

**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

TODD C. BANK,

*Petitioner-Appellant,*

v.

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

*Registrant-Appellee.*

Docket No. 19-1880

**RECEIVED**

NOV 25 2019

United States Court of Appeals  
For The Federal Circuit

**APPELLANT'S MOTION FOR ORAL ARGUMENT ON THE APPEAL  
AND, IF ADVISABLE, ON THE PARTIES' MOTIONS FOR SANCTIONS**

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*

## **INTRODUCTION**

Appellant, Todd C. Bank (“Bank”), moves, pursuant to Rule 27 of the Federal Rules of Appellate Procedure, for the scheduling of oral argument on the appeal and, if advisable, on the parties’ motions for sanctions.

## **ARGUMENT**

### **POINT I**

#### **THE IMPORTANCE OF THE ISSUES BEFORE THIS COURT WARRANTS ORAL ARGUMENT**

The issues that this appeal concerns are significant: (i) whether the lack of a right to assert, for the *merits* of a challenge to a trademark, a particular basis, *i.e.*, offensiveness in this case, precludes that basis from being the grounds of the challenger’s *standing*; (ii) whether a mark, if otherwise functional, ceases to be functional if its functionality also applies to goods or services of industries other than the industry of the markholder, *i.e.*, here, the restaurant and/or gift-shop industry; (iii) whether, in order to challenge a mark on the basis that the mark is functional, the challenger must be a competitor of the markholder or a would-be user of the mark, or have a current or prospective right or interest in using the mark; and (iv) whether a form of entertainment that, as its primary effect, increases customers’ enjoyment of a business’s goods or services, as opposed to identifying the source of those goods or services, may be trademarked as a “mere aesthetic feature.”

**POINT II**

**APPELLANT REQUESTS, IF DEEMED ADVISABLE BY THE COURT,  
ORAL ARGUMENT ON THE PARTIES' MOTIONS FOR SANCTIONS**

With respect to the motion for sanctions (Doc. 31) against Bank, by Appellee, Al Johnson's Swedish Restaurant & Butik, Inc. (the "Restaurant"), Bank has explained, in his opposition and motion for sanctions against the Restaurant and its counsel (Doc. 33), that the Restaurant's motion is frivolous and vexatious. Accordingly, Bank requests oral argument on the motions if Bank's opposition/motion has not, in the Court's views, sufficiently addressed the bases of the Restaurant's and/or Bank's motions.

**CONCLUSION**

Appellant respectfully requests that the Court schedule oral argument on the appeal and, if advisable, on the parties' motions for sanctions.

**STATEMENT OF OPPOSITION**

As described in the accompanying declaration, Katrina G. Hull, counsel to the Restaurant, refused to engage in the discussion required by Federal Circuit Rule 27(a)(5). Instead, Ms. Hull stated, by email, that the Restaurant would oppose oral argument of the appeal.

Dated: November 21, 2019



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-Appellant*

**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

**Bank** v. **Al Johnson's Swednsh Rest.**

Case No. **19-1880**

**CERTIFICATE OF INTEREST**

Counsel for the:

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

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:

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

FORM 9. Certificate of Interest

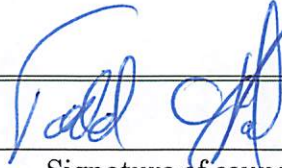
Form 9  
Rev. 10/17

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

11/21/2019

Date



Signature of counsel

Todd C. Bank

Printed name of counsel

Please Note: All questions must be answered

cc: \_\_\_\_\_

Reset Fields

**DECLARATION OF TODD C. BANK**

1. On November 20, 2019, I sent an email (a copy of which is annexed as Exhibit “A” hereto) to Katrina G. Hull, counsel to the Restaurant, that stated: “[p]lease let me know of your availability beginning at 5:00 today or any time tomorrow or Friday to discuss, pursuant to Local Rule 27(a)(5), my anticipated motion for oral argument of the appeal.” I immediately received an automatic reply (a copy of which is annexed as Exhibit “B” hereto).

