

No. 19-1880 [CORRECTED]

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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.*

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AUG 19 2019

United States Court of Appeals  
For The Federal Circuit

ON APPEAL FROM THE UNITED STATES  
PATENT AND TRADEMARK OFFICE,  
TRADEMARK TRIAL AND APPEAL BOARD

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**APPELLANT'S PRINCIPAL BRIEF AND APPENDIX**

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**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**  
**Bank** v. **Al Johnson's Swedish Rest.**

Case No. 19-1880

**CERTIFICATE OF INTEREST**

Counsel for the:

(petitioner)  (appellant)  (respondent)  (appellee)  (amicus)  (name of party)

**Todd C. Bank**

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
Todd C. Bank	Todd C. Bank	N/A

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

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Todd C. Bank, Attorney at Law, P.C.

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5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. See Fed. Cir. R. 47.4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

N/A

8-13-19

Date



Signature of counsel

Todd C. Bank

Printed name of counsel

Please Note: All questions must be answered

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**STATEMENT OF RELATED CASES**

1. There have not been any other appeals in or from the same proceeding in the lower body before this or any other appellate court.
2. Appellant, Todd C. Bank (“Bank”), knows of no other case pending in this or any other court that might directly affect, or be directly affected by, the result of this appeal.

**STATEMENT OF JURISDICTION**

The Trademark Trial and Appeal Board (the “T.T.A.B.” or “Board”) had jurisdiction under 15 U.S.C. §§ 1064(1) and (3), and 37 C.F.R. § 2.111. Bank filed a Notice of Appeal (Appx19) on May 15, 2019, from the T.T.A.B. Order that had disposed of all of Bank’s claims. This Court has jurisdiction under 15 U.S.C. § 1071(a).

**STATEMENT OF THE ISSUES**

1. Whether Bank has standing to seek the cancellation of Trademark Registration No. 2007624.
2. Whether Trademark Registration No. 2007624 is invalid.

**STATEMENT OF THE CASE**

**A. Nature of the Case**

The case before the Board was a cancellation proceeding.

**B. Course of Proceedings**

On October 12, 2018, Bank filed a Petition (Appx14-16). On November 28, 2018, Appellee, Al Johnson's Swedish Restaurant & Butik, Inc. (the "Restaurant"), filed a motion to dismiss the Petition pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure. On March 27, 2019, the Board issued an order (the "Order") granting the motion with leave to file an amended petition. On May 2, 2019, the Board issued an order dismissing the Petition with prejudice.

**STATEMENT OF THE FACTS**

Bank, in accordance with 37 C.F.R. § 2.111, petitioned the Board to cancel Trademark Registration No. 2007624.

**SUMMARY OF THE ARGUMENT**

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The Board found, wrongly, that Bank lacks standing because the basis of his assertion of standing differed from the basis of his position on the merits. The Board also wrongly found that standing is limited to competitors of a markholder.

The Restaurant's mark is functional, and, contrary to the Board's finding, an assessment of functionality is not limited to the goods or services to which a mark applies.

## STATEMENT OF THE STANDARD OF REVIEW

Bank addresses two issues in this brief: (i) Bank's standing; and (ii) whether Bank stated a claim on the merits. Each is subject to *de novo* review. *See*, respectively, *Shenyang Yuanda Aluminum Industry Engineering Co., Ltd. v. United States*, 918 F.3d 1355, 1363 (Fed. Cir. 2019), and *Athey v. United States*, 908 F.3d 696, 705 (Fed. Cir. 2018).

## ARGUMENT

### POINT I

#### APPELLANT HAS STANDING

##### **A. The Board Conflated the Question of Standing with the Question of the Merits**

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The Board stated:

In this case, as acknowledged by Petitioner, the *only ground for cancellation* is the claim of *functionality*. Thus, Petitioner *must adequately plead his standing to assert a claim of functionality*. *Ritchie* [*v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999)] found that the plaintiff adequately pleaded his standing to assert that the subject marks were *scandalous under Section 2(a)* of the Trademark Act, 15 U.S.C. § 1052(a), by alleging that he found the subject mark *offensive* to his personal values. *See Ritchie*, 170 F.3d at 1094 (“[T]he controlling precedents of this court, as well as the precedents of the Board, are fully consistent with recognizing that someone in Mr. Ritchie’s position has standing to oppose a registration **on the grounds raised here.**”) (emphasis added) [(the standing requirements for a petitioner for cancellation are the same as for an opposer, *see Ritchie*, 170 F.3d at 1095, n.2; *accord, Young v. AGB Corp.*, 152 F.3d 1377, 1379-1380 (Fed. Cir. 1998))].

*Ritchie* does not establish that an *individual's personal offense* to a mark is sufficient to plead standing to assert a claim of *functionality*. Thus, Petitioner may not rely upon allegations that the involved mark is *personally offensive to him* to plead his standing to assert a claim that the involved mark is *functional*.

Order at 6 (Appx7) (bold in original; other emphases added; footnote omitted).

The Board's misunderstanding of basic standing doctrine is shocking. Whether Bank 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*” (emphases 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).

Example: a group of Klansmen and/or neo-Nazis stages protests on public property, and the only law that the group thereby violates 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 against the group. Although he could, of course, assert standing on the basis that the noise, *unrelated to the content* of the protests, is causing him harm, he could, instead, claim that the protests are *offensive and disparaging* to him. Undoubtedly, the First Amendment would preclude the court from ruling in his favor on the *merits* on the basis of such offense and disparagement; but, of course, the court *could* rule in his favor on the merits on the basis that the protesters were violating the *TPM* statute.

Example: someone routinely removes political signs from a person's front yard, writes a message on the blank side of the signs, and then turns the signs around and

puts them back. The homeowner likes the new messages and does not bring a legal action. One day, however, the sign remover writes a message 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 sign remover's message*. Again, the First Amendment would preclude the court from ruling against the sign remover based upon that *content*, 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 a ruling that the sign remover had, on account of his destruction (or alteration) of the sign, engaged in trespass to chattels.

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Example: a restaurant has a trademark for a neon-light logo. A person who lives across the street petitions the Board for the mark's cancellation, claiming, with respect to the merits, that the mark is deceptive in violation of 15 U.S.C. Sections 1052(a) and/or (e), but alleges, with respect to *standing*, that the neon light is hurting his eyes, causing him to lose sleep, or causing a medical ailment. The fact that the petitioner has not alleged that he was deceived, *i.e.*, has not alleged that his *injury* correlates with the *merits* of his claim, would not deprive him of standing.

Example: a petitioner for cancellation claims, with respect to the *merits*, that a mark is deceptive in violation of 15 U.S.C. Sections 1052(a) and/or (e). With respect

to standing, he alleges that he wants to use the mark (presumably in a non-deceptive manner). Such a case is, essentially, the opposite of the instant one, and just as the lack of correlation between the basis for standing and the basis of the merits would not deprive the exemplified petitioner of standing, neither does it deprive Bank of standing.

Finally, whereas, under *Matal v. Tam*, 137 S. Ct. 1744 (2017), the Government may not decline to register, nor may cancel, a mark based upon offensiveness, that prohibition concerns the *merits* of such a refusal or cancellation. Thus, with respect to the *merits* of the Petition, Bank may not, and does not, rely upon the offensiveness of the Restaurant's mark. However, the foreclosure of such reliance has *nothing to do with standing*.

