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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92069777
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Cancellation No. 92069777

In the matter of:

Trademark Registration No. 2,007,624, for
Goats on a Grass Roof;
Date registered: October 15, 1996,

and

International Trademark Registration No. 3,942,832,
for Building Décor With a Roof Comprised of
Grass and Bearing Several Goats on the Roof;
Date registered: April 12, 2011

TODD C. BANK,

Petitioner,

v.

AL JOHNSON'S SWEDISH
RESTAURANT & BUTIK, INC.,

Registrant.

**PETITIONER'S MEMORANDUM OF LAW IN OPPOSITION
TO REGISTRANT'S MOTION TO DISMISS PETITION**

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INTRODUCTION

Petitioner, Todd C. Bank (“Bank”), submits this memorandum of law in opposition to the motion by Registrant, Al Johnson’s Swedish Restaurant & Butik, Inc., for dismissal of the Petition pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.

ARGUMENT

POINT I

PETITIONER HAS STANDING

A. Registrant Conflates the Question of Petitioner’s Standing to Assert his Claim with the Merits of that Claim

In *Matal v. Tam*, --- U.S. ---, 127 S. Ct. 1744 (2017), the Court held that 15 U.S.C. Section 1052(a), which “prohibit[s] the registration of trademarks that may ‘disparage ... or bring ... into contemp[t] or disrepute’ any ‘persons, living or dead[,]’ . . . violates the Free Speech Clause of the First Amendment.” *Id.* at 1751. Registrant states that, as a result of *Matal*, “marks that some may find offensive or disparaging cannot be denied registrations on this basis.” Reg. Mem. at 5. Petitioner does not take issue with that statement. However, Petitioner *does* take issue with Registrant’s contention that, “[i]t follows that if registration cannot be barred for such marks, then a cancellation action *as well as standing* to bring a cancellation action also cannot be based on allegations [that] a mark is disparaging or offensive.” *Id.*

First, whether Petitioner has *standing* has *nothing to do with the merits of his claims*. See *Whitmore v. Arkansas*, 495 U.S. 149, 155 (1990) (“[o]ur threshold inquiry into *standing* ‘in no way depends on the merits of the [petitioner’s] contention that particular conduct is illegal,’” quoting *Warth v. Seldin*, 422 U.S. 490, 500 (1975) (emphases added)); *H.L. v. Matheson*, 450 U.S. 398, 430 (1981) (“standing is a jurisdictional issue, *separate and distinct from the merits*” (emphasis added)); *Mielo v. Steak ‘n Shake Operations, Inc.*, 897 F.3d 467, 478-479 (3d Cir. 2018) (“[i]n determining

whether [the] [p]laintiffs have suffered an invasion of a legally protected interest, we must *carefully separate our standing inquiry from any assessment of the merits of the plaintiff's claim*. . . . [O]ur standing inquiry must *avoid any consideration of the merits beyond a screening for mere frivolity*" (emphases added; citation and quotation marks omitted); *Hochendoner v. Genzyme Corp.*, 823 F.3d 724 (8th Cir. 2016):

Although the *same pleading standards* apply both to *standing determinations and Rule 12(b)(6) determinations*, the two inquiries remain *fundamentally distinct*: "standing in no way depends on the merits of the plaintiff's contention that particular conduct is illegal." *Warth*, 422 U.S. at 500; *accord, Ariz. State Legislature v. Ariz. Indep. Redistricting Comm'n*, --- U.S. ---, 135 S.Ct. 2652, 2663 (2015). An individual's plausible allegations of a personal injury will generally suffice to plead an injury in fact, *even if the claim is ultimately lacking on the merits*. See, e.g., *Chaudhry v. City of Los Angeles*, 751 F.3d 1096, 1109 (9th Cir. 2014); *Katz [v. Pershing, LLC]*, 672 F.3d [64] at 72 [(1st Cir. 2012)]; *Carver v. City of New York*, 621 F.3d 221, 225–26 (2d Cir. 2010); *Muir v. Navy Fed. Credit Union*, 529 F.3d 1100, 1105–07 (D.C.Cir.2008). It follows that, in conducting our inquiry into *standing*, we have *not considered the validity of any of the plaintiffs' claims as a matter of law or the adequacy of their pleading to state a claim under Rule 12(b)(6)*.

