

Case No. 10-17329  
District Court No. 08-cv-03133-JAM-DAD (E.D. Cal.)

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IN THE UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT

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SHINGLE SPRINGS BAND OF MIWOK INDIANS,  
Plaintiff-Appellee,

v.

CESAR CABALLERO  
Defendant-Appellant.

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Answering Brief of Plaintiff-Appellee  
Shingle Springs Band of Miwok Indians

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### **Preliminary Statement**

Appellee Shingle Springs Band of Miwok Indians (hereinafter, “Tribe”) has operated its federally recognized tribal government under the name “Shingle Springs Band of Miwok Indians” (the “Mark” or the “Tribe’s Mark”)<sup>1</sup> for over thirty years. During this time the Tribe provided governmental and educational services to its members and the public and its Mark became well known.

Appellant Cesar Caballero is not a member of the Tribe, but identifies himself as a person of “Miwok” ancestry. In 2008, after he learned the Tribe planned to open a casino, he began to do business under the Tribe’s Mark and represent to third parties, through local and federal government filings, that he was the “Chief” and “Tribal Historian” of the “Shingle Springs Band of Miwok Indians.” These representations were false.

The Tribe never authorized Mr. Caballero to use its Mark or act on its behalf in any manner. Nor had Mr. Caballero ever used the Tribe’s Mark before. Indeed, as the District Court observed, “[i]t is of no coincidence . . . that Mr. Caballero was nowhere to be found until [the Tribe’s] casino was built, and suddenly he declared himself to be the true owner of the name [and] the head of this tribe.” (Reporter’s

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<sup>1</sup> Although the Tribe has alleged that Mr. Caballero infringed other trademarks it owns (*see* S.E.R. 270–288.), Mr. Caballero’s appeal concerns only the Tribe’s “Shingle Springs Band of Miwok Indians” mark.

Transcript of Motion for Preliminary Injunction (“Transcript”), Appellant’s Excerpts of Record (“E.R.”) 3-15:14–19.)

Since then, Mr. Caballero has put up a website and issued various publications featuring the Tribe’s Mark, offering his services as a “Tribal Historian,” and offering the public “membership” in his “tribe.” The Tribe sued Mr. Caballero for trademark infringement, but Mr. Caballero continued to misappropriate the Tribe’s Mark. After Mr. Caballero used the Tribe’s Mark to mislead postal employees into transferring the Tribe’s mail to Mr. Caballero’s own address, the District Court enjoined him from using the Tribe’s Mark in connection with his competing services. Because the District Court properly found the Tribe is likely to show the Lanham Act prohibits Mr. Caballero’s deceptive conduct and a preliminary injunction is justified, this Court should affirm.

### **Jurisdictional Statement**

The District Court has jurisdiction over the Tribe’s federal trademark claims under 15 U.S.C. §§ 1121 and 1125(a) and 28 U.S.C. § 1331. The District Court has supplemental jurisdiction over the Tribe’s state law claims under 28 U.S.C. § 1367.

This Court has appellate jurisdiction to review the District Court’s order granting a preliminary injunction under 28 U.S.C. §1292(a)(1).

The District Court's order granting preliminary injunction issued September 15, 2010, and Mr. Caballero timely filed his Notice of Appeal under Fed. R. App. P. 4(a)(1)(A) on October 14, 2010.

**Statement of the Issues Presented for Review**

1. Did the District Court properly find the Tribe is likely to succeed in demonstrating its Mark is valid as a trademark for association and education services it provides as an Indian tribal government?
2. Did the District Court properly find the Tribe is likely to succeed in demonstrating that Mr. Caballero's use of the Tribe's Mark in connection with competing association and education services is likely to cause confusion among the relevant consumer groups?
3. Did the District Court properly find the Tribe will suffer irreparable harm absent an injunction?
4. Did the District Court properly find the balance of hardships supports a preliminary injunction?
5. Did the District Court properly find an injunction is in the public interest?
6. Did the District Court properly limit the scope of its injunction to misleading use of the Tribe's Mark lacking communicative value apart from designating a competitor's services as those of the Tribe?

### **Statement of the Case**

On December 23, 2008, the Tribe sued Mr. Caballero alleging federal trademark infringement and various state law claims based on Mr. Caballero's competing use of the name "Shingle Springs Band of Miwok Indians." (Tribe's Supplemental Excerpts of Record ("S.E.R.") 344–354.) With his answer, Mr. Caballero filed counterclaims (styled "Cross-Complaint"), consisting of a federal trademark infringement claims, which were essentially a mirror image of the Tribe's, and various state law claims. (S.E.R. 316–343.). On May 20, 2009, the District Court dismissed the counterclaims with prejudice. (Docket #33.) Mr. Caballero prematurely appealed that order and this Court dismissed the appeal (No. 09-16544). (Docket #40, #66.) Following the dismissal of Mr. Caballero's counterclaims, his attorney unsuccessfully sought to withdraw. (Docket #44, #58.)

On November 23, 2009, with leave of the Court, the Tribe filed an amended complaint based on conduct discovered after the original complaint, including Mr. Caballero's use of additional infringing marks and websites. (Docket #69; S.E.R. 289–307.) On May 28, 2010, the District Court signed the parties' stipulation staying various deadlines in the case to pursue settlement. (Docket #86.) After settlement efforts failed, the Tribe filed a second amended complaint on August 20, 2010, which added allegations about newly discovered infringing domain names Mr. Caballero possessed. (S.E.R. 270–288.)

On September 3, 2010, on the basis of the Tribe's application for a temporary restraining order due to Mr. Caballero's diversion of the Tribe's mail, the District Court granted the Tribe's application and set a hearing on the Tribe's application for a preliminary injunction. (Docket #91.) On September 8, 2010, Mr. Caballero filed a motion to dissolve the temporary restraining order and opposition to the application for a preliminary injunction. (Docket #94.) On September 13, 2010, the Tribe filed its reply papers, along with a proposed order to show cause why Mr. Caballero, his attorney, and an employee of Mr. Caballero's attorney should not be held in contempt for violating the District Court's temporary restraining order. (Docket #95, #96; E.R. 7-1-7-4.)

On the morning of the September 15, 2010 preliminary injunction hearing, hours before it was to begin, Mr. Caballero filed what appeared to be a duplicate copy of the brief he filed on September 8, 2010 (*compare* E.R. 4 *with* E.R. 8) along with four declarations not previously filed. (Docket #97.) At the hearing, the District Court found "there's no question in my mind based on the evidence before the Court, that the plaintiff is likely to prevail on this [trademark] claim, on all the elements necessary." (Transcript, E.R. 3-15:6-10.) Specifically, the 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 Mr. Caballero has used marks that are almost identical to or identical to the Tribe's Mark. (Transcript, E.R. 3-14:23-3-15:10.) The District Court also found the Tribe would

likely prevail in showing Mr. Caballero's use "presents a likelihood of confusion" within the meaning of the Lanham Act. (*Id.*) Finding for the Tribe on each of the preliminary injunction factors (Transcript, E.R. 3-17:1-5), the District Court enjoined Mr. Caballero from using trademarks confusingly similar to the Tribe's trademarks and required him to immediately return all mail he diverted from the Tribe. (Preliminary Injunction Against Cesar Caballero ("Order"), E.R. 2-3:14-2-4:6.) Although the District Court found that Mr. Caballero violated the temporary restraining order (Order, E.R. 2-3:8-10), it declined to issue any order to show cause regarding contempt. (Transcript, E.R. 3-18:20-21.) The Tribe has not appealed that decision, which is not before this Court.<sup>2</sup>

### **Statement of Facts**

The United States government has recognized the Tribe as the "Shingle Springs Band of Miwok Indians, Shingle Springs Rancheria (Verona Tract), California," and the Tribe has provided services under that name for decades. 45 Fed. Reg. 27828, 27830 (April 24, 1980); 74 Fed. Reg. 40218, 40221 (August 11,

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<sup>2</sup> The action before the District Court is currently stayed based on Mr. Caballero's representation that he "is under criminal investigation that may have a relationship to the Tribe's claims in this action." (S.E.R. 1:23-24.)

2009).<sup>3</sup> The Tribe has consistently used, and come to be known by, the name “Shingle Springs Band of Miwok Indians” (“the Mark”) in various dealings with the United States, local government entities, and the public in connection with promoting its governmental interests and the interests of its members. (S.E.R. 117:8–17, 120–155, 168–169; 325:8–24, 326:23–327:3, 338:7–18.) The Tribe has also used the Mark in connection with producing publications regarding its government and its Tribal community, including through its website, and for official Tribal correspondence. (S.E.R. 94:6–19, 96–115.) Through this use, the public associates the Tribe’s services with its Mark. (S.E.R. 325:8–24, 326:23–327:3, 338:7–18; 117:8–17, 125–155; 175:7–9, 178–180.)

For many years, before the Tribe opened its gaming operation, the Tribe’s reservation, located in El Dorado County, was landlocked, without unfettered commercial access, and many of its members survived on federal subsistence. (E.R. 11-3:9–13, 11-4:10–25; S.E.R. 117:24–118:4.) In an effort to pursue economic development through gaming, the Tribe set out to resolve its access problem. In 1999, the Tribe signed a compact with the State of California to

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<sup>3</sup> The Bureau of Indian Affairs has repeatedly confirmed the Tribe’s recognition under that name. 73 Fed. Reg. 18553, 18556 (April 4, 2008); 72 Fed. Reg. 13648, 13650 (March 22, 2007); 70 Fed. Reg. 71194, 71196 (November 25, 2005); 68 Fed. Reg. 68180, 68182 (December 5, 2003); 67 Fed. Reg. 46328, 46331 (July 12, 2002); 60 Fed. Reg. 9250, 9253 (February 16, 1995); 53 Fed. Reg. 52829, 52831 (December 29, 1988); 50 Fed. Reg. 6055, 6057 (January 25, 1985); 47 Fed. Reg. 53130, 53133 (November 10, 1982).

conduct gaming on its reservation. (S.E.R. 118:5–14.) After the Tribe resolved its access problem (through the construction of an interchange connecting the reservation to public roadways), and after defending years of litigation challenging its planned gaming project and the proposed interchange, the Tribe entered an amended compact with the State in July 2008, paving the way for the construction and operation of its Red Hawk Casino, which opened in December 2008. (*Id.*)

After the Tribe’s entry of the amended compact with the State, on or about August 19, 2008, without telling the Tribe, Mr. Caballero filed with the Office of the County Clerk of El Dorado, California, a Fictitious Business Name Statement declaring, under penalty of perjury, that he is doing business as the “Shingle Springs Band of Miwok Indians.” (S.E.R. 118:15–19, 170–171; 205:5–8.) On the same day, Mr. Caballero, who lives in El Dorado County, applied for, and subsequently received, a business license issued by El Dorado County under the name “Shingle Springs Band of Miwok Indians.” (S.E.R. 175:13–16, 205:19–21.)

