19-1880

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

TODD C. BANK

Appellant,

v.

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

Appellee.

Appeal from the United States Patent and Trademark Office,
Trademark Trial and Appeal Board in Cancellation No. 92069777

APPELLEE'S MOTION FOR SANCTIONS UNDER RULE 38 OF THE FEDERAL RULES OF APPELLATE PROCEURE

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Attorneys for Appellee
November 6, 2019

INTRODUCTION

Appellee Al Johnson's Swedish Restaurant and Butik, Inc. ("Al Johnson's Restaurant"), by its undersigned attorneys, moves for sanctions against Appellant Todd C. Bank ("Bank") under Rule 38 of the Federal Rules of Appellate Procedure. As detailed below, Bank's appeal is frivolous as filed and as argued. Al Johnson's Restaurant respectfully requests that it be awarded its costs and attorneys fees, including the fees incurred in filing this motion for sanctions, and any other relief this Court deems appropriate.

BACKGROUND

Al Johnson's Restaurant's Counterstatement of the Case provides the full history of the proceedings before the Trademark Trial and Appeal Board (the "Board") between Al Johnson's Restaurant and Bank. *See* Appellee's Br. at 1-6. The following timeline provides the background for this motion:

May 27, 2011 – Bank represents Robert Doyle, a man allegedly desiring to photograph goats on grass roofs, and files a petition with the Board to cancel Al Johnson's Restaurant's Reg. No. 2,007,624 for the Goats on the Roof Restaurant Décor, alleging the Goats on the Roof Restaurant Décor trade dress is functional (the "2011 Petition"). SAppx016-024.

February 10, 2012 – In a precedential decision (the "February 2012 Order"), the Board dismisses the 2011 Petition because Bank fails to allege

Doyle's standing **and** fails to allege a plausible claim the Goats on the Roof Restaurant Décor is functional. *Doyle v. Al Johnson's Swedish Restaurant and Butik, Inc.*, No. 92054059, 2012 WL 695211, at *4 (T.T.A.B. Feb. 10, 2012). The Board warns Bank that if he chooses to file an amended petition to allege a functionality claim he should first "carefully review Fed. R. Civ. P. 11." *Id.*

March 1, 2012 – On behalf of Doyle, Bank files an amended petition with the Board alleging that Doyle has standing because Doyle also wants to dine in restaurants with goats on grass roofs and to write a book about goats on grass roofs (the "2012 Petition"). SAppx023-033. With respect to the functionality allegations, the 2012 Petition adds a single conclusory statement that goats on a grass roof are a superior form of entertainment. *Compare* SAppx018-020 *with* SAppx026-029.

July 12, 2012 – The Board dismisses the 2012 Petition for failing to allege standing (the "July 2012 Order"), explaining to Bank that Doyle does not have a "real interest" to cancel a registration or a "reasonable belief" in damages under *Ritchie v. Simpson,* 170 F.3d 1092, 1095 (Fed. Cir. 1999). SAppx034-042. Because the Board dismisses on standing, it declines to address if Bank adequately pleads functionality. SAppx42. The Board's July 2012 Order makes it clear if either standing or a valid claim are not sufficiently alleged, the Board will dismiss.

October 12, 2018 – Bank files a petition with the Board on his own behalf to cancel the Goats on the Roof Restaurant Décor registration as functional (the

"2018 Petition"). Appx14-16. The 2018 Petition is identical to the 2012 Petition in its allegations the Goats on the Roof Restaurant Décor is functional. For standing, Bank alleges that granting a trademark "that applies to the activity of an animal . . . is demeaning to the type of animal that is the subject of such mark" and "the demeaning of animals" is "offensive to Bank" and "offensive to numerous persons." Appx15.

March 27, 2019 – The Board dismisses the 2018 Petition for failing to allege Bank's standing **and** for failing the allege a plausible claim the Goats on the Roof Restaurant Décor is functional (the "March 2019 Order"). Appx2-13. Bank is granted leave to file "an amended petition to cancel that properly pleads his standing **and** states a valid claim for relief, if (Bank) 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." Appx11 (emphasis added).

May 2, 2019 – Bank does not amend the 2018 Petition, and the Board dismisses the 2018 Petition with prejudice on May 2, 2019 (the "Board's May 2019 Order"). Appx1. The Board's dismissal of Bank's 2018 Petition is the subject of the appeal to this Court (the "Appeal").

In this motion, the parties' appeal briefs will hereafter be referred to as Bank's Brief (Doc. 21), the Restaurant's Brief (Doc. 24) and Bank's Reply (Doc. 26).

ARGUMENT

Rule 38 of the Federal Rules of Appellate Procedure provides that "if a court of appeals determines that an appeal is frivolous, it may . . . award just damages and single or double costs to the appellee." Rule 38 sanctions "perform two vital functions: They compensate the prevailing party for the expense of having to defend a wholly meritless appeal, and by deterring frivolity, they preserve the appellate calendar for cases truly worthy of consideration." *Finch v. Hughes Aircraft Co.*, 926 F.2d 1574, 1578 (Fed. Cir. 1991). This Court has awarded attorney fees and double costs under Rule 38. *See Refac Int'l, Ltd. v. Hitachi, Ltd.*, 921 F.2d 1247, 1256 (Fed. Cir. 1990) (awarding attorneys' fees and double costs under Rule 38 against an appellant that failed to cite cases supporting its argument and failed to argue for changes in the law).

The Federal Circuit has "recognized two distinct (though in practice often related) senses in which an appeal may be frivolous." *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 948 F.2d 1573, 1578 (Fed. Cir. 1991). First, an appeal is "frivolous as filed" when the judgment on appeal "was so plainly correct and the legal authority contrary to the appellant's position so clear that there is really no appealable issue." *Finch,* 926 F.2d at 1579–80. Second, an appeal is "frivolous as argued" when the appellant's conduct during the appeal "distort[s] the record, by disregarding or mischaracterizing the clear authority against its position, and by

attempting to draw illogical deductions from the facts and the law." *State*, 948 F.2d at 1579.

In this case, Bank's appeal is frivolous as filed and frivolous as argued. When "no non-frivolous arguments could be made to support" the appeal as filed, then "logically [the appeal] must also be frivolous as argued." *Finch*, 926 F.2d at 1580. Bank's briefs filed with this Court provide no basis in law or fact to reverse the Board's March 2019 Order. Because a "full analysis of every baseless or otherwise improper argument would unduly lengthen" the Court's consideration of sanctions, this motion focuses on three representative examples of the frivolity of Bank's appeal. *Id*.

First, Bank's Brief and Bank's Reply misstate the issues on appeal, such that he makes no arguments in either brief that he properly pleads a claim the Goats on the Roof Restaurant Décor is functional. Second, Bank fails to cite any relevant authority to support his position that offense provides a basis for standing in a Board proceeding **filed after** the Supreme Court ruled that trademark registrations can no longer be cancelled as offensive in *Matal v. Tam*, 137 S. Ct. 1744 (2017). Third, Bank's argument that granting a trademark registration that "applies to the activity of an animal" demeans the animal and offends Bank defies logic.

Finally, in addition to the representative examples of frivolity, Bank has filed essentially the same functionality claim three times with the Board, and the

Board has twice warned Bank to review Rule 11 before continuing to pursue cancellation of the Goats on the Roof Restaurant Décor Registration as functional. Thus, Bank was well aware that his pleading lacked a "sound basis" in the law when he filed this Appeal and, indeed, Bank fails to argue that he adequately pleads a claim the Goats on the Roof Restaurant Décor is functional.

A. Bank's Brief Incorrectly States the Issues on Appeal and Bank's Reply Falsely States that Standing Is the Only Issue on Appeal.

The Board's March 2019 Order is abundantly clear that the dismissal of the 2018 Petition is for failing to allege standing **and** for failing to allege a plausible claim the Goats on the Roof Restaurant Décor is functional. *See* Appx7 ("Respondent's motion to dismiss Petitioner's claim in its entirety for failure to adequately allege standing is granted."); *see also* Appx11 ("Respondent's motion to dismiss Petitioner's claim of functionality is granted."). Nonetheless, Bank falsely states that the second issue on appeal is "Whether Trademark Registration No. 2007624 is invalid." Bank's Br. at 1; Doc. 21 at 10. [1]

The Restaurant's Brief calls out Bank's error in the Counterstatement of the Issues:

> Whether the Trademark Trial and Appeal Board (the "Board") properly dismissed Bank's petition to cancel U.S. Trademark Registration No. 2,007,624 (the "Goats on the Roof Restaurant Décor Registration") for failure to plead standing?

[1] Bank identifies the first issue on appeal is "Whether Bank has standing to seek the cancellation of Trademark Registration No. 200074."

> Whether the Board properly dismissed Bank's petition to cancel the Goats on the Roof Restaurant Décor Registration for failure to plead the building décor trade dress is functional?

Restaurant's Br. at 1; Doc. 24 at 8.

Instead of addressing his incorrect statement about the second issue on appeal, Bank instead falsely claims in his Reply that only standing is on appeal. In the footnote on page1 of Bank's Reply (Doc. 26 at 5) he inaccurately states that "Appellee's observation that the issue of standing is the only issue on appeal, *see* Appellee's Brief (Doc. 24) at 24-25, is well taken." The cited pages of the Restaurant's Brief do not state that standing is the only issue on appeal. This is false and misconstrues the Restaurant's Brief and the Board's March 2019 Order.

Instead, the Restaurant's Brief clearly states that the second issue on appeal is the sufficiency of the pleading to state a valid claim. Restaurant's Br. at 1; Doc. 24 at 8. Further, the pages of the Restaurant's Brief cited in Bank's Reply never say that standing is the only issue on appeal. The introductory sentences of this section of the Restaurant's Brief restate the second issue on appeal:

> On appeal is the sufficiency of Bank's second try to plead a claim before the Board that the Goats on the Roof Restaurant Décor is functional. The Board has twice dismissed the functionality claims filed by Bank under Federal Rule of Civil Procedure 12(b)(6).

Restaurant's Br. at 24; Doc. 24 at 31. The Restaurant's Brief also calls out Bank's false statement that the validity of the Goats on the Roof Restaurant Décor

Registration is on appeal. *Id.* Because Bank misstates the issues on appeal, Bank makes no argument on Appeal that he pleads a plausible claim the Goats on the Roof Restaurant Décor 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). *See* Bank's Brief at 10-16; Doc. 21 at 19-25 (failing to argue the adequacy of the pleading to state a valid claim).

When Bank was given an opportunity in his Reply to address his blatant misstatement of the second issue on appeal, Bank falsely states that the only issue on appeal is standing. Bank's Reply at 1; Doc 26 at 5. Thus, Bank's Reply also makes no arguments that Bank properly pleads a plausible claim the Goats on the Roof Restaurant Décor is functional. "[P]ost-filing conduct, consisting of irrelevant and illogical arguments based on factual misrepresentations and false premises, is the sort of appellate litigation behavior that makes an appeal frivolous *as argued,* and thus eligible for sanctions." *Romala Corp. v. United States*, 927 F.2d 1219, 1222 (Fed. Cir. 1991).

Moreover, the Board's March 2019 Order is abundantly clear that the Board is dismissing Bank's 2018 Petition because he fails to allege standing **and** he fails to allege a claim the Goats on the Roof Restaurant Décor is functional. Appx7, Appx11. Furthermore, the well-established precedents of this Court are also

abundantly clear that pleading both standing **and** a valid claim for cancellation are required. *Young v. AGB Corp.*, 152 F.3d 1377, 1379-1380 (Fed. Cir. 1998).

It is inexplicable that Bank's Brief fails to address the adequacy of his 2018 Petition to state a valid claim. *See* Bank's Br. at 10-16; Doc. 21 at 19-25 (block quoting a law review and then block quoting the Board's March 2019 Order without arguing he pleads a valid claim or referring to the plausibility pleading requirements in *Iqbal* and *Twombly*). It is even more inexplicable that, when given the opportunity in his Reply to address his misstatement, Bank instead falsely states that the only issue on appeal is standing. Bank's Reply at 1 (Doc. 26 at 5). When a pro se attorney ignored two of the three bases on which a court's judgment could be sustained, the Federal Circuit sanctioned the attorney for filing a frivolous appeal because he made "no attempt to address the overwhelming authority against his position, much less rebut that authority." *Finch*, 926 F.2d at 1580.

Bank's misstatements and false statements regarding the issues on appeal, as well as his failure to put forth any arguments that he adequately pleads a valid claim, is more than enough to find the appeal frivolous as filed and as argued. *See id.* at 1579 ("submitting rambling briefs that make no attempt to address the elements requisite to obtaining reversal" is frivolous); *State,* 948 F.2d at 1580 (misstating the record and the controlling law on appeal is "not only frivolous as filed but also frivolous as argued"); *E-Pass Techs., Inc. v. 3Com Corp.*, 559 F.3d

1374, 1380 (Fed. Cir. 2009) (noting that "misrepresentations" on appeal are sanctionable and "far outweigh any non-frivolous argument that may be lurking in its briefs").

B. Bank Relies on an Unconstitutional Provision of the Lanham Act as the Only Basis for His Standing.

Bank presents the Court with no authority that offensiveness is grounds to cancel a trademark registration as functional. There is none. Bank's personal offense and the alleged offense of "numerous persons" is the only alleged injury. Below are the first four paragraphs of Bank's 2018 Petition:

> 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.

Appx15.

If Bank had filed a cancellation petition with the Board before the Supreme Court's 2017 decision in *Tam*, then perhaps the disparagement clause in Section 2(a) of the Lanham Act would have provided Bank with a basis to allege offensiveness as injury that could be addressed by cancelling a trademark registration. After *Tam*, however, offensiveness can no longer serve as the basis to deny registration of a trademark: "The disparagement clause denies registration to any mark that is offensive to a substantial percentage of the members of any group. That is viewpoint discrimination in the sense relevant here: Giving offense is a viewpoint." 137 S. Ct. 1744 at 1479.

Bank's argument that he does not have to plead an injury that can be addressed under the Lanham Act is "patently illogical." *See State*, 948 F.2d at 1580 (finding a party's misrepresentations of the controlling law and "its patently illogical and irrelevant arguments" to be frivolous as filed and argued). It is illogical that the Supreme Court would strike down the disparagement clause as unconstitutional and then allow parties, like Bank, to continue to challenge registration when the only alleged injury caused by a mark is its offensiveness.

Indeed, this is not the first time Bank has been chastised for failing to plead an injury. The Second Circuit recently explained to Bank and his client Robert Doyle, i.e. the same person that wanted to take pictures of goats on a grass roof, that standing requires alleging an injury that can be addressed under the law:

> Regardless of whether a class is certified for purposes of a DCCPPA claim, Doyle would lack standing to sue on its behalf because he alleges no injury under that (or any other consumer protection) statute. His alleged injury is based on an entirely separate—and meritless—breach-of-contract theory.

Doyle v. Mastercard Int'l Inc., 700 Fed. Appx. 22, 25 (2d Cir. 2017).

Although the Second Circuit case is unrelated to the Lanham Act, the logic is the same. Bank lacks standing to sue on his own behalf and on behalf of alleged "numerous persons" because he alleges no injury addressable under the Lanham Act—the only statute providing a basis to challenge trademark registration before the Board. Bank's "alleged injury is based on an entirely separate—and meritless—" theory that the Goats on the Roof Restaurant Décor Registration causes offense. "This sort of argument, based on half-truths and illogical deductions from misused legal authority, is sanctionable." *State*, 948 F.2d at 1580.

C. Bank's Argument He Is Harmed by the Granting of a Registration Is Illogical and Unsupported.

Bank's Reply disagrees with Al Johnson's Restaurant's interpretation of the 2018 Petition to mean that Bank finds the "activity of the animal," i.e., the goats grazing on a grass roof, to be "demeaning to animals" and offensive to Bank. *See* Reply Br. at 1-2; Doc 26 at 6-7 (quoting the Restaurant's Brief and stating that the Restaurant misread the 2018 Petition). Al Johnson's Restaurant interpreted the 2018 Petition to mean that Bank found the "activity of the animal" to be offensive because the alternative interpretation makes no sense. In his Reply, 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 U.S. Patent and Trademark Office ("USPTO") granting Al Johnson's Restaurant a registration for the Goats on the Roof Restaurant Décor.

Bank offers no explanation for how granting a registration, i.e. the USPTO issuing a registration certificate for the Goats on the Roof Restaurant Decor, demeans goats and offends Bank. For granting a registration to demean goats would require Bank to also allege that the goats were aware the USPTO granted a registration. The correct legal authority, and the authority that Bank fails to correctly apply, requires Bank to have a "real interest" in cancelling a registration and a "reasonable belief" in damages to have standing before the Board.[2] *Ritchie,*170 F.3d at 1095 (Fed. Cir. 1999); *Doyle*, 2012 WL 695211, at *4; *see also* Restaurant's Br. at 10-19; Doc. 24 at 17-26 (discussing and applying cases involving standing before the Board to challenge a trademark registration as functional).

Bank's appeal is frivolous because he "has manufactured 'arguments' in support of reversal by distorting the record, by disregarding or mischaracterizing

[2] Instead, Bank's Brief cites irrelevant cases regarding standing in Article III courts in completely unrelated matters, such a death row inmate's standing to challenge another inmate's death sentence. *See* Bank's Br. at 4; Doc. 21 at 13; *see also* Restaurant's Br. at 22; Doc. 24 at 29 (discussing the irrelevant cases relied on by Bank).

the clear authority against [his] position, and by attempting to draw illogical deductions from the facts and the law." *State*, 948 F.2d at 1579. The argument that granting a registration causes offense is a manufactured argument. Bank's appeal is frivolous and sanctionable.

D. The Board Twice Advised Bank to Review Rule 11 Before Proceeding with His Claims.

Bank filed this Appeal after receiving repeated Rule 11 warnings from the Board. In the February 2012 Order, the Board directed Bank to "carefully review Fed. R. Civ. P. 11" and to "be aware of the extreme difficulties he would likely face in ultimately proving that respondent's mark is functional." *Doyle,* 2012 WL 695211, at *4. In the March 2019 Order, the Board again warned Bank that if he wanted to pursue his claims, that he must have "a sound basis for doing so pursuant to Fed. R. Civ. P. 11." Appx36.

The Board's February 2012 Order, July 2012 Order and March 2019 Order all carefully explain to Bank the requirements to establish standing before the Board to cancel a federal trademark registration as functional. *Doyle*, 2012 WL 695211, at **2-3; SAppx037-042; Appx29-33. Just as Bank ignored the law cited by the Board when he filed his 2018 Petition, he continues to ignore the law when pursuing this Appeal. Indeed, after the Board twice rejected Bank-drafted pleadings that Bank's client, Doyle, i.e., the photographer who desired to dine in restaurants with goats on the roof, had sufficiently alleged standing to cancel the

Goats on the Roof Restaurant Décor Registration, Bank was undeterred.

Bank then filed on his own behalf and alleged his personal offense as a basis for standing. The Board's discussion of standing, and the Federal Circuit cases cited in the February 2012 Order and July 2012 Order, apply equally to Bank's 2018 Petition that alleges the same functionality basis for cancellation. Bank was well aware of the Federal Circuit's standing requirements and requirements to plead a valid claim before he filed the 2018 Petition, and before he filed this Appeal. Bank's briefs also do not argue that any of the precedential cases, including *Doyle*, were wrongly decided by the Board or the Federal Circuit.

Tellingly, the Second Circuit recently affirmed sanctions under Rule 11 against Bank in a case where he contended that "his citations to older or abrogated cases provided persuasive authority that sufficed to justify his arguments as not frivolous." *McCabe v. Lifetime Entm't Servs., LLC*, 761 Fed. Appx. 38, 42 (2d Cir. 2019), *cert. denied.,* No. 18-1353, 2019 WL 4921303 (U.S. Oct. 7, 2019). Like the Second Circuit's affirmation of sanctions against Bank, the Federal Circuit should also sanction Bank because when "the law of this Circuit is clearly contrary to a litigant's arguments, such cases cannot constitute a good-faith argument that existing law should be reversed." *Id.*

Even when an attorney appears pro se before this Court, he is "chargeable with knowledge of (his) ethical duty of candor towards the court, and with the

responsibility for knowledge of our rules." *Finch*, 926 F.2d at 1583. Like the sanctioned-attorney in *Finch*, Bank "signed the briefs himself, and the fact that he is litigating on his own behalf cannot diminish his obligation to litigate responsibly." *Id.*

In connection with this motion, Al Johnson's Restaurant is seeking its attorneys' fees and costs to defend this frivolous Appeal and to bring this motion for sanctions.[3] Since 2011, Al Johnson's Restaurant has incurred costs and attorney fees when defending against the 2011 Petition, the 2012 Petition and the 2018 Petition. Bank has wasted the resources of the Board and this Court. After the Board dismissed the 2011 Petition, trademark scholar John L. Welch wrote, "What gets my goat is that the Board can't award monetary sanctions against a plaintiff that who brings such a ridiculous claim." *See* "Precedential No. 4: TTAB Dismisses 'Goats on a Roof' Cancellation Petition for Lack of Standing, Failure to State Claim," *The TTABlog*, February 15, 2012, at http://thettablog.blogspot.com/2012/02/precedential-no-4-ttab-dismisses-goats.html (last visited November 5, 2019).

Although the Board does not have authority to impose monetary sanctions against Bank, the Federal Circuit does have authority under Rule 38 of the

[3] Should the Court grant this Motion for Sanctions, Al Johnson's Restaurant will submit a claim for its reasonable attorney's fees and costs incurred with defending this Appeal and filing this Motion for Sanctions.

Federal Rules of Appellate Procedure to impose sanctions and award costs and fees. The Court has also not scheduled oral arguments in this Appeal. *See* Doc. 30 (Notice of Submission without Oral Arguments). Should Bank request an oral argument, Al Johnson's Restaurant respectfully submits that oral arguments are unnecessary and would further increase its costs and fees to respond to this frivolous Appeal. *See also* Rule 34 of the Federal Rules of Appellate Procedure (noting the Federal Circuit may also decline to schedule oral arguments when an appeal is frivolous).

CONCLUSION

WHEREFORE, Al Johnson's Restaurant respectfully requests sanctions under Rule 38 of the Federal Rules of Appellate Procedure and any other relief this Court deems just.

STATEMENT OF OPPOSITION

In compliance with Federal Circuit Rule 27(a)(5), counsel for Appellee-Al Johnson's Restaurant discussed this Motion with Bank. *See* Declaration of Katrina G. Hull ¶¶ 7-9. During the discussion, Bank refused to state if he intends to object and respond to this Motion. *Id.* ¶ 10. In subsequent correspondence with Bank, counsel informed Bank it would treat Bank's failure to participate in a phone call that Bank requested an indication that Bank objects to the Motion and intends to oppose it. *Id.* ¶ 17.

Dated: November 6, 2019 Respectfully submitted

/s/ Katrina G. Hull

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Counsel for Appellee Al Johnson's Swedish Restaurant and Butik, Inc.

CERTIFICATE OF INTEREST

Counsel for Appellee, Al Johnson's Swedish Restaurant & Butik, Inc., certifies the following:

1. Full name of the party represented by me:

Al Johnson's Swedish Restaurant & Butiks, Inc.

2. Name of the real party in interest represented by me is:

N/A

3. Parent corporations and publicly held companies that own 10% or more of the stock in the party:

None

4. The names of the all law firms and the partners or associates that appeared for the party now represented by me in the agency or are expected to appear in this court are:

Katrina G. Hull and Emily M. Haas of Michael Best and Friedrich LLP appeared before the agency; Katrina G. Hull and Jacqueline L. Patt of Markery Law, LLC are appearing in this Court.

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.

None

Dated: November 6, 2019

/s/ Katrina G. Hull
Katrina G. Hull

DECLARATION OF KATRINA G. HULL

1. I am an attorney duly admitted to practice law in the State of Wisconsin and I am of counsel with Markery Law, LLC, counsel to the Appellee Al Johnson's Swedish Restaurant and Butiks, Inc. ("Al Johnson's Restaurant").

2. I have personal knowledge of the facts set forth in this declaration.

3. Attached hereto as Exhibit A is a true and correct copy of the email chain between Attorney Bank and myself from November 1, 2019 through November 6, 2019.

4. Attached hereto as Exhibit B are true and correct copies of the letters that I received from Attorney Bank on November 5 and 6, 2019. He sent the letters as attachments to emails and in response to my emails in Exhibit A.

5. All dates referenced in this declaration are in 2019, and all times references in this declaration are in the Eastern time zone.

6. On November 1, I emailed the Appellant Todd C. Bank ("Bank") and informed him that Al Johnson's Restaurant intended to file a Motion for Sanctions under Rule 38 of the Federal Rules of Appellate Procedure (the "Motion") for filing and arguing a frivolous appeal. In the email, I asked Attorney Bank if he consented to the motion and if he would file a response. *See* Exhibit A.

7. On November 1, Attorney Banks requested a discussion by phone of the Motion, and we discussed the Motion during a 59-minute phone call on November 1.

8. During the November 1 phone call, I described to Attorney Bank the factual basis for the Motion including the following:

- Trademark Trial and Appeal Board (the "Board") dismissed Bank's 2018 petition to cancel Al Johnson's Restaurant's Goats on the Roof Trade Dress Registration for (1) failure to plead standing; and (2) failure to allege a valid basis for cancellation. Bank misstates the issues on appeal and does not argue that he alleged a valid basis for cancellation.

- The Supreme Court ruled that trademark registrations can no longer be challenged as offensive *before* Attorney Bank filed the 2018 petition, which alleges only offense as the injury.

- Bank has filed three cancellation petitions with the Board to cancel Al Johnson's Restaurant's Goats on the Roof Trade Dress Registration, and all have been dismissed at the pleading stage under Rule 12(b)(6).

9. During the November 1 call, we further discussed the factual and legal basis for our position that his Appeal was frivolous, including that his arguments on appeal are inconsistent with the law. 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.

10. During 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.

11. Toward the end of the call on November 1, Attorney Bank requested that the phone discussion of the Motion continue at a later date.

12. On November 4, I sent Attorney Bank an email that explained that I did not believe that a further phone discussion would be productive, and I renewed the request that Attorney Bank provide us with his decision on if he planned to object to the Motion and respond to the Motion. *See* Exhibit A.

13. On November 5, Attorney Bank sent four letters in response to the emails I sent him in Exhibit A. *See* Exhibit B.

14. During the November 5, exchange of correspondence with Attorney Bank, we agreed to speak by phone at 3 p.m. on November 5 and I provided a conference call number for the phone call.

15. On November 5, I called the conference line number provided to Attorney Bank at 3 p.m., which was the time Attorney Bank stated he was available for the call. I waited until 3:11 p.m. and Attorney Bank did not join the call.

16. In the fourth letter that Attorney Bank sent on November 5, he requested a phone call on November 6, and stated he was available between 1:30 and 4 (except for 2:45 to 3:00). *See* Exhibit B.

17. On November 6 at 6:18 a.m., I sent Attorney Bank an email and informed him that I would be available for a call at 2:30 p.m., which was during

the time period he requested. In that email, I indicated that we would treat Bank's failure to participate in the phone call "as an indication [he] does not consent to the Motion for Sanctions, and that [he] intends to oppose the motion for sanctions." *See* Exhibit A.

18. On November 6, I called the conference line number provided to Attorney Bank at 2:30 p.m. I stayed on the line until 2:45 p.m. and Attorney Bank did not join the call.

19. In sum, I have made myself available for three telephone calls with Attorney Bank to discuss the Motion. I discussed the Motion with Attorney Bank for 59 minutes on November 1. I called at the time he requested on November 5 to continue the discussion and waited for 11 minutes for him to join the call. He did not join the call. I called again at the time he requested on November 6 and waited 15 minutes for him to join the call. He did not join the call.

20. Based on the foregoing, I have made good faith effort to discuss the Motion with Attorney Bank.

21. I declare under the penalty of perjury that the foregoing is true and correct to the best of my knowledge.

Executed on November 6, 2019

/s/ Katrina G. Hull
Katrina G. Hull

EXHIBIT A

Wednesday, November 6, 2019 at 2:53:30 PM Eastern Standard Time

Subject: RE: URGENT: Re: Rule 27(a)(5) Notice of Rule 38 Motion for Sanctions - 19-1880-MA Bank v. Al Johnson's Swedish Rest.
Date: Wednesday, November 6, 2019 at 2:36:20 PM Eastern Standard Time
From: Katrina Hull <katrinahull@markerylaw.com>
To: Todd Bank <tbank@toddbanklaw.com>
CC: Jacqueline Patt <jackiepatt@markerylaw.com>

Attorney Bank,

Jackie Patt and I are both on the phone. Please let us know if you are having any difficulty joining the call.

Regards,

Katrina

Katrina G. Hull, Esq.
Markery Law, LLC
t: 202-888-2047 (Direct)
KatrinaHull@MarkeryLaw.com

From: Katrina Hull
Sent: Wednesday, November 6, 2019 12:06 PM
To: Todd Bank <tbank@toddbanklaw.com>
Cc: Jacqueline Patt <jackiepatt@markerylaw.com>
Subject: RE: URGENT: Re: Rule 27(a)(5) Notice of Rule 38 Motion for Sanctions - 19-1880-MA Bank v. Al Johnson's Swedish Rest.

Attorney Bank,

We will be on the conference line at 2:30 p.m. today.

Regards,

Katrina

Katrina G. Hull, Esq.
Markery Law, LLC
t: 202-888-2047 (Direct)

KatrinaHull@MarkeryLaw.com

From: Todd Bank <tbank@toddbanklaw.com>
Sent: Wednesday, November 6, 2019 10:09 AM
To: Katrina Hull <katrinahull@markerylaw.com>
Subject: Re: URGENT: Re: Rule 27(a)(5) Notice of Rule 38 Motion for Sanctions - 19-1880-MA Bank v. Al Johnson's Swedish Rest.

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

On 11/6/2019 6:18 AM, Katrina Hull wrote:

> Attorney Bank,
>
> We have grown weary of your unwarranted attacks. We have already stated, ad nauseum, that our hour-long call is sufficient for compliance with Federal Circuit Rule 27(a)(5) (the "Rule"). You have failed to make a cogent argument otherwise. We made ourselves

available at your requested time on Tuesday, November 5 for another call, to which you failed to appear. We have also already explained why the 15 additional minutes we offered as a courtesy should be sufficient for you to ask lingering questions and provide your consent or not to the Motion for Sanctions (the "Motion"). Now you have come back with yet another time and continued the misrepresentation of our obligations and compliance with the Rule.

We ask that you kindly refrain from continuing to misstate our position on the Rule. It is a false statement/mischaracterization that we have "repeatedly made clear" that we refuse to comply with Rule. These false statements are contrary to the spirit of cooperation and good faith, and portend a lack of civil discourse in any further discussions.

We will continue to disagree on the meaning of the length and nature of the "discussion" required by the Rule, which states:

> "The movant must state in the motion that the movant has discussed the motion with the other parties, whether any party will object, and whether any party will file a response."

Nothing in the Rule requires us to have anything more than a discussion of the motion, and we will have made ourselves available for such a discussion three times as of this afternoon. Further, nothing in the Rule requires us to continue to discuss the Motion until you are satisfied with the substance or length of the discussion.

Nonetheless, we will, again, be on the call line previously provided at 2:30 p.m. Eastern (DIAL IN 1-267-866-0999; PIN 6346 00 3805) today (Wednesday, November 6) during the time period you requested. We will, again, treat your failure to appear as an indication that you do not consent to the Motion for Sanctions, and that you intend to oppose the Motion for Sanctions.

To increase the efficiency of the call, we would appreciate if you could provide us with your questions/discussion requests ahead of time so that we can prepare succinct responses.

Regards,

Katrina

Katrina G. Hull, Esq.
Markery Law, LLC
t: 202-888-2047 (Direct)
KatrinaHull@MarkeryLaw.com

From: Todd Bank <tbank@toddbanklaw.com>
Sent: Tuesday, November 5, 2019 4:10 PM
To: Katrina Hull <katrinahull@markerylaw.com>
Subject: Re: URGENT: Re: Rule 27(a)(5) Notice of Rule 38 Motion for Sanctions - 19-1880-MA Bank v. Al Johnson's Swedish Rest.

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

On 11/5/2019 4:36 PM, Katrina Hull wrote:

> Attorney Bank,
>
> At 3:00 p.m. Eastern* today, I called in to the conference bridge number I provided to you at the time you requested in your letter of 9:33 a.m. today. I remained on the phone until 3:11 p.m. Unfortunately, you did not call in to the number provided. (*All references in this email are to the Eastern time zone.)

We have a fundamental disagreement regarding the obligations under Rule 27(a)(5). We are also confused by the contradictions in your correspondence. Your 9:33 a.m. letter states your belief that "comply[ing] with [our good faith obligation under Federal Circuit Rule 27(a)(5)" would be to "resume our conversation today" and that "[you] will be available at 3:00 today (during the window of time that we had agreed upon) provided that you confirm your availability by 1:00." We then agreed to a further call at 3:00 p.m. by way of our email response at 12:25 p.m. We requested that the call be limited to 15 minutes given the hour long call we already had on Friday.

However, your letter of 1:28 p.m. represents that we "once again, refuse to comply with Rule 27(a)(5)" and states that "[s]hould you agree to comply with that rule, 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." Our response at 2:25 p.m. stated that we complied with the Rule with the hour long call. Nonetheless, we agreed to an additional call at 3:00 p.m. as you requested and explained that we believed 15 minutes was sufficient to answer your questions and for you to consent, or not, to the Motion. We also provided the call in details.

Finally, your letter of 3:03 p.m., received after the start of the call, stated that because we have "given no indication that [we] intend to comply with Local Rule 27(a)(5), [you] do not accept [our] proposal." However, we had already dialed in to the conference line for the additional call you requested, and we were waiting for you to join the call.

Rule 27(a)(5) requires a statement that we have "discussed the motion with the other parties." We discussed the Motion for an hour on Friday and dialed in to a conference line at the agreed time for further discussions today. Therefore, we have fulfilled our obligations under Rule 27(a)(5) to discuss the motion.

We will treat your lack of participation in today's call as an indication that you do not consent to the Motion for Sanctions, and that you intend to oppose the Motion for Sanctions.

Regards,

Katrina

Katrina G. Hull, Esq.
Markery Law, LLC
t: 202-888-2047 (Direct)
KatrinaHull@MarkeryLaw.com

From: Katrina Hull
Sent: Tuesday, November 5, 2019 2:06 PM
To: Todd Bank <tbank@toddbanklaw.com>
Cc: Jacqueline Patt <jackiepatt@markerylaw.com>
Subject: RE: URGENT: Re: Rule 27(a)(5) Notice of Rule 38 Motion for Sanctions - 19-1880-MA Bank v. Al Johnson's Swedish Rest.

Attorney Bank,

We are on the phone now, and waiting for you to join. Please call dial in if you want to have a call: DIAL IN 1-267-866-0999; PIN 6346 00 3805.

We are ready to continue the discussion. Please join the call in the next five minutes. We will remain on the line until 3:10 p.m. Easter.

Regards,

Katrina

Katrina G. Hull, Esq.
Markery Law, LLC
t: 202-888-2047 (Direct)
KatrinaHull@MarkeryLaw.com

From: Todd Bank <tbank@toddbanklaw.com>
Sent: Tuesday, November 5, 2019 2:03 PM
To: Katrina Hull <katrinahull@markerylaw.com>
Subject: Re: URGENT: Re: Rule 27(a)(5) Notice of Rule 38 Motion for Sanctions - 19-1880-MA Bank v. Al Johnson's Swedish Rest.

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

On 11/5/2019 2:25 PM, Katrina Hull wrote:

> Attorney Bank,
>
> We have already fulfilled our obligation under Rule 27(a)(5) to discuss the motion with you with the hour-long call on Friday.
>
> We are offering you an additional 15 minutes as a courtesy. We believe 15 minutes is more than sufficient to answer any lingering questions you have and for you to provide a clear answer regarding your consent to the motion or not, and your intention to file a response.
>
> Please use the following information for our call at 3 p.m. Eastern: DIAL IN 1-267-866-0999; PIN 6346 00 3805.
>
> Regards,

Katrina

Katrina G. Hull, Esq.
Markery Law, LLC
t: 202-888-2047 (Direct)
KatrinaHull@MarkeryLaw.com

From: Todd Bank <tbank@toddbanklaw.com>
Sent: Tuesday, November 5, 2019 12:12 PM
To: Katrina Hull <katrinahull@markerylaw.com>
Subject: Re: URGENT: Re: Rule 27(a)(5) Notice of Rule 38 Motion for Sanctions - 19-1880-MA Bank v. Al Johnson's Swedish Rest.

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

On 11/5/2019 12:25 PM, Katrina Hull wrote:

Attorney Bank,

Your representation of our conversation is inaccurate. During the nearly hour-long call, I outlined the Restaurant's main arguments in its Rule 38 Motion for Sanctions against you for filing and arguing a frivolous appeal including:

- You have filed three cancellation petitions with the Trademark Trial and Appeal Board (the "Board") to cancel Al Johnson's Restaurant's Goats on the Roof Trade Dress Registration, and all have been dismissed at the pleading stage under Rule 12(b)(6).
- The Supreme Court ruled that trademark registrations can no longer be challenged as offensive *before* you filed the 2018 petition, which alleges only offense as the injury.
- The Board dismissed your 2018 petition for (1) failure to plead standing; and (2) failure to allege a valid basis for cancellation, and your reply brief incorrectly states that standing is the only issue on appeal.

I declined to argue with you on the phone on November 1 and stated that the conversation was not productive because the Restaurant's position on the merits of the underlying appeal is set forth in its brief already filed with the Court.

For all motions filed with the Federal Circuit, Rule 27(a)(5) requires the movant to "state in the motion that the movant has discussed the motion with the other parties, whether any party will object, and whether any party will file a response." I'm not aware of any requirement that the discussion must occur by phone instead of email.

As outlined above, I provided you with sufficient information about the contents of the Motion for Sanctions for you to answer the questions of whether you object to the Motion for Sanctions and whether you will file a response to the Motion for Sanctions.

We are available for a phone call at 3 p.m. Eastern today, on the following conditions:

1. The call will be limited to 15 minutes;
2. The call will be recorded to avoid any future disagreement about the substance of the discussion; and
3. You will answer the following questions during the call (a) whether you will withdraw the appeal, (b) whether you object to the Motion for Sanctions, and (c) whether you will file a response to the Motion for Sanctions.

If you agree to these terms, I will send out a phone number for the call. If you do not agree to these conditions, then please provide us with your additional discussion questions by email, and we will provide our responses in writing. We also renew the request for your response to the questions asked by Rule 27(a)(5): whether you object to the Motion for Sanctions and whether you plan to respond to the Motion for Sanctions.

We decline to argue with you on the phone. Your arguments about why your appeal is not frivolous should be filed with the Court in response to the Motion for Sanctions.

In closing, you have filed three cases with the Board against a small, family-owned business located in Wisconsin. In the absence of your response to this email, we will proceed with filing the Motion for Sanctions.

Regards,

Katrina

Katrina G. Hull, Esq.
Markery Law, LLC
t: 202-888-2047 (Direct)
KatrinaHull@MarkeryLaw.com

From: Todd Bank <tbank@toddbanklaw.com>
Sent: Tuesday, November 5, 2019 9:33 AM
To: Katrina Hull <katrinahull@markerylaw.com>
Subject: URGENT: Re: Rule 27(a)(5) Notice of Rule 38 Motion for Sanctions - 19-1880-MA Bank v. Al Johnson's Swedish Rest.
Importance: High

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

On 11/4/2019 11:59 AM, Katrina Hull wrote:

> Attorney Bank,
>
> This email follows up on our mandated Federal Circuit Rule 27(a)(5) phone discussion on Friday, November 1 regarding Al Johnson's Restaurant's Motion for Sanctions against you under Rule 38 of the Federal Rules of Appellate Procedure for filing and arguing a frivolous appeal. As you know, Federal Circuit Rule 27(a)(5) requires that the "movant must state in the motion that the movant has discussed the motion with the other parties, whether any party will object, and whether any party will file a response."
>
> The nearly hour-long November 1 phone call was not productive for several reasons including that, despite knowing the purpose of the call, you repeatedly declined to state whether you would object to our Motion and/or if you planned to file a response. In addition, your attempts on the call to relitigate the merits of your initial appeal were argumentative and irrelevant to the purpose of the call.

We hereby decline your request for an additional call because, unfortunately, it is unlikely to be any more productive than the November 1 call. We also decline your request to provide you with a draft copy of the Motion before filing because it is not mandated by the Rules. Please note that the Practice Notes to Rule 38 state that "a party whose case has been challenged as frivolous is expected to respond or to request dismissal of the case." Thus, you will have the opportunity to respond as you see fit.

Please provide us with your decision of whether you will object to the Motion for Sanctions by 3 p.m. Eastern on Tuesday, November 5, 2019. In the absence of your response, we will file an unconsented Motion for Sanctions.

Regards,

Katrina

Katrina G. Hull, Esq.
Markery Law, LLC
t: 202-888-2047 (Direct)
KatrinaHull@MarkeryLaw.com

From: Todd Bank <tbank@toddbanklaw.com>
Sent: Friday, November 1, 2019 11:51 AM
To: Katrina Hull <katrinahull@markerylaw.com>
Subject: Re: Rule 27(a)(5) Notice of Rule 38 Motion for Sanctions - 19-1880-MA Bank v. Al Johnson's Swedish Rest.

Ms. Katrina:

I will not be available at that time, but should be available at 5:00.

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

On 11/1/2019 12:36 PM, Katrina Hull wrote:

> Todd,
>
> Are you available this afternoon at 3 Eastern?
>
> Katrina
>
> Sent from my iPhone

> On Nov 1, 2019, at 11:27 AM, Todd Bank <tbank@toddbanklaw.com> wrote:

Ms. Katrina:

As the rule requires that "the movant has discussed the motion with the other parties," please let me know your availability to discuss the motion.

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

On 11/1/2019 9:41 AM, Katrina Hull wrote:

> Dear Attorney Bