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

Proceeding	92069777
Party	Defendant Al Johnson's Swedish Restaurant and Butiks, Inc.
Correspondence Address	AL JOHNSONS SWEDISH RESTAURANT AND BUTIKS INC 10698 N BAY SHORE DRIVE SISTER BAY, WI 54234 UNITED STATES no email provided no phone number provided
Submission	Motion to Dismiss - Rule 12(b)
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Signature	/katrinaghull/
Date	11/28/2018
Attachments	24703392_Motion_to_Dismiss_Bank_Petition_to_Cancel.PDF(166082 bytes) 24701853_MtToDismissExA.PDF(741419 bytes)

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

Todd C. Bank,
Petitioner

v.

Al Johnson’s Swedish Restaurant & Butik, Inc.
Registrant

Cancellation No. 92069777

**AL JOHNSON’S SWEDISH RESTAURANT AND BUTIK, INC.’S MOTION AND
MEMORANDUM IN SUPPORT OF MOTION TO DISMISS THE CANCELLATION
PETITION FOR FAILURE TO STATE A CLAIM UNDER RULE 12(b)(6)**

Registrant Al Johnson’s Swedish Restaurant and Butik, Inc. (“Al Johnson’s Restaurant”) respectfully requests dismissal with prejudice of the cancellation petition (the “Petition”) filed by Petitioner Todd C. Bank (“Bank”) because the petition fails to state a claim for relief under Rule 12(b)(6) of the Federal Rules of Civil Procedure. In particular, Bank lacks standing to bring the Petition, failed to alleged facts sufficient to support a plausible claim that Al Johnson’s Restaurant’s trade dress for restaurant and gift shop décor is functional, and brought a claim based on Lanham Act provisions the Supreme Court invalidated as unconstitutional.

BACKGROUND

Al Johnson’s Restaurant is an authentic Swedish family-owned business based in Door County, Wisconsin. Founded by family patriarch Al Johnson over 65 years ago, Al Johnson’s Restaurant offered and continues to offer restaurant services in its world-famous Swedish restaurant. Today, Al Johnson’s children continue to run Al Johnson’s Restaurant, and the business has expanded to include a retail store selling gifts, décor, and Swedish food products.

In 1973, Al Johnson's Restaurant adopted a unique building décor trade dress after a practical joke ended with a goat on the sod roof of Al Johnson's Restaurant. Al Johnson liked the appeal of goats on the sod roof, and decided to develop distinctive building décor inspired by the goats. The result became the world famous Goats on the Roof trade dress. The trade dress consists of goats on a roof of grass as shown below:



Al Johnson's Restaurant owns U.S. Registration No. 2,007,624 for restaurant services and No. 3,942,832 for retail store services for its building décor trade dress (hereafter the "Goats on the Roof Décor" for the trade dress and the "Goats on the Roof Registrations" for the trade dress registrations).

In 2011, Robert Doyle hired Bank, the Petitioner in this case, to file for cancellation of the Goats on the Roof Registrations. *Doyle v. Al Johnson's Swedish Restaurant & Butik, Inc.*, 101 U.S.P.Q.2d 1780 (T.T.A.B. 2012). In *Doyle*, the "petitioner allege[d] that 'Registrant's marks primarily serve, and are intended by Registrant to primarily serve, as a form of entertainment and attraction in order to enhance the enjoyment of visiting Registrant's restaurant; and, as such, Registrant's marks are functional.'" *Id.* at 1782 (quoting the petitioner's Notice of Opposition). The petitioner further alleged that "the goats on respondent's roof eat the grass, which 'negates...the need to cut the grass.'" *Id.* In a precedential opinion, the Trademark Trial and Appeal Board ("TTAB") dismissed the petition, finding Doyle lacked standing for failure to demonstrate he would suffer any reasonable harm from the registrations and that Doyle's allegations were insufficient to state a claim for functionality. *Id.* at 1784. Copies of both the

original petition and the amended petition from the *Doyle* proceeding are attached hereto at Exhibit A.