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**B. ~~The Board Wrongly Found that Standing is Limited to Competitors of a Markholder~~**

The Board stated: “[i]n order to plead standing to challenge a registration based on a claim that the mark is functional, a plaintiff must plead that it is a *competitor*, that it is engaged in the *manufacture or sale of the same or related goods*, or that it otherwise has a current or prospective *right or interest in using the mark*.” Order at 4 (Appx5), citing *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 U.S.P.Q.2d 1508, 1512 (T.T.A.B. 2017) (emphases added). *Poly-America*, however, cited *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999), for the proposition that “[a] petitioner is required only to be in a position to have a right to use the mark in question,” *Poly-America*, 124 U.S.P.Q.2d at 1512, whereas *Ritchie* contained no such requirement.



Rather, the opposite is the case, for, as *Ritchie* explained:

In *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*. Nor have we ever held that being a member of a group with many members is itself disqualifying. The 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. *See* 15 U.S.C. § 1063.

*Ritchie*, 170 F.3d at 1096-1097 (emphases added).

The Board next cites *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 U.S.P.Q.2d 1829, 1832 (T.T.A.B. 2013), for “finding standing to assert claim of functionality where opposer demonstrated that it was engaged in the manufacture of goods similar to those in the subject application.” Order at 4-5 (Appx5-6). However, *AS Holdings* did not suggest that standing was *limited* to business competitors of the markholder; indeed, *AS Holdings* recognized that “[an] opposer must meet the liberal threshold for proving standing as discussed by the Court of Appeals for the Federal Circuit, namely, whether an opposer's belief in damage has a ‘reasonable’ basis in fact and reflects a ‘real interest’ in the case,” *AS Holdings*, 107 U.S.P.Q.2d at 1832, for which *AS Holdings* cited, *inter alia*, *Ritchie*.

**C. It is Irrelevant, to a Petition for Cancellation, Whether the Mark in Question is Part of a Class of Marks to Which the Petitioner Might also Object**

The Board stated:

Moreover, Petitioner's pleading of standing is vague and *does not relate specifically to the involved service mark*. Petitioner pleads that a registration "that applies to the activity of an animal is demeaning to the type of animal that is the subject of such mark." Petition to cancel ¶¶ 1-3. The pleading therefore appears to allege, in general, that a trademark registration for *any mark involving the use of animals* for use in connection with *any services* is "demeaning." The petition to cancel does not allege that Petitioner has a reasonable belief of harm from *Respondent's involved registration for restaurant services*.

Order at 7 (Appx8) (emphases added). The fact that the basis of Bank's assertion of harm, *i.e.*, that Appellant's mark, in "appl[ying] to the activity of an animal (as opposed to a trademark that is merely a representation of such activity) is demeaning to the type of animal that is the subject of such mark," Pet., ¶ 1 (Appx15), and that "[t]he demeaning of animals in the manner set forth in the previous paragraph is offensive to Bank and denigrates the value he places on the respect, dignity, and worth of animals," *id.*, ¶ 2 (Appx15), might also apply to *other* marks does not deprive Bank of standing. In *Ritchie*, this Court held that the petitioner had standing to oppose "the trademarks O.J. SIMPSON, O.J., and THE JUICE," *Ritchie*, 170 F.3d at 1093, based upon:

"[his] [alleg]ation, *inter alia*, that he would be damaged by the registration of the marks because the marks disparage

his *values*, especially those values *relating to his family*. In addition, in his notice of opposition, Mr. Ritchie described himself as a “*family man*” who believes that the “sanctity of marriage requires a husband and wife who *love and nurture one another*,” and as a member of a group that could be *potentially damaged by marks that allegedly are synonymous with wife-beater and wife-murderer*. Furthermore, Mr. Ritchie alleged that the marks are *scandalous* because they would “*attempt to justify physical violence against women*.”

*Id.* at 1097 (emphases added). Just as the petitioner in *Ritchie* had standing even though the number of marks that could have offended him was as limitless as the imagination, and just as he was concerned solely with the mere existence of the opposed marks, rather than with their intended uses, *i.e.*, “with a broad range of goods, including figurines, trading cards, sportswear, medallions, coins, and prepaid telephone cards,” *id.* at 1093, Bank, who is analogously situated, likewise has standing.

## POINT II

### APPELLEE’S MARK IS FUNCTIONAL

The absurdity of the Appellee’s mark 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.

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. . . [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 [R]estaurant, 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 [Restaurant's] advertising slogan, "Come for the goats, stay for the food," highlights that the goats are a key component of the overall [R]estaurant experience*. [footnote citing Stephan Kinsella, *When Trademark Law and Goats Run Amok*, CHRISTIAN SCI. MONITOR (Sept. 24, 2010), [www.csmonitor.com/Business/Mises-Economics-Blog/2010/0924/When-trademark-law-and-goats-run-amok](http://www.csmonitor.com/Business/Mises-Economics-Blog/2010/0924/When-trademark-law-and-goats-run-amok) [(last checked June 3, 2019)]. 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 [R]estaurant's *lawn[-]maintenance* needs is enough [footnote citing *Traffix Devices*, 532 U.S. at 34]. Interestingly, the *[Restaurant's] 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 [R]estaurant 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.

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. . . . [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 the Restaurant's mark as "the mark that stands [] beyond [the] nontraditional summit").

**A. The Board's Notion that Functionality Must be Assessed with Respect to Only the Goods or Services to Which a Mark Applies**

The Board stated:

Petitioner has pleaded that placing goats on a grass roof is "economically advantageous" because it reduces the need to cut grass on a grass roof; however, Petitioner does not allege that goats on grass roofs are essential to the use or purpose or affect the cost or quality of **restaurant services**. See *Doyle [v. Al Johnson's Swedish Restaurant & Butik, Inc.]*, 101 U.S.P.Q.2d [1780] at 1783 [(T.T.A.B. 2012)] ("[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.**") (emphasis in

original).

Order at 9 (Appx10) (bold in original). In *Doyle*, the Board also stated:

[B]y 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).*

*Doyle*, 101 U.S.P.Q.2d at 1783 (underlining in original; other emphases added).

However, neither *Two Pesos* nor *Duramax Marine* even suggest that functionality exists only when it pertains *solely or specifically* to the *particular goods or services*

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to which a mark applies. Of course, it would only make sense that the question of functionality would *often* pertain to such goods or services, for it is naturally common for a business to utilize features that are tailored to the business's industry. According to *Doyle*, however, a grocery store's plastic bags are *non-functional* because plastic bags are used by *many* types of businesses. Could the assertion of functionality of a bank's bulletproof glass be refuted by the argument that such glass would equally protect the employees of any other type of business? How obviously ridiculous!

Like the Restaurant's goats, the Hooter's restaurant chain's scantily clad employees provide aesthetic enjoyment to (at least some) customers, but Hooter's surely could not obtain a trademark for "scantily-clad waitresses," even though, like

the Restaurant's mark, the use of scantily-clad employees: (i) is not "essential to the use or purpose or affect the cost or quality of restaurant services," Order at 9 (Appx10) (bold in original); (ii) is "unrelated, to restaurant . . . services," *id.* (bold in original); and (iii) could benefit many types of businesses. Under the Board's rationale, a convenience-store owner could bring his dog to work and seek to register a mark for "dogs at a convenience-store." How obviously absurd! If the Restaurant hired an employee to stand in front of its restaurant all day and sing Swedish folk songs, would the Restaurant be entitled to register a mark for "singing Swedish folk songs in front of a restaurant"? If a restaurant's front yard had a pond 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 another restaurant owner who, on a cold January day, receives a cease-and-desist letter!