On February 5, 2009, Mr. Caballero attended a rally outside the State Capitol Building in Sacramento, California, presenting himself as a representative of the “Shingle Springs Band of Miwok.” (S.E.R. 175:17–176:3, 214–221, 205:27–206:3.) Mr. Caballero distributed a flyer promoting the rally, which lists as a guest speaker “Cesar Caballero - Shingle Springs Band of Miwok.” (S.E.R. 175:17–176:3, 214–221.) As a result, a reporter for a Northern California newspaper covering the rally reported that Mr. Caballero was a guest speaker and

representative “of the Shingle Springs Band of Miwok.” (S.E.R. 176:4–8, 206:7–11, 222–224.)

Mr. Caballero controls an unauthorized website which he purports to maintain as the “Shingle Springs Band of Miwok Indians” of the “Shingle Springs Reservation.” (S.E.R. 176:9–15, 186:13–18, 206:15–17, 225–226.) Information on the website states that Mr. Caballero is operating the website in his capacity as “Tribal Historian” and provides an email address inviting visitors to submit “Enrollment Questions.” (S.E.R. 225–226.) Mr. Caballero has also distributed to members of the public business cards identifying himself as the “Shingle Springs Miwok Chief.”<sup>4</sup> (S.E.R. 186:19–21, 206:18–20.)

On or about August 23, 2010, the Tribe stopped receiving its United States Postal Service (“USPS”) mail deliveries at its government offices. (S.E.R. 118:20–119:3.) Upon discovery that the Tribe’s official government mail had been diverted, Nicholas Fonseca, the Tribe’s Chairman, called the local post office and learned that Mr. Caballero had changed the Tribe’s address. (*Id.*) Chairman Fonseca visited the post office, where he obtained a copy of an official USPS change of address form, which had been signed by Cesar Caballero, purportedly of

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<sup>4</sup> Mr. Caballero’s fantasy life has other contours: in December, 2009, through other counsel, he filed a brief amicus curiae in a pending U.S. Supreme Court case, *Wolfchild v. U.S.*, No. 09-579, in the name of “Historic Shingle Springs Miwok.” (SER 176:24–27, 236.) Certiorari was denied as of April 19, 2010. (SER 176:24–27.)

the “Shingle Springs Miwok Tribe,” forwarding the mail to Mr. Caballero’s address commencing August 23, 2010. (S.E.R. 118:20–119:3, 172–173; *see* S.E.R. 310 (providing the same address that appears on the change of address form) and S.E.R. 170–171 (fictitious business statement bearing same address).)

Indeed, Mr. Caballero admitted—both in filings before the District Court, and in interviews with the U.S. Postal Inspector—that he submitted “Change of Address” forms with the USPS for the purpose of rerouting delivery of the Tribe’s mail to his own address. (S.E.R. 35:16–23, 36:3–9; E.R. 8-11:22–8-12:18.) Mr. Caballero accomplished this scheme by completing the requisite USPS forms for both of the Tribe’s mailing addresses—specifically, a physical address on the Tribe’s reservation and a P.O. box—while purporting to act on behalf of the “Shingle Springs Rancheria” and “Shingle Springs Band of Miwok Indians.” (S.E.R. 35:16–23, 36:3–9, 92:10–18; E.R. 6-24:6–17, 6-27–6-30, 6-34:13–16, 6-35–6-37, 8-11:22–8-12:18.)

Four days after the Court issued its TRO, Mr. Caballero returned to the Placerville Post Office to ask why the Tribe’s mail was not being forwarded to Mr. Caballero’s address, and to try to resurrect the fraudulently redirected mail deliveries. (S.E.R. 35:24–36:2; E.R. 6-24:18–6-25:14.) Mr. Caballero argued that he was authorized to act for the Tribe, and as “proof,” he produced what appeared to be a document from the Internal Revenue Service bearing Mr. Caballero’s address and variations of the Tribe’s name—“Shingle Springs Band of Miwok”

and “Shingle Springs Miwok Tribe.” (E.R. 4-12:24–4-13:12, 6-24:25–6-25:5, 6-31–6-32 8-11:22–8-12:18, 8-17–8-19; S.E.R. 36:10–17, 45–46.) The USPS employees at the post office were personally aware of the ongoing investigation and did not honor the request. (E.R. 6-24:18–6-25:5.) However, the USPS generally must honor official change of address forms, which are processed automatically at a central location away from the local post office. (E.R. 6-25:21–26.) The USPS has no system in place to preemptively prevent forwarding mail from a particular address. (S.E.R. 119:12–17; E.R. 6-25:21–26.)

Thus, it appears that for several days (until the Tribe discovered the diversion and was able to stop it), the Tribe’s mail bound for its government office was not received and was instead routed to Mr. Caballero. (S.E.R. 119:4–11.) The Tribe routinely receives confidential, sensitive, and proprietary communications at its governmental offices, which can include letters relating to management of its gaming operation, attorney communications, medical records of Tribal members or patients of the Tribe’s health clinic, checks of significant monetary value, and various other documents essential to its governmental operations. (*Id.*) Despite the existence of the District Court’s temporary restraining order directing Mr. Caballero “immediately return” to the Tribe all of the mail he diverted, and despite repeated requests for the mail from the Tribe’s legal counsel, Mr. Caballero did not “immediately” comply. (E.R. 9-3:16–17.) Rather, he waited until the day of the hearing (12 days after the TRO was issued) to check his “tribe’s” “office” for the

mail, which his attorney claimed at the hearing “the office” had simply dropped back in the mail. (Transcript, E.R. 3-9:19–3-10:1.)

### **Standard of Review**

This Court reviews a district court’s order granting a preliminary injunction for abuse of discretion. *Brown v. Cal. Dep’t of Transp.*, 321 F.3d 1217, 1221 (9th Cir. 2003). This Court also reviews the scope of injunctive relief for abuse of discretion. *Idaho Watersheds Project v. Hahn*, 307 F.3d 815, 823 (9th Cir. 2002). A district court abuses its discretion in issuing a preliminary injunction by basing its decision on either an erroneous legal standard or clearly erroneous factual findings. *Walczak v. EPL Prolong, Inc.*, 198 F.3d 725, 730 (9th Cir. 1999).

In determining whether a restriction on speech is constitutional, this Court conducts an independent, *de novo* examination of the facts. *Jacobsen v. United States Postal Serv.*, 993 F.2d 649, 654 (9th Cir. 1992).

The Court of Appeals may affirm the District Court’s decision on any ground fairly supported in the record, even if the District Court ruled on a different basis. *Lee v. United States*, 809 F.2d 1406, 1409 (9th Cir. 1987), *cert. denied*, 484 U.S. 1041 (1988).

### **Summary of Argument**

The District Court correctly decided there is “no question” the Tribe is likely to prevail on its claims. Mr. Caballero does not even try to attack the evidentiary foundations underpinning this finding. Instead, he seeks to distort federal law to

strip trademark protection from a category of enterprises this Court, and others, have confirmed enjoy Lanham Act protection.

The record establishes that both the Tribe and Mr. Caballero have used the Tribe's Mark for association and educational services relating to their respective tribal enterprises, but that the Tribe's use began much earlier. Whether or not the Tribe or Mr. Caballero profit, or try to, this competing use in the marketplace is precisely what the Lanham Act governs.

Through the Tribe's continuous use of its Mark, it has acquired secondary meaning among the relevant consumer groups for the services of an Indian tribe, including the public, the media, the United States, and other governments. Indeed, Mr. Caballero misappropriated the Tribe's exact Mark precisely because of the value and recognition it had acquired.

Not only is Mr. Caballero's use of the same Mark for the same type of services through the same marketing channels likely to cause confusion as to the services' source, but the record demonstrates that such confusion has already occurred. Governmental officials and the media have already mistaken Mr. Caballero's services on behalf of his "tribe" as those of the Tribe.

The District Court properly decided that equitable considerations require preliminary injunctive relief to prohibit Mr. Caballero from continuing to usurp the Tribe's identity for his own purposes. While infringement of a valid trademark alone can establish irreparable harm, the record confirms that Mr. Caballero's

conduct has already tangibly harmed the Tribe by causing confusion as to its Mark and interfering with mail directed to its tribal government. On the other hand, prohibiting Mr. Caballero from misleadingly using a Mark he copied from the Tribe causes him no harm, and implicates no First Amendment rights. Rather than usurping the name in which the Tribe has already created value, he can select among innumerable other names. He can still seek government benefits for his “tribe” in a manner that does not falsely purport to act on behalf of the Tribe. As Congress has confirmed, the public interest is served when courts prohibit trademark infringers from misleading the public as to the source of services.

Accordingly, the District Court properly ruled that Mr. Caballero’s opportunistic efforts to offer his services using the Tribe’s Mark must be preliminarily enjoined.

### **Argument**

#### **I. The District Court Properly Found The Tribe Is Likely To Succeed On The Merits.**

At the preliminary injunction hearing, the District Court found “there’s no question in my mind based on the evidence before the Court, that the plaintiff is likely to prevail on this [trademark] claim, on all the elements necessary” (Transcript, E.R. 3-15:6–10.) Undisputed facts in the record support this finding.