Six years later, Doyle's attorney from the 2012 cancellation decision, Bank, filed this cancellation against the same Goats on the Roof Registrations at issue in *Doyle*. Bank's 2018 pleading is highly similar to the pleadings the Board dismissed in 2012. Bank regurgitates the same claim made on Doyle' behalf regarding functionality. [Petition, ¶¶ 5-10.] This claim suffers from the same deficiencies as the claim Bank made for Doyle six years ago. Bank also alleges his belief the Goats on the Roof Décor trade dress is demeaning and offensive to goats. [*Id.* at ¶¶ 1-4.] Bank makes such a claim despite the Supreme Court holding the prohibition against registering offensive and disparaging marks unconstitutional. Like the petition he prepared for Doyle, the petition Bank prepared on his own behalf fails to allege how Bank is harmed by the Goats on the Roof Registrations. As Bank does not have standing and has not articulated a claim upon which relief can be granted, Al Johnson's Restaurant moves to dismiss.

ARGUMENT

I. Motion to Dismiss

A cancellation petition is subject to dismissal under Rule 12(b)(6) when the petition fails to establish that either (1) the petitioner has standing to bring the proceeding; or (2) a valid ground exists to cancel the registration. *See* T.B.M.P. § 503.02 (*citing Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024 (C.C.P.A. 1981)). The Board reviews a motion to dismiss by assuming all well-pleaded allegations in the petition are true and by construing these allegations in a light most favorable to the petitioner. *Consolidated Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829, 831 (T.T.A.B. 1985). "However, [the Board is] not required to accept as true

legal conclusions or unwarranted factual inferences.” *NSM Resources Corp. v. Microsoft Corp.*, 113 U.S. P.Q.2d 1029, 1032 (T.T.A.B. 2014).

Even under this deferential standard, Bank fails to state a claim. The Supreme Court held that the prohibition against registering offensive and disparaging marks is unconstitutional. Further, the petition contains no facts that reasonably support standing or the asserted functionality ground. As “it appears that [Bank] is entitled to no relief under any set of facts which could be proved in support of [his] claim,” the Board should dismiss Bank’s petition. *Consolidated Foods*, 226 U.S.P.Q. at 831.

II. As a matter of law, offense does not prevent registration of a mark.

“The idea [that the government has an interest in preventing speech expressing ideas that offend] strikes at the heart of the First Amendment. ... [T]he proudest boast of our free speech jurisprudence is that we protect the freedom to express ‘the thought that we hate.’” *Matal v. Tam*, --- U.S. ---, 127 S. Ct. 1744, 1764 (2017) quoting *United States v. Schwimmer*, 279 U.S. 644m 655, 49 S. Ct. 448 (1929) (Holmes, J. dissenting). In so finding, the Supreme Court held that the prohibition against registering disparaging and offensive trademarks in the Lanham Act, 15 U.S.C. § 1052(a), was unconstitutional. As a result, marks that some people believe are offensive and disparaging may be registered with the USPTO.

Bank seeks to cancel the Goats on the Roof Décor trade dress because Bank asserts he finds it offensive and demeaning to goats. [Petition, ¶¶ 1-4.] Banks apparently seeks to cancel the registration pursuant to 15 U.S.C. § 1064(3), which allows for cancellation if the registration is “contrary to the provisions...of subsection (a)...of section 1052.” This section includes the

prohibition against registering disparaging and offensive trademarks—the provision the Supreme Court found unconstitutional.¹

As a result of *Tam*, marks that some may find offensive or disparaging cannot be denied registrations on this basis. It 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 a mark is disparaging or offensive.² To hold otherwise would contradict the Supreme Court’s finding in *Tam*.

Bank’s claim for cancellation based on allegations the Goats on the Roof Décor trade dress is denigrating to animals fails as a matter of law. Disparagement and offense are not considerations for whether a mark is entitled to registration. Thus, Bank’s alleged offense on behalf of goats cannot provide standing or a basis for cancellation. Bank’s claim should be dismissed with prejudice.

III. Bank failed to plead factual support for his claims.

A “plaintiff’s obligations to provide the ‘grounds’ of his ‘entitlement to relief’ requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555, 127 S. Ct. 1955, 1964-1965 (2007). Rule 8 “demands more than an unadorned, the-defendant-unlawfully-harmed-me accusation.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678, 129 S. Ct. 1937, 1949 (2009). “Factual allegations must be enough to raise a right to relief above the speculative level...on the assumption that all the allegations in the complaint are true (even if doubtful in fact).” *Twombly*,

¹ While other portions of § 1052(a) remain constitutional and in force, the clause at issue in Bank’s claims is the disparagement clause portion of § 1052(a). The disparagement clause, that is, the prohibition against disparaging and offensive trademarks, is the provision the Supreme Court ruled unconstitutional. *Tam*, 127 S. Ct. at 1770-1771.

