

No. 19-1880

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**United States Court of Appeals for the Federal Circuit**

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TODD C. BANK,

*Appellant,*

v.

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

*Appellee.*

ON APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE, TRADEMARK TRIAL AND APPEAL BOARD
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**APPELLANT'S REPLY BRIEF**

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TODD C. BANK,  
ATTORNEY AT LAW, P.C.  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
(718) 520-7125  
tbank@toddbanklaw.com  
By: Todd C. Bank

*Counsel to Appellant*

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## ARGUMENT

### POINT I

#### APPELLANT HAS STANDING<sup>1</sup>

##### **A. Petitioner Alleges Harm from the Appellee’s Mark, Not from the Activity that is the Subject of that Mark**

Appellee, Al Johnson’s Swedish Restaurant & Butik, Inc. (the “Restaurant”), states: “[l]ike the petitioner in *NSM Resources* [*v. Microsoft Corp.*, 113 U.S.P.Q. 2d 1029, 2014 WL 7206403 (T.T.A.B. Nov. 25, 2014)], ‘the perceived damage’ to [Appellant, Todd C. Bank (‘Bank’)] ‘is plainly not due to the registration of’ Al Johnson’s Restaurant’s service mark, *but instead by the ‘activity of an animal’* that Bank alleges demeans the animal.” Restaurant (“Rest.”) Br. at 14 (underlining in original; emphasis added; footnote omitted). In the omitted footnote, the Restaurant states: “[the] Restaurant interprets Bank’s pleading to mean that he finds the ‘*activity of the animal,*’ i.e. *the goats grazing on a grass roof,* to be demeaning to goats. Appx15. The USPTO’s act of granting a registration has absolutely no impact on the activity of the goats in question.” *Id.* at 14, n.7 (emphasis added). It is inconceivable that the Restaurant inadvertently misread the Petition so egregiously (and

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<sup>1</sup> Appellee’s observation that the issue of standing is the only issue on this appeal, *see* Appellee’s Brief (Doc. 24) at 24-25, is well-taken. *See Ford Motor Co. v. United States*, 811 F.3d 1371, 1380 (Fed. Cir. 2016); *Secure Access, LLC v. PNC Bank N.A.*, 859 F.3d 998, 1017 (Fed. Cir. 2017) (Plager, *J.*, concurring in denial of panel rehearing); *Kornitzky Group, LLC v. Elwell*, 929 F.3d 737, 746-747 (D.C. Cir. 2019). Accordingly (and regretfully), Bank does not address the merits in this brief.

conveniently). *See* Pet., ¶¶ 1, 3 (Appx15). The Restaurant’s statements that, “even if Bank suffers the alleged harm because the *activity* of goats grazing on a grass roof ‘denigrates the value he places on the respect, dignity, and worth of animals,’ cancelling the [Restaurant’s] Registration does not address that harm,” Rest. Br. at 14, quoting Pet., ¶ 2 (Appx15) (emphasis added), and that, “Bank does not articulate what *activity* of the goats is causing him harm or explain how the Goats on the Roof Restaurant Décor Registration is denigrating his values,” *id.* (emphasis added), are similarly disingenuous, as is the Restaurant’s statement that, “[t]he Board’s analysis in *NSM* applies to Bank.” *Id.* The same is true of the Restaurant’s statement that, “Bank does not articulate the basis for his harm because Bank’s alleged damage has *nothing to do with the Goats on the Roof Restaurant Décor Registration*,” *id.* (emphasis added; citation and quotation marks omitted), just as it also undergirds the Restaurant’s attempt to analogize Bank’s asserted basis of standing and the asserted basis for standing that the Board rejected in *Doyle v. Al Johnson’s Swedish Restaurant and Butik, Inc.*, No. 92054059, 2012 WL 695211 (T.T.A.B. Feb. 10, 2012), *see* Rest. Br. at 15, and its statement that, “Bank has [asserted] standing to cancel the . . . Registration based on an *underlying activity* that offends him.” *Id.* at 16 (emphasis added).