**A. The Record Supports The District Court’s Finding That The Tribe’s Mark Is Valid.**

The record contains no real evidentiary disputes regarding the validity of the Tribe’s Mark. Mr. Caballero concedes the Tribe began using the Mark decades ago in connection with the services of a Tribal government (Opening Brief, p. 6), and presents no evidence he used the Mark before then. Mr. Caballero also acknowledges that the Tribe and Mr. Caballero use the Mark “in connection with virtually identical services,” *i.e.*, tribal government association services and educational services. (Opening Brief, pp. 32–33.) Because the Lanham Act prohibits competing uses of a trademark likely to cause confusion, whether or not the use is for a fee or derives a profit, the District Court properly concluded the Tribe is likely to prevail. *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 679 (9th Cir. 2005); *Committee for Idaho’s High Desert v. Yost*, 92 F.3d 814, 818-19, 825-26 (9th Cir. 1996).

**1. The Tribe And Mr. Caballero Have Engaged In Commercial Use Under The Lanham Act Whether Or Not They Charge A Fee For, Or Profit From, Their Services.**

Because the Tribe and Mr. Caballero use the Tribe’s Mark in connection with competing services, Mr. Caballero has violated the Lanham Act. This is true whether or not Mr. Caballero or the Tribe earn—or attempt to earn—a monetary profit from their respective uses.

The Lanham Act is broad, prohibiting use of a trademark that is likely to cause confusion about the source of a product or service. *Bosley*, 403 F.3d at 676. The Act protects both registered and unregistered marks. *See* 15 U.S.C. §§ 1114(1), 1125(a). For unregistered marks, like the Tribe's Mark, the Act requires that the defendant's use be "on or in connection with any goods or services" and be likely to cause confusion, mistake or deception as to as to the origin of the "goods, services or commercial activities" of the defendant. 15 U.S.C. § 1125(a)(1)(A); *see Stanislaus Custodial Deputy Sherrifs' Ass'n v. Deputy Sheriff's Ass'n of Stanislaus County*, 2010 U.S. Dist. LEXIS 59177, \*22-23 (E.D. Cal. June 1, 2010).<sup>5</sup>

Although this Court has recognized a "commercial use" requirement for claims involving registered trademarks, it has confirmed the Act simply "does not require any actual *sale* of goods and services." *Bosley*, 403 F.3d at 679 (Ninth Circuit's emphasis). Rather than focusing on sales or profits, "the appropriate inquiry is whether [the defendant] offers *competing* services to the public." *Bosley*, 403 F.3d at 679 (citing *United We Stand America, Inc. v. United We Stand*,

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<sup>5</sup> Contrary to Mr. Caballero's suggestion in his opening brief, the Tribe did not contend before the District Court, nor did the District Court hold, that the Bureau of Indian Affairs "confer[s] trademarks" or that the BIA's listing of Indian entities is tantamount to trademark registration. (Opening Brief, p. 30.) The Tribe's application with the United States Patent and Trademark Office for federal trademark registration of "Shingle Springs Band of Miwok Indians" (Ser. No. 77/707,568) is pending. (SER 117:8-12.)

*America New York, Inc.*, 128 F.3d 86, 90 (2nd Cir. 1997)) (Ninth Circuit’s emphasis).

Nowhere does the Act require that trademark infringement requires goods or services be offered to fulfill a “profit motive.” 15 U.S.C. § 1125(a); *see* 15 U.S.C. § 1127 (the intent of the Lanham Act is to “mak[e] actionable the deceptive and misleading use of marks in . . . commerce” and “to protect persons engaged in . . . commerce against unfair competition”). Indeed, where Congress wishes to impose a “for-profit” requirement for infringement of intellectual property rights, it has done so expressly. *Cf.* 15 U.S.C. § 1125(d)(1)(A) (providing that a claim for domain name cybersquatting requires “a bad faith intent to profit from that mark”).

Of course, this Court has confirmed the Lanham Act’s protection of nonprofit organizations. *Committee for Idaho’s High Desert*, 92 F.3d at 818-19, 825-26 (protecting mark used in connection with nonprofit activities of environmental advocacy organization); *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981). Lower courts and courts from other Circuits agree. *United We Stand America, Inc.*, 128 F.3d at 89-90, 92 (applying the Lanham Act to a mark for expressive activities of a nonprofit political campaign and recognizing “[t]he Lanham Act has thus been applied to defendants furnishing a wide variety of non-commercial public and civic benefits”); *TE-TA-MA Truth Foundation-Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 667 (7th Cir. 2002) (enjoining

church's use of mark in connection with its expressive activities); *United States Jaycees v. San Francisco Junior Chamber of Commerce*, 354 F. Supp. 61, 71 (N.D. Cal. 1972) ("benevolent, religious, charitable or fraternal organizations are entitled to injunctive relief protecting against the continued use of their name by local chapters which disaffiliate"); see *SMJ Group, Inc. v. 417 Lafayette Restaurant LLC*, 439 F. Supp. 2d 281, 287 (S.D.N.Y. 2006) (Nonprofit organization advocating for restaurant workers "seek[s] to educate the public, an admirable service, but an individual being educated should not be misled about the source of that education, just as an individual purchasing a can of peas should not be misled about the source of those peas.").

This Court's decision in *Committee for Idaho's High Desert* is instructive as to the broad protection the Lanham Act provides trademarks of nonprofit organizations engaged in political advocacy, even where the infringing use also constitutes nonprofit expressive activity. 92 F.3d at 818-19, 825-26. The plaintiff in that case was a "non-profit environmental education and advocacy organization." *Id.* at 817. Under the mark "Committee for Idaho's High Desert" ("CIHD"), plaintiff offered services that included "dissemination of information on environmental issues through a variety of channels, advocacy of a conservationist agenda on its members' behalf, and education of the public about the desert." *Id.* at 821-22. Twelve years after plaintiff began using that mark, three individuals with "virtually antithetical" viewpoints to plaintiff's, formed a corporation under

the exact same name. *Id.* at 817, 821. The president of the newly formed corporation then testified at a public hearing held by the United States Air Force in support of a land use proposal plaintiff opposed. *Id.* at 818.

The district court found a trademark violation, holding that defendants “adopted and used [the CIHD name] in order to cause confusion, obstruct [CIHD’s] pursuit of its environmental agenda, and thereby to obtain an advantage in the snail de-listing litigation by preventing [CIHD’s] intervention.” *Id.* This Court affirmed and held that defendants’ formation of an organization under plaintiff’s trademark and their testimony before the U.S. Air Force constituted “us[e] in commerce, in connection with services” supporting liability under the Lanham Act. *Id.* at 823.

Mr. Caballero apparently reads this Court’s decision in *Bosley* as rewriting the Lanham Act to impose a commercial use requirement that would strip trademark protection from nonprofits and all those who provide their services, such as political advocacy or membership services, free of charge. (Opening Brief, pp. 23–25.) *Bosley* did nothing of the sort.

*Bosley* simply addressed whether the Lanham Act prohibited “noncommercial use of a trademark as the domain name of a website—the subject of which is consumer commentary about the products and services represented by the mark.” 403 F.3d at 674. Because the defendant only criticized the Bosley’s hair replacement services, and offered no competing services, “no customer will

mistakenly purchase a hair replacement service from [defendant] under the belief that the service is being offered by Bosley.” *Id.* at 679-80. Indeed, in *Bosely*, this Court cited with approval *United We Stand America*, 128 F.3d 86, for the Second Circuit’s reading of the Act’s commercial use requirement, which confirmed the Act protects of marks for nonprofit political activities. *Id.* at 679.

Caballero cites the district court opinion in *Stanislaus Custodial Deputy Sherrifs’ Ass’n v. Deputy Sheriff’s Ass’n of Stanislaus County*, 2010 U.S. Dist. LEXIS 21729 (E.D. Cal. March 10, 2010) (“*Stanislaus I*”), which does not support Mr. Caballero’s unprecedented reading of the Lanham Act. (Opening Brief, p. 23.) There, the plaintiff was a nonprofit association established to “provid[e] representation for its members relating to employment and working conditions” and to “endorse[] political candidates.” *Id.* at \*2. Judge O’Neill held that plaintiff failed to state a trademark claim where it failed to allege that the defendants, a nonprofit organization and its president, used plaintiff’s mark in connection with any goods or services. *Id.* at \*19.

After the plaintiff amended its complaint, Judge O’Neill held, in a subsequent decision Mr. Caballero chooses not to cite, that the Lanham Act protects marks designating nonprofit political activities. *Stanislaus Custodial Deputy Sherrifs’ Ass’n v. Deputy Sheriff’s Ass’n of Stanislaus County*, 2010 U.S. Dist. LEXIS 59177, \*22-24 (E.D. Cal. June 1, 2010) (“*Stanislaus II*”). The amended complaint alleged that plaintiff’s “name has good will within the

community and is associated in the mind of the public with its services” and that defendants “provide competing charitable and civic services.” *Id.* at \*26-27.

Following *Bosley*, Judge O’Neill concluded that those allegations stated a claim because “the Lanham Act protects trade names in a ‘competitive’ context.” *Id.* at \*26. Thus, even in the absence of profits or a profit motive for either plaintiff or defendants, defendants “reaped a commercial benefit” from the use of plaintiff’s mark supporting Lanham Act liability. *Id.* at \*27.<sup>6</sup>

Accordingly, to demonstrate commercial use under the Lanham Act, the Tribe must only show that the Tribe and Mr. Caballero engaged in competing use of the Mark.

**2. The Tribe Is Likely To Succeed In Demonstrating The Parties’ Competing And Commercial Use Of The Tribe’s Mark In Connection With Association And Educational Services.**

The Lanham Act protects not only traditional sales of goods services, but also marks for nonprofit association services, such as those offered by benevolent, religious, or charitable organizations, and political advocacy groups. *Bosley*, 403

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<sup>6</sup> To the extent the district court in *Hancock Park Homeowners Association v. Hancock Park Homeowners Association*, 2006 U.S. Dist. LEXIS 96211 (C.D. Cal. 2006) (Opening Brief, pp. 23-24) reads into the Lanham Act a “for profit” requirement for infringement absent from the statute’s text or a “commercial use” requirement inconsistent with this Court’s decisions, this Court should—indeed, must—decline Mr. Caballero’s invitation to follow that lower court. *Bosley*, 403 F.3d at 679; *Committee for Idaho’s High Desert*, 92 F.3d at 818-19, 825-26; see *Stanislaus II*, 2010 U.S. Dist. LEXIS 59177, \*19-27 (rejecting *Hancock Park* holding in light of binding Ninth Circuit precedent).