² Even 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.

550 U.S. at 555-556, 127 S. Ct. at 1965. A complaint does not assert a claim “if it tenders ‘naked assertion[s]’ devoid of ‘further factual enhancement.’” *Iqbal*, 556 U.S. at 678, 129 S. Ct. at 1949 quoting *Twombly*, 550 U.S. at 557, 127 S. Ct. at 1955. “Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice.” *Ashcroft*, 556 U.S. 662, 129 S. Ct. at 1949.

a. Bank failed to plead facts to demonstrate standing to bring this petition.

i. The Lanham Act’s standing requirements require a real controversy and the reasonable potential for damage.

“The purpose of the standing requirement...is to prevent litigation when there is no real controversy between the parties.” *NSM*, 113 U.S.P.Q.2d at 1032 (internal quotations omitted) (dismissing petition for no standing). Accordingly, a “petitioner must allege facts which, if ultimately proven, would establish that [the] petitioner has a ‘real interest,’ i.e., a ‘personal stake,’ in the proceeding.” *Doyle*, 101 U.S.P.Q.2d at 1782. To meet the personal stake requirement, the petitioner must show that the continued registration of the trademark or trade dress at issue is harming the petitioner. *NSM*, 113 U.S.P.Q.2d at 1033. The petitioner must also show that the claimed harm has a reasonable basis in fact. *Doyle*, 101 U.S.P.Q.2d at 101 citing *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999).

ii. Bank lacks a real interest in the proceeding.

“A real interest in the outcome of a proceeding” is required “in order to have standing.” *Ritchie*, at 1095. The real interest requirement “prevent[s] ‘mere intermeddlers’ who do not raise a real controversy from bringing oppositions or cancellation proceedings in the PTO.” *Id.* To meet the real interest requirement, 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. See *Consolidated Foods*, 226 U.S.P.Q. at 831-832 (no standing when opposer failed 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.*

Bank fails to carry his burden. The registrations at issue are for restaurant and gift shop services. Bank, however, failed to plead facts showing he provides restaurant or gift shop services. Bank provides no evidence that he is in the restaurant or retail store business and Bank fails to plead facts regarding any such business. Bank also fails to plead facts showing his intent to begin either type of business.

The allegations in the Petition do not, under any circumstances, establish or even suggest that Bank is in a position to now or ever use the registered Goats on the Roof Décor trade dress. If anything, Bank's Petition suggests the opposite. Bank claims he is deeply offended by goats on grass roofs. [Petition, ¶¶ 1-4.] It would defy logic that someone would desire to use a trade dress that by his own words "denigrates the value he places on the respect, dignity, and worth of animals." [*Id.* ¶2.]

Bank does not have a direct and personal stake in this cancellation. He is three times over an intermeddler. He is not raising a real controversy. His Petition should again be dismissed.

iii. Bank's damage claim does not have a reasonable basis in fact.

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." *Ritchie*, 170 F.3d at 1098. A subjective belief is not enough.

Bank claims that as an attorney he is someone damaged by the alleged functionality of the Goats on the Roof Building Décor trade dress. Bank fails to plead any reasonable basis in

fact for this belief. Instead, Bank reiterates the same grounds he previously presented to the Board on behalf of Doyle. [*Compare* Petition, ¶¶ 5-10 with *Doyle*, 101 U.S.P.Q.2d at 1783, and Exhibit A.] In *Doyle*, Bank and Doyle were told that, even if their allegations were “accepted as true,” those allegations “nevertheless cannot, as a matter of law, establish the functionality of [the Goats on the Roof Décor trade dress] in connection with the subject services.” *Id.* at 1784. Despite this, Bank reiterated the same claim. An objectively reasonable person does not claim to be damaged by reiterating a claim the Board already told him “cannot, as a matter of law,” succeed. Further, it is unreasonable to assert that someone is harmed by the alleged functionality of a trade dress they have no intent to ever use.

Bank’s other alleged injury—that he finds goats on grass roofs offensive—is not a type of “damage” recognized under the Lanham Act. *See Tam*, 127 S. Ct. at 1765 (ruling the disparagement clause unconstitutional). Even if the disparagement clause was 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. *Twombly*, 550 U.S. at 555, 127 S. Ct. at 1964-1965 (“labels and conclusions” do not state a claim for relief).

Bank fails to adequately plead reasonable belief of damage. Bank fails to properly allege standing. Bank fails to state a claim upon which relief may be granted.

b. Bank failed to adequately plead a claim of functionality.

