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

APPELLANT'S OPPOSITION TO APPELLEE'S MOTION 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"), opposes the motion (Doc. 31) for sanctions by Appellee, Al Johnson's Swedish Restaurant & Butik, Inc. (the "Restaurant").

ARGUMENT

POINT I

APPELLANT FULLY ADDRESSED THE ISSUES ON APPEAL

Bank, in the Statement of the Issues, stated, as the first issue: "[w]hether Bank has standing to seek the cancellation of Trademark Registration No. 2007624." Bank's Principal Brief ("Bank Pr. Br.," Doc. 21) at 1. The Restaurant does not dispute the accuracy of this statement. Bank stated the second issue as: "[w]hether Trademark Registration No. 2007624 is invalid." *Id.* Bank further stated, in his Statement of the Standard of Review, that "Bank addresses two issues in this brief: (i) Bank's standing; and (ii) whether Bank stated a claim on the merits." Bank Pr. Br. at 3. The phrase "stated a claim" necessarily refers to Rule 12(b)(6); and, "in determining whether [a] plaintiff states a claim under Rule 12(b)(6), [a] court necessarily assesses the merits of [the] plaintiff's case," *Maya v. Centex Corp.*, 658 F.3d 1060, 1068 (9th Cir. 2011); *see also Cayuga Nation v. Tanner*, 824 F.3d 321, 332 (2d Cir. 2016) ("whether a private cause of action exists goes to the merits of the claim and is properly addressed via a [Rule] 12(b)(6) motion"). Thus, courts, when referring to Rule 12(b)(6), often refer to the issue as whether a plaintiff has 'stated a claim on the

merits.' *See Estate of Boyland v. United States Dept. of Agriculture*, 913 F.3d 117, 123 (D.C. Cir. 2019); *In Touch Concepts, Inc. v. Cellco P'ship*, 788 F.3d 98, 100 (2d Cir. 2015); *Long v. Insight Communications of Central Ohio, LLC*, 804 F.3d 791, 794 (6th Cir. 2015); *Herrick v. Grindr LLC*, 765 F. Appx. 586, 591 (2d Cir. 2019); *Moore v. United States Dept. of State*, 351 F. Supp. 3d 76, 87 (D.D.C. 2019). Furthermore, Bank noted in his Statement of the Standard of Review that the second issue is "subject to *de novo* review," Bank Pr. Br. at 3, for which he properly cited *Athey v. United States*, 908 F.3d 696, 705 (Fed. Cir. 2018). *See id.*

The Restaurant contends that, "[b]ecause Bank misstates the issues on appeal, Bank makes no argument on Appeal that he pleads a plausible claim the [Restaurant's mark] is functional under the pleading requirements set forth in *Ashcroft v. Iqbal*, 556 U.S. 662 (2009), and *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007)," Rest. Mtn. at 9, citing Bank Pr. Br. at 10-16, and that Bank "fail[ed] to argue the adequacy of the pleading to state a valid claim." *Id.*, citing Bank Pr. Br. at 10-16. The very pages of Bank's Principal Brief that the Restaurant cites in support of these contentions clearly show that the contentions are deceptive. The Board did not find that Bank failed to plead a *sufficient level of detail* in alleging functionality. Instead, the Board rejected Bank's *legal theory*, which is why Bank correctly described the second issue as pertaining to the merits; and, Bank fully addressed the validity of his *legal theory*. *See* Bank Pr. Br. at 10-16. Likewise, the Restaurant's contention that,

"[t]t is inexplicable that Bank's [Principal] Brief fails to address the adequacy of his 2018 Petition to state a valid claim," Rest. Mtn. at 10, is nonsensical, as is the Restaurant's assertion that Bank "block quot[ed] a law review and then block quot[ed] the Board's March 2019 Order without arguing he pleads a valid claim or referring to the plausibility pleading requirements in *Iqbal* and *Twombly*." *Id.*, citing Bank Pr. Br. at 10-16.

Bank, in response to the Board's rejection of his legal theory, stated, in the Summary of the Argument, that, "[t]he Restaurant's mark is functional," Bank Pr. Br. at 2, and added that, "contrary to the Board's finding, an assessment of functionality is not limited to the goods or services to which a mark applies." *Id.* Accordingly, Bank titled Point II of that brief, "Appellee's Mark is Functional," *id.* at 10; and, as noted above, the entire argument of Point II was directed at the *reasoning* of the Board's rejection of Bank's legal theory. *See id.* at 10-16.