F.3d at 679; *Committee for Idaho's High Desert*, 92 F.3d at 818-19, 825-26; *United We Stand America*, 128 F.3d at 88; *United States Jaycees*, 354 F. Supp. at 71. It also protects marks for nonprofit educational services. *SMJ Group, Inc.*, 439 F. Supp. 2d at 287. Thus, the Tribe's and Mr. Caballero's respective uses of the Tribe's Mark for association and education services fall within the scope of services governed by the Act.

For many years, the Tribe has used the mark "Shingle Springs Band of Miwok Indians" in connection with providing a website with information about the Tribe, its governmental and commercial activities, and its history and culture. (S.E.R. 94:6-10, 94:16-19, 111-115.)

The Tribe has also produced educational publications and newsletters regarding the Tribal community's history, government and society. (S.E.R. 94:6-10, 94:16-19, 96-115; 117:18-23, 156-167.) The Tribe has also used its Mark in its dealing with the United States, local government entities, and the public in the course of providing government services to its members. (S.E.R. 117:8-17, 120-155, 168-169; 94:16-19, 111-113, 325:8-24, 326:23-327:3, 338:7-18.)

Mr. Caballero attempted to capitalize on the Tribe's fame by setting up an unauthorized website which he purports to operate as the "Shingle Springs Band of Miwok Indians" of the "Shingle Springs Reservation." (S.E.R. 176:9-15, 186:13-18, 206:15-17, 225-226.) The website advertises Mr. Caballero's services as a "Tribal Historian." (*Id.*) It advertises Mr. Caballero's association services,

providing an email address to which it invites visitors to submit questions about enrollment in his association. (*Id.*) Mr. Caballero's services, providing education about the history of Indians in Northern California and offering association services relating to membership in an Indian tribal entity, directly compete with the Tribe's services. Thus, whether or not Mr. Caballero or the Tribe make a profit, his use is commercial within the meaning of the Lanham Act. *Bosley*, 403 F.3d at 679.

Mr. Caballero's deceptive conduct directed toward the federal government and its employees is also commercial use within the meaning of the Lanham Act. In *Committee for Idaho's High Desert*, this Court confirmed that "public officials and agencies," were part of the "relevant 'consumer' group" of the environmental advocacy group's services. 92 F.3d at 822. As such, testimony of defendant organization's president, under the name of plaintiff's organization, before the U.S. Air Force was "us[e] in commerce, in connection with services" infringing plaintiff's trademark within the meaning of the Lanham Act. *Id.* at 823. Similarly, here, the United States government, with whom the Tribe has had a government-to-government relationship for over thirty years, is part of the "relevant 'consumer' group" of the governmental services the Tribe carries out on behalf of its members. (S.E.R. 117:8–17, 122–124, 128–153.) *See* 25 U.S.C. § 2 ("The Commissioner of Indian Affairs shall, under the direction of the Secretary of the Interior, and agreeably to such regulations as the President may prescribe, have the management

of all Indian affairs and of all matters arising out of Indian relations.”). Because government instrumentalities, like the USPS, are part of the relevant consumer group for the Tribe’s government services, Mr. Caballero’s misappropriation of the Tribe’s Mark in “educating” postal employees about the Tribe’s history directly competes with the Tribe’s services within the meaning of the Lanham Act. *Bosley*, 403 F.3d at 679.

Moreover, the postal employees to whom Mr. Caballero purported to provide information regarding the Tribe’s “history” are among the “relevant ‘consumers’” of the information services the Tribe offers to the general public. Mr. Caballero’s attempt to provide directly competing services to the individual postal employees under the Tribe’s Mark violates the Lanham Act.

Indeed, apart from his competing use, Mr. Caballero has submitted multiple official government filings attesting that his use of the Tribe’s Mark is in the nature of a commercial business. On or about August 19, 2008, without telling the Tribe, Mr. Caballero filed with the Office of the County Clerk of El Dorado, California, a Fictitious Business Name Statement. (S.E.R. 118:15–19, 170–171; 205:5–8.) The Statement declares, under penalty of perjury, that he had “commenced to transact business under the fictitious business name” of “Shingle Springs Band of Miwok Indians.” (S.E.R. 118:15–19, 170–171; 205:5–8.) On the same day, Mr. Caballero also applied for a “Business License” under the name “Shingle Springs Band of

Miwok Indians,” which issued September 10, 2008. (S.E.R. 175:13–16, 205:19–21, 211–213.)

Mr. Caballero’s argument that the Tribe’s Mark does not deserve trademark protection is strange (or simply self-serving) because his own trademark application, signed under penalty of perjury, asserted that the “Shingle Springs Band of Miwok Indians” is protectable as a trademark for the services of his Indian “tribe.” (S.E.R. 12.) Specifically, Mr. Caballero contended that the “Shingle Springs Band of Miwok Indians” mark was registrable as a mark for “[a]ssociation services, namely, organizing chapters of a fraternity and promoting the interests of the members thereof” and providing “[i]nformation in the field of government affairs.” (S.E.R. 12–13.) Mr. Caballero further attested that the “Shingle Springs Band of Miwok Indians” mark “has become distinctive of the goods/services through [Mr. Caballero’s] substantially exclusive and continuous use in commerce for at least the five years.” (S.E.R. 14.) Similarly, Mr. Caballero’s unsuccessful counterclaims against the Tribe asserted that he was the owner of the Mark, and that the Tribe’s use of that Mark “in a commercial venture, trade, business and/or solicitation” violated his trademark rights. (S.E.R. 335:16–18, 336:13–337:6.)

Moreover, even if the trademark infringement provisions of the Lanham Act required an intent to profit, the record supports a finding that Mr. Caballero intended to profit from usurping the Tribe’s identity. Mr. Caballero did not seek to use the Tribe’s decades-old name until August 2008, after the Shingle Springs

Band cleared the last legal hurdle to the construction and operation of a gaming facility on its reservation. It is undisputed Mr. Caballero has reserved websites with the name of the Tribe's gaming facility, Red Hawk Casino. (Opening Brief, p. 8; S.E.R. 9:10–15, 25–33.) A defendant's "pattern of registering multiple domain names containing famous trademarks" is "highly relevant" to determining whether defendant 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); *E. & J. Gallo Winery v. Spider Webs, Ltd.*, 286 F.3d 270, 276 (5th Cir. 2002); *cf.* 15 U.S.C. § 1125(d)(1)(B)(i)(VIII) (relevant factor in determining "bad faith intent to profit" is "the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names"). Additionally, Mr. Caballero's own pleadings in this litigation demonstrate he seeks to financial gain from usurping the Tribe's identity. (*See* S.E.R. 342:24–27 (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").)

The District Court did not abuse its discretion by concluding that the Tribe's uncontradicted evidence, and Mr. Caballero's admissions, show the Tribe is likely succeed in demonstrating commercial use of its Mark.

**3. Uncontradicted Evidence In The Record Demonstrates The Tribe's Priority Of Use.**

Uncontradicted evidence in the record demonstrates the Tribe used its Mark extensively before Mr. Caballero. “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 commences use of a mark has a right superior to any subsequent user. *Id.*

It was not until August 19, 2008, that Mr. Caballero filed a fictitious business name statement, purporting to do business as the “Shingle Springs Band of Miwok Indians.” (S.E.R. 118:5–14, 170–171; 205:5–8.) Indeed, Mr. Caballero’s opening brief admits that the Tribe’s continuous use began decades earlier. (Opening Brief, p. 6.)

By the time Mr. Caballero decided to misappropriate its Mark, the Tribe had already become well known across California, and especially in El Dorado County, for its plans to build Red Hawk Casino on the Shingle Springs Rancheria. The Tribe signed a gaming Compact with the State of California in 1999, and an amended Compact in July 2008, an occurrence that resulted in extensive publicity for the Tribe and was covered by local and regional media. (S.E.R. 168–169; 227–232.)

Mr. Caballero does not seriously dispute that the Tribe’s use of the Mark predates his. Rather, he suggests vaguely that “Defendant has used his ethnic and

historic identity continuously, and his tribe has been present and similarly existed as Miwok Indians through their history.” (Opening Brief, p. 32.) In support, Mr. Caballero cites Excerpts of Record numbers 11 and 12, in their entirety, without pinpoint citations. (*Id.*) Neither excerpt supports Mr. Caballero’s assertion or reflects any usage of “Shingle Springs Band of Miwok Indians” by Mr. Caballero or anyone else.<sup>7</sup>

In any event, even if someone used “Shingle Springs Band of Miwok Indians” before the Tribe (and nothing in the record suggests that is the case), “a third party’s prior use of a trademark is not a defense in an infringement action.” *Committee for Idaho’s High Desert*, 92 F.3d at 820.

Given the uncontradicted evidentiary record showing the Tribe’s prior use of its Mark in commerce, the District Court did not abuse its discretion in finding the Tribe’s rights superior to Mr. Caballero’s.

**4. Uncontradicted Evidence In The Record Demonstrates The Tribe’s Mark’s Secondary Meaning.**

Whether or not the Tribe’s Mark is descriptive, the record establishes the Mark has acquired distinctiveness entitling it to trademark protection.

“[D]escriptive marks may acquire the distinctiveness which will allow them to be

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<sup>7</sup> Although Mr. Caballero’s index to his Excerpts of Record describes Excerpt of Record 12 as “[a]ffidavits supporting Class Action Cross Complaint and Answer to Complaint,” they are actually *unauthenticated exhibits* to Mr. Caballero’s “Cross Complaint.” (See Docket #11.)

protected under the Act. . . . This acquired distinctiveness is generally called ‘secondary meaning.’” *Two Pesos v. Taco Cabana*, 505 U.S. 763, 769 (1992).

“Secondary meaning is used generally to indicate that a mark . . . ‘has come through use to be uniquely associated with a specific source.’” *Id.* at 766 n.4.