“[A] product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Mag Instrument Inc. v. Brinkmann Corp.*, 96 U.S.P.Q.2d 1701, 1718 (T.T.A.B. 2010) *aff’d* 2011 WL 5400095 (Fed. Cir. 2011). The purpose of the functionality doctrine is to prevent businesses from using trademark law to “inhibit legitimate competition by allowing a producer to control a useful product feature.” *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165 (1995). To that end, “functionality must be assessed in connection with the goods or services at issue.” *Doyle*, 101 U.S.P.Q.2d at 1783.

Bank makes two assertions regarding functionality—that the trade dress is “entertaining,” [Petition, ¶¶ 5-9], and that “the placement of goats on a grass roof negates or ameliorates, due to the goats’ grazing, the need to cut the grass, and is thus economically advantageous and, therefore, functional,” [*Id.* at ¶10.] Neither theory states a claim for relief.

Bank’s assertion that the goats save in mowing expenses does not state a claim for relief for functionality. Indeed, when Bank asserted this same theory on behalf of Doyle in 2012, the Board found that “this allegation is not specific, and is in fact completely unrelated, to *restaurant or gift shop services*.” *Doyle*, 101 U.S.P.Q.2d at 1783 (emphasis in original). Under such 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.” *Id.* (emphasis added). This assertion is insufficient to state a claim for functionality, as “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.” *Id.* Despite the Board

explaining that facts showing how functional allegations must be related to the goods or services offered under the mark in order to state a claim, Bank ignored that requirement. Just as he did when filing the same claim for Doyle, Bank again failed to provide any factual support to show the Goats on the Roof Décor is functional for restaurant and gift shop services.

Bank's other basis for functionality fares no better. Bank claims that "the primary use of [the Goats on the Roof Décor trade dress] is as a form of entertainment that increases, to customers, the appeal of [Al Johnson's Restaurant's] place of business." [*Id.* at ¶ 5.]

"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 U.S. 763 (1992) (finding restaurant trade dress inherently distinctive).

No facts in the Petition show 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.

Unsurprisingly, when presented with nearly identical allegations in *Doyle*, the Board found that such allegations were insufficient to state a claim for functionality. *Doyle*, 101 U.S.P.Q.2d at 1783-1784. The only difference between the allegations 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. The addition of this unsupported conclusory allegation does not help Bank state a claim. *Iqbal*, 556 U.S. at 678, 129 S. Ct. at 1949; *Twombly*, 550 U.S. at 557, 127 S. Ct. at 1955.

Bank attempted to raise this claim before, on behalf of Doyle in 2012. Bank failed then. Bank repeats the failures of the previously dismissed cancellation pleading. Bank’s petition is woefully devoid of facts supporting his claims. Bank does not state a claim for relief and Bank should not be permitted any more bites at the apple or, in this case, kicks at Al Johnson’s Restaurant’s goats or its Goats on the Roof Registrations. The petition should be dismissed with prejudice, and Bank should not be granted leave to amend as this is his third try to plead the same flawed claims.

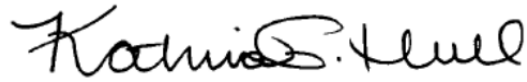
CONCLUSION

In light of the foregoing, this Board should dismiss with prejudice the Petition for failure to state a claim upon which relief may be granted.

Respectfully submitted this 28th day of November 2018,

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

By its Attorneys,

A handwritten signature in black ink that reads "Katrina G. Hull". The signature is written in a cursive style with a horizontal line underneath it.

Katrina G. Hull
Emily M. Haas
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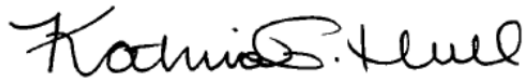
CERTIFICATE OF SERVICE AND MAILING

I hereby certify that a true and correct copy of the foregoing Motion to Dismiss is being served upon Petitioner by email:

Todd C. Bank
119-40 Union Turnpike
Fourth Floor
Kew Gardens, NY 11415
UNITED STATES
tbank@toddbanklaw.com

and that a copy of the same was filed electronically on the same date via ESTTA with the Trademark Trial and Appeal Board.