**B. The Board Wrongly Found that Aesthetics are Entirely Unrelated to Functionality**

The Board stated:

Petitioner also pleads that use of the involved mark is *primarily a form of entertainment* and that it "*increases the appeal*" of Respondent's services and that the use of goats on a grass roof is a *superior form of entertainment*. Petitioner has again failed to plead a nexus between the *alleged aesthetic superiority* of the design and *Respondent's restaurant services*. Moreover, "functionality hinges on whether registration of a particular feature hinders *competition* and not on whether the feature

contributes to the product's *commercial success*." *M-5 Steel Mfg, Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1097 (TTAB 2001). Petitioner has failed to allege that the alleged superior design *hinders competition* or "provide[s] a *competitive advantage*." *See id.* In other words, Petitioner has failed to allege that the involved registration is *functional*, as opposed to *merely aesthetically pleasing*. *See Qualitex Co. v. Johnson Products Co., Inc.*, 514 U.S.159, 165 (1995) ("The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.").

Order at 9-10 (Appx 10-11 (emphases added). Here, the Board completely misread not only *Qualitex*, but *M-5 Steel*. In the latter, the Board stated:

The Federal Circuit has made clear that traditional trademark principles govern the registrability of a proposed mark's *aesthetic features*. The test for functionality hinges on whether registration of a particular feature *hinders competition* and not on whether the feature contributes to the product's *commercial success*. [*Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532 (Fed. Cir. 1994)][.] That is, "[a]esthetic ingredients to commercial success are *not necessarily de jure functional*." *Id.* [at 1533][.] In the *Brunswick* case, *color compatibility* and the ability to *decrease apparent engine size* were *not said to be mere aesthetic features*. Rather, these features supplied a *competitive advantage*. *See also Deere & Co. v. Farmhand, Inc.*, 560 F.Supp. 85, 217 USPQ 252 (S.D. Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir. 1983) [per curiam] (*color green* was held to be "*aesthetically functional*" in that *purchasers wanted their farm equipment to match*); and *In re Ferris Corp.*, 59 USPQ2d 1587 (TTAB 2000) (*pink or flesh color* held *functional for wound dressings*).

*M-5 Steel*, 61 U.S.P.Q.2d at 1097 (emphases added).



In *Qualitex*, 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).” *Qualitex*, 514 U.S. at 169 (citing cases). Just as the colors in the *Qualitex* Court’s examples were not relevant to how the products performed, but, rather, affected one’s enjoyment of using the products and thus provided a competitive advantage, and, therefore, were not “mere aesthetic features,” *M-5 Steel*, 61 U.S.P.Q.2d at 1097, or not “merely aesthetically pleasing,” Order at 10 (Appx11), but were, instead, “aesthetically functional,” *M-5 Steel*, 61 U.S.P.Q.2d at 1097, so, too, is the Restaurant’s mark. See above quotation from Burgunder, *supra*.

[continued on next page]

**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: August 14, 2019



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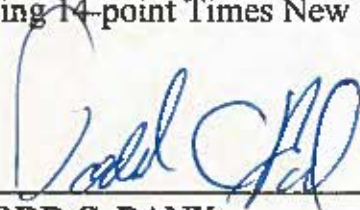
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*Counsel to Appellant*

**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 4,068 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: August 14, 2019

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

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 APPENDIX**

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*Counsel to Appellant*

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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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mbm/tdc

May 2, 2019

Cancellation No. 92069777

*Todd C. Bank*

v.

*Al Johnson's Swedish Restaurant and  
Butiks, Inc.<sup>1</sup>*

**By the Trademark Trial and Appeal Board:**

On March 27, 2019, Petitioner was allowed twenty days in which to file and serve an amended petition to cancel that properly pleads his standing and states a valid claim for relief, if Petitioner has a sound basis for doing so pursuant to Fed. R. Civ. P. 11, failing which the petition to cancel will be denied with prejudice.

To date, no response has been received.

In view thereof, the petition to cancel is denied with prejudice.

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<sup>1</sup> Registrant's revocation and power of attorney filed April 18, 2019 is noted. The Board records have been updated to reflect this change.

THIS ORDER IS NOT A  
PRECEDENT OF THE  
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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mbm

March 27, 2019

Cancellation No. 92069777

*Todd C. Bank*

*v.*

*Al Johnson's Swedish Restaurant and  
Butiks, Inc.*

**By the Trademark Trial and Appeal Board:**

This proceeding now comes before the Board for consideration of the motion (filed November 28, 2018) of Al Johnson's Swedish Restaurant and Butiks, Inc. ("Respondent") to dismiss the petition to cancel of Todd C. Bank ("Petitioner") for failure to state a claim upon which relief may be granted under Fed. R. Civ. P. 12(b)(6). Petitioner filed a response to the motion to dismiss on November 30, 2018.

**I. Background**

Respondent is the owner of Registration No. 2007624, for the mark displayed below, for "Restaurant services" in International Class 42:<sup>1</sup>

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<sup>1</sup> Registration No. 2007624, issued October 15, 1996, alleging June 1, 1973 as both the date of first use and the date of first use in commerce. Section 8 and 9 declaration accepted January 19, 2017.

Cancellation No. 92069777



The description of the involved mark is as follows: “The mark consists of goats on a roof of grass. The dotted lines in the drawing are intended to indicate the location of the mark and are not a feature of the mark.”

On October 12, 2018, Petitioner filed a petition to cancel Respondent’s involved registration on the ground that the mark is functional under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5).<sup>2</sup>

In lieu of filing an answer to the petition to cancel, Respondent filed a motion to dismiss. Respondent contends that Petitioner has failed to adequately plead his standing or a cognizable ground for relief.

## II. Motion to Dismiss

To 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.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 663, 129 S. Ct. 1937, 1949 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570, 127 S. Ct. 1955, 1974 (2007). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged. See *Twombly*, 550 U.S. at 556-557. However, the plausibility standard does not require

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<sup>2</sup> In his response to the motion to dismiss, Petitioner acknowledges that functionality is the only asserted ground for cancellation in the petition to cancel.



Cancellation No. 92069777

that a plaintiff set forth detailed factual allegations. *Id.* Rather, a plaintiff need only allege “enough factual matter...to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). Moreover, it is well established that whether a plaintiff can actually prove its allegations is not a matter to be determined upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (“A motion to dismiss does not involve a determination of the merits of the case...”).

For purposes of determining such motion, all of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 1161, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). As plaintiff, the claimant must plead factual content that allows the Board to draw a reasonable inference that it has standing and that a valid ground for cancellation exists. *Cf. Twombly*, 550 U.S. at 556. In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Iqbal*, 129 S. Ct. at 1949 (*citing Twombly*, 550 U.S. at 555).

#### **A. Standing**

Section 14 of the Trademark Act provides that “[a] petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee,

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be filed...by any person who believes that he is or will be damaged...by the registration of a mark on the [P]rincipal [R]egister.” Section 14 thus establishes a broad doctrine of standing; by its terms, the statute requires only that a person have a belief that he would suffer some kind of damage if the mark is registered. As interpreted in binding precedent, a petitioner must have a “real interest” in the outcome of the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage by the continued registration of the mark. *See Empresa Cubana del Tabaco*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)); *Universal Oil Prods. Co. v. Rexall Drug & Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). To prove a “real interest” in the case, Opposer must show that it has a “direct and personal stake” in the outcome and is more than a “mere intermeddler.” *Ritchie*, 50 USPQ2d at 1026-27.

