

J. Peter Staples, OSB No. 794042
E-mail: pete@chernofflaw.com
Robert N. Lyman, OSB No. 081009
E-mail: rlyman@chernofflaw.com
CHERNOFF, VILHAUER, MCCLUNG & STENZEL, LLP
601 SW Second Avenue, Suite 1600
Portland, OR 97204
Telephone: (503) 227-5631
Fax: (503) 228-4373

Attorneys for Plaintiffs

CERTIFIED TRUE COPY

UNITED STATES DISTRICT COURT
DISTRICT OF OREGON

BENCHMADE KNIFE CO., INC., an
Oregon corporation, and **MENTOR GROUP,**
L.L.C., an Oregon Limited Liability
Corporation,

Plaintiffs,

v.

JONATHAN A. BENSON, an individual
doing business as Roadside Imports, and
ROADSIDE IMPORTS, L.L.C., a Colorado
Limited Liability Company,

Defendants.

Civil Case No. 08-00967-HA

**PLAINTIFFS' RESPONSE TO
DEFENDANT BENSON'S MOTION FOR
APPOINTMENT OF COUNSEL**

**PATENT CASE
TRADEMARK CASE**

Plaintiffs object to Defendant Benson's Motion for Appointment of Counsel (Pro Bono),
document # 11, filed January 12, 2009.

Plaintiffs recognize that defendant Benson filed his motion *pro se*, and is probably not
familiar with the rules of practice in federal courts. However, plaintiffs note that Mr. Benson's

motion is procedurally deficient in several respects. It is unsigned and lacks contact information for defendant, both contrary to Fed. R. Civ. P. 11. Further, there is no certification under Local Rule 7.1, nor has there been any attempt to contact or confer with plaintiffs.

Without waiving these objections, plaintiffs respond as follows:

Appointment of Counsel

With respect to defendant Benson's request that counsel be appointed, without conceding any of the factual allegations contained Benson's request, plaintiffs do not oppose this motion.

Change of Venue

With respect to defendant Benson's request for a change of venue, Mr. Benson has failed to satisfy the requirements of this circuit. Magistrate Judge Sullivan of this district has recently summarized these requirements:

To transfer a case, a defendant must first show that the transferee court is one in which the action could have been commenced originally. Second, defendant must show that transfer would result in greater convenience to the parties and witnesses, as well as advance the interest of justice. 28 U.S.C. § 1404(a). The Ninth Circuit has set forth several considerations that can be used in weighing these factors, including: (1) plaintiff's choice of forum; (2) convenience of the parties; (3) convenience of the witnesses; (4) ease of access to evidence; (5) familiarity of each forum with the applicable law; (6) feasibility of consolidation of other claims; (7) local interest in the controversy; and (8) the relative court congestion and time of trial in each forum. *See Decker Coal Co. v. Commonwealth Edison Co.*, 805 F.2d 834, 843 (9th Cir.1986). The court must balance the preference given to plaintiff's choice of forum with the

burden of litigating in an inconvenient forum. *Id.*; see also *Telephone Management Corp. v. The Goodyear Tire & Rubber Company*, 5 F.Supp.2d 896, 897 (D.Or. 1998).

Partney v. Ducks Unlimited, 2008 WL 4838849 (D.Or. 2008). Defendant Benson argues only that Connecticut would be a more convenient forum for him to litigate. Since it will not be more convenient for plaintiffs, that factor is at best neutral. Mr. Benson does not demonstrate that witnesses would find Connecticut more convenient or that evidence would be easier to procure, nor is there any reason to believe that a Connecticut court would be more familiar with patent and trademark law than an Oregon court. Mr. Benson has not identified other claims to be consolidated, nor has he presented any evidence of relative court congestion. The interest of Connecticut in the litigation is not controlling, particularly since defendant Roadside Imports, LLC, added as a defendant in the Second Amended Complaint filed January 14, 2008, is incorporated under Colorado law. None of these factors outweigh plaintiff's right to choose its forum to litigate. The motion for change of venue should be denied.

Benchmade's U.S. Trademark Registrations

Defendant Benson asks the Court to cancel certain of plaintiff Benchmade's trademark registrations. Plaintiffs take this as a motion for summary judgment that the registrations are invalid. Procedurally, defendant Benson's motion does not comply with the formal requirements of Local Rule 56. For example, it lacks a concise statement of material fact.

Substantively, the Lanham Act provides that a federal trademark registration constitutes "*prima facie* evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration."

15 U.S.C. § 1115. Plaintiff Benchmade is therefore entitled to a presumption of validity and ownership of the trademarks.

Defendant Benson's motion is insufficient to overcome this presumption or meet the evidentiary requirements of a motion for summary judgment. It merely contains several paragraphs of argument. Defendant Benson has not filed an answer and no discovery has been taken. Under such circumstances, this issue is not ripe for summary judgment and Mr. Benson's request should be denied.

Conclusion

For the foregoing reasons, defendant Benson's motion for change of venue and motion to cancel trademark registrations should be denied.

DATED: January 21, 2009

CHERNOFF, VILHAUER, MCCLUNG & STENZEL, LLP

/s/ J. Peter Staples
J. Peter Staples, OSB No. 74042
Of Attorneys for Plaintiffs