Id. at 734 (emphases added).

Second, the notion that the Constitution prohibits the Government from acting upon certain grounds is a *merits*-based notion. Thus, under *Matal*, the Government is prohibited from refusing (or cancelling) a mark based upon offensiveness; but, as in *Matal*, that prohibition concerns the *merits* of such a refusal (or cancellation). Thus, Petitioner may not rely upon the offensiveness of Registrant's trademark in order to prevail *on the merits*. However, the foreclosure upon such reliance has *nothing to do with standing*, which is merely a *statutory prerequisite* to the Board's *jurisdiction*. If the Board were to cancel Registrant's trademark, it would do so for *reasons other than offensiveness*.

Suppose a group of Klansmen or neo-Nazis stages protests on public property, and that the

only law they violate is a time, place, and manner (“TPM”) statute. A neighbor brings, as authorized by the TPM statute’s private-right-of-action provision, an action seeking an injunction and damages. Although he could, of course, assert standing on the basis that the noise, *unrelated to the content* of the protests, is causing him harm (likely one of the very reasons for the statute), he could, instead, claim that the protests are *offensive and disparaging to him*. Undoubtedly, the court could not grant the injunction on the *basis* of such offense and disparagement; but, of course, the court *could* issue the requested injunction on the basis that the protesters were *violating the TPM statute*.

Suppose, as another example, that someone has been removing political signs from a person’s front yard, upon which he writes a message on the blank side of the sign and then puts the sign back. The homeowner likes the new messages and does not bring a legal action. One day, the sign remover writes a message (in favor of a different candidate, for example) that the homeowner dislikes, upon which the homeowner brings an action for trespass to chattels. Obviously, it would not make a difference whether the homeowner asserted, as his basis for *standing*, destruction (or alteration) of his signs, or that he was offended by the content of the message. The court certainly could not rule against the sign remover *based upon* the content of the message, but the mere fact that the asserted harm, *i.e.*, the basis for the homeowner’s assertion of standing, *was* that content, would, not, of course, preclude the court from ruling that the sign remover had engaged in trespass to chattels and issuing an injunction.

Registrant, perhaps again confusing the question of standing with the question of the merits, contends that, “Bank claims that as an attorney he is someone *damaged by the alleged functionality* of the Goats on the Roof Building Décor trade dress.” Reg. Mem. at 7. Nowhere, however, does Petitioner make that allegation. Instead, Petitioner addresses functionality in connection with the *merits* of his claim, *i.e.*, in connection with his position that Registrant’s mark is *substantively invalid*;

that is, invalid *apart* from the matter of whether Petitioner has *standing to make that claim*.

Finally, Registrant claims: “it is unreasonable to assert that someone is harmed by the *alleged functionality* of a trade dress they have no intent to ever use.” Reg. Mem. at 8 (emphasis added). Yet again, Registrant confuses the question of merits with the question of standing.

B. Petitioner’s Claim is Against Registrant’s Mark, Not Against Registrant’s (or any Other’s) Goats

Registrant states: “[e]ven if *Tam* had not struck offense as a reason for not permitting a mark to be registered, Petitioner still cannot assert a claim. The Lanham Act applies to natural and juristic persons, that is, natural persons and organizations capable of being sued in a court of law. 15 U.S.C. §§ 1052 & 1127. Goats are not natural persons, nor are goats capable of being sued.” Reg. Mem. at 5, n.2. It is difficult to discern whether Registrant is merely being silly (or humorous), or whether Registrant has so low an opinion of the Board that it thinks that the Board might rule that the Petition must be dismissed because Petitioner cannot sue goats.