Where a mark is a composite of more than one term, it should be viewed as a whole. *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1455 (9th Cir. 1985); *Committee for Idaho’s High Desert*, 92 F.3d at 821-23 (rejecting argument that the terms “Idaho’s high desert” and “committee” were generic and concluding that “Committee for Idaho’s High Desert” was protectable on a showing of secondary meaning).

**a) The Record Demonstrates Fulfillment Of This Court’s Secondary Meaning Factors.**

“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*, 92 F.3d at 822. Where the trademark is used in connection with political advocacy, the focus is nevertheless on the “relevant ‘consumer’ group.” *Id.* (defining environmental advocacy association’s “relevant ‘consumer’ group” as the association’s “members and

potential members, public officials and agencies involved in making policy decisions on [the] lands [in question], conservationist groups and individuals, and other members of the interested public”).

The record before the District Court contains undisputed facts demonstrating its Mark has acquired secondary meaning among the relevant consumer groups. Specifically, the Tribe’s government has functioned under its tribal name, and used that name in its dealings with the United States, for over thirty years (45 Fed. Reg. 27828, 27830 (April 24, 1980); 74 Fed. Reg. 40218, 40221 (August 11, 2009)). The Tribe has used and advertised its tribal name extensively in connection with governmental services it provides on behalf of its members and educational services it provides to the public. (S.E.R. 117:13–23, 120–124, 156–167; 94:6–10, 94:16–19, 111–113.) The State, local governments, and public associate the Tribe’s government operations with its Mark. (S.E.R. 117:8–17, 120–155, 168–169; 178–179, 227–232.) In fact, as Mr. Caballero’s own counterclaims admitted, through “systematic” use and advertising of the Tribe’s Mark, “the Bureau of Indians [sic] Affairs, The County of El Dorado, The State of California, Local Agency Formation Commission, El Dorado Irrigation, investors or bond holders and the public” have come to associate the Tribe’s governmental operations with the Tribe’s federally recognized name. (S.E.R. 325:8–24, 326:23–327:3, 338:7–18.)

This record further demonstrates the Tribe's use was exclusive for decades until Mr. Caballero began to use the Mark in 2008. (S.E.R. 118:5–14, 168–171; S.E.R. 205:5–8, 227–232.) Indeed, the District Court specifically found that, although the Tribe used its Mark “for over 30 years,” “[i]t is of no coincidence . . . that Mr. Caballero was nowhere to be found until [the Tribe's] casino was built, and suddenly he declared himself to be the true owner of the name [and] the head of this tribe.” (Transcript, E.R. 3-15:14–19.)

Mr. Caballero suggests that the Tribe's Mark lacks secondary meaning because its use has not been exclusive, asserting that Mr. Caballero “has used his ethnic and historic identity continuously” and that his “tribe” has “existed as Miwok Indians through their history.” (Opening Brief, p. 32.) Neither of the excerpts of record Mr. Caballero cites, nor anything else in the record, supports this assertion. (E.R. 11, 12.) In any event, that a portion of the Tribe's Mark may be descriptive of Mr. Caballero or another person in no way prevents the Tribe from creating, and the public attaching, secondary meaning in its Mark. *See Two Pesos*, 505 U.S. at 769; *California Cooler, Inc.*, 774 F.2d at 1455.

Importantly, nowhere does Mr. Caballero suggest, much less point to evidence in the record, that he, or anyone else, used the actual mark “Shingle Springs Band of Miwok Indians” before the Tribe did. Indeed, even if the record substantiated Mr. Caballero's assertion that he or someone else used the Tribe's Mark at some other time, the District Court properly accepted the Tribe's

uncontroverted evidence that the public nevertheless associates the Tribe's Mark with the services it provides.

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

In fact, "[p]roof of exact copying, without any opposing proof, can be sufficient to establish a secondary meaning." *Committee for Idaho's High Desert*, 92 F.3d at 823. The rationale is that "[t]here is no logical reason for the precise copying save an attempt to realize upon a secondary meaning that is in existence." *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1016 (9th Cir. 1985). Here, Mr. Caballero intentionally adopted the exact Mark of the Tribe's at the precise moment when the fame of the Tribe's Mark exploded because of publicity the Tribe's gaming venture. (Transcript, E.R. 3-15:14-19.) He did so out of an expressed belief that the Tribe should not have been recognized by the United States by the name "Shingle Springs Band of Miwok Indians." (S.E.R. 332:5-23, 335:24-336:9.) That Mr. Caballero admittedly adopted the Tribe's exact name by itself establishes secondary meaning. *Committee for Idaho's High Desert*, 92 F.3d at 823.

**c) The Record Demonstrates Secondary Meaning Among The Relevant Consumer Groups.**

Without questioning the Tribe's undisputed evidence that the public associates the Tribe's Mark with the Indian tribal and educational services it provides, Mr. Caballero asserts that the Tribe's Mark lacks secondary meaning.

(Opening Brief, pp. 31–32.) Specifically, he asserts that there is no evidence of “purchasers,” “advertise[ment],” or “use” connected with the Tribe’s Mark because the Tribe has not used its Mark “in conjunction with the sale of any good or service.” (*Id.*) In essence, this position simply restates his argument that nonprofit services offered for free lack Lanham Act protection. As discussed above (*supra* pp. 15–21), this contention finds no support in the law of this Circuit. *Bosley*, 403 F.3d at 679; *Committee for Idaho’s High Desert*, 92 F.3d at 821.

In *Committee for Idaho’s High Desert*, this Court held that the “relevant ‘consumer’ group” for a nonprofit environmental advocacy organization was not purchasers of any good or services, but rather “members and potential members, public officials and agencies involved in making policy decisions on [the] lands [in question], conservationist groups and individuals, and other members of the interested public.” *Id.* at 822. Thus, this Court upheld the district court’s finding of secondary meaning where “[a] reporter on environmental issues, a former state senator and environmentalist, a political science professor specializing in environmental politics, and a fifteen-year Bureau of Land Management employee” associated the mark at issue with the plaintiff. *Id.* This Court went on to hold that the organization’s advertising of its nonprofit advocacy activities supported a finding of secondary meaning under the Lanham Act. 92 F.3d at 822.

Here, likewise, the Tribe’s showing that government officials and the public associate the Tribe’s Mark with its services supports a finding of secondary

meaning. The Tribe's advertisement of its association and educational services similarly supports a finding of secondary meaning, whether or not the services it advertises are "for sale." *Id.*; see *Bosley*, 403 F.3d at 679.

Because uncontradicted record evidence supports each of the factors this Court has identified as proof of secondary meaning, the District Court did not abuse its discretion in finding the Tribe's would likely succeed in demonstrating its Mark is valid.

**B. Mr. Caballero Does Not Dispute The Record Supports The District Court's Finding Mr. Caballero's Conduct Is Likely To Confuse.**

The Ninth Circuit uses an eight factor test for evaluating the likelihood of confusion caused by infringement, which it enunciated in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979). The "*Sleekcraft*" factors are: "(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 is not a rigid set of requirements, but rather "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). "Especially at the preliminary injunction stage, the court is

not required to examine every one of the eight factors.” *See Apple Computer, Inc. v. Formula International, Inc.*, 725 F.2d 521, 526 (9th Cir. 1984). Any doubts about likelihood of conclusion 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 (9th Cir. 1997).

Importantly, Mr. Caballero points to no evidence in the record relating to the *Sleekcraft* factors or in any way suggesting that the District Court abused its discretion in concluding Mr. Caballero’s use of the Tribe’s Mark is likely to confuse the relevant consumers of the Tribe’s services. Instead, Mr. Caballero simply reasserts there were no “mistaken purchasing decisions” because, under his unique and erroneous view of the Lanham Act, the Tribe and Mr. Caballero did not engage in commercial use. (Opening Brief, p. 32.) Of course, as discussed above (*supra* pp. 15–21), the Lanham Act’s protection is much broader than Mr. Caballero would like and extends to the Tribe’s and Mr. Caballero’s respective uses of the Mark. *Bosley*, 403 F.3d at 679; *Committee for Idaho’s High Desert*, 92 F.3d at 821.

In any event, undisputed record evidence shows the Tribe is likely to prevail in establishing the *Sleekcraft* factors.

### **1. Strength Of The Tribe’s Mark**

The Tribe’s Mark has become well known and synonymous with the Tribe’s government operations and related services in El Dorado County and beyond.

(S.E.R. 117:8–17, 120–155, 168–169; 227–232.) Indeed, it appears to be the very value of the Tribe’s name—its goodwill forged through relationships with the local and federal governments and outreach to the public—that led Mr. Caballero to copy the Tribe’s name and use its reputation for his own ends. (*See* S.E.R. 325:8–24, 326:23–327:3, 338:7–18.)

The strength of a mark is 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 United States and other governments associate the Tribe’s services with its Mark. 74 Fed. Reg. 40218, 40221 (August 11, 2009) (S.E.R. 325:8–24, 326:23–327:3, 338:7–18; 125–155; 178–179.) Through media coverage and the Tribe’s advertising and web presence, the general public also associates the Tribe with its Mark, a fact Mr. Caballero also has admitted. (S.E.R. 118:20–27, 170–173; 94:6–19, 96–113; 325:8–24, 326:23–327:3, 338:7–18.) The strength of the Tribe’s decades-old Mark supports a finding that Mr. Caballero’s infringement is likely to cause confusion.

## **2. 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). The Tribe uses its Mark in connection with virtually identical services to

Mr. Caballero's: operating a Tribal government and educating the public about the Tribe's culture, government, and history. (S.E.R. 94:6–19, 96–115; 176:9–15, 186:13–18, 205:15–17, 225–226.)

### **3. Similarity Of The Marks/Caballero's Intent**

The greater the similarity between the two marks, 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.* (use of the marks "Livewire Studios," "Livewire Media," and "Livewire Network Services" infringed the mark "Live Wire" and were preliminarily enjoined); *Golden Door, Inc. v. Odisho*, 646 F.2d 347, 350 (9th Cir. 1980). If the product type is identical, less similarity in the marks is necessary to support a finding of infringement. *Guess?, Inc.*, 993 F. Supp. at 1283.

Here, Mr. Caballero used an identical mark to the Tribe's Mark, "Shingle Springs Band of Miwok Indians," in connection with virtually identical services. (*Compare* S.E.R. 94:6–19, 96–115 *with* S.E.R. 176:9–15, 186:13–18, 206:15–17, 225–226.) Indeed, the entire theory behind Mr. Caballero's failed counterclaims is that he and his purported "tribe" intentionally adopted the Tribe's Mark out of a belief that the Tribe should not have been recognized by the United States by the name "Shingle Springs Band of Miwok Indians." (S.E.R. 332:5–23, 335:24–

336:9.) “When the alleged infringer knowingly adopts a mark similar to another’s, reviewing courts presume that the defendant can accomplish his purpose: that is, that the public will be deceived.” *Sleekcraft*, 599 F.2d at 354. “In effect, such a finding shifts the burden to the defendant to show that his efforts have proven unsuccessful.” *HMH Pub. Co., Inc. v. Brincat*, 504 F.2d 713, 720 (9th Cir. 1974). Having intentionally adopted the name he admits the Tribe has been using for decades, with the imprimatur of the United States, Mr. Caballero fails to meet his burden to show that his use is not likely to deceive the public.

Mr. Caballero’s use of the confusingly similar term “Shingle Springs Miwok Tribe” also infringes the Tribe’s Mark and gives rise to a presumption of confusion. (E.R. 6-24:25–6-25:5, 6-31–6-32; S.E.R. 36:10–17, 45–46, 118:20–119:3, 172–173.) That term shares three of the major terms with the Tribe’s Mark, and substitutes the word “Tribe,” a generic term referring to a group of Indians, in the place of “Band of . . . Indians.” See *Electropix*, 178 F. Supp. 2d at 1131; *Golden Door, Inc. v. Odisho*, 646 F.2d at 350. Moreover, Mr. Caballero left no doubt as to his intent to deceive the USPS, by listing the address of the Tribe’s government as his own. (S.E.R. 118:15–18, 172–173.)

Mr. Caballero’s use of the Tribe’s exact Mark, and confusingly similar terms, for the very purpose of deception, supports the District Court’s finding the Tribe probably will succeed on the merits in demonstrating a likelihood of confusion.

#### 4. Evidence Of Actual Confusion

Although evidence of actual confusion is not necessary to prevail at trial or at the preliminary injunction stage, “[e]vidence that use of the two marks has already led to confusion is persuasive proof that future confusion is likely.” *Sleekcraft*, 599 F.2d at 352. Here, Mr. Caballero successfully halted the Tribe’s mail service by impersonating the Tribe and submitting a phony change of address form on its behalf, thereby convincing USPS employees he was authorized to divert the Tribe’s mail. (E.R. 4-12:24–4-13:12; S.E.R. 118:15–18, 172–173; 92:10–18.) Also, Mr. Caballero previously convinced El Dorado County officials to lodge a fictitious business statement under the Tribe’s Mark and to issue him a business license under that name. (S.E.R. 118:5–14, 170–171; 205:5–8, 205:19–21, 211–213.) Additionally, Mr. Caballero’s deception caused a reporter for the *Lake County News* to erroneously report that Mr. Caballero was a guest speaker “of the Shingle Springs Band of Miwok” at a rally regarding tribal corruption. (S.E.R. 175:17–176:8, 206:7–11, 214–224.) In sum, the record shows actual confusion, in that Mr. Caballero succeeded in duping government officials and the public into believing that he provides services on behalf of the “Shingle Springs Band of Miwok Indians,” demonstrating a strong likelihood that the Tribe will prevail on its claims.

## 5. 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).

Here, both the Tribe and Mr. Caballero use websites to promote their competing association and education services. (S.E.R. 94:6–19, 96–115, 176:9–15, 186:13–18, 206:15–17, 225–226.) 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.

Because the record demonstrates that the Tribe is likely to prevail on all of the relevant *Sleekcraft* factors, the District Court did not abuse its discretion in finding the Tribe was likely to succeed in showing a likelihood of confusion.

### **C. The District Court’s Fact Finding Methodology Complied With Applicable Law.**

The District Court’s Order issued following an expedited briefing and hearing schedule under Federal Rule of Civil Procedure 65. The Court reviewed the parties’ briefs and the accompanying evidence and found for the Tribe regarding each element of its trademark claims and on each requirement for

issuance of a preliminary injunction. (Transcript, E.R. 3-12:6, 3-12:14–16, 3-14:23–3-15:10.) This is precisely what a district court presented with such a motion must do. *FTC v. H. N. Singer, Inc.*, 668 F.2d 1107, 1109 (9th Cir. 1982) (where order granting preliminary injunction “made it clear that the court had considered the pleadings, memoranda and affidavits and had concluded that the [plaintiff] was likely to prevail upon the merits and that in the absence of preliminary relief immediate and irreparable harm would occur . . . explicit findings of fact were not necessary for meaningful appellate review”).

Mr. Caballero suggests the District Court abused its discretion by failing to make factual findings on each element of the Tribe’s claims before granting preliminary injunctive relief. (Opening Brief, p. 26.) The cases he cites in no way support his argument. *Walczak*, 198 F.3d at 730 (abuse of discretion will be found only when the court “base[d] its decision on either an erroneous legal standard or clearly erroneous factual findings”); *Federal Trade Commission v. Enforma Natural Products, Inc.*, 362 F.3d 1204, 1215 (9th Cir. 2004) (remanding for additional factual findings where defendants’ evidence “raise[d] a genuine dispute” and “there [was] no record of the hearing or conference that preceded the grant of the petition for preliminary injunctive relief”); *LGS Architects, Inc. v. Concordia Homes of Nevada*, 434 F.3d 1150, 1155 (9th Cir. 2006) (remand not necessary where district court’s reasoning consisted of a single sentence and entitlement to the preliminary injunction was based on a legal issue).

Mr. Caballero makes much of a factual dispute regarding whether Gregory Wayland, a law clerk for Mr. Caballero's attorney, violated the temporary restraining order. (Opening Brief, pp. 34–35.) In ruling in Mr. Wayland's favor, the District Court disregarded certain statements in third-party declarations that the Tribe submitted regarding Mr. Wayland's conduct. (Transcript, E.R. 3-8:16–24.) Mr. Caballero suggests this means the District Court abused its discretion in finding for the Tribe on other factual issues supporting an injunction against *Mr. Caballero*. (Opening Brief, pp. 27, 34–35.)

To be sure, Mr. Caballero's Opening Brief does not identify a single piece of evidence in any way inconsistent with the Tribe's evidence regarding *Mr. Caballero's* conduct. In fact, the declaration of Lark Stone that Mr. Caballero submitted the morning of the preliminary injunction hearing actually corroborates the Tribe's evidence of Mr. Caballero's misrepresentations at the post office, confirming he presented false identification and purported to act on behalf of the Tribe. (E.R. 4-12:24–28.) Indeed, Ms. Stone's declaration even evidences her actual confusion as to the source of services under the Tribe's Mark. Specifically, a few days later, Ms. Stone met with Nicholas Fonseca, the Chairman of the Tribe, and did not believe was authorized to act on behalf of the Tribe because his Tribal identification looked different than Mr. Caballero's. (E.R. 4-12:24–4-13:12; S.E.R. 117:1–2.) Of course, even if a conflict in the evidence had existed, the District Court's resolution of a conflict in documentary evidence is unreviewable,

absent clear error. Fed. R. Civ. P. 52 (a)(6); *Nichols v. Azteca Rest. Enters.*, 256 F.3d 864, 871 (9th Cir. 2001).

**II. The District Court Properly Found The Tribe Will Suffer Irreparable Harm Absent An Injunction.**

This Court has held that “irreparable injury may be presumed from a showing of likelihood of success on the merits” of a trademark infringement claim. *Marlyn Nutraceuticals, Inc. v. Mucos Pharma GmbH & Co.*, 571 F.3d 873, 877 (9th Cir. 2009). Intangible injuries, such as damage to goodwill, constitute irreparable harm. *Regents of Univ. of Cal. v. American Broadcasting Cos.*, 747 F.2d 511, 519-20 (9th Cir. 1984); *PepsiCo, Inc. v. Reyes*, 70 F. Supp. 2d 1057, 1060 (C.D. Cal. 1999).

The record before the District Court demonstrates the repetitive and harmful nature of Mr. Caballero’s infringement. Mr. Caballero has acquired websites infringing the Tribe’s trademarks, and used the Tribe’s Mark on those websites by purporting to offer competing services on behalf of the Tribe. (S.E.R. 206:15–17, 225–226.) He has submitted fraudulent filings with the United States and local government, purportedly on behalf of the “Shingle Springs Band of Miwok Indians.” (S.E.R. 205:5–8, 205:19–21.) He has also distributed business cards representing that he is “Chief” of the Tribe. (S.E.R. 186:19–21, 196–97, 206:18–20.) Indeed, Mr. Caballero misappropriated the Tribe’s Mark to use it in conjunction with his services as a tribal historian, and has successfully deceived

the public regarding his affiliation with the Tribe. (S.E.R. 175:17–176:8, 206:7–11, 214–224.) The harm this deception causes the Tribe’s reputation is irreparable. *Regents of Univ. of Cal.*, 747 F.2d at 519-20.

Mr. Caballero has gone even further, harming the Tribe by representing to the USPS that he was authorized to act on behalf of the Tribe’s government to literally take the Tribe’s mail. (S.E.R. 118:20–119:3, 172–173; 92:10–18; 35:16–23, 36:3–9; E.R. 8-11:22–8-13:4.; E.R. 6-24:6–17, 6-27–6-30; E.R. 6-34:13–16, 6-35–6-37.) The record demonstrates that mail service is essential to the Tribe’s operations and its diversion irreparably harms the Tribe’s interests. (S.E.R. 119:4–11.)

Without citation to the record, Mr. Caballero suggests that the Tribe has “forc[ed] the post office to take actions to insure [sic] their mail was not diverted.” (Opening Brief, p. 33.) Not so. The record demonstrates that the Tribe cannot prevent Mr. Caballero from again diverting the Tribe’s mail, as the USPS must honor official change of address forms, and has no system in place to prevent the unauthorized forwarding of mail from a particular address. (S.E.R. 119:12–17; E.R. 6-34:5–12.) Additionally, the Tribe receives mail from a variety of commercial and governmental sources, many of which have procedures for changing the recipient’s mailing address, all of which are potentially vulnerable to Mr. Caballero’s apparent propensity to defraud them and the public as to his affiliation with the Tribe. (S.E.R. 119:12–17.)