2. After receiving the automatic reply, I forwarded, to Jacqueline Patt of Ms. Hull’s firm, the email that I had sent to Ms. Hull, and stated: “[i]f Ms. Hull will be unavailable during the times stated below, please let me know of your availability” (a copy of this email is annexed as Exhibit “C” hereto).

3. On November 21, 2019, I received an email from Ms. Hull (a copy of which is annexed as Exhibit “D” hereto) that stated: “[t]he deadline to request an oral argument has passed. Further, oral argument will unnecessarily increase the costs of this appeal. For these reasons, we will oppose your motion, should you decide to file it. You have our statement of opposition to your proposed motion.”

4. At 12:14 pm on November 21, 2019, I emailed a letter to Ms. Hull (a copy of which is annexed as Exhibit “E” hereto) that stated: “[r]egarding your email of this morning: as you know, Federal Circuit Rule 27(a)(5) requires us to discuss my anticipated motion. Therefore, please let me know when, today and/or tomorrow, you and/or Ms. Patt will be available.”

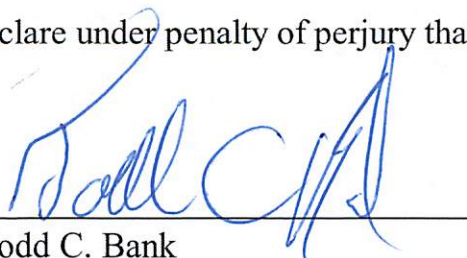
5. At 2:53 pm on November 21, 2019, I forwarded, to Ms. Patt, the 12:14 email, and stated: “[i]f Ms. Hull will be unavailable during the times stated below, please let me know of your availability” (a copy of this email is annexed as Exhibit “F” hereto).

6. At 3:44 pm on November 21, 2019, I emailed a letter to Ms. Hull (a copy of which is annexed as Exhibit “G” hereto) that stated: “I will also be seeking oral argument on the two sanctions motions. Therefore, please confirm whether you will comply with Federal Circuit Rule 27(a)(5); and, if you will comply, please let me know when, today and/or tomorrow, you and/or Ms. Patt will be available.”

7. At 4:51 pm on November 21, 2019, I forwarded, to Ms. Patt, the 3:44 email, and stated: “[i]f Ms. Hull will be unavailable to discuss the motion described in the below letter, please let me know of your availability as requested therein” (a copy of this email is annexed as Exhibit “G” hereto).

8. All of the communications between the Restaurant’s counsel and me with respect to the instant motion are set forth above.

Pursuant to 28 U.S.C. Section 1746, I declare under penalty of perjury that the foregoing is true and correct.

  
\_\_\_\_\_  
Todd C. Bank  
Executed on November 21, 2019



**EXHIBIT “A”**

**Email from Todd C. Bank  
to Katrina G. Hull**

**November 20, 2019**

**Subject:** Bank v. Al Johnson's Swedish Rest.  
**From:** Todd Bank <[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)>  
**Date:** 11/20/2019, 12:02 PM  
**To:** Katrina Hull <[katrinahull@markerylaw.com](mailto:katrinahull@markerylaw.com)>

Ms. Hull:

Please let me know of your availability beginning at 5:00 today or any time tomorrow or Friday to discuss, pursuant to Local Rule 27(a)(5), my anticipated motion for oral argument of the appeal.