C. Petitioner Has Alleged Harm

Registrant states: “[a] petitioner must have more than a subjective belief he will be damaged; he must show a belief that he will be damaged that ‘ha[s] a reasonable basis in fact.’” Reg. Mem. at 7, quoting *Ritchie v. Simpson*, 170 F.3d 1092, 1098 (Fed. Cir. 1999). First, in *Ritchie*, *supra*, the court explained that one whose standing depends on a particular trait, or on a particular emotional reaction to a mark, must have more than a subjective belief that the mark would cause him damages. Thus, one who contends that a mark would disparage members of a certain group could allege that he is member of that group, *see Ritchie*, 170 F.3d at 1097-1098, and one whose contention of disparagement does not depend on group membership could allege, for example, that other people also believe the mark to be disparaging. *See id.* at 1098. However, such showings are only examples of how one might demonstrate standing, for the court also stated that “[t]he *crux* of the matter is *not*

how many others share one's belief that one will be damaged by the registration, but whether that belief is *reasonable and reflects a real interest in the issue.*" *Id.* at 1097 (emphases added).

Second, a court is not required, at the motion-to-dismiss stage, to consider whether the factual allegations are probably true. Rather, under *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007), a court must take the factual allegations as true, no matter how skeptical the court may be. *See id.* at 555 (a court must proceed "on the assumption that all the allegations in the complaint are true (even if doubtful in fact)"); *see also id.* at 556 ("a well-pleaded complaint may proceed even if it strikes a savvy judge that actual proof of the facts alleged is improbable"); *Neitzke v. Williams*, 490 U.S. 319, 327 (1989) ("Rule 12(b)(6) does not countenance . . . dismissals based on a judge's disbelief of a complaint's factual allegations"); *McZeal v. Sprint Nextel Corp.*, 501 F.3d 1354 (Fed. Cir. 2007), which explained that it remained after *Twombly* that:

where pleadings are sufficient, yet it appears almost a certainty to the court that the facts alleged cannot be proved to support the legal claim, a motion to dismiss for failure to state a claim must nevertheless be overruled. Under a motion for summary judgment, the court can instead consider affidavits or depositions, answers to interrogatories and the material outside the pleadings. If these documents reveal that no genuine issue of fact exists, then a summary judgment properly disposes of the case.

Id. at 1358 (citation and quotation marks omitted).

Registrant's reliance upon *Ashcroft v. Iqbal*, 129 S. Ct. 1937 (2009), *see* Reg. Mem. at 6, 7, is misplaced. In *Iqbal*, the Court reiterated the well settled rule that, "[t]o survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Id.* at 1949, quoting *Twombly*, 550 U.S. at 570. The point of law that *Iqbal* clarified is that this rule applies only to *factual*, as opposed to *legal*, allegations: "the tenet that a court must accept as true all of the allegations contained in a complaint is inapplicable to *legal* conclusions." *Id.* (emphasis added). Here, Registrant is prematurely attempting to cast doubt on the

truth of Petitioner's *factual* allegations during this stage of the proceeding, *i.e.*, the motion-to-dismiss stage.

Finally, Registrant claims:

Even if the disparagement clause was [sic] still good law, which it is not, Bank still fails to carry his burden. Bank did not "allege[] that he possesses a trait or characteristic that is clearly and directly implicated by the [trade dress]." *See Ritchie*, 170 F.3d at 1092. Instead, Bank alleges that the Goats on the Roof Décor trade dress is *demeaning to goats*, and Bank does not allege that *he is a goat*. [Petition, ¶1.] Bank also did not allege facts to "show that [Bank] is not alone in his belief of damage" such as by pleading information "in the form of surveys or petitions" or "affidavits from public interest groups representing people who allegedly share the damage caused by the mark." *See Ritchie*, 170F.3d at 1092. Instead, Bank relied on a conclusory statement that "numerous persons" are offended. Such conclusory statements are insufficient to state a claim.

Reg. Mem. at 8. First, Bank's allegation that "[n]umerous persons believe that the granting to, or possession by, a person of a mark that applies to the activity of an animal is demeaning to the type of animal that is the subject of such mark," Pet., ¶ 3, clearly satisfies Rule 8(a) notice pleading. Second, and again, *Ritchie* referred to opinion surveys and similar measures as *examples* of how to show that one's beliefs are reasonable. Thus, even if the Petition had not referred to the beliefs of other persons, the Board could not merely assume that Petitioner's beliefs are not reasonable; rather, Registrant would be entitled to take discovery regarding the basis for those beliefs; and, moreover, there is obviously nothing inherently unreasonable about finding that Registrant's mark is demeaning to goats.