**B. Appellant was not Required to Cite, in his Petition, Evidence in Support of His Allegations**

The Restaurant states: “[e]ven if Bank’s personal offense could constitute a legitimate personal interest in cancelling the [Restaurant’s mark], *Ritchie* [v. *Simpson*, 170 F.3d 1092 (Fed. Cir. 1999)] also requires that Bank allege a reasonable basis in fact to support his belief in his damages,” *id.*, adding that Bank “does not plead the existence of any other evidence, in the forms of surveys, petitions or affidavits, to establish that others share in his belief in his harm,” *id.* at 18, whereby, “[i]n contrast, [the petitioner in *Ritchie*] alleged that he ‘obtained petitions signed by people from all over the United States’ who agreed with [his] belief the [opposed] marks were scandalous, denigrated their values, encouraged spousal abuse and minimized the problem of domestic violence.” *Id.*, citing *Ritchie*, 170 F.3d at 1098. However, while a petitioner is certainly free to cite evidence to support his allegations, he need not do so in order to withstand a motion under Rule 12(b)(6):

A motion made under Rule 12(b)(6) challenges the *legal theory* of the complaint, ***not the sufficiency of any evidence that might be adduced***. The purpose of the rule is to allow the court to eliminate actions that are *fatally flawed in their legal premises* and destined to fail . . . . *Neitzke v. Williams*, 490 U.S. 319, 326–27 (1989). Such a motion, which cuts off a claimant at the threshold, must be denied “*unless it appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief*. *Conley v. Gibson*, 355 U.S. 41, 45–46 (1957).

*Advanced Cardiovascular Systems v. SciMed Life Systems*, 988 F.2d 1157, 1160 (Fed.

Cir. 1993) (emphases added). *See also Hall v. Bed Bath & Beyond, Inc.*, 705 F.3d 1357, 1364 (Fed. Cir. 2013) (“[a] court’s task in ruling on a Rule 12 (b)(6) motion is merely to assess the *legal feasibility* of the complaint, *not to assay the weight of the evidence which might be offered in support thereof*” (emphases added; citation and quotation marks omitted)); *Barefoot Architect, Inc. v. Bunge*, 632 F.3d 822, 835 (3d Cir. 2011) (“*evidence is irrelevant to a Rule 12(b)(6) motion*, and [a court is] presented only with the *purely legal question* whether . . . [a] [ ]claim states a cause of action” (emphases added)); *Animal Legal Defense Fund, Inc. v. Perdue*, 872 F.3d 602, 610 (D.C. Cir. 2017) (“we must treat the complaint’s factual allegations as true, must grant [the] plaintiff the benefit of all reasonable inferences from the facts alleged, and may uphold [a] [Rule 12(b)(6)] dismissal only if it appears *beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief*” (emphases added)); *Klocke v. Watson*, No. 17-11320, --- F.3d ---, 2019 WL 3977545 (5th Cir. Aug. 23, 2019):

Under *Rule 12(b)(6)*, a federal court may dismiss a case for failure to state a claim upon which relief may be granted if, accepting all well-pleaded factual allegations as true, the complaint does not state a plausible claim for relief. *Ashcroft v. Iqbal*, 556 U.S. 662, 678–79 (2009). This is not an insuperable pleading barrier, and *it requires no evidentiary support*: “a well-pleaded complaint may proceed *even if it strikes a savvy judge that actual proof of those facts is improbable, and that a recovery is very remote and unlikely.*” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 556 (2007) (quotation marks omitted).



*Id.* at \*4 (emphases added). Of course, Bank, as the petitioner, would be required to produce evidence to support *all* of his allegations, which, of course, include, but are not limited to, his allegations 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 (Appx15), and that, “[t]he demeaning of animals in the manner set forth [in paragraph ‘3’] is offensive to numerous persons and denigrates the value they place on the respect, dignity, and worth of animals.” *Id.*, ¶ 4 (Appx15).