Date: November 28, 2018



Trademark Trial and Appeal Board Electronic Filing System. <http://estta.uspto.gov>

ESTTA Tracking number: **ESTTA411697**

Filing date: **05/27/2011**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Robert Doyle		
Entity	Individual	Citizenship	UNITED STATES
Address	3984 SW 157 Avenue Miramar, FL 33027 UNITED STATES		

Attorney information	Todd C. Bank 119-40 Union Turnpike Fourth Floor Kew Gardens, NY 11415 UNITED STATES TBLaw101@aol.com, TBLaw101@yahoo.com Phone:718-520-7125		
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Registrations Subject to Cancellation

Registration No	3942832	Registration date	04/12/2011
Registrant	Al Johnson's Swedish Restaurant & Butik, Inc. 10698 N. Bay Shore Drive Sister Bay, WI 54234 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 1973/06/01 First Use In Commerce: 1973/06/01
All goods and services in the class are cancelled, namely: Retail store and online retail store services featuring gifts, food, clothing, toys, linens, dolls, books and music

Grounds for Cancellation

The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)		
Registration No	2007624	Registration date	10/15/1996
Registrant	Al Johnson's Swedish Restaurant and Butik 702 Bay Shore Drive Sister Bay, WI 54234 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 1973/06/01 First Use In Commerce: 1973/06/01
All goods and services in the class are cancelled, namely: restaurant services

Grounds for Cancellation

The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)		
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Attachments	petition.pdf (3 pages)(58443 bytes) Exh. A - 1.pdf (2 pages)(125366 bytes) Exh. A - 2.pdf (3 pages)(539092 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/No service was made; see TBMP309.02(c)/
Name	Todd C. Bank
Date	05/27/2011

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

PETITION TO CANCEL

In the matter of

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

and

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

ROBERT DOYLE,

Petitioner,

v.

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

Registrant.

Cancellation No. _____

Petitioner, Robert Doyle, an individual and citizen of the United States with an address at 3984 SW 157 Avenue, Miramar, Florida 33027, hereby petitions the Trademark Trial and Appeal Board of the United States Patent and Trademark Office, in accordance with 37 C.F.R. § 2.111, to cancel Trademark Registration No. 2,007,624 and International Trademark Registration No. 3,942,832.

Registrant, Al Johnson's Swedish Restaurant & Butik, Inc., is, and was at all relevant times herein, a corporation organized and existing under the laws of Wisconsin, and maintains its principal

executive office at 695 South Spring Road, Sister Bay, Wisconsin 54234.

As grounds for cancellation, Petitioner alleges the following:

1. Many establishments in the classes to which Registrant's marks apply have, because of Registrant's marks, refrained from placing goats on their grass roofs, as a result of which Petitioner has been, and will continued to be, damaged in that Petitioner has been, and will continue to be, unable to satisfy his desire to take photographs of goats on grass roofs.

2. Registrant's marks primarily serve, and are intended by Registrant to primarily serve, as a form of entertainment and attraction in order to enhance the enjoyment of visiting Registrant's restaurant; and, as such, Registrant's marks are functional.

3. With respect to establishments that feature the marks at issue, or would feature such marks if they were not currently protected, such marks primarily serve, or would primarily serve, as a form of entertainment and attraction in order to enhance the enjoyment of visiting such establishments.

4. The functionality of Registrant's marks is made abundantly clear by the website of Registrant's restaurant, throughout which is promoted Registrant's marks as an attractive and entertaining feature of the restaurant experience (copies of pages from the website are annexed hereto as Exhibit "A").

5. The two components of Registrant's marks are themselves functional.

6. Sod roofs last a relatively long time and thus are ultimately cheaper than other types of roofs to maintain.

7. A sod roof helps keep temperatures lower, which, in turn, can lower a building's air-conditioning expenses and make buildings without air conditioners more comfortable and more conducive, and less costly, to conducting business.

8. The placement of goats on a sod roof negates, by virtue of the goats' grazing, the need to cut the grass, a fact that was mentioned on the website of Registrant's restaurant prior to changes having been made to the website in or about April or May, 2011.

WHEREFORE, Petitioner requests that Trademark Registration No. 2,007,624 and International Trademark Registration No. 3,942,832 be canceled.

Dated: May 27, 2011

Respectfully submitted,

 / **Todd C. Bank** /
TODD C. BANK
119-40 Union Turnpike
Fourth Floor
Kew Gardens, New York 11415
(718) 520-7125

Counsel to Petitioner

[HOME](#) [MENU](#) [RESTAURANT](#) [SHOP ONLINE](#) [GOAT CAM](#)

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HISTORY



As you top the hill and head down the main street in Sister Bay, one can not help but get excited. For right in the middle of town, you will spot the goats on the roof at Al Johnson's! This grassy roof and those goats have drawn tourists and locals alike. An icon for visitors for over 58 years, Al Johnson's Swedish Restaurant has a rich history in this town and county!