D. Petitioner is Not Required to Allege that He Uses, or Wishes to Use, Registrant's Mark

Registrant contends that, “a petitioner must, at the very least, be in a position to use the registered mark for goods or services related to the goods or services in the registration.” Reg. Mem. at 6. Likewise, Registrant claims: “[that there is] no standing when [an] opposer fail[s] to plead facts showing it used or had the potential to use the mark at issue[.]. Indeed, the Board dismisses proceedings for lack of standing when the claimant party fails to plead facts to establish that it sells or manufactures goods or services similar to those sold under the mark at issue.” *Id.* at 6-7, citing *Consolidated Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829, 831-832 (T.T.A.B. 1985). First, neither *Consolidated Foods* nor any other case holds that use of a mark (actual or desired) is the *only* proper basis of standing.

Second, Registrant's assertions contradict *Ritchie*, in which the court noted that, “[i]n *no case* has this court *ever* held that one must have a specific *commercial interest*, not shared by the general public, in order to have standing as an opposer.” *Ritchie*, 170 F.3d at 1096-1097 (emphases added) (the standing requirements for a petitioner for cancellation are the same as those for an opposer, *see id.* at 1095, n.2; *accord, Young v. AGB Corp.*, 152 F.3d 1377, 1379-1380 (Fed. Cir. 1998)). The *Ritchie* court proceeded to rule that the opposer had standing based on his allegation that the proposed marks, which related to O.J. Simpson, would “disparage [the opposer's] values,” *Ritchie*, 170 F.3d at 1097, and would be “offensive to him as a Christian, family man.” *Id.* at 1098. Clearly, the standing of the opposer in *Ritchie* was not based on his intended use of the marks at issue, commercial or otherwise.

POINT II

REGISTRANT’S MARK IS FUNCTIONAL

The slapstick dubiousness of Registrant’s speaks for itself and has been recognized by legal scholars. *See, e.g.*, Lee B. Burgunder, *Trademark Protection of Live Animals: The Bleat Goes On*, 10 J. Marshall Rev. Intell. Prop. L. 715 (2011):

[G]oats on a grass roof . . . [is] *aesthetically functional* based on competitive needs. This is because goats *may be one of the few, if not the only, animal that can walk reliably on a slanted roof without falling*. . . . [T]he addition of grass does not change the result, not only because sod is generic, but also because the grass surface serves important functions for the animals in terms of traction, food and their general welfare.

. . . [T]rademarks should not govern *key aesthetic features that are important ingredients in commercial success*. Although the goats are not the primary reason that customers go to the restaurant, they certainly are an *important consideration when families with kids choose where they want to eat*. In this regard, protecting the goats would be like *giving a pool hall the exclusive right to serve Chinese food*, which clearly is overreaching. Indeed, *the advertising slogan, “Come for the goats, stay for the food,” highlights that the goats are a key component of the overall restaurant experience*. [footnote citing Stephan Kinsella, *When Trademark Law and Goats Run Amok*, CHRISTIAN SCI. MONITOR (Sept. 24, 2010), www.cs-monitor.com/Business/Mises-Economics-Blog/2010/0924/When-trademark-law-and-goats-run-amok (last checked Nov.30, 2018); (when entering the address, do not include the hyphen in “cs-monitor” that appears here)]. Also, the goats have a *utilitarian function* for Swedish restaurants with authentic sod roofs because they *help keep the grass trimmed*. According to *Traffix [Devices, Inc. v. Mktg. Displays, Inc.]*, 532 U.S. 23 (2001)], it might not matter that other methods exist, such as using a lawn mower [footnote citing *Traffix Devices*, 532 U.S. at 34 (2001)]. Rather, the fact that the goats make an *important contribution* to the restaurant’s *lawn maintenance* needs is enough [footnote citing *Traffix Devices*, 532 U.S. at 34]. Interestingly, the *company lawyer* illustrated the overall problem when he reportedly stated to Al Johnson’s father, “Lars, you have something very valuable here.” [footnote citing Justin Scheck & Stu Woo, *Lars Johnson Has Goats on His Roof and a Stable of Lawyers*

to Prove It, Wall St. J., Sept. 17, 2010, at A1]. This makes it *exceedingly clear* that the lawyer recognized the *non-reputation-related advantage that the restaurant would enjoy through its trademark*.

For these reasons, *Al Johnson's should not have been granted the sole right to put goats on the roof of a food service business. . . . [T]he agency clearly made a mistake by granting trademark rights to Al Johnson's restaurant solely for having goats on a grass roof.*

. . . . [T]he PTO *erred when it registered Al Johnson's goats on a roof* because it *did not sufficiently evaluate the functional nature of the mark*. Therefore, the mark *should be cancelled*.

Id. at 733-735 (emphases added; additional footnotes omitted). *See also* Ann Gilson LaLonde & Jerome Gilson, *Getting Real With Nontraditional Trademarks: What's Next After Red Oven Knobs, The Sound of Burning Methamphetamine, and Goats on a Grass Roof?*, 101 Trademark Rep. 186, 209 (2011) (referring to Registrant's mark as "the mark that stands [] beyond [the] nontraditional summit").

A. The Notion that Functionality Must be Assessed with Respect to Only the Goods or Services at Issue is Nonsensical

Registrant contends that, "functionality must be assessed in connection with the goods or services at issue." Reg. Mem. at 9, quoting *Doyle v. Al Johnson's Swedish Restaurant & Butik, Inc.*, 101 U.S.P.Q.2d 1780 (T.T.A.B. 2012). *Doyle* stated:

[W]hile petitioner alleges that respondent's goats and sod roof affect respondent's costs, by reducing respondent's energy and mowing expenses, this allegation is *not specific*, and is in fact *completely unrelated*, to restaurant or gift[-]shop services. In other words, by petitioner's logic, goats on sod roofs would be functional for any good or service provided through a facility with a roof that could be covered in sod, because goats on sod roofs reduce the good or service provider's costs. Yet, it is well settled that *functionality must be assessed in connection with the goods or services at issue, in this case restaurant and gift shop services*. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769-70 (1992) and *Duramax Marine*

LLC v. R.W. Fernstrum & Co., 80 USPQ2d 1780, 1791-94 (TTAB 2006).

Id. at (emphases added; underlining in original).

Neither *Two Pesos* nor *Duramax Marine* even suggest that functionality exists only when it pertains *solely or specifically* to the *particular goods or service at issue*. Of course, it would only make sense that the question of functionality would *often* pertain to the particular good or service at issue, for it is naturally common for a business to utilize features that are tailored to the business's industry. According to Registrant's position (or *Doyle's*), a grocery store's plastic bags are *non-functional* because plastic bags are used by *many* types of businesses. Could the contention that a bank's bulletproof windows are functional be refuted by the argument that such windows would equally protect employees of any other type of business? How obviously ridiculous!

B. Registrant's Mark is Functional

Registrant states:

“There is no prohibition against a trade[-]dress mark both functioning to indicate source and being aesthetically pleasing.” *In re Hudson News Company*, 39 U.S.P.Q.2d 1915, 1923 (T.T.A.B. 1996). As a matter of law, restaurant décor that is entertaining and attractive cannot be functional *merely* because the décor is alleged to be entertaining and attractive. Under such a standard, no restaurant décor could ever be protected as trade dress. Restaurant décor, however, is a well-recognized category of trade dress. *See e.g. Two Pesos Inc. v. Taco Cabana, Inc.*, 50 5U.S. 763 (1992) (finding restaurant trade dress inherently distinctive).