Sincerely,

Todd C. Bank  
Attorney at Law  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
Telephone: (718) 520-7125  
Facsimile: (856) 997-9193  
[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)

**EXHIBIT “B”**

**Email from Katrina G. Hull  
to Todd C. Bank**

**November 20, 2019**

**Subject:** Automatic reply: Bank v. Al Johnson's Swedish Rest.

**From:** Katrina Hull <katrinahull@markerylaw.com>

**Date:** 11/20/2019, 12:02 PM

**To:** Todd Bank <tbank@toddbanklaw.com>

Thank you for your message. I will be out of the office through Friday, November 22, 2019 to attend the INTA Leadership Meeting, but I will have some access to email. If it is an emergency, please contact one of our paralegals: Tara Day ([TaraDay@MarkeryLaw.com](mailto:TaraDay@MarkeryLaw.com)), Direthea Cummings ([DiretheaCummings@MarkeryLaw.com](mailto:DiretheaCummings@MarkeryLaw.com)), or Michelle Goodwin ([MichelleGoodwin@MarkeryLaw.com](mailto:MichelleGoodwin@MarkeryLaw.com)). Otherwise, I will respond to your message as soon as I am able.

Katrina

**EXHIBIT “C”**

**Email from to Todd C. Bank  
to Jacqueline Patt**

**November 20, 2019**

**Subject:** Fwd: Bank v. Al Johnson's Swedish Rest.  
**From:** Todd Bank <[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)>  
**Date:** 11/20/2019, 2:53 PM  
**To:** [jackiepatt@markerylaw.com](mailto:jackiepatt@markerylaw.com)

Ms. Patt:

If Ms. Hull will be unavailable during the times stated below, please let me know of your availability.

Sincerely,

Todd C. Bank  
Attorney at Law  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
Telephone: (718) 520-7125  
Facsimile: (856) 997-9193  
[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)

----- Forwarded Message -----

**Subject:** Bank v. Al Johnson's Swedish Rest.  
**Date:** Wed, 20 Nov 2019 12:02:03 -0500  
**From:** Todd Bank <[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)>  
**To:** Katrina Hull <[katrinahull@markerylaw.com](mailto:katrinahull@markerylaw.com)>

Ms. Hull:

Please let me know of your availability beginning at 5:00 today or any time tomorrow or Friday to discuss, pursuant to Local Rule 27(a)(5), my anticipated motion for oral argument of the appeal.

Sincerely,

Todd C. Bank  
Attorney at Law  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
Telephone: (718) 520-7125  
Facsimile: (856) 997-9193  
[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)

**EXHIBIT “D”**

**Email from Katrina G. Hull  
to Todd C. Bank**

**November 21, 2019**

**Subject:** Re: Bank v. Al Johnson's Swedish Rest.  
**From:** Katrina Hull <katrinahull@markerylaw.com>  
**Date:** 11/21/2019, 8:57 AM  
**To:** Todd Bank <tbank@toddbanklaw.com>

Attorney Bank,

The deadline to request an oral argument has passed. Further, oral argument will unnecessarily increase the costs of this appeal. For these reasons, we will oppose your motion, should you decide to file it. You have our statement of opposition to your proposed motion.

Regards,

Katrina

Sent from my iPhone

On Nov 20, 2019, at 11:02 AM, Todd Bank <tbank@toddbanklaw.com> wrote:

Ms. Hull:

Please let me know of your availability beginning at 5:00 today or any time tomorrow or Friday to discuss, pursuant to Local Rule 27(a)(5), my anticipated motion for oral argument of the appeal.

Sincerely,

Todd C. Bank  
Attorney at Law  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
Telephone: (718) 520-7125  
Facsimile: (856) 997-9193  
[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)



**EXHIBIT “E”**

**Emailed Letter from Todd C. Bank  
to Katrina G. Hull**

**November 21, 2019**

**TODD C. BANK, ATTORNEY AT LAW, P.C.**  
**119-40 Union Turnpike, Fourth Floor**  
**Kew Gardens, New York 11415**  
**Telephone: (718) 520-7125**  
**Facsimile: (856) 997-9193**

[www.toddbanklaw.com](http://www.toddbanklaw.com)

[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)

November 21, 2019

Markery Law LLC  
1200 G St., N.W.  
Suite 800  
Washington, DC 20005  
Attn.: Katrina G. Hull

**Re: Todd C. Bank v. Al Johnson's Swedish Restaurant & Butik, Inc.**  
**Court of Appeals for the Federal Circuit; Case 19-1880**

Dear Ms. Hull:

Regarding your email of this morning: as you know, Federal Circuit Rule 27(a)(5) requires us to discuss my anticipated motion. Therefore, please let me know when, today and/or tomorrow, you and/or Ms. Patt will be available.