The Restaurant relies upon *McDermott v. San Francisco Women’s Motorcycle Contingent*, No. 91169211, 2006 WL 2682345 (T.T.A.B. Sept. 13, 2006), *aff’d*, 240 F. Appx. 865 (Fed. Cir. 2007), but *McDermott* supports Bank. As the Restaurant notes:

[*McDermott*] found that [the petitioner] “failed to *allege* that he possessed a trait or characteristic implicated by applicant’s applied-for mark—that is, that he is a ‘lesbian’ or ‘dyke.’” 2006 WL 2682345 at \*6. Similarly, here, Bank does not plead that he is a goat or possesses the traits or characteristics of goat.

Rest. Br. at 17-18. The *McDermott* Board did not state that the petitioner had failed to cite *evidence* “that he is a ‘lesbian’ or ‘dyke,’” but, rather, that he had simply not *alleged* that he was. By contrast, Bank *has* made the relevant allegations, *i.e.*, that the Restaurant’s mark is offensive to Bank, *see* Pet., ¶¶ 1, 2 (Appx15), and that numerous persons likewise find the mark offensive. *See id.*, ¶¶ 3, 4 (Appx15) (the Restaurant’s

notation that “Bank does not plead that he is a goat or possesses the traits or characteristics of goat” indicates that, according to the Restaurant, only a goat could be offended by the mark, which is obviously untrue).

Finally, the Restaurant notes that this Court “affirmed the [*McDermott*] Board’s dismissal for failure to allege standing because [the petitioner]’s pleadings ‘contain[ed] no allegations that his belief is shared by others *and* no reference to supporting evidence demonstrating such a shared belief’ such as ‘surveys, petitions or affidavits from public[-]interest groups,’” Rest. Br. at 18, quoting *McDermott*, 240 F. Appx. at 867 (emphasis added); again, a claimant is required to make allegations that, *if supported by evidence*, would state a cause of action. Surveys, petitions, affidavits from public interest-groups, etc., are *evidence* of an allegation that numerous people are offended by a mark. Thus, although a petition may, of course, allege their existence, it need not do so.

**C. Appellee Conflates the Question of Standing with the Question of the Merits**

The Restaurant contends that, “the section of the Lanham Act that allowed [the petitioner in *Ritchie*] to allege harm based on his personal offense is no longer [C]onstitutional,” Rest. Br. at 19, and argues that *Ritchie* recognized that such un-Constitutionality would vitiate the basis of standing that Bank has asserted. *See id.*, block-quoting *Ritchie*, 170 F.3d at 1099. However, the discussion of that issue in *Ritchie*, by both the majority and the dissent, pertained to the *merits* (that is, the

potential merits of the petitioner’s claim), not the petitioner’s standing. *See Ritchie*, 170 F.3d at 1098-1099; *id.* at 1103-1104 (Newman, *J.*, dissenting). Thus, the Restaurant’s conclusion that, “the Lanham Act also no longer addresses Bank’s pleaded harm at all,” Rest. Br. at 19, deceptively conflates standing with the merits.

The Restaurant takes, out of context, Bank’s quoting of *Whitmore v. Arkansas*, 495 U.S. 149 (1990), and *Warth v. Seldin*, 422 U.S. 490 (1975), *see* Rest. Br. at 22 and *compare with* Bank Br. (Doc. 21) at 4, and does nothing, of course, to support its argument that Bank’s alleged basis for *standing* is precluded by the inability of Bank to rely on that basis in order to prevail on the *merits*.