Reg. Mem. at 10 (emphasis added). Here, Registrant tells only half the story, for “a feature is *nonfunctional* where it is unrelated to the consumer demand ... *and* serves *merely* to identify the source of the product or business.” *Fair Wind Sailing, Inc. v. Dempster*, 764 F.3d 303, 311 (3d Cir. 2014) (emphases added; citation and quotation marks omitted); *see also Gateway, Inc. v. Companion Prods., Inc.*, 384 F.3d 503, 508 (8th Cir. 2004) (“trade dress is *nonfunctional* if it is an *arbitrary*

embellishment primarily adopted for purposes of identification and individuality. But if the trade dress is an important ingredient in the commercial success of the product, it is clearly functional” (emphases added; citation and quotation marks omitted). Only discovery could (theoretically) support the nonsensical notion that the goats on the roof of Registrant’s restaurant are non-functional.

Like Registrant’s goats, the Hooter’s restaurant chain’s scantily clad waitresses provide aesthetic enjoyment to (at least some) customers, but Hooter’s surely could not obtain a trademark for “scantily-clad waitresses,” whether or not the mark would be limited to a particular type of floor. Likewise, a Spanish restaurant could not obtain a mark for “roving violinists” (again, whether or not the mark would be limited to a particular type of floor); and the former Ground Round restaurant chain’s practice of encouraging customers to throw their peanut shells on the floor certainly could not be trademarked. By Registrant’s rationale, a convenience-store owner could bring his dog to work and seek trade-dress protection for “dogs at a convenience-store” (perhaps Registrant’s rationale would apply only if the store had a particular type of floor). How obviously absurd! If Registrant hired an employee to stand in front of the restaurant all day and sing Swedish folk songs, could Registrant have obtained a mark for “singing Swedish folk songs in front of a restaurant,” or, if not, for “singing Swedish folk songs while standing on a concrete floor in front of a restaurant”? If a restaurant had a pond in front that froze in the wintertime, could that restaurant secure, under trademark law, the exclusive right to have its employees (or customers) “skate on a frozen pond in front of a restaurant”? Imagine the reaction of the restaurant owner who, on a cold January day, receives the cease-and-desist letter!

As explained in *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996 (2d Cir. 1995), “[w]hile ‘arbitrary,’ ‘fanciful,’ or ‘suggestive’ packaging of a product may be presumed to serve [a] source-identifying function, and thus may be deemed *per se* distinctive of the source, the same presumption

may not be made with regard to product features or designs whose *primary purposes* are likely to be *functional or aesthetic*.” *Id.* at 1008 (emphases added). Thus, in *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159 (1995), the Court “note[d] that lower courts have permitted competitors to copy the green color of farm machinery (because customers wanted their farm equipment to match) and have barred the use of black as a trademark on outboard boat motors (because black has the special functional attributes of decreasing the apparent size of the motor and ensuring compatibility with many different boat colors).” *Id.* at 169 (citing cases). Just as the colors at issue in the cases cited by the *Qualitex* Court were primarily aesthetic and therefore not registrable, Registrant’s mark likewise should not have been registered.

Neither of the colors in the *Qualitex* Court’s examples are relevant to how the products performed, just as Registrant’s mark presumably has no bearing on the taste of the food at Registrant’s restaurant. That is, the colors in the *Qualitex* Court’s examples are no more “essential to the use or purpose” (Reg. Mem. at 7) of their corresponding products than Registrant’s mark is essential to the provision of a good meal. Thus, although Registrant correctly notes that “restaurant décor that is entertaining and attractive cannot be functional *merely* because the décor is alleged to be entertaining and attractive.” Reg. Mem. at 7 (emphasis added), that argument overlooks the principle that, again, a design feature whose primary purpose is functional or aesthetic is not registrable.

As explained in *Best Cellars, Inc. v. Wine Made Simple, Inc.*, 320 F. Supp. 2d 60 (S.D.N.Y. 2003):

While the Lanham Act protects the “overall image or appearance” created by a product’s design or packaging, the [mark holder] must precisely articulate the specific elements that comprise its distinct trade dress, so that courts can evaluate claims of infringement and fashion relief that is appropriately tailored to the distinctive combination of elements that merit protection. *See*

Landscape Forms [v. *Columbia Cascade Co.*], 113 F.3d [373] at 381 [(2d Cir. 1997)] (plaintiffs must provide “a precise expression of the character and scope of the claimed trade dress”). This articulation requirement also helps to ensure that claims of trade[-]dress infringement are pitched at an appropriate level of generality, for “just as copyright law does not protect ideas but only their concrete expression, neither does trade dress law protect an idea, a concept, or a generalized type of appearance.”