The Restaurant also addresses Bank's statement, in his Reply Brief, that: "Appellee's observation that the issue of standing is the only issue on this appeal, *see* Restaurant's Brief ('Rest. Br.,' Doc. 24) at 24-25, is well-taken. Accordingly (and regretfully), Bank does not address the merits in this brief." Bank's Reply Brief ("Bank Reply Br.," Doc. 26) at 1, n.1 (citations omitted). *See* Rest. Mtn. at 8. The Restaurant, in the pages of its Brief that Bank cited in this footnote, had stated, "[t]o be clear, the validity of the [Restaurant's mark] is not on appeal," Rest. Br. at 24, and

that, "[t]he Board could not and did not consider the merits of the underlying cancellation action when granting [the] Restaurant's Rule 12(b)(6) motion." *Id.* at 25. Bank should have stated, "Appellee's observation that the issue of standing *and whether Bank stated a claim* (or, asserted a valid legal theory) are the issues on this appeal." In any event, each of the parties, like the Board, had addressed the question of whether Bank stated a claim (Bank having done so in his Principal Prief, as noted above). Thus, Bank's inadvertently incomplete statement did not in any way harm or prejudice the Restaurant, and its request for sanctions in connection with that statement is plainly vexatious. That Bank, in his Reply Brief, did not *again* address whether he "properly pleads a plausible claim the [Restaurant's mark] is functional," Rest. Mtn. at 9, is irrelevant; and, moreover, Bank had sufficiently done so in his Principal Brief and, as such, did not need to address, in his Reply Brief, the Restaurant's argument on that issue, as Bank would, in doing so, have merely referred to the arguments made in his Principal Brief.

For the reasons discussed above, the Restaurant's claim that, "Bank's [Principal] Brief and Bank's Reply [Brief] misstate the issues on appeal, such that he makes no arguments in either brief that he properly pleads a claim the [Restaurant's mark] is functional," Rest. Mtn. at 6, is utterly false.

POINT II

APPELLEE'S ARGUMENTS REGARDING STANDING, NOT APPELLANT'S, ARE FRIVOLOUS

The Restaurant states: "Bank presents the Court with no authority that offensiveness is grounds to cancel a trademark registration as functional. There is none." Rest. Mtn. at 11. The Restaurant makes this point notwithstanding that *it* cited no authority in support of *its* position. In connection with its statement, the Restaurant states: "[i]f Bank had filed a cancellation petition with the Board before the Supreme Court's 2017 decision in [*Matal v.*] *Tam*[,] [137 S. Ct. 1744 (2017)], then perhaps the disparagement clause in Section 2(a) of the Lanham Act [(15 U.S.C. § 1052(a))] would have provided Bank with a basis to allege offensiveness *as injury* that could be *addressed* by *cancelling a trademark registration.*" Rest. Mtn. at 12 (emphases added). Thus, the Restaurant implicitly recognizes the *factual* plausibility of Bank's alleged injury of offensiveness. However, the Restaurant argues that, "offense [no longer] provides a [*legal*] basis for standing in a Board proceeding **filed after** [*Tam*] ruled that trademark registrations can no longer be *cancelled as offensive.*" Rest. Mtn. at 6 (bold/underlining in original; emphasis added). As set forth beginning in the next paragraph, the Restaurant is wrong because it incorrectly assumes that the question of standing is contingent on *why* a registration is invalid, whereas the "why" concerns the *merits* of a claim.

First (and preliminarily), this Court, in *Ritchie v. Simpson*, 170 F.3d 1092 (Fed.

Cir. 1999), referring to the standing provisions that govern opposers and petitioners for cancellation, *i.e.*, respectively, 15 U.S.C. § 1063 and 15 U.S.C. § 1064, explained that, "we construe the requirements of [15 U.S.C. § 1063 and 15 U.S.C. § 1064] . . . consistently." *Ritchie*, 170 F.3d at 1095, n.2.