The Restaurant’s critique of Bank’s “bright neon light” hypothetical, *see* Rest. Br. at 22-23, is well taken. However, unlike in that hypothetical, it is the *registration* of the Restaurant’s mark that is the subject of the Petition, not the activity to which the mark applies; thus, Bank *would* obtain redress if he were to prevail before the Board *whether or not goats continued thereafter to occupy the Restaurant’s roof*, whereas, in the “bright neon light” hypothetical, as the Restaurant points out, the success of the petitioner, whose harm was caused the light *itself* rather than the *mark*, would not ensure that the source of the harm, *i.e.*, the light, would be eliminated. *See* Rest. Br. at 23.

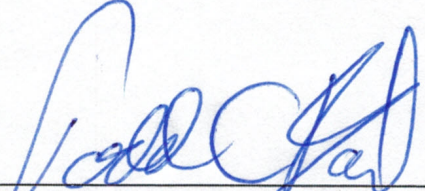
Finally, the Restaurant notes that *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490 (Fed. Cir. 1987), and *Selva & Sons, Inc. v. Nina*

*Footwear, Inc.*, 705 F.2d 1316 (Fed. Cir. 1983), “provide[] . . . example[s] of when the Board confused a merits determination with a standing determination,” Rest. Br. at 21, and contends that, in the present case by contrast, “[i]n the Board’s standing discussion there is absolutely no discussion of the merits of Bank’s pleaded claim to cancel the [Restaurant’s mark] as functional[,] [and] [t]he Board appropriately applie[d] the ‘real interest’ test described in *Jewelers, Selva and Ritchie*.” *Id.* This contention is manifestly false. *See* Bank Br. at 3-7. It is also of a piece with the Restaurant’s contention that, “[t]o have a real interest to challenge a registration as functional, a party must plead a ‘present or prospective right to use’ the trade dress.” Rest. Br. at 21, quoting *Poly-America, L.P. v. Illinois Tool Works Inc.*, No. 92056833, 2017 WL 4687981, \*4 (T.T.A.B. Oct. 18, 2017) (Bank previously addressed *Poly-America*, *see* Bank Br. at 7-8). That is true neither of a trade dress nor any other type of mark; indeed, the last thing that the petitioner in *Ritchie* wished to do was to use the challenged marks (and, of course, Bank did not argue that *Ritchie* stands “for the proposition that a petitioner does not [(emphasis in original)] need to be a competitor *or have any other ‘real interest’* to allege functionality as the basis to cancel a registration is misplaced.” Rest. Br. at 11 (emphasis added). *See* Bank Br. at 7-8.

**CONCLUSION**

This Court should vacate the judgment of dismissal, remand the matter to the United States Patent and Trademark Office, and grant Appellant such other and further relief as authorized by law.

Dated: September 23, 2019



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TODD C. BANK,  
ATTORNEY AT LAW, P.C.  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
(718) 520-7125  
tbank@toddbanklaw.com  
By: Todd C. Bank

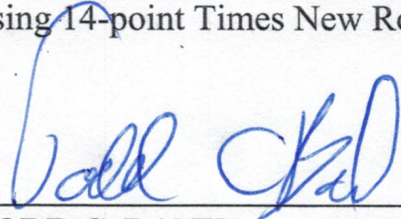
*Counsel to Appellant*

**CERTIFICATE OF COMPLIANCE WITH RULE 32(a)**

1. This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) because this brief contains 2,153 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using 14-point Times New Roman.

Dated: September 26, 2019

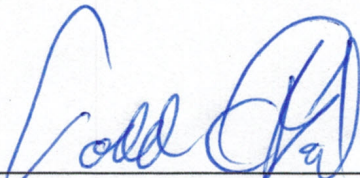
  
\_\_\_\_\_  
TODD C. BANK

**CERTIFICATE OF SERVICE**

I hereby certify that on September 26, 2019, a true and accurate copy of the foregoing was served, by First Class mail of the United States Postal Service, on the following:

Katrina. G. Hull  
Markery Law, LLC  
P.O. Box 84150  
Gaithersburg, MD 20883-4150

Dated: September 26, 2019

  
\_\_\_\_\_  
TODD C. BANK