Back in the early days, Al was "chief cook and bottle washer." He did it all. Friends remember a time when he'd serve the breakfast, clean-up the kitchen, and then hang a "Gone Fishin'" sign on the door

and head out for an afternoon break, before reopening for the dinner hour! To many of his local, lifelong buddies, "those were the good old days!" Coffee flowed, the talk was rich, and tall tales abounded. Life in the county was more laid back... it was a different time!

Then, in 1960 Al met who was to be his future wife, Ingert. She was the one who helped change and shape the interior décor of the restaurant. With a flair for style, plus deep roots in Scandinavian heritage and design, she felt it necessary to keep the look of the place very traditional. Ingert's vision included adding a gift shop where people could browse while waiting to be seated. Today, that vision has grown into two very large and welcoming Butiks that have a draw all their own.

Hard work is the key to any business and that rings true for the Johnson Family. It has been and continues to be family run. In earlier years, you could hear Al's booming voice in the dining room, saying "I've got a two-top here!" or "There's a 4-top clear over there!" which meant the hostess was to fill that table quickly from the list of waiting customers! Al cleared tables, bussed trays, and washed dishes. Al set a fast pace for the dining room. A two hour wait was common and turn over was key. Al wanted to get the next people in as quickly as possible, so those dishes would be flying off the tables!



The food is served on dishes from Porsgrund, Norway, the decorative rosemaled painting around the interior was done by renowned Norwegian artist Sigmund Arseth. Many of the foods served are Swedish and Norwegian. Anything from the Swedish pancakes and meatballs served with Swedish lingonberries (a small, red berry much like a cranberry or currant in taste) to the varied Swedish crackers and Limpa bread on the bread tray, to the many specialty cheeses from Sweden, there is much to delight the palate! (For those wanting a more American fare, the menu includes the famed Al's burger, local perch and whitefish plates, traditional ham, turkey, or clubhouse sandwiches, as well as a full array of salads and daily soups.) Breakfast is served all day and is a meal in itself! There is literally something tasty for everyone!

The restaurant was renovated in 1973. The log buildings were assembled in Norway, taken apart and shipped to Sister Bay, where they were put together around the existing building. A special underlayer was put on the roof and it was

More About Al Johnson

["The Impact of Al Johnson," by Myles Dannhausen Jr., from the June 17, 2010 Peninsula Pulse](#)

[Al Johnson, an excerpt from Norbert Blei's "Door Way" \(published 1981, The Ellis Press\) - By Norbert Blei](#)

[Counter Culture: Wintering at Al's \(From Winter Book/The Quiet Time in Door \(Ellis Press\) - By Norbert Blei](#)

[20 Years Ago: Al's Snowshoe Race](#)

seeded with grass. The restaurant never closed during that time and it was the beginning of the grass on the roof, which was a



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ABOUT AL JOHNSON'S



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The menu consists of a variety of Swedish fare, from pancakes with lingonberries to Swedish meatballs, whitefish, sandwiches, salads, and a variety of hot and cold plates.

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From the arrival of Oscar the goat, it was a short trip to putting both Oscar himself, and the dozens of later goats onto the roof of the already-famed restaurant, turning it into "that place with the goats on the roof," as thousands and thousands of Door County visitors have called it while requesting directions.

In an interview shortly before his death this past June 12, Al Johnson spoke about his goats, laughing heartily the entire time, and what they have meant to his restaurant's world-wide renown: "It doesn't matter where I've been — and Inger and I have traveled the entire world — but everybody knows about those goats. If I mention to someone overseas that I'm from Sister Bay in Door County, Wisconsin, they usually say the same thing: "Oh, you mean that place with the goats on the roof?"

[More About Al Johnson](#)



[Podcast – Writer Norbert Blei Interviews Al Johnson](#)

The intersection of technology with goats was inevitable, says Al's son Lars, who now runs the restaurant with his siblings Rolf and Annika. "Our visitors fall in love with the goats and are always so concerned about them, their health, and their safety," said Lars. "They want to know how they get onto the roof each day (there's a very safe slanted stairway with foot-holds), where the goats go each evening when we take them off the roof and load them onto a pickup truck (to a barn and pasture at Lars' home outside Sister Bay), and whether they can fall off the roof (yes, it's happened a couple of times, but no one was hurt)."