Second, the basis of the opposer's standing in *Ritchie*, *i.e.*, "that he would be damaged by the registration of the marks [at issue] because [they] disparage his values, especially those values relating to his family," *Ritchie*, 170 F.3d at 1097, coincided with the *merits* of his claims, *i.e.*, "that the marks are immoral or scandalous matter and should be denied registration under [15 U.S.C. § 1052(a)]." *Id.* at 1093. However, in assessing whether the opposer had *standing*, this Court did not find that standing requires such a connection. Instead, this Court addressed the provision that governs *standing* for opposers, *i.e.*, 15 U.S.C. § 1063 (Section 13 of the Lanham Act), which, tracking the relevant language of the provision that governs standing for petitioners for cancellation, *i.e.*, 15 U.S.C. § 1064, states: "'*[a]ny person* who believes that he would be *damaged* by the ***registration*** *of a mark* . . . may . . . file an opposition in the Patent and Trademark Office, stating the grounds therefor ....'" *Ritchie*, 170 F.3d at 1095, quoting 15 U.S.C. § 1064 (emphases added). As this Court explained:

> [The Article III] "case" and "controversy" restrictions for standing do not apply to matters before administrative agencies and boards, such as the PTO. . . .

> Thus, the *starting point* for a standing determination for a litigant before an administrative agency is not Article III, but is *the statute that confers* ***standing*** *before that agency*. In the case at hand, the *starting point* for the standing determination of the opposer is *§ 13 of the Lanham Act*[.] . . .
>
> Section 13 of the Lanham Act establishes a *broad class of persons* who are proper opposers; by *its* terms the statute *only requires that a person have a belief that he would suffer* ***some kind of damage*** *if the mark is registered*. However, in addition to meeting the broad requirements of § 13, an opposer must meet two judicially-created requirements in order to have standing—the opposer must have a *"real interest"* in the proceedings and must have a *"reasonable" basis for his belief of damage*.

Id. at 1094, 1095 (emphases added). Bank addressed each of these requirements. *See*, respectively, Bank Pr. Br. at Point I(B) and Bank Reply Br. at Point I(C); Bank Pr. Br. at Point I(C) and Bank Reply Br. at Point I(B).

Ritchie first addressed the "real interest" requirement:

> Th[e] "real interest" requirement stems from a policy of preventing "mere intermeddlers" who do not raise a real controversy from bringing oppositions *or cancellation* proceedings in the PTO. Pursuant to the "real interest" requirement, to have standing an opposer to a registration is required to have a *legitimate personal interest* in the opposition. In other words, the opposer must have a *direct and personal stake* in the outcome of the opposition.

Id. at 1095 (emphases added; citations omitted). However:

> The Board placed an *overly constrictive interpretation* on what constitutes a "real interest." According to the Board, a person may only have a "real

> interest" if he or she has "a personal interest in the proceeding *beyond that of the general public*." . . .
>
> ***
>
> [The] suggest[ion] [that] a requirement of establishing an interest different from that of the general public is contrary to the Supreme Court's view expressed in *Sierra Club* [*v. Morton*, 405 U.S. 727 (1972)], which discourages such a comparison. . . .
>
> ***
>
> 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.

Id. at 1095, 1096-1097 (emphases added).

Regarding the second of the two "judicially-created requirements in order to have standing," *id.* at 1095, *i.e.*, that "the [petitioner] must have a *'real interest'* in the proceedings and must have a *'reasonable' basis for his belief of damage*," *id.*, this Court again examined only the *standing* provision at issue, *not* the *substantive provision* at issue, *i.e.*, not the provision that was the basis of the *merits* of the petitioner's claims. *See id.* at 1097-1098.

Even the dissenting opinion in *Ritchie* was based on an examination of the *standing* provision, not the substantive (*i.e.*, *merits*) provision. *See id.* at 1099-1103

(Newman, *J.*, dissenting).

In sum, Bank's standing is determined by the *standing* provision, *i.e.*, 15 U.S.C. § *1064*, in the present case, not by the *substantive* provision that is the basis of his claim, *i.e.*, his cause of action, which in the present case is 15 U.S.C. § *1052(e)(5)*.

Although Article III does not apply to, and thus does not limit, standing before the Board, case law regarding Article III is applicable to the question of whether Bank had standing before the Board (a petitioner *must* have Article III standing in order to appeal a ruling of the Board before this Court, *see General Electric Co. v. United Technologies Corp.*, 928 F.3d 1349, 1353 (Fed. Cir. 2019)). First, as this Court explained, "the goal of [15 U.S.C. § 1063 (and, therefore, Section 1064)] is *in harmony with the* ***standing requirements*** *for maintaining a law suit in an* ***Article III*** *court*." *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 492 (Fed. Cir. 1987) (emphases added).