Id. at 69, quoting *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 32 (2d Cir. 1995).

Here, no part of Registrant’s mark warrants protection.

Finally, the photographs annexed as Exhibit “A” hereto reflect that people look at Registrant’s goats for aesthetic pleasure; not because the goats serve to identify the source of the restaurant.

C. Registrant’s Argument Concerning the Meaning of “Essential” is Nonsensical

Registrant states: “[n]o facts in the Petition show [that] other restaurants and retail stores are placed at a significant non-reputation-related disadvantage because goats on a grass roof are the only (or one of a handful of ways) to make restaurants and retail establishments attractive and entertaining. No facts in the Petition that show that the Goats on the Roof Décor trade dress is essential to the use or purpose of providing restaurant or retail services.” Reg. Mem. at 10. First, Petitioner refers the Board to the quoted excerpt from *Trademark Protection of Live Animals: The Bleat Goes On*. See un-subheaded section of Point II, *supra*.

Second, a feature, in order to be functional, is not required to be “essential” in the sense that Registrant seems to suggest. Hooters could employ other waitresses to serve food, as the service of food is the essence of Hooter’s business; a convenience-store owner surely does not have to bring his dog to work in order to carry out the “essence” of his business; yet such “non-essentiality” (as Registrant seems to understand that term) obviously does not warrant trademark status. Mark Zuckerberg could surely run Facebook while dressed in something other than a hooded sweatshirt; so, would that enable Facebook to get a trademark for “CEOs wearing hoodies”? or “social-media

CEO's wearing hoodies"? Of course not!

D. Registrant's Argument Concerning the Meaning of "Superiority" is Nonsensical

Registrant states:

The only difference between the allegations [that] the Board rejected in *Doyle* and Bank's current pleading is that Bank added a single conclusory statement that the Goats on the Roof Décor trade dress is "superior to other methods" of increasing the appeal of restaurants and retail stores. Bank did not plead any factual support for this conclusory statement. Instead, Bank simply lifted some language out of the *Doyle* opinion that noted a lack of evidence that "goats on sod roofs are superior to other methods of attracting customers to restaurants or gift shops." *Doyle*, 101 U.S.P.Q.2d at 1783.

Reg. Mem. at 10-11. First, although the Petition alleges superiority, *see* Pet., ¶ 9, it need not have done so, because superiority is relevant to *designs*, *see, e.g., ERBE Elektromedizin GmbH v. Canady Technology LLC*, 629 F.3d 1278, 1281 (Fed. Cir. 2010), not to *activities*.

Second, it is unclear, in any event, what Registrant would have Petitioner plead with respect to other methods of attracting and entertaining customers. Surely, for example, Petitioner could have stated that Registrant's mark is superior to a grass roof without goats, goats on a non-grass roof, or, for that matter, pinball machines in the dining room. Had there been only a limited number of alternative methods to entertain customers, Petitioner could have specifically listed those methods and alleged that Registrant's mark is superior to them. However, there are countless ways to entertain customers, making it virtually impossible to list them all. In any event, the superiority requirement is a *relative* one, such that even if that requirement were applicable here, Petitioner would have to ultimately show that Registrant's mark is *relatively* superior rather than superior to every possible alternative.

CONCLUSION

Based upon the foregoing, Petitioner respectfully requests that this Court deny Registrant's motion.

Dated: November 30, 2018

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EXHIBIT “A”





CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document is being filed electronically via ESTTA with the Trademark Trial and Appeal Board, and that, immediately after the filing is made available to the undersigned, it will be served upon Registrant's counsel by email:

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Dated: November 30, 2018

/ **Todd C. Bank** /
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