Moreover, the record shows that, even if money damages from Mr. Caballero could compensate the Tribe for the injury it has suffered, and will continue to suffer, from his infringing conduct, Mr. Caballero lacks any means to pay such a judgment. (S.E.R. 308–309.) In connection with a motion to proceed *in forma pauperis* on a prior appeal, Mr. Caballero had filed a sworn statement with the District Court affirming that “because of [his] poverty, [he] cannot prepay the docket fees of [his] appeal or post a bond for them” and reciting that his total monthly income is \$300.00. (*Id.*) Thus, any injury he causes the Tribe is inherently irreparable by money damages. *Cornwell v. Sachs*, 99 F. Supp. 2d 695, 707 (E.D. Va. 2000) (damage to plaintiff’s reputation was irreparable where defendant was “judgment proof” and “could not even afford to hire counsel”).

Mr. Caballero suggests that the harm Mr. Caballero’s conduct has caused the Tribe does not result from “purchasing decisions” and so cannot be remedied under the Lanham Act. (Opening Brief, p. 33.) As discussed above (*supra* pp. 15–21), this misstates Ninth Circuit law. The Lanham Act protects the Tribe from Mr. Caballero’s infringement of its Mark in connection with offering “competing services to the public.” *Bosley*, 403 F.3d at 679 (emphasis deleted). By purporting to act as the Tribe’s historian and the Tribe’s chief in the course of offering “competing services,” Mr. Caballero has engaged in conduct that violates the Lanham Act and supports an injunction to prevent irreparable harm to the Tribe.

### **III. The District Court Properly Found The Balance Of Hardships Supports Injunctive Relief.**

The record supports the District Court's finding that the balance of hardships favors a preliminary injunction. Any harm to Mr. Caballero is outweighed by the significant harm the Tribe faces from his continual trademark infringement. Importantly, any claim by Mr. Caballero that he will suffer harm from an injunction prohibiting him from using the name by which the Tribe has been federally recognized for thirty years carries no weight in balancing the equities of injunctive relief. Where a person builds an enterprise by infringing the intellectual property of another, harm to that enterprise as a result of enjoining such infringement in no way affects the viability of an injunction. *Concrete Machinery Co., Inc. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 612 (1st Cir. 1988). This is true even for "a business which is exclusively based on an infringing activity and which would be virtually destroyed by a preliminary injunction." *Id.*

In any event, the District Court found that an injunction barring Mr. Caballero from using names confusingly similar to the Tribe's Mark would not harm him or his "tribe." Specifically, the District Court found that Mr. Caballero could select from "innumerable potential names for his tribe in which the [Tribe] ha[s] not already expended decades of effort and created valuable name recognition." (Transcript, E.R. 3-18:11-13.) The District Court emphasized the "injunction does not prevent Mr. Caballero from arguing that his tribal group

should be recognized by the United States.” (Transcript, E.R. 3-18:8–9.) Indeed, the District Court specifically ordered that “Mr. Caballero is free to make his case for federal recognition of his tribe to any government official or anyone else in authority who will listen,” so long as he does not “violate[] the [Tribe]’s trademark rights by *fraudulently usurping* the [T]ribe’s identity.” (Transcript, E.R. 3-18:8–9, 3-18:16–18 (emphasis added); *see* Order, E.R. 2-4:1–3 (permitting Mr. Caballero to petition on behalf of “any tribal entity he represents, so long as he does not misrepresent that he [is] authorized to speak or act for the Tribe”).)

Mr. Caballero cites Excerpt of Record number 7 for the proposition that he “cannot secure rights for his people” “without identifying his truthful Miwok heritage and his authority to represent Miwok Indians from the Shingle Springs area.” (Opening Brief, p. 36.) Excerpt of Record number 7 is the Tribe’s application for an order to show cause regarding contempt and its proposed order to show cause. (E.R. 7.) Neither that document, nor anything in the record, supports the proposition that Mr. Caballero must use a term confusingly similar to—let alone, pretend to represent—the “Shingle Springs Band of Miwok Indians,” to communicate to the United States (or others) that he has “Miwok heritage” or to explain that he represents “Miwok Indians from the Shingle Springs area” and that “his tribe” should be recognized.

The District Court’s order permits Mr. Caballero to continue providing his services as a historian and Indian tribal “chief” so long as he does not

misappropriate the Tribe's trademark to falsely represent that he is acting on behalf of the Tribe recognized by the United States, and the public, as the "Shingle Springs Band of Miwok Indians." (Transcript, E.R. 3-18:8-9; Order, E.R. 2-4:1-3.) Accordingly, the District Court did not abuse its discretion in concluding the balance of hardships favored such an injunction.

#### **IV. The District Court Properly Found An Injunction Is In The Public Interest.**

Trademark policies are designed "(1) to protect consumers from being misled as to the enterprise, or enterprises, from which the goods or services emanate or with which they are associated; (2) to prevent an impairment of the value of the enterprise which owns the trademark; and (3) to achieve these ends in a manner consistent with the objectives of free competition." *Intel Corp. v. Terabyte Int'l, Inc.*, 6 F.3d 614, 618 (9th Cir. 1993). Enjoining infringement furthers these goals because members of the public have a right not to be confused and deceived and to know "with whom they are doing business." *RE/MAX North Central, Inc. v. Cook*, 120 F. Supp. 2d 770, 775 (E.D. Wis. 2000). Because avoiding confusion to consumers is in the public interest, the likelihood of success of a trademark claim can by itself establish that injunctive relief is in the public interest. *ProtectMarriage.com - Yes on 8 v. Courage Campaign*, 680 F. Supp. 2d 1225, 1228 (E.D. Cal. 2010) (citing *Internet Specialties West, Inc. v. Milon-Digiorgio Enters.*, 559 F.3d 985, 993 (9th Cir. 2009)).

Additionally, the public has an interest in the orderly administration of Indian affairs, which is flouted where an individual unaffiliated with a federally recognized Indian tribe misappropriates the tribe's identity to pass his services off as the tribe's. *Seminole Nation v. Norton*, 223 F. Supp. 2d 122, 140 (D.D.C. 2002) (The United States "has the authority and responsibility to ensure that the [tribe's] representatives, with whom it must conduct government-to-government relations, are the valid representatives of the [tribe] as a whole." (citing *Seminole Nation v. United States*, 316 U.S. 286, 296 (1942))).

Not surprisingly, trademark law is in accord. *In re Julie White*, 73 U.S.P.Q.2d (BNA) 1713, 2004 TTAB LEXIS 529 (Trademark Tr. & App. Bd. 2004) ("[W]e have no doubt that the record supports refusal of registration of APACHE as a mark for cigarettes because use of the name of the federally recognized Apache tribes would falsely suggest a connection between applicant and those persons or institutions."); *In re White*, 80 U.S.P.Q.2d (BNA) 1654, 2006 TTAB LEXIS 263 (Trademark Tr. & App. Bd. 2006); *see* 15 U.S.C. § 1052(a) (prohibiting registration of marks that "falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols").

The public has a clear interest in avoiding deception as to the services a federally recognized Indian tribe provides. Accordingly, the District Court did not abuse its discretion in finding an injunction against Mr. Caballero furthers the public interest.

**V. The Scope Of The Injunction Is Proper.**

This Court may not disturb the scope of the District Court’s injunction absent an abuse of discretion. *Transgo*, 768 F.2d at 1021. In practical terms, this means that, “[t]o succeed in its attack on the injunction, [defendant] must show that there was no reasonable basis for the district court’s decision.” *Id.* An injunction need not address only past conduct, but “may be framed to bar future violations that are likely to occur.” *Id.* at 1022.

**A. The Court’s Preliminary Injunction Properly Prohibits Confusing Use Of The Tribe’s Mark.**

In a trademark case, the district court’s injunction may prohibit “any name or designation which [is] likely to cause confusion.” *Transgo*, 768 F.2d at 1022. In *Transgo*, defendants infringing the mark “Shift Kit” were properly enjoined from using the name “Shift Kit,” using any other name including the words “Shift” and “Kit,” and “using any name, designation or material . . . likely to cause confusion, mistake or deception as to source relative to plaintiff’s trademark.” *Id.* at 1021.

Here, as in *Transgo*, the Court’s preliminary injunction prohibits Mr. Caballero from using the terms “Shingle Springs Band of Miwok Indians,” “Shingle Springs Rancheria,” “Shingle Springs Miwok Tribe,” “Shingle Springs Miwok Indians,” or “any confusingly similar variation” of those terms. (Order, E.R. 2-3:20–23.) The District Court did not abuse its discretion by framing the

injunction to prohibit Mr. Caballero's use of terms confusingly similar to the Tribe's Mark.

**B. Mr. Caballero Has Not Challenged Several Provisions Of The District Court's Injunction, Waiving Any Objections Thereto.**

In addition to prohibiting Mr. Caballero from using the name "Shingle Springs Band of Miwok Indians" and confusing variations of that name, the District Court's injunction also prohibited the use of the term "Shingle Springs Rancheria," which is the name of the trust land held for the benefit of the Tribe. (Order, E.R. 2-3:20–23.) It also prohibited Mr. Caballero from "represent[ing] that he is associated with, or lives on, the Shingle Springs Rancheria, the sovereign territory and land base that is held in trust by the United States for the Tribe." (Order, E.R. 2-3:24–26.) In his Opening Brief, Mr. Caballero did not challenge the portion of the injunction prohibiting him from using the mark "Shingle Springs Rancheria" or suggest that the District Court erred in finding the Tribe was likely to prevail on its claims relating to that name. (*See, e.g.*, Opening Brief, pp. 1–2, 18–19, 25, 28.) Accordingly, any such arguments have been waived. *James River Ins. Co. v. Hebert Schenk, P.C.*, 523 F.3d 915, 920 n.1 (9th Cir. 2008) (issues which are not "specifically and distinctly" discussed in a party's opening brief are waived); *World Wide Rush, LLC v. City of Los Angeles*, 606 F.3d 676, 681 n.1 (9th Cir. 2010) (appellant waived two arguments it raised before the district court but failed to brief on appeal). Thus, this Court can and should summarily affirm those

portions of the injunction Mr. Caballero has failed to dispute, including the provisions restricting Mr. Caballero's representations regarding "Shingle Springs Rancheria."