Second, the standing provision at issue here states that, "[a] petition to cancel a registration of a mark . . . may . . . be filed as follows by *any person* who believes that he *is or will be damaged* . . . by the *registration* of a mark," 15 U.S.C. § 1064 (emphases added), and similarly broad statutory provisions create standing that is as extensive as Article III standing. *See, e.g.*, *Mason v. Adams County Recorder*, 901 F.3d 753, 756 (6th Cir. 2018) (Fair Housing Act, 42 U.S.C. §§ 3601-3619) (*accord*,

Mhany Mgmt., Inc. v. County of Nassau, 819 F.3d 581, 600 (2d Cir. 2016)); *American Soc'y for Prevention of Cruelty to Animals v. Feld Entmnt., Inc.*, 659 F.3d 13 (D.D.C. 2011) (Endangered Species Act of 1973, 16 U.S.C. §§ 1531-1543); *Fresh Air for the Eastside, Inc. v. Waste Mgmt. of New York, L.L.C.*, No. 18-cv-06588, --- F. Supp. 3d ---, 2019 WL 4415682, *6 (W.D.N.Y. Sept. 16, 2019) (Resource Conservation and Recovery Act, 42 U.S.C. §§ 6901-6992k).

Third, the basis of one's standing under provisions that are similar in breadth to the one at issue here need not be a harm that the cause of action, *i.e.*, the *substantive statutory provision that was violated* (and which concerns the *merits* of the claim) was intended to prevent. *See* Bank Pr. Br., Point I(A); Bank Reply Br., Point I(C). An example of this principle is *Loeffler v. Staten Island Univ. Hosp.*, 582 F.3d 268 (2d Cir. 2009), in which the majority found that the plaintiffs had standing even though their injuries were *not* of the type that the violated *substantive statutory provision* was ***aimed at preventing*** (*see id.* at 277, wherein Chief Judge Jacobs explained that, with respect to standing, the concurring opinion "constitutes the opinion of the Court.").

In *Loeffler*, the court addressed two provisions of the Rehabilitation Act of 1973, Pub. L. No. 93-112, 87 Stat. 355 ("RA"), with respect to which the court stated:

> The RA provides that "[n]o otherwise qualified individual with a ***disability*** ... shall, solely by reason of *her or his* ***disability*** [i] be *excluded from the participation in*, [ii] be *denied the benefits of*, or [iii] be *subjected to*

> *discrimination under* any program or activity receiving Federal financial assistance." 29 U.S.C. § 794(a) (emphases added). The [second] section provides a ***private right of action***: "The remedies, procedures, and rights set forth in title VI of the Civil Rights Act of 1964 (42 U.S.C. 2000d *et seq.*) ... shall be available to ***any person aggrieved*** by any act or failure to act by any recipient of Federal assistance or Federal provider of such assistance under section 794 of this title." 29 U.S.C. § 794a(a)(2).

Loeffler, 582 F.3d at 284 (emphases added). As the court explained, the basis of a plaintiff's *standing* did not need to be found in the *substantive* part of the statute; and, accordingly, an injury would give rise to standing whether or not it was of a type that the substantive part of the statute had been intended to prevent:

> "***[A]ny person aggrieved*** by any act or failure to act by any recipient of Federal assistance" under the RA ***may bring suit***. 29 U.S.C. § 794a(a)(2). This includes the ***non-disabled***. In fact, "the use of ***such broad language*** in the enforcement provisions of the RA evinces a congressional intention to define standing to bring a private action under [the RA] ... *as broadly as is permitted by Article III of the Constitution*."
>
> The ***standing*** *provision* of the RA, § 794a(a)(2), is ***distinct*** *from the provision* ***prohibiting discriminatory conduct*** on the part of the recipient of federal assistance, § 794(a). *Therefore, the* ***type of injury*** *a "person aggrieved" suffers* ***need not be*** *"exclu[sion] from the participation in, ... deni[al of] the benefits of, or ... subject[ion] to discrimination under any program or activity receiving Federal financial assistance."* 29 U.S.C. § 794(a). As we made clear in *Innovative* [*Health Sys., Inc. v. City of White Plains*, 117 F.3d 37 (2d Cir. 1997)], we interpret the *standing provision* of the RA as broadly as possible under the Constitution, ***irrespective of § 794(a)***. *See Innovative Health Sys.*, 117 F.3d at 47. *Cf. Trafficante v. Metro. Life*

> *Ins. Co.*, 409 U.S. 205, 209 (1972) (interpreting the Civil Rights Act of 1964, 42 U.S.C. § 2000e-5(a)).