"What Rolf, Annika and I like about having a Goat Cam on the roof," said Lars, "which is actually two web cameras with different perspectives of the entire roof area, is that our visitors and friends can maintain a relationship with the restaurant and the goats throughout the season, no matter where they live the rest of the year."

Al Johnson's goats usually go onto the restaurant's sod roof at the start of each tourism season, in late May. The goats then spend the winter in a barn and pasture from mid-October to the start of the next season.

AL JOHNSON'S LIFE: A PHOTO GALLERY



Al, 12 years old, Appleport - 1937



ESTTA Tracking number: **ESTTA459380**

Filing date: **03/01/2012**

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

Proceeding	92054059
Party	Plaintiff Robert Doyle
Correspondence Address	TODD C BANK 119 40 UNION TURNPIKE , FOURTH FLOOR KEW GARDENS, NY 11415 UNITED STATES TBLaw101@aol.com, TBLaw101@yahoo.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Todd
Filer's e-mail	TBLaw101@aol.com
Signature	/ Todd C. Bank /
Date	03/01/2012
Attachments	amended petition.pdf (4 pages)(61551 bytes) Exh. A - 1.pdf (2 pages)(125366 bytes) Exh. A - 2.pdf (3 pages)(539092 bytes)

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

AMENDED PETITION TO CANCEL

Cancellation No. 92054059

In the matter of

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

and

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

ROBERT DOYLE,

Petitioner,

v.

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

Registrant.

Petitioner, Robert Doyle, an individual and citizen of the United States with an address at 3984 SW 157 Avenue, Miramar, Florida 33027, hereby petitions the Trademark Trial and Appeal Board of the United States Patent and Trademark Office, in accordance with 37 C.F.R. § 2.111, to cancel Trademark Registration No. 2,007,624 and International Trademark Registration No. 3,942,832.

Registrant, Al Johnson's Swedish Restaurant & Butik, Inc., is, and was at all relevant times herein, a corporation organized and existing under the laws of Wisconsin, and maintains its principal

executive office at 695 South Spring Road, Sister Bay, Wisconsin 54234.

As grounds for cancellation, Petitioner alleges the following:

1. Establishments in the classes to which Registrant's marks apply ("Covered Establishments") are precluded by Registrant's marks from placing goats on their grass roofs.

2. Petitioner desires to dine and shop in Covered Establishments with a grass roof because Petitioner enjoys the look and smell of grass roofs.

3. Petitioner desires to dine and shop in Covered Establishments with a grass roof because the moderating effects that a grass roof has on the climate of the building that it covers lessens the need for artificial climate controls and therefore makes the dining and/or shopping experience more enjoyable to Petitioner.

4. Petitioner desires to dine and shop in Covered Establishments with goats on a grass roof because Petitioner finds goats on a grass roof to be entertaining.

5. Petitioner desires to interview witnesses to goats on the grass roofs of Covered Establishments, and compare the reactions of such witnesses to the reactions of witnesses to animals, including goats, on the roofs in situations in which Registrant's marks do not apply, *i.e.*, (1) where goats appear on a non-grass roof of a Covered Establishment in; (2) where goats appear on a grass roof of a non-Covered Establishment; and (3) where goats appear on a non-grass roof of a non-Covered Establishment.

6. Petitioner desires to take photographs of goats on the grass roofs of Covered Establishments.

7. Petitioner desires to use, for his personal enjoyment, the aforementioned interviews and photographs.

8. Petitioner desires to report his findings relating to paragraph 5 herein by publishing

and selling a book that features the aforementioned interviews and photographs.

9. Because it is economically advantageous, where there is a grass roof, to keep goats on such roof (as described in paragraphs 16 through 18 herein), fewer Covered Establishments maintain a grass roof than would be the case if Covered Establishments were not precluded by Registrant's marks from keeping goats on such roof.

10. As a result of Registrant's marks, Petitioner has been, and will continue to be, damaged in that Petitioner has been, and will continue to be, unable to satisfy his aforementioned desires.

11. Registrant's marks primarily serve, and are intended by Registrant to primarily serve, as a form of entertainment and attraction in order to enhance the enjoyment of visiting Registrant's restaurant; and, as such, Registrant's marks are functional.

12. Registrant's marks do not primarily serve, and are not intended by Registrant to primarily serve, as a form of identification of Registrant's restaurant and gift shop.