Sincerely,

*s/ Todd C. Bank*

Todd C. Bank

## **EXHIBIT “F”**

**Email from to Todd C. Bank  
to Jacqueline Patt**

**November 21, 2019**

**Subject:** Fwd: Bank v. Al Johnson's Swedish Rest.  
**From:** Todd Bank <[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)>  
**Date:** 11/20/2019, 2:53 PM  
**To:** [jackiepatt@markerylaw.com](mailto:jackiepatt@markerylaw.com)

Ms. Patt:

If Ms. Hull will be unavailable during the times stated below, please let me know of your availability.

Sincerely,

Todd C. Bank  
Attorney at Law  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
Telephone: (718) 520-7125  
Facsimile: (856) 997-9193  
[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)

----- Forwarded Message -----

**Subject:** Bank v. Al Johnson's Swedish Rest.  
**Date:** Wed, 20 Nov 2019 12:02:03 -0500  
**From:** Todd Bank <[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)>  
**To:** Katrina Hull <[katrinahull@markerylaw.com](mailto:katrinahull@markerylaw.com)>

Ms. Hull:

Please let me know of your availability beginning at 5:00 today or any time tomorrow or Friday to discuss, pursuant to Local Rule 27(a)(5), my anticipated motion for oral argument of the appeal.

Sincerely,

Todd C. Bank  
Attorney at Law  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
Telephone: (718) 520-7125  
Facsimile: (856) 997-9193  
[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)

**EXHIBIT “G”**

**Emailed Letter from Todd C. Bank  
to Katrina G. Hull**

**November 21, 2019**

**TODD C. BANK, ATTORNEY AT LAW, P.C.**  
**119-40 Union Turnpike, Fourth Floor**  
**Kew Gardens, New York 11415**  
**Telephone: (718) 520-7125**  
**Facsimile: (856) 997-9193**

[www.toddbanklaw.com](http://www.toddbanklaw.com)

[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)

November 21, 2019

Markery Law LLC  
1200 G St., N.W.  
Suite 800  
Washington, DC 20005  
Attn.: Katrina G. Hull

**Re: Todd C. Bank v. Al Johnson's Swedish Restaurant & Butik, Inc.**  
**Court of Appeals for the Federal Circuit; Case 19-1880**

Dear Ms. Hull:

I will also be seeking oral argument on the two sanctions motions. Therefore, please confirm whether you will comply with Federal Circuit Rule 27(a)(5); and, if you will comply, please let me know when, today and/or tomorrow, you and/or Ms. Patt will be available.

Sincerely,

*s/ Todd C. Bank*

Todd C. Bank

## **EXHIBIT “H”**

**Email from to Todd C. Bank  
to Jacqueline Patt**

**November 21, 2019**

**Subject:** Fwd: Bank v. Al Johnson's Swedish Rest.  
**From:** Todd Bank <[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)>  
**Date:** 11/21/2019, 4:51 PM  
**To:** [jackiepatt@markerylaw.com](mailto:jackiepatt@markerylaw.com)

Ms. Patt:

If Ms. Hull will be unavailable to discuss the motion described in the below letter, please let me know of your availability as requested therein.

Sincerely,

Todd C. Bank  
Attorney at Law  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
Telephone: (718) 520-7125  
Facsimile: (856) 997-9193  
[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)

----- Forwarded Message -----

**Subject:**Bank v. Al Johnson's Swedish Rest.  
**Date:**Thu, 21 Nov 2019 15:44:16 -0500  
**From:**Todd Bank <[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)>  
**To:**Katrina Hull <[katrinahull@markerylaw.com](mailto:katrinahull@markerylaw.com)>

Ms. Hull:

Please see the attached letter.