In order to plead standing to challenge a registration based on a claim that the mark is functional, a plaintiff must plead that it is a competitor, that it is engaged in the manufacture or sale of the same or related goods, or that it otherwise has a current or prospective right or interest in using the mark. *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (“A petitioner is required only to be in a position to have a right to use the mark in question...This test logically also applies to the question of whether Petitioner has standing to assert its claim that Respondent’s mark ... comprises matter that, as a whole, is functional.”); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1832 (TTAB

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2013) (finding standing to assert claim of functionality where opposer demonstrated that it was engaged in the manufacture of goods similar to those in the subject application).

In support of his standing, Petitioner alleges, *inter alia*, the following:

- “[Petitioner] believes that the granting ... of a trademark, including a service mark ... that applies to the activity of an animal (as opposed to a trademark that is merely a representation of such activity) is demeaning to the type of animal that is the subject of such mark.” Petition to cancel ¶ 1.
- “The demeaning of animals in the manner set forth in the previous paragraph is offensive to [Petitioner] and denigrates the value he places on the respect, dignity, and worth of animals.” *Id.* at ¶ 2.
- “Numerous 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.” *Id.* at ¶ 3.
- “The demeaning of animals in the manner set forth above is offensive to numerous persons and denigrates the value they place on the respect, dignity, and worth of animals.” *Id.* at ¶ 4.

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Respondent argues that Petitioner has failed to plead his standing to bring a claim that Respondent’s involved mark is functional. Respondent contends that the Supreme Court found in *Matal v. Tam*, 127 S.Ct. 1744, 1764 (2017) that the prohibition against registering disparaging marks under Section 2(a) of the Trademark Act is unconstitutional. 4 TTABVUE 5. As a result, Respondent contends that Petitioner’s assertions that he finds the involved mark offensive to Petitioner and demeaning to goats cannot form the basis for Petitioner’s purported standing to bring this proceeding. *Id.*

In response, Petitioner acknowledges that disparagement is no longer a cognizable claim under the Trademark Act. 6 TTABVUE 7. Petitioner argues, however, that his

Cancellation No. 92069777

allegations that the mark is offensive to him are sufficient to support a pleading of standing. *Id.* Accordingly, Petitioner argues that although he “may not rely upon the offensiveness of [Respondent’s] trademark in order to prevail on the merits ... the foreclosure upon such reliance has **nothing to do with standing...**” *Id.* at 8 (emphasis in original). Petitioner relies upon *Ritchie v. Simpson*, 170 F.3d 1092, 1098 (Fed. Cir. 1999) for the proposition that a plaintiff may have standing where the plaintiff pleads that a mark “would disparage members of a certain group [and] could allege that he is a member of that group.” *Id.* at 10.

In this case, as acknowledged by Petitioner, the only ground for cancellation is the claim of functionality. Thus, Petitioner must adequately plead his standing **to assert a claim of functionality**. *Ritchie* found that the plaintiff adequately pleaded his standing to assert that the subject marks were scandalous under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), by alleging that he found the subject mark offensive to his personal values. *See Ritchie*, 170 F.3d at 1094 (“[T]he controlling precedents of this court, as well as the precedents of the Board, are fully consistent with recognizing that someone in Mr. Ritchie’s position has standing to oppose a registration **on the grounds raised here.**”) (emphasis added). *Ritchie* does not establish that an individual’s personal offense to a mark is sufficient to plead standing to assert a claim of functionality. Thus, Petitioner may not rely upon allegations that the involved mark is personally offensive to him to plead his standing to assert a claim that the involved mark is functional.<sup>3</sup>

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<sup>3</sup> If a plaintiff adequately pleads its standing to assert one claim, then the plaintiff may also plead any other legally sufficient claim. *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d

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Here, Petitioner has not pleaded that he has a present or prospective right or interest in Respondent's involved mark or any other facts sufficient to allege his standing to assert a claim that Respondent's involved mark is functional. *See Poly-America, L.P.*, 124 USPQ2d at 1512.

Moreover, Petitioner's pleading of standing is vague and does not relate specifically to the involved service mark. Petitioner pleads that a registration "that applies to the activity of an animal is demeaning to the type of animal that is the subject of such mark." Petition to cancel ¶¶ 1-3. The pleading therefore appears to allege, in general, that a trademark registration for any mark involving the use of animals for use in connection with any services is "demeaning." The petition to cancel does not allege that Petitioner has a reasonable belief of harm from Respondent's involved registration for restaurant services.

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In view thereof, Respondent's motion to dismiss Petitioner's claim in its entirety for failure to adequately allege his standing is granted.

Notwithstanding the foregoing, it is the Board's well-established practice to freely grant leave to amend pleadings found to be insufficient upon challenge under Fed. R. Civ. P. 12(b)(6). *See Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711,

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1873 (TTAB 2011) (finding pleading of standing different for different claims and finding that once a plaintiff has pleaded standing as to at least one properly pleaded ground, the plaintiff may also plead any other legally sufficient claims); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012) ("[O]nce an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052" and finding that because the plaintiff had established a real interest and reasonable basis for belief of damage "in the form of likelihood of confusion or dilution, it also has standing to assert a claim on descriptiveness grounds."). Inasmuch as the only claim asserted is functionality, however, Petitioner must plead standing to assert that claim.

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1714 (TTAB 1993); *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1955 (TTAB 2009). In view thereof, Petitioner is allowed time in which to amend his pleading, if justified and appropriate, as further set forth below.

## B. Functionality

In support of his claim of that the involved mark is functional, Petitioner pleads, *inter alia*, the following:

- “The primary use of the Marks[sic] is as a form of entertainment that increases, to customers, the appeal of [Respondent’s] place of business, which is Al Johnson’s Swedish Restaurant & Butik (the ‘Establishment’).” Petition to cancel ¶ 5.
- “To whatever extent the Marks[sic] serve as identification with respect to the Establishment, such service is not the primary effect of the Marks[sic], and such service pales in comparison to the provision, by the Marks[sic], of entertainment that increases, to customers, the appeal of the Establishment.” *Id.* at ¶ 6.
- “The use of the Marks[sic] as a form of entertainment that increases, to customers, the appeal of the Establishment is unique.” *Id.* at ¶ 7.
- “The use of the Marks[sic] as a form of entertainment that increases, to customers, the appeal of the Establishment is functional.” *Id.* at ¶ 8.
- “The use of the Marks[sic] as a form of entertainment that increases, to customers, the appeal of the Establishment is superior to other methods.” *Id.* at ¶ 9.
- “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.

A mark is unregistrable under Section 2(e)(5) of the Trademark Act where it “comprises any matter that, as a whole, is functional.” There are two forms of functionality: utilitarian functionality and aesthetic functionality. *See In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 13 n.1 (CCPA 1982); *In re Florists’*

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*Transworld Delivery Inc.*, 106 USPQ2d 1784, 1786-87 (TTAB 2013). 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 USPQ2d 1701, 1718 (TTAB 2010) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). A functional feature is one the “exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1164 (1995). “[I]t is well settled that functionality must be assessed in connection with the goods or services at issue....” *Doyle v. Al Johnson’s Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780, 1783 (TTAB 2012) (citing *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)).

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Petitioner has pleaded that placing goats on a grass roof is “economically advantageous” because it reduces the need to cut grass on a grass roof; however, Petitioner does not allege that goats on grass roofs are essential to the use or purpose or affect the cost or quality of **restaurant services**. See *Doyle*, 101 USPQ2d at 1783 (“[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**.”) (emphasis in original).

