non-functional features that appear on the Adidas

¹⁰ As with the Real Madrid jersey, Plaintiff adds the conclusory words “distinctive and non-functional” to this allegation in the Amended Complaint. Again, the Court need not take such conclusions as “facts” to be assumed to be true.

“Argentina” jerseys. Am. Compl. at ¶¶ 8, 56. The accused HOFSM “Lionel Messi” jerseys have no Adidas triangle logo, no AFA crest or logo, and *dark blue* strips of a different thickness than those on the Adidas “Argentina” jersey. Am. Compl. at ¶ 56 and images on p. 25. The HOFSM collectible jerseys also have the uniform number on the *front* of the jersey, which the alleged Adidas jerseys do not. The *only* design element common to the HOFSM jerseys and the claimed “Argentina” trade dress is three stripes -- on the shoulders of the HOFSM jersey and which extend beyond the shoulder seam on Adidas’ jersey.

The bottom line is that the HOFSM collectible jerseys, when compared to the Adidas jerseys, are so different that no reasonable jury could find they infringe Adidas’ claimed trade dress. Most of what the jerseys have in common are aesthetically or otherwise functional (color, player name and number), and the HOFSM collectible jerseys lack not only some functional features (team and sponsor logos), but also the Adidas triangle mark on the front of the jersey.

Further, when zooming in on the number on the back of HOFSM’s products from the photos in paragraph 56 of the Amended Complaint, the number contains a patch identifying the product as an HOFSM product, as shown here:



DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

This crown symbol, that is at the bottom of the number of the photographs used in paragraph 56 of the Amended Complaint, is more clearly seen here, taken from HOFSM.com:



Additionally, as noted above, the HOFSM jerseys are sold with a disclaimer of any affiliation with “any...manufacturer,” further differentiating the products’ appearance in the marketplace. The only possible source-identifying parts of the alleged trade dress that is on the HOFSM jerseys – the stripes on the shoulders – is not enough to support a finding that the HOFSM collectible jerseys are sufficiently like the Adidas jerseys to cause confusion. Plaintiffs’ trade dress claims should be dismissed.

IV. Plaintiff’s Dilution Claims Should Be Dismissed for Failure to Meet Pleading Requirements.

The Fourth and Fifth claims, for trademark dilution under federal, Oregon, and New Jersey law, fail because Plaintiff has not plausibly pleaded facts from which one could conclude that HOFSM’s sales of its collectible jerseys has or is likely to tarnish Adidas’ reputation or dilute the distinctiveness of its mark. In addition, because it is undisputed that HOFSM has ceased advertising, offering for sale, or selling the accused products and has committed to destroy any remaining accused products, the Fifth claim based on Oregon law is moot, as ORS 647.107 provides only for injunctive relief.

For a trademark dilution claim, “a plaintiff must show that (1) the mark is famous and distinctive; (2) the defendant is making use of the mark in commerce; (3) the defendant’s use began after the mark became famous; and (4) the defendant’s use of the mark is likely to cause dilution by blurring or dilution by tarnishment.” *Grapery, Inc. v. Bloom Fresh Int’l Ltd.*, 2024 WL

3891032, at *6 (C.D. Cal., Aug. 19, 2024) (*citing Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 634 (9th Cir. 2008)). “Tarnishment occurs when a famous mark is improperly associated with an inferior or offensive product or service.” *Id.* at *6, (*quoting Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316, 1326 n. 7 (9th Cir. 1998)).

Pleading the elements of a dilution claim without alleging facts to support a plausible claim that HOFSM’s use of Adidas’ 3-stripe mark on the shoulders of collectible soccer jerseys is likely to cause dilution by blurring or tarnishment is insufficient and requires dismissal. *Glob. Apogee v. Sugarfina, Inc.*, 2018 WL 4945305, at *4 (C.D. Cal. Oct. 10, 2018); *Ketab Corp. v. Mesriani L. Grp.*, 2015 WL 12655670, at *4 (C.D. Cal. Feb. 6, 2015); *Adobe Sys. Inc. v. A&S Elecs., Inc.*, 2015 WL 13022288, at *6 (N.D. Cal. Aug. 19, 2015); *Pendleton Woolen Mills, Inc. v. Round Up Ass’n.*, 2012 WL 2721856, at *8 (D. Or. July 9, 2012) (dismissing dilution by tarnishment claim lacking allegations or supporting facts that defendant’s “products are of shoddy quality or portray the PENDLETON Mark in an unwholesome or unsavory context”); *Mintz v. Subaru of Am., Inc.*, 716 F. App’x 618, 621 (9th Cir. 2017) (affirming dismissal of dilution by tarnishment claim); *Klein Elecs., Inc. v. Boxwave Corp.*, 2100 WL 2560238, at *2-3 (S.D. Cal. June 27, 2011) (dismissing dilution claim for pleading only “labels and conclusions”).

Plaintiff’s dilution claims (Am. Compl. at ¶¶ 97-100, 102-105) plead no more than the bare elements of dilution claims, without any factual support. The Court should dismiss Plaintiff’s dilution claims.

CONCLUSION

Adidas has not pleaded that it owns a registered trademark covering the use of three stripes on soccer jerseys, other than one mark for diagonal stripes that do not appear on HOFSM’s jerseys, thus dooming its First Claim. The Second (counterfeiting) claim fails to pass muster because

DEFENDANT’S MOTION TO DISMISS AMENDED COMPLAINT

Plaintiff has failed to plead a registered mark covering soccer jerseys, HOFSM's use of such a mark on its products, or that HOFSM's products, including how they are sold, are stitch-for-stitch copies of Adidas' products. HOFSM's accused collectible soccer jerseys are so different than Adidas' jerseys that a trade dress cannot survive a motion to dismiss either. And Adidas has not alleged facts sufficient to support its dilution claims. This Court should, therefore, dismiss the Amended Complaint with prejudice and award HOFSM its costs and reasonable attorneys' fees, and such other relief as the Court deems just and appropriate.

DATED this 1st day of April 2025.

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DEFENDANT'S MOTION TO DISMISS AMENDED COMPLAINT

Page -32