Id. at 280 (emphases added). *Accord, MX Group, Inc. v. City of Covington*, 293 F.3d 326, 334 (6th Cir. 2002); *Weber v. Cranston School Committee*, 212 F.3d 41, 48 (1st Cir. 2000). The *Loeffler* court reiterated that there must, of course, be *some type* of harm in order for there to be standing:

> Th[e] [standing provision of the RA] does not relieve *the person aggrieved* of establishing an injury ***causally related to, but separate and distinct from, a disabled person's injury under the statute.*** . . . In our view, [the plaintiffs] need only establish that each suffered an injury ***independent from their [disabled father]*** that was causally related to the *[defendant]'s* failure to provide services to *their [father]*.

Id. at 280 (emphases added). Whereas the alleged violation in the present case is of 15 U.S.C. § 1052(e)(5) (for a mark that "comprises any matter that, as a whole, is functional"), the *cause* of Bank's injury is "the *registration* of [the Restaurant's] mark." 15 U.S.C. § 1064 (emphasis added).

Loeffler, applying the principles described above, found that the plaintiffs had standing:

> [The plaintiffs]—at least for standing purposes—have established three such injuries. First, [the plaintiffs] were *forced to provide sign[-]language interpretation* [to their disabled father]. They were required *to fill the gap left by the [defendant]'s failure to honor its obligations under the statute* [to provide that service to their father]. Second, because they had to provide interpretation—and be on-call via pager twenty-four hours a day—*they missed school.*

> Third, because they were required to attend to their father in order to provide this service, they were needlessly and involuntarily exposed to their father's condition and thus *unnecessarily placed at risk for emotional trauma because of their young age.*

Id. at 280-281 (emphases added). Thus, the court ruled that the plaintiffs had standing even though their injuries were not among the types of harms that the substantive part of the statute, including the violated provision, were intended to prevent, just as, following *Tam*, offensiveness is not the type of injury that the functionality provision (15 U.S.C. § 1052(e)(5)) or any other substantive provision of the Lanham Act is intended to prevent; but, just as the plaintiffs in *Loeffler* had standing, so, too, does Bank.

The Restaurant has not, and cannot, refute the examples of the protest or the political signs that Bank provided. *See* Bank Pr. Pr. at 5-6. Instead, the Restaurant, betraying its misunderstandings (whether real or feigned) of elemental principles of standing, made the feeble argument that, "[i]n Bank's example of the person offended by the *content* of a Klansman protest, the time-place-statute authorizes a private cause of action for a violation of the law, and merely pleading offense, without pleading a cause of action that can be addressed under the law, would not establish standing." Rest. Br. at 22, n.10 (emphasis added). In that example, however, as in the present case, the basis of the plaintiff's standing was *not* (and, Constitutionally, *could* not have been) the basis of the *merits* of his claim, *i.e.*, his cause of action, as the latter

was for the violation of a time-place-and-manner statute, which had nothing to do with the *content* of the speech of a violator, whereas the plaintiff's *harm*, *i.e.*, his basis for *standing*, *was* the content of the speech at issue. Thus, the plaintiff had standing even though the time-place-and-manner statute did not (indeed, *could* not) authorize a *cause of action* based on the content of one's speech; that is, the statute was not intended to prevent harm due to the content of one's speech. The Restaurant did not express disagreement with the example on its face, but, instead, further demonstrated its conflation of standing and the merits by stating: "the Lanham Act does not authorize a cause of action to cancel a registration based on personal offense. As Bank has only pleaded offense as his injury, he has not pleaded an injury addressable under the Lanham Act." *Id.* Again, the Restaurant's fundamental misunderstanding is that, as offensiveness may not serve as the basis of the *merits* of Bank's claim, offensiveness therefore may not serve as the basis of Bank's *standing*; but (still again), under the broad language of 15 U.S.C. § 1064, which provides standing for harms that result from the registration of a mark, it is irrelevant that Bank does not predicate the *merits* of his claim upon offensiveness. In short, the Restaurant ignores the principle that "'cause of action' and 'standing' are 'distinct concepts,'" *Harris County, Texas v. MERSCORP Inc.*, 791 F.3d 545, 552 (5th Cir. 2015), quoting *Bond v. United States*, 564 U.S. 211, 218 (2011), and further "noting the 'general tendency to confuse cause-of-action concepts with standing.'" *Id.*, quoting 13A

Charles Alan Wright, *et al.*, *Federal Practice & Procedure*, § 3531.6 (3d ed.).