Petitioner also pleads that use of the involved mark is primarily a form of entertainment and that it “increases the appeal” of Respondent’s services and that

Cancellation No. 92069777

the use of goats on a grass roof is a superior form of entertainment. Petitioner has again failed to plead a nexus between the alleged aesthetic superiority of the design and Respondent's restaurant services. Moreover, "functionality hinges on whether registration of a particular feature hinders competition and not on whether the feature contributes to the product's commercial success." *M-5 Steel Mfg, Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1097 (TTAB 2001). Petitioner has failed to allege that the alleged superior design hinders competition or "provide[s] a competitive advantage." *See id.* In other words, Petitioner has failed to allege that the involved registration is functional, as opposed to merely aesthetically pleasing. *See Qualitex Co. v. Johnson Products Co., Inc.*, 514 U.S. 159, 165 (1995) ("The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.").

In view thereof, Respondent's motion to dismiss Petitioner's claim of functionality is **granted**. Petitioner is allowed time in which to replead, however, if justified and appropriate, as further set forth below.

Petitioner is allowed until **twenty days** from the date of this order in which to file and serve an amended petition to cancel that properly pleads his standing and states a valid claim for relief, if Petitioner has a sound basis for doing so pursuant to Fed. R. Civ. P. 11, failing which the petition to cancel will be denied with prejudice.



Cancellation No. 92069777

In turn, Respondent is allowed until **twenty days** from the date of service of the amended petition to cancel in which to file and serve an answer or otherwise respond to the amended pleading.

### III. Schedule

Proceedings herein are resumed. Remaining dates are reset as follows:

Time to Answer	<b>5/7/2019</b>
Deadline for Discovery Conference	<b>6/6/2019</b>
Discovery Opens	<b>6/6/2019</b>
Initial Disclosures Due	<b>7/6/2019</b>
Expert Disclosures Due	<b>11/3/2019</b>
Discovery Closes	<b>12/3/2019</b>
Plaintiff's Pretrial Disclosures Due	<b>1/17/2020</b>
Plaintiff's 30-day Trial Period Ends	<b>3/2/2020</b>
Defendant's Pretrial Disclosures Due	<b>3/17/2020</b>
Defendant's 30-day Trial Period Ends	<b>5/1/2020</b>
Plaintiff's Rebuttal Disclosures Due	<b>5/16/2020</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>6/15/2020</b>
Plaintiff's Opening Brief Due	<b>8/14/2020</b>
Defendant's Brief Due	<b>9/13/2020</b>
Plaintiff's Reply Brief Due	<b>9/28/2020</b>
Request for Oral Hearing (optional) Due	<b>10/8/2020</b>

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be

Cancellation No. 92069777

submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

PETITION TO CANCEL

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,	
<i>Petitioner,</i>	
v.	
AL JOHNSON'S SWEDISH RESTAURANT & BUTIK, INC.,	
<i>Registrant.</i>	

Cancellation No. \_\_\_\_\_

Petitioner, Todd C. Bank (“Bank”), an individual and citizen of the United States with an address at 119-40 Union Turnpike, Fourth Floor, Kew Gardens, New York 11415, 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 the marks that are covered by Trademark Registration No. 2,007,624 and International Trademark Registration No. 3,942,832 (collectively, the “Marks”).

Registrant, Al Johnson’s Swedish Restaurant & Butik, Inc., is a corporation organized and existing under the laws of Wisconsin, and maintains its principal place of business at 10698 North Bay Shore Drive, Sister Bay, Wisconsin 54234.

As grounds for cancellation, Bank alleges:

1. Bank believes that the granting to, or possession by, a person (here, and with respect to all other references to persons, "person" is used as defined in 15 U.S.C. § 1127) of a trademark, including a service mark (each, a "mark"), that applies to the activity of an animal (as opposed to a trademark that is merely a representation of such activity) is demeaning to the type of animal that is the subject of such mark.

2. The demeaning of animals in the manner set forth in the previous paragraph is offensive to Bank and denigrates the value he places on the respect, dignity, and worth of animals.

3. Numerous 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.

4. The demeaning of animals in the manner set forth above is offensive to numerous persons and denigrates the value they place on the respect, dignity, and worth of animals.

5. The primary use of the Marks is as a form of entertainment that increases, to customers, the appeal of Registrant's place of business, which is Al Johnson's Swedish Restaurant & Butik (the "Establishment").

6. To whatever extent the Marks serve as identification with respect to the Establishment, such service is not the primary effect of the Marks, and such service pales in comparison to the provision, by the Marks, of entertainment that increases, to customers, the appeal of the Establishment.

7. The use of the Marks as a form of entertainment that increases, to customers, the appeal of the Establishment is unique.

8. The use of the Marks as a form of entertainment that increases, to customers, the appeal of the Establishment is functional.

9. The use of the Marks as a form of entertainment that increases, to customers, the appeal of the Establishment is superior to other methods.

10. 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.

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

Dated: October 12, 2018

Respectfully submitted,

/ Todd C. Bank /

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 Petitioner*



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### Record 1 out of 1

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**Goods and Services** IC 035. US 100 101 102. G & S: Retail store and online retail store services featuring gifts, food, clothing, toys, linens, dolls, books and music. FIRST USE: 19730601. FIRST USE IN COMMERCE: 19730601

**Mark Drawing Code** (2) DESIGN ONLY

**Design Search Code** 03.07.10 - Goats ; Goats, sheep, rams ; Lambs ; Rams ; Sheep  
 05.13.03 - Grasses  
 07.01.04 - Detached house

**Serial Number** 77936651

**Filing Date** February 16, 2010

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** January 25, 2011

**Change in Registration** CHANGE IN REGISTRATION HAS OCCURRED

**Registration Number** 3942832

**Registration Date** April 12, 2011

**Owner** (REGISTRANT) Al Johnson's Swedish Restaurant & Butiks, Inc. CORPORATION WISCONSIN 10698 N. Bay Shore Drive Sister Bay WISCONSIN 54234

**Attorney of Record** Katrina G. Hull

**Prior Registrations** 2007624

**Description of Mark** Color is not claimed as a feature of the mark. The mark consists of building décor with a roof comprised of grass and bearing several goats on the roof. The broken lines show the placement of the mark in relation to the

supporting building which is not claimed as part of the mark.

Type of Mark SERVICE MARK

Register PRINCIPAL-2(F)

Affidavit Text SECT 15. SECT 8 (6-YR).

Live/Dead Indicator LIVE

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

TODD C. BANK,  <i>Petitioner.</i>
v.
AL JOHNSON'S SWEDISH RESTAURANT & BUTIK, INC.,  <i>Registrant.</i>

Cancellation No. 92069777

**NOTICE OF APPEAL**

**PLEASE TAKE NOTICE**, that Petitioner, Todd C. Bank, hereby appeals the following to the United States Court of Appeals for the Federal Circuit: (i) each and every part of the Order dated March 27, 2019; and (ii) each and every part of the Order dated May 2, 2019.

Dated: May 3, 2019

---

/ Todd C. Bank /

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Kew Gardens, New York 11415  
(718) 520-7125  
tbank@toddbanklaw.com  
By: Todd C. Bank

*Counsel to Petitioner*



UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

TODD C. BANK,

Appellant,

v.

AL JOHNSON'S SWEDISH  
RESTAURANT AND BUTIKS,  
INC.,

Appellee.

Appeal No. 2019-1880

Re: TTAB Cancellation No. 92069777

**NOTICE FORWARDING CERTIFIED LIST**

A notice of appeal to the United States Court of Appeals for the Federal Circuit was timely filed on May 3, 2019, in the United States Patent and Trademark Office (USPTO), in connection with the above-identified cancellation proceeding.