13. With respect to establishments that feature the marks at issue, or would feature such marks if they were not currently protected, such marks primarily serve, or would primarily serve, as a form of entertainment and attraction in order to enhance the enjoyment of visiting such establishments.

14. The functionality of Registrant's marks is made abundantly clear by the website of Registrant's restaurant, throughout which is promoted Registrant's marks as an attractive and entertaining feature of the restaurant experience (copies of pages from the website are annexed hereto as Exhibit "A").

15. Registrant's placement of goats on the grass roof of Registrant's restaurant has been an effective method of attracting customers to Registrant's restaurant and gift shop, and is superior

to other methods.

16. Grass roofs are functional because they last a relatively long time and thus are ultimately cheaper than other types of roofs to maintain.

17. Grass roofs are functional because they help moderate temperatures and therefore can lower a building's artificial climate-control expenses.

18. The placement of goats on a grass roof negates, by virtue of the goats' grazing, the need to cut the grass.

WHEREFORE, Petitioner requests that Trademark Registration No. 2,007,624 and International Trademark Registration No. 3,942,832 be canceled.

Dated: February 29, 2012

Respectfully submitted,

 / **Todd C. Bank** /
TODD C. BANK
119-40 Union Turnpike
Fourth Floor
Kew Gardens, New York 11415
(718) 520-7125

Counsel to Petitioner

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HISTORY



As you top the hill and head down the main street in Sister Bay, one can not help but get excited. For right in the middle of town, you will spot the goats on the roof at Al Johnson's! This grassy roof and those goats have drawn tourists and locals alike. An icon for visitors for over 58 years, Al Johnson's Swedish Restaurant has a rich history in this town and county!

Back in the early days, Al was "chief cook and bottle washer." He did it all. Friends remember a time when he'd serve the breakfast, clean-up the kitchen, and then hang a "Gone Fishin'" sign on the door

and head out for an afternoon break, before reopening for the dinner hour! To many of his local, lifelong buddies, "those were the good old days!" Coffee flowed, the talk was rich, and tall tales abounded. Life in the county was more laid back... it was a different time!

Then, in 1960 Al met who was to be his future wife, Ingert. She was the one who helped change and shape the interior décor of the restaurant. With a flair for style, plus deep roots in Scandinavian heritage and design, she felt it necessary to keep the look of the place very traditional. Ingert's vision included adding a gift shop where people could browse while waiting to be seated. Today, that vision has grown into two very large and welcoming Butiks that have a draw all their own.

Hard work is the key to any business and that rings true for the Johnson Family. It has been and continues to be family run. In earlier years, you could hear Al's booming voice in the dining room, saying "I've got a two-top here!" or "There's a 4-top clear over there!" which meant the hostess was to fill that table quickly from the list of waiting customers! Al cleared tables, bussed trays, and washed dishes. Al set a fast pace for the dining room. A two hour wait was common and turn over was key. Al wanted to get the next people in as quickly as possible, so those dishes would be flying off the tables!



The food is served on dishes from Porsgrund, Norway, the decorative rosemaled painting around the interior was done by renowned Norwegian artist Sigmund Arseth. Many of the foods served are Swedish and Norwegian. Anything from the Swedish pancakes and meatballs served with Swedish lingonberries (a small, red berry much like a cranberry or currant in taste) to the varied Swedish crackers and Limpa bread on the bread tray, to the many specialty cheeses from Sweden, there is much to delight the palate! (For those wanting a more American fare, the menu includes the famed Al's burger, local perch and whitefish plates, traditional ham, turkey, or clubhouse sandwiches, as well as a full array of salads and daily soups.) Breakfast is served all day and is a meal in itself! There is literally something tasty for everyone!

The restaurant was renovated in 1973. The log buildings were assembled in Norway, taken apart and shipped to Sister Bay, where they were put together around the existing building. A special underlayer was put on the roof and it was

More About Al Johnson

["The Impact of Al Johnson," by Myles Dannhausen Jr., from the June 17, 2010 Peninsula Pulse](#)

[Al Johnson, an excerpt from Norbert Blei's "Door Way" \(published 1981, The Ellis Press\) - By Norbert Blei](#)

[Counter Culture: Wintering at Al's \(From Winter Book/The Quiet Time in Door \(Ellis Press\) - By Norbert Blei](#)

[20 Years Ago: Al's Snowshoe Race](#)

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