Sincerely,

Todd C. Bank  
Attorney at Law  
119-40 Union Turnpike  
Fourth Floor  
Kew Gardens, New York 11415  
Telephone: (718) 520-7125  
Facsimile: (856) 997-9193  
[tbank@toddbanklaw.com](mailto:tbank@toddbanklaw.com)

----- Attachments: -----

11-21-19 - 2.pdf

77.8 KB



**CERTIFICATE OF SERVICE**

I hereby certify that on November 21, 2019, a true and accurate copy of the foregoing was served, by the overnight delivery service of Federal Express, on the following:

Katrina. G. Hull  
Markery Law, LLC  
1200 G St, N.W., Suite 800  
Washington, D.C. 20005

Dated: November 21, 2019



---

Todd C. Bank

TODD C. BANK, ATTORNEY AT LAW, P.C.  
119-40 Union Turnpike, Fourth Floor  
Kew Gardens, New York 11415  
Telephone: (718) 520-7125  
Facsimile: (856) 997-9193

www.toddbanklaw.com

tbank@toddbanklaw.com

November 21, 2019

Clerk of Court  
United States Court of Appeals  
for the Federal Circuit  
717 Madison Place NW  
Washington, DC 20439  
Room 401

**RECEIVED**

NOV 25 2019

United States Court of Appeals  
For The Federal Circuit

**via Federal Express**  
**7770 5404 4168**

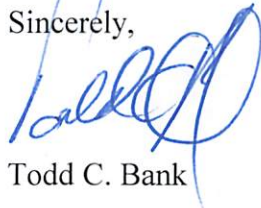
**Re: Todd C. Bank v. Al Johnson's Swedish Restaurant & Butik, Inc.**  
**Docket No. 19-1880**

Dear Sir or Madam:

I am the appellant in the above-referenced appeal. Enclosed is Appellant's motion for oral argument.

Thank you.

Sincerely,



Todd C. Bank

Enclosure

ORIGIN ID:HTOA (718) 520-7125  
TODD C. BANK, ATTORNEY AT LAW, P.C.

119-40 UNION TURNPIKE  
FOURTH FLOOR  
KEW GARDENS, NY 11415  
UNITED STATES US

SHIP DATE: 21NOV19  
ACTWGT: 1.00 LB  
CAD: 102449297/NET4160

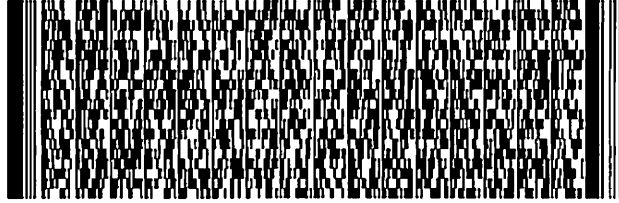
BILL SENDER

TO **CLERKS OFFICE  
FEDERAL CIRCUIT  
717 MADISON PLACE NW  
ROOM 401  
WASHINGTON DC 20439**

567J1F330/05A2

(202) 275-8000 REF

INV PO DEPT

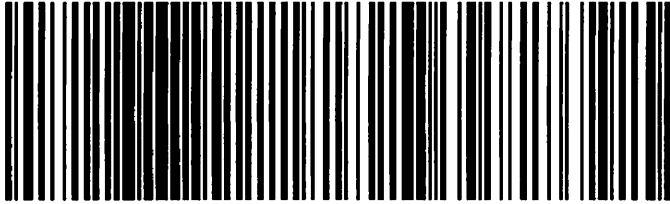


**FRI - 22 NOV 10:30A  
PRIORITY OVERNIGHT**

TRK# 7770 5404 4168  
0201

**EP BZSA**

**20439  
DC-US IAD**



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