Pursuant to 15 U.S.C. § 1071(a)(3) and Federal Circuit Rule 17(b)(1), the USPTO is today forwarding, to counsel for Appellant and Appellee, a certified list of documents comprising the record in the USPTO.

Respectfully submitted,

**ANDREI IANCU**

Under Secretary of Commerce for Intellectual  
Property and Director of the United States Patent  
and Trademark Office

Date: June 28, 2019

By: /s/ Krishawn D. Graham

**Krishawn D. Graham**

Paralegal Specialist

Mail Stop 8, P.O. Box 1450

Alexandria, Virginia 22313-1450

571-272-9035

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing NOTICE FORWARDING CERTIFIED LIST has been served via U.S. mail and electronic mail on pro se Appellant and counsel for Appellee this 28<sup>th</sup> day of June, 2019 as follows:

Todd C. Bank  
Todd C. Bank, Attorney at Law, P.C.  
119-40 Union Turnpike, Fourth Floor  
Kew Gardens, NY 11415  
Email: [tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)  
*Pro se Appellant*

Katrina Hull  
Jacqueline Patt  
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P.O. Box 84150  
Gaithersburg, MD 20883-4150  
Email(s): [katrinahull@markerylaw.com](mailto:katrinahull@markerylaw.com),  
[jackiepatt@markerylaw.com](mailto:jackiepatt@markerylaw.com)  
*Attorneys for Appellee*

---

By: /s/ Krishawn D. Graham  
**Krishawn D. Graham**  
Paralegal Specialist

Form PTO 55 (12-80)

**U.S. DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office**

June 28, 2019

(Date)

**THIS IS TO CERTIFY** that the annexed is an accurate statement of the content entries in the file of the trademark cancellation proceeding identified below. The list was taken from the TSDR and TTABVue electronic databases of this Office and comprises the record before the United States Patent and Trademark Office.

*Todd C. Bank*

v.

*Al Johnson's Swedish Restaurant and  
Butiks, Inc.*

Cancellation No. 92069777

Serial No. 74/646,306

Registration No. 2,007,624

Mark:



By authority of the  
DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

*/s/ Krishann D. Graham*

*Certifying Officer*

**HISTORY OF CANCELLATION NO. 92069777**  
**Federal Circuit Appeal No. 2019-1880**

Mark:



DATE	DESCRIPTION
10/12/2018	PETITION FOR CANCELLATION
10/22/2018	ORDER: NOTICE AND TRIAL DATES SENT; ANSWER DUE
11/28/2018	PETITIONER'S MOTION AND MEMORANDUM IN SUPPORT OF MOTION TO DISMISS THE CANCELLATION PETITION FOR FAILURE TO STATE A CLAIM UNDER RULE 12(b)(6)
11/29/2018	ORDER: PROCEEDINGS SUSPENDED PENDING DISPOSITION OF MOTION
11/30/2018	PETITIONER'S MEMORANDUM OF LAW IN OPPOSITION TO REGISTRANT'S MOTION TO DISMISS PETITION
03/27/2019	ORDER: MOTION TO DISMISS GRANTED; PROCEEDINGS RESUMED; TRIAL DATES RESET
04/18/2019	REVOCATION AND POWER OF ATTORNEY
04/18/2019	REVOCATION AND POWER OF ATTORNEY (DUPLICATE)
05/02/2019	BOARD DECISION
05/03/2019	NOTICE OF APPEAL TO THE FEDERAL CIRCUIT

**PROSECUTION HISTORY OF SERIAL NO. 74/646,306  
(REGISTRATION NO. 2,007,624)  
Federal Circuit Appeal No. 2019-1880**

Mark:



DATE	DESCRIPTION
02/27/1995	APPLICATION
02/27/1995	SPECIMEN
04/11/1995	FEE RECORD SHEET
07/05/1995	AMENDMENT WORKSHEET
08/07/1995	FILE JACKET
08/09/1995	XSEARCH SEARCH SUMMARY
08/14/1995	OFFICE ACTION
09/06/1995	RESPONSE TO OFFICE ACTION
09/28/1995	OFFICE ACTION
03/20/1996	DECLARATION
03/28/1996	RESPONSE TO OFFICE ACTION
05/14/1996	AMENDMENT EXAMINATION WORKSHEET
06/04/1996	PUBLICATION/REGISTRATION EXAMINATION WORKSHEET
06/21/1996	NOTICE OF PUBLICATION
07/23/1996	PUBLICATION CONFIRMATION
10/15/1996	REGISTRATION CERTIFICATE
08/23/2002	COMBINED AFFIDAVIT OF USE AND INCONTESTABILITY UNDER SECTIONS 8 AND 15, WITH DECLARATION
08/23/2002	COMBINED AFFIDAVIT OF USE AND INCONTESTABILITY UNDER SECTIONS 8 AND 15, WITH DECLARATION (FAXED COPY)
10/20/2005	SPECIMEN
10/20/2005	COMBINED DECLARATION OF USE IN COMMERCE AND APPLICATION FOR RENEWAL OF REGISTRATION OF A MARK UNDER SECTIONS 8 AND 9
01/18/2006	NOTICE OF ACCEPTANCE AND NOTICE OF RENEWAL
12/30/2008	NOTICE OF DESIGN SEARCH CODE FOR SERIAL NUMBER 74646306 AND REGISTRATION NUMBER 2007624
10/15/2015	OFFICIAL USPTO COURTESY REMINDER OF REQUIRED TRADEMARK REGISTRATION MAINTENANCE FILINGS UNDER SECTIONS 8 AND 9
10/11/2016	SECTION 7 REQUEST FORM

DATE	DESCRIPTION
10/12/2016	SPECIMEN
10/12/2016	COMBINED DECLARATION OF USE AND/OR EXCUSABLE NONUSE/APPLICATION FOR RENEWAL OF REGISTRATION OF A MARK UNDER SECTIONS 8 AND 9
01/04/2017	NON-FINAL OFFICE ACTION
01/18/2017	RESPONSE TO OFFICE ACTION FOR POST-REGISTRATION MATTERS
01/19/2017	OFFICIAL USPTO NOTICE OF ACCEPTANCE AND RENEWAL SECTIONS 8 AND 9
02/21/2017	UPDATED REGISTRATION CERTIFICATE
04/22/2017	REVOCATION, APPOINTMENT AND/OR CHANGE OF ADDRESS OF ATTORNEY/DOMESTIC REPRESENTATIVE

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

<p>TODD C. BANK,</p> <p style="text-align: right;"><i>Petitioner,</i></p> <p style="text-align: center;">v.</p> <p>AL JOHNSON'S SWEDISH RESTAURANT &amp; BUTIK, INC.,</p> <p style="text-align: right;"><i>Registrant.</i></p>
--

Cancellation No. 92069777

NOTICE OF APPEAL

PLEASE TAKE NOTICE, that Petitioner, Todd C. Bank, hereby appeals the following to the United States Court of Appeals for the Federal Circuit: (i) each and every part of the Order dated March 27, 2019; and (ii) each and every part of the Order dated May 2, 2019.

Dated: May 3, 2019

/ Todd C. Bank /  
TODD C. BANK,  
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By: Todd C. Bank

*Counsel to Petitioner*

OFFICE OF THE GENERAL COUNSEL  
2019 MAY 13 PM 5: 01  
US PATENT AND  
TRADEMARK OFFICE

THIS ORDER IS NOT A  
PRECEDENT OF THE  
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

mbm

March 27, 2019

Cancellation No. 92069777

*Todd C. Bank*

v.

*Al Johnson's Swedish Restaurant and  
Butiks, Inc.*

**By the Trademark Trial and Appeal Board:**

This proceeding now comes before the Board for consideration of the motion (filed November 28, 2018) of Al Johnson's Swedish Restaurant and Butiks, Inc. ("Respondent") to dismiss the petition to cancel of Todd C. Bank ("Petitioner") for failure to state a claim upon which relief may be granted under Fed. R. Civ. P. 12(b)(6). Petitioner filed a response to the motion to dismiss on November 30, 2018.

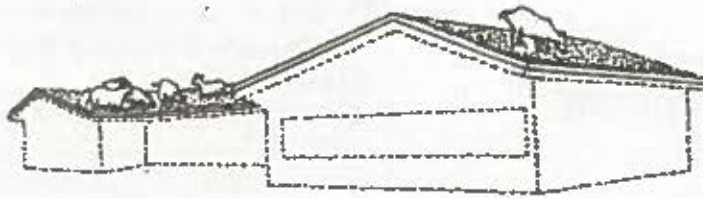
**I. Background**

Respondent is the owner of Registration No. 2007624, for the mark displayed below, for "Restaurant services" in International Class 42:<sup>1</sup>

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<sup>1</sup> Registration No. 2007624, issued October 15, 1996, alleging June 1, 1973 as both the date of first use and the date of first use in commerce. Section 8 and 9 declaration accepted January 19, 2017.





The description of the involved mark is as follows: "The mark consists of goats on a roof of grass. The dotted lines in the drawing are intended to indicate the location of the mark and are not a feature of the mark."

On October 12, 2018, Petitioner filed a petition to cancel Respondent's involved registration on the ground that the mark is functional under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5).<sup>2</sup>

In lieu of filing an answer to the petition to cancel, Respondent filed a motion to dismiss. Respondent contends that Petitioner has failed to adequately plead his standing or a cognizable ground for relief.

## II. Motion to Dismiss

To 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.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 663, 129 S. Ct. 1937, 1949 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570, 127 S. Ct. 1955, 1974 (2007). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged. See *Twombly*, 550 U.S. at 556-557. However, the plausibility standard does not require

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<sup>2</sup> In his response to the motion to dismiss, Petitioner acknowledges that functionality is the only asserted ground for cancellation in the petition to cancel.

that a plaintiff set forth detailed factual allegations. *Id.* Rather, a plaintiff need only allege “enough factual matter...to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isootoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). Moreover, it is well established that whether a plaintiff can actually prove its allegations is not a matter to be determined upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (“A motion to dismiss does not involve a determination of the merits of the case...”).

For purposes of determining such motion, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 1161, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). As plaintiff, the claimant must plead factual content that allows the Board to draw a reasonable inference that it has standing and that a valid ground for cancellation exists. *Cf. Twombly*, 550 U.S. at 556. In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Iqbal*, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 555).

#### A. Standing

Section 14 of the Trademark Act provides that “[a] petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee,

be filed...by any person who believes that he is or will be damaged...by the registration of a mark on the [P]rincipal [R]egister.” Section 14 thus establishes a broad doctrine of standing; by its terms, the statute requires only that a person have a belief that he would suffer some kind of damage if the mark is registered. As interpreted in binding precedent, a petitioner must have a “real interest” in the outcome of the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage by the continued registration of the mark. *See Empresa Cubana del Tabaco*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)); *Universal Oil Prods. Co. v. Rexall Drug & Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). To prove a “real interest” in the case, Opposer must show that it has a “direct and personal stake” in the outcome and is more than a “mere intermeddler.” *Ritchie*, 50 USPQ2d at 1026-27.

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In order to plead standing to challenge a registration based on a claim that the mark is functional, a plaintiff must plead that it is a competitor, that it is engaged in the manufacture or sale of the same or related goods, or that it otherwise has a current or prospective right or interest in using the mark. *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (“A petitioner is required only to be in a position to have a right to use the mark in question...This test logically also applies to the question of whether Petitioner has standing to assert its claim that Respondent’s mark ... comprises matter that, as a whole, is functional.”); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1832 (TTAB

2013) (finding standing to assert claim of functionality where opposer demonstrated that it was engaged in the manufacture of goods similar to those in the subject application).

In support of his standing, Petitioner alleges, *inter alia*, the following:

- “[Petitioner] believes that the granting ... of a trademark, including a service mark ... that applies to the activity of an animal (as opposed to a trademark that is merely a representation of such activity) is demeaning to the type of animal that is the subject of such mark.” Petition to cancel ¶ 1.
- “The demeaning of animals in the manner set forth in the previous paragraph is offensive to [Petitioner] and denigrates the value he places on the respect, dignity, and worth of animals.” *Id.* at ¶ 2.
- “Numerous 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.” *Id.* at ¶ 3.
- “The demeaning of animals in the manner set forth above is offensive to numerous persons and denigrates the value they place on the respect, dignity, and worth of animals.” *Id.* at ¶ 4.

Respondent argues that Petitioner has failed to plead his standing to bring a claim that Respondent’s involved mark is functional. Respondent contends that the Supreme Court found in *Matal v. Tam*, 127 S.Ct. 1744, 1764 (2017) that the prohibition against registering disparaging marks under Section 2(a) of the Trademark Act is unconstitutional. 4 TTABVue 5. As a result, Respondent contends that Petitioner’s assertions that he finds the involved mark offensive to Petitioner and demeaning to goats cannot form the basis for Petitioner’s purported standing to bring this proceeding. *Id.*

In response, Petitioner acknowledges that disparagement is no longer a cognizable claim under the Trademark Act. 6 TTABVue 7. Petitioner argues, however, that his

allegations that the mark is offensive to him are sufficient to support a pleading of standing. *Id.* Accordingly, Petitioner argues that although he “may not rely upon the offensiveness of [Respondent’s] trademark in order to prevail on the merits ... the foreclosure upon such reliance has **nothing to do with standing...**” *Id.* at 8 (emphasis in original). Petitioner relies upon *Ritchie v. Simpson*, 170 F.3d 1092, 1098 (Fed. Cir. 1999) for the proposition that a plaintiff may have standing where the plaintiff pleads that a mark “would disparage members of a certain group [and] could allege that he is a member of that group.” *Id.* at 10.

In this case, as acknowledged by Petitioner, the only ground for cancellation is the claim of functionality. Thus, Petitioner must adequately plead his standing to assert a claim of functionality. *Ritchie* found that the plaintiff adequately pleaded his standing to assert that the subject marks were scandalous under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), by alleging that he found the subject mark offensive to his personal values. *See Ritchie*, 170 F.3d at 1094 (“[T]he controlling precedents of this court, as well as the precedents of the Board, are fully consistent with recognizing that someone in Mr. Ritchie’s position has standing to oppose a registration **on the grounds raised here.**”) (emphasis added). *Ritchie* does not establish that an individual’s personal offense to a mark is sufficient to plead standing to assert a claim of functionality. Thus, Petitioner may not rely upon allegations that the involved mark is personally offensive to him to plead his standing to assert a claim that the involved mark is functional.<sup>3</sup>

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<sup>3</sup> If a plaintiff adequately pleads its standing to assert one claim, then the plaintiff may also plead any other legally sufficient claim. *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d

Here, Petitioner has not pleaded that he has a present or prospective right or interest in Respondent's involved mark or any other facts sufficient to allege his standing to assert a claim that Respondent's involved mark is functional. See *Poly-America, L.P.*, 124 USPQ2d at 1512.