**C. Mr. Caballero Enjoys No First Amendment Right To Misappropriate His Competitor's Trademark.**

This Court has "reject[ed] outright" the proposition that an injunction against trademark infringement is unconstitutional on the ground that it "constitutes a prior restraint in violation of free speech guaranteed by the United States Constitution." *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 n.11 (9th Cir. 1997); see *E. & J. Gallo Winery*, 967 F.2d at 1297 (trademark injunction does not implicate the First Amendment "because misleading commercial speech can be restricted."); accord *Transgo*, 768 F.2d at 1021–22. This is because "[t]he prohibition of the Lanham Act is content neutral, and therefore does not arouse the fears that trigger the application of constitutional 'prior restraint' principles." *Id.*

As this Court has held, so long as the plaintiff demonstrates the parties offer "competing services to the public," the commercial use requirement is satisfied. *Bosley*, 403 F.3d at 679 (Ninth Circuit's emphasis). Accordingly, where speech is misleading and uttered in connection with goods or services under the Lanham Act, no balancing of First Amendment rights and property rights is required. *E. & J. Gallo Winery*, 967 F.2d at 1297; *Transgo*, 768 F.2d at 1021–22. The Lanham

Act has already struck the proper balance, and requiring plaintiff to demonstrate the elements of trademark infringement protects free speech rights. *Transgo*, 768 F.2d at 1021-22.

Even where the services involved are expressive in nature, “[t]rademark rights promote the aims of the first amendment by enabling producers of the spoken and written word to differentiate themselves.” *TE-TA-MA Truth Foundation*, 297 F.3d at 667; see *Committee for Idaho’s High Desert*, 92 F.3d at 821; *United We Stand America*, 128 F.3d at 89-90, 92. Confusing use of marks in connection with expressive activities is unprotected commercial speech even where the relevant “consumers” of the services are government employees or others involved in the political process. *Committee for Idaho’s High Desert*, 92 F.3d at 822 (use of mark as identifier of source of testimony before U.S. Air Force violated Lanham Act); *United We Stand America*, 128 F.3d at 90 (where defendant engaged in “political organizing; established and equipped an office; solicited politicians to run on the [defendant’s] slate; issued press releases intended to support particular candidates and causes; endorsed candidates; and distributed partisan political literature” it provided “services” supporting liability under the Lanham Act); *San Francisco Arts & Ath. v. United States Olympic Comm.*, 483 U.S. 522, 541 (1987) (“The mere fact that the [defendant] claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to ‘appropriat[e] to itself the harvest of those who have sown.’”).

Mr. Caballero attempts to elevate to a constitutional level his argument that the Tribe's and Mr. Caballero's use of the Mark is not "commercial." (Opening Brief, pp. 18–22.) While Mr. Caballero's narrow view of "commercial use" is inconsistent with the law of this Circuit in any event (*supra* pp. 15–21) (not to mention his own trademark application filed under penalty of perjury), Mr. Caballero's own authorities confirm that the Lanham Act's terms, on their face, ensure compliance with the First Amendment, making a separate constitutional inquiry unnecessary. *Taubman Co. v. Webfeats*, 319 F.3d 770, 775 (6th Cir. 2003) (because "any expression embodying the use of a mark not 'in connection with the sale . . . or advertising of any goods or services,' and not likely to cause confusion, is outside the jurisdiction of the Lanham Act and necessarily protected by the First Amendment" . . . "we need not analyze [defendant]'s constitutional defenses independent of our Lanham Act analysis").

Mr. Caballero's First Amendment argument fails to comprehend the distinction between the use of another's trademark as a "communicative message" and the unprotected use as "a source identifier." *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002); *United We Stand America*, 128 F.3d at 92 (use of mark in connection with political organizing did not trigger First Amendment scrutiny when used "as a source identifier"). It is only where a trademark has "taken on an expressive meaning apart from its source-identifying

function,” that First Amendment concerns can come into play at all. *MCA Records*, 296 F.3d at 900.

The cases Mr. Caballero cites involving parody of trademarks have no application where defendant uses plaintiff’s trademark as a source identifier. *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 967 (10th Cir. 1996) (parody does not create consumer confusion as to source because “parody relies upon a *difference* from the original mark, presumably a humorous difference, in order to produce its desired effect” (Tenth Circuit’s emphasis)); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32 (1st Cir. 1987) (holding that defendant “did not use Bean’s mark to identify or promote goods or services to consumers” and suggesting that “[a] parody which causes confusion in the marketplace implicates the legitimate commercial and consumer protection objectives of trademark law”).

Mr. Caballero does not argue, nor does the record suggest, that he has used the term “Shingle Springs Band of Miwok Indians” for parody, or for any expressive purposes apart from falsely representing that he is providing services on the Tribe’s behalf. Accordingly, the District Court properly held that Mr. Caballero’s infringing conduct consisted of falsely “representing that he represents the [T]ribe.” (Transcript, E.R. 3-17:19–24.) In any event, the Court’s injunction prohibits no such expressive usage, but only Mr. Caballero’s use of “confusingly similar terms” suggesting that “he is associated with or a representative of” the

Tribe. (Order, E.R. 2-3:20–23.) The Court emphasized that the injunction did not reach Mr. Caballero’s attempts to petition “any government official or anyone else in authority who will listen” so long as he does not “fraudulently usurp[] the [T]ribe’s identity.” (Transcript, E.R. 3-18:14–18; Order, E.R. 2-4:1–3.) Mr. Caballero could select from “innumerable potential names for his tribe in which the [Tribe] ha[s] not already expended decades of effort and created valuable name recognition.” (Transcript, E.R. 3-18:11–13.) Mr. Caballero simply has no right, constitutional or otherwise, to provide competing services under the Tribe’s Mark.

Accordingly, the scope of the District Court’s injunction is properly limited to use that misleads consumers of the Tribe’s services into identifying Mr. Caballero’s services as the Tribe’s. *Transgo*, 768 F.2d at 1021-22.

In addition to the established governmental interest in protecting consumers of services from being misled, which deprives Mr. Caballero’s false commercial speech of Constitutional protection, Congress has expressed a special interest in the accurate designation of Indian tribes by their federally recognized names. Federally Recognized Indian Tribe List Act of 1994, Pub. L. No. 103-454, § 103(2), 108 Stat. 4791 (finding “the United States has a trust responsibility to recognized Indian tribes, maintains a government-to-government relationship with those tribes, and recognizes the sovereignty of those tribes”); 25 U.S.C. §§ 479a, 479a-1 (requiring Secretary of the Interior to annually publish a complete list of federally recognized tribes); *see also Seminole Nation*, 223 F. Supp. 2d at 140.

Even if this Court were to balance Mr. Caballero's right to use misleadingly the Tribe's federally recognized name, if any such right existed, against the Tribe's Congressionally authorized property rights, the special value Congress has recognized in the orderly recognition and designation of federally recognized Indian tribes weighs heavily in favor of sustaining the injunction. *Cf. San Francisco Arts & Ath.*, 483 U.S. at 537-39, 541 (deferring to Congress' judgment that prohibiting third parties from using the word "Olympic," even in expressive contexts, was necessary to further "public interest in promoting, through the activities of the USOC, the participation of amateur athletes" in the Olympic Games).

### **Conclusion**

Unable to justify his misleading conduct under the law of this Circuit, Mr. Caballero asks this Court to rewrite the Lanham Act, stripping from its protection trademarks for services that have been safeguarded for years. Neither precedent nor reason supports doing so.

The District Court concluded, based on uncontradicted record evidence and the binding law of this Circuit, that the Tribe is likely to prevail on all aspects of its trademark claims and that all the prerequisites for a preliminary injunction support immediate relief. Accordingly, the District Court's preliminary injunction order should be affirmed in its entirety.

Dated: December 10, 2010

Respectfully submitted,

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**Statement of Related Cases**

Pursuant to Ninth Circuit Rule 28-2.6, the Tribe states it is aware of no related cases before this Court.

**Certificate of Compliance**

The undersigned certifies that, according to the word count provided by Microsoft Word 2002, the body of the foregoing brief contains 13,836 words, exclusive of those parts excluded by Fed. R. App. P. 32(a)(7)(B)(iii), which is less than the 14,000 words permitted by Fed. R. App. P. 32(a)(7)(B). The text of the brief is in 14-point Times New Roman, which is proportionately spaced. *See* Fed. R. App. P. 32(a)(5), (6).

/s/ Paula M. Yost

**Addendum**

**15 U.S.C. § 1125(a)**

**§ 1125. False designations of origin, false descriptions, and dilution forbidden**

(a) Civil action.

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, 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,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term “any person” includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this Act for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

**15 U.S.C. § 1127**

**§ 1127. Construction and definitions; intent of chapter**

...

The intent of this Act is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

**25 U.S.C. § 479a**

**§ 479a. Definitions**

For the purposes of this title:

- (1) The term “Secretary” means the Secretary of the Interior.
- (2) The term “Indian tribe” means any Indian or Alaska Native tribe, band, nation, pueblo, village or community that the Secretary of the Interior acknowledges to exist as an Indian tribe.
- (3) The term “list” means the list of recognized tribes published by the Secretary pursuant to section 104 of this title.

**25 U.S.C. § 479a**

**§ 479a-1. Publication of list of recognized tribes**

(a) Publication of list. The Secretary shall publish in the Federal Register a list of all Indian tribes which the Secretary recognizes to be eligible for the special programs and services provided by the United States to Indians because of their status as Indians.

(b) Frequency of publication. The list shall be published within 60 days of enactment of this Act, and annually on or before every January 30 thereafter.

**Certificate of Service**

The undersigned certifies that a copy of the foregoing Answering Brief for Plaintiff-Appellee Shingle Springs Band of Miwok Indians was served on December 10, 2010, on all counsel of record via this Court's CM/ECF system.

/s/ Paula M. Yost

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