The Restaurant also contends that Bank does not satisfy the "real interest" standard, because he "offers no explanation for how granting [the Restaurant's] registration . . . demeans goats and offends Bank," Rest. Mtn. at 14; and, notwithstanding the Restaurant's implicit recognition of the *factual* plausibility of the injury of offensiveness, as noted above, the Restaurant claims that, "[in order] [f]or [the] granting [of] a registration to demean goats[,] . . . Bank . . . would [be] require[d] to also allege that the goats were aware the USPTO granted a registration." *Id.* However, the Petition alleges that, "Bank believes that the granting to, or possession . . . of[,] a trademark . . . 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," Pet., ¶ 1 (Appx15) (emphases added), and that such "demeaning of animals . . . is *offensive to Bank* and denigrates *the value he places* on the *respect, dignity, and worth of animals*." *Id.*, ¶ 2 (Appx15) (emphases added). The Restaurant is certainly free to question Bank's allegation that he finds it demeaning to an animal to make that animal's activities the subject of a trademark, and that doing so offends Bank, but the notion that the Restaurant's skepticism (whether self-serving or not) should preclude Bank from having standing is untenable. In addition, the Restaurant's notion that an animal can be demeaned only if the *animal* is aware of the reason it is being demeaned is plainly absurd.

The Restaurant contends that it "interpreted the 2018 Petition to mean that Bank found the '*activity of the animal*' to be offensive because the alternative interpretation makes no sense," Rest. Mtn. at 13 (emphasis added), but that, "Bank is now arguing that he takes no offense to the 'activity of the animal,' but that he and unnamed 'numerous persons' are offended by the . . . granting . . . [of] [the] *registration* for the Goats on the Roof Restaurant Décor." *Id.* at 13-14 (emphasis added). Notably, the Restaurant made the opposite argument in its Brief, arguing, correctly, that it would not make sense to base standing upon the *activity* of the Restaurant's goats (as opposed to the Restaurant's *trademark*), because the cancellation of the mark would not prevent that activity. *See* Rest. Br. at 14.

The Restaurant, encapsulating its erroneous conflation of *standing* to assert a claim under the broad standing provision at issue, *i.e.*, 15 U.S.C. § 1064, with the *merits* of Bank's claim, which are addressed in a *different provision* of the Lanham Act, *i.e.*, 15 U.S.C. § 1052(e)(5), contends that Bank "alleges no *injury addressable* under the Lanham Act—the only statute providing a basis to challenge trademark registration before the Board." Rest. Br. at 13 (emphasis added). The Restaurant then makes the false assertion (one that the Restaurant has never even purported to support) that Bank's argument relating to his "theory that the [Restaurant's mark] causes offense . . . [is] 'based on half-truths and illogical deductions from misused legal authority, [and] is sanctionable.'" *Id.*, quoting *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 948 F.2d 1573, 1580 (Fed. Cir. 1991).

CONCLUSION

Appellee's motion for sanctions should be denied.

Dated: November 18, 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

FORM 9. Certificate of Interest

Form 9
Rev. 10/17

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

11/18/2019
Date

Todd C. Bank
Signature of counsel

Please Note: All questions must be answered

Todd C. Bank
Printed name of counsel

cc: _____

Reset Fields

DECLARATION OF TODD C. BANK

1. On November 5 and 6, 2019, I emailed five letters to Katrina G. Hull, counsel to the Restaurant.

2. Ms. Hull attached my five letters as Exhibit "B" to her declaration (Doc. 31, pp.42-50). However, those letters were put in the following order: first letter (p.43); fourth letter (p.45); second letter (p.46); third letter (p.48); and fifth letter (p.49).

3. Regarding the conversation between Ms. Hull and me on November 1, 2019, Ms. Hull states: "Bank appeared to disagree and persisted to argue about the applicable case law. I declined to engage in an argument and referred him to the briefs on Appeal, which set forth the applicable law." Hull Decl., ¶ 9. As noted in the first of my letters, Ms. Hull, who had initially tried to avoid having a discussion altogether, referred to the Restaurant's Brief but refused to engage in any substantive discussion, and refused to discuss the merits of Appellee's sanction motion, even though the question of whether a party will consent to a motion (or, to be more specific in the present case, withdraw the party's appeal) necessarily requires at least some discussion of the merits of the motion. As I explained in my second letter:

> As I previously stated [in my first letter], throughout our conversation you "refus[ed] further explanation in response to my questions regarding the motion." [first letter, Doc. 31 at 43.] Insofar as you characterize my questions as constituting argument regarding the merits of your motion,

> the purpose of the discussion *is* to discuss the merits so that the parties may make informed choices regarding the motion. Indeed, your statement that "[y]our arguments about why your appeal is not frivolous should be filed with the Court in response to the Motion for Sanctions," ignores the requirement to first discuss those arguments before proceeding with the motion.

Doc. 31 at 46 (emphasis in original).

4. Ms. Hull states: "[d]uring the November 1 phone call, I asked Attorney Bank at least five times if he consented to the Motion and if he planned to respond to the Motion. Attorney Bank refused to answer these questions." Hull Decl., ¶ 10. Again, I tried to explain to Ms. Hull that, absent a proper discussion of the motion (and, at this time, I had, of course, not seen the motion), I did not have a sufficiently informed basis upon which to decide whether to withdraw the appeal in response.

5. Ms. Hull states that, on two occasions, I did not appear on a telephone call that she had arranged. *See* Hull Decl., ¶¶, 15, 18. However, I had repeatedly requested that Ms. Hull agree to comply with Rule 27(a)(5) in good faith, but Ms. Hull ignored those requests. *See* my first letter, Doc. 31 at 44 ("[p]lease confirm that you will comply with your good-faith obligation under Federal Circuit Rule 27(a)(5) and, to that end, [please confirm] your representation that we would resume our conversation today."); my second letter, Doc. 31 at 46 ("[s]hould you agree to comply with [Rule 27(a)(5)], and refrain from artificially limiting the time of the conversation

to 15 minutes, I would be amenable to the resumption of our November 1 conversation."); my third letter, Doc. 31 at 48 ("[a]s you have given no indication [in your email at Doc. 31 at 32] that you inten[d] to comply with Local Rule 27(a)(5), I do not accept your proposal ['offering you an additional 15 minutes as a courtesy']. Indeed, your statement that 'we have already fulfilled our obligation under Rule 27(a)(5) to discuss the motion with you with the hour-long call on Friday,' is, as I trust you know, false."); my fourth letter, Doc. 31 at 45 ("I have made clear that you are required to comply in good faith with Rule 27(a)(5), which you have repeatedly made clear you will not do. *** In sum, you have not 'fulfilled [y]our obligations under Rule 27(a)(5) to discuss the motion,' which you must do so before proceeding. Once again, I await your representation that you will comply in good faith with Rule 27(a)(5). To that end, I will be available tomorrow between 1:30 and 4:00 (except for 2:45 to 3:00)."); and my fifth letter, Doc. 31 at 49 ("I am concerned that you chose 2:30 [in your email at Doc. 31 at 27-28] in order to artificially limit the conversation to 15 minutes, to which I will, as previously stated, not agree. Please confirm that, if we begin the conversation at 2:30, we will resume it later today if necessary. Furthermore, I continue to await your representation that you will comply in good faith with Rule 27(a)(5).").

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 18, 2019

CERTIFICATE OF SERVICE

I hereby certify that on November 18, 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 18, 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 18, 2019

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

via Federal Express
7770 1104 2265

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 are the following:

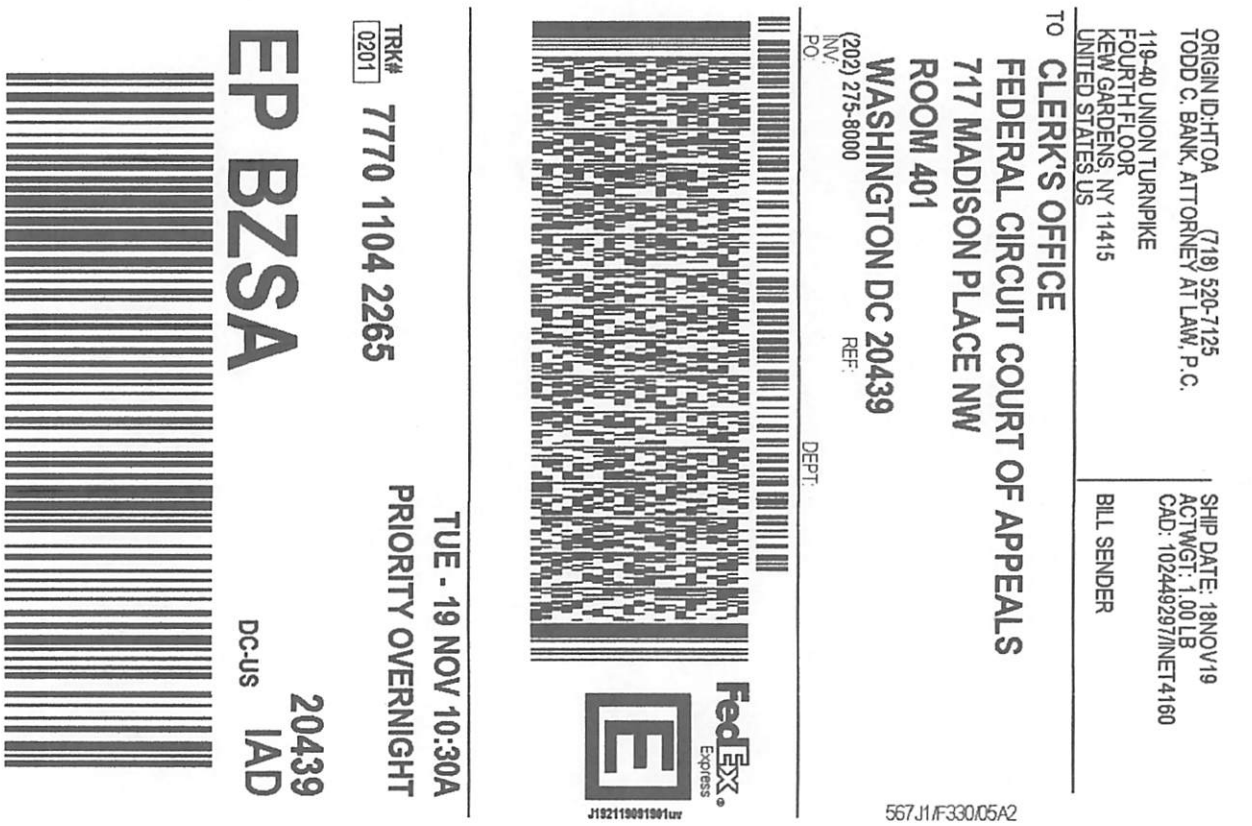
1. Appellant's opposition to Appellee's motion for sanctions; and
2. Appellant's motion for sanctions.

Thank you.

Sincerely,

Todd C. Bank

Enclosures



After printing this label:
1. Use the 'Print' button on this page to print your label to your laser or inkjet printer.
2. Fold the printed page along the horizontal line.
3. Place label in shipping pouch and affix it to your shipment so that the barcode portion of the label can be read and scanned.

Warning: Use only the printed original label for shipping. Using a photocopy of this label for shipping purposes is fraudulent and could result in additional billing charges, along with the cancellation of your FedEx account number.
Use of this system constitutes your agreement to the service conditions in the current FedEx Service Guide, available on fedex.com.FedEx will not be responsible for any claim in excess of $100 per package, whether the result of loss, damage, delay, non-delivery,misdelivery,or misinformation, unless you declare a higher value, pay an additional charge, document your actual loss and file a timely claim.Limitations found in the current FedEx Service Guide apply. Your right to recover from FedEx for any loss, including intrinsic value of the package, loss of sales, income interest, profit, attorney's fees, costs, and other forms of damage whether direct, incidental,consequential, or special is limited to the greater of $100 or the authorized declared value. Recovery cannot exceed actual documented loss.Maximum for items of extraordinary value is $1,000, e.g. jewelry, precious metals, negotiable instruments and other items listed in our ServiceGuide. Written claims must be filed within strict time limits, see current FedEx Service Guide.