Moreover, Petitioner's pleading of standing is vague and does not relate specifically to the involved service mark. Petitioner pleads that a registration "that applies to the activity of an animal is demeaning to the type of animal that is the subject of such mark." Petition to cancel ¶¶ 1-3. The pleading therefore appears to allege, in general, that a trademark registration for any mark involving the use of animals for use in connection with any services is "demeaning." The petition to cancel does not allege that Petitioner has a reasonable belief of harm from Respondent's involved registration for restaurant services.

In view thereof, Respondent's motion to dismiss Petitioner's claim in its entirety for failure to adequately allege his standing is **granted**.

Notwithstanding the foregoing, it is the Board's well-established practice to freely grant leave to amend pleadings found to be insufficient upon challenge under Fed. R. Civ. P. 12(b)(6). See *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711,

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1873 (TTAB 2011) (finding pleading of standing different for different claims and finding that once a plaintiff has pleaded standing as to at least one properly pleaded ground, the plaintiff may also plead any other legally sufficient claims); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012) ("[O]nce an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052" and finding that because the plaintiff had established a real interest and reasonable basis for belief of damage "in the form of likelihood of confusion or dilution, it also has standing to assert a claim on descriptiveness grounds."). Inasmuch as the only claim asserted is functionality, however, Petitioner must plead standing to assert that claim.

1714 (TTAB 1993); *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1955 (TTAB 2009). In view thereof, Petitioner is allowed time in which to amend his pleading, if justified and appropriate, as further set forth below.

### B. Functionality

In support of his claim of that the involved mark is functional, Petitioner pleads, *inter alia*, the following:

- “The primary use of the Marks[sic] is as a form of entertainment that increases, to customers, the appeal of [Respondent’s] place of business, which is Al Johnson’s Swedish Restaurant & Butik (the ‘Establishment’).” Petition to cancel ¶ 5.
- “To whatever extent the Marks[sic] serve as identification with respect to the Establishment, such service is not the primary effect of the Marks[sic], and such service pales in comparison to the provision, by the Marks[sic], of entertainment that increases, to customers, the appeal of the Establishment.” *Id.* at ¶ 6.
- “The use of the Marks[sic] as a form of entertainment that increases, to customers, the appeal of the Establishment is unique.” *Id.* at ¶ 7.
- ~~“The use of the Marks[sic] as a form of entertainment that increases, to customers, the appeal of the Establishment is functional.” *Id.* at ¶ 8.~~
- “The use of the Marks[sic] as a form of entertainment that increases, to customers, the appeal of the Establishment is superior to other methods.” *Id.* at ¶ 9.
- “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.

A mark is unregistrable under Section 2(e)(5) of the Trademark Act where it “comprises any matter that, as a whole, is functional.” There are two forms of functionality: utilitarian functionality and aesthetic functionality. *See In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9, 13 n.1 (CCPA 1982); *In re Florists’*

*Transworld Delivery Inc.*, 106 USPQ2d 1784, 1786-87 (TTAB 2013). 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 USPQ2d 1701, 1718 (TTAB 2010) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982)). A functional feature is one the “exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1164 (1995). “[I]t is well settled that functionality must be assessed in connection with the goods or services at issue....” *Doyle v. Al Johnson’s Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780, 1783 (TTAB 2012) (citing *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)).

Petitioner has pleaded that placing goats on a grass roof is “economically advantageous” because it reduces the need to cut grass on a grass roof; however, Petitioner does not allege that goats on grass roofs are essential to the use or purpose or affect the cost or quality of **restaurant services**. See *Doyle*, 101 USPQ2d at 1783 (“[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**.”) (emphasis in original).

Petitioner also pleads that use of the involved mark is primarily a form of entertainment and that it “increases the appeal” of Respondent’s services and that



the use of goats on a grass roof is a superior form of entertainment. Petitioner has again failed to plead a nexus between the alleged aesthetic superiority of the design and Respondent's restaurant services. Moreover, "functionality hinges on whether registration of a particular feature hinders competition and not on whether the feature contributes to the product's commercial success." *M-5 Steel Mfg, Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1097 (TTAB 2001). Petitioner has failed to allege that the alleged superior design hinders competition or "provide[s] a competitive advantage." *See id.* In other words, Petitioner has failed to allege that the involved registration is functional, as opposed to merely aesthetically pleasing. *See Qualitex Co. v. Johnson Products Co., Inc.*, 514 U.S. 159, 165 (1995) ("The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.").

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In view thereof, Respondent's motion to dismiss Petitioner's claim of functionality is **granted**. Petitioner is allowed time in which to replead, however, if justified and appropriate, as further set forth below.

Petitioner is allowed until **twenty days** from the date of this order in which to file and serve an amended petition to cancel that properly pleads his standing and states a valid claim for relief, if Petitioner has a sound basis for doing so pursuant to Fed. R. Civ. P. 11, failing which the petition to cancel will be denied with prejudice.

In turn, Respondent is allowed until **twenty days** from the date of service of the amended petition to cancel in which to file and serve an answer or otherwise respond to the amended pleading.

**III. Schedule**

Proceedings herein are resumed. Remaining dates are reset as follows:

Time to Answer	<b>5/7/2019</b>
Deadline for Discovery Conference	<b>6/6/2019</b>
Discovery Opens	<b>6/6/2019</b>
Initial Disclosures Due	<b>7/6/2019</b>
Expert Disclosures Due	<b>11/3/2019</b>
Discovery Closes	<b>12/3/2019</b>
Plaintiff's Pretrial Disclosures Due	<b>1/17/2020</b>
Plaintiff's 30-day Trial Period Ends	<b>3/2/2020</b>
Defendant's Pretrial Disclosures Due	<b>3/17/2020</b>
Defendant's 30-day Trial Period Ends	<b>5/1/2020</b>
Plaintiff's Rebuttal Disclosures Due	<b>5/16/2020</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>6/15/2020</b>
Plaintiff's Opening Brief Due	<b>8/14/2020</b>
Defendant's Brief Due	<b>9/13/2020</b>
Plaintiff's Reply Brief Due	<b>9/28/2020</b>
Request for Oral Hearing (optional) Due	<b>10/8/2020</b>

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be

submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500  
General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

mbm/tdc

May 2, 2019

Cancellation No. 92069777

*Todd C. Bank*

v.

*Al Johnson's Swedish Restaurant and  
Butiks, Inc.<sup>1</sup>*

**By the Trademark Trial and Appeal Board:**

On March 27, 2019, Petitioner was allowed twenty days in which to file and serve an amended petition to cancel that properly pleads his standing and states a valid claim for relief, if Petitioner has a sound basis for doing so pursuant to Fed. R. Civ.

P. 11, failing which the petition to cancel will be denied with prejudice.

To date, no response has been received.

In view thereof, the petition to cancel is denied with prejudice.

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<sup>1</sup> Registrant's revocation and power of attorney filed April 18, 2019 is noted. The Board records have been updated to reflect this change.

**CERTIFICATE OF SERVICE**

I hereby certify that on August 14, 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: August 14, 2019

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

RECEIVED

AUG 19 2019

United States Court of Appeals  
For The Federal Circuit

**Todd C. Bank, Attorney at Law, P.C.**  
**119-40 Union Turnpike**  
**Fourth Floor**  
**Kew Gardens, New York 11415**

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**TO:** United States Court of Appeals  
for the Federal Circuit  
717 Madison Place NW  
Washington, DC 20439  
Room 401  
Attn.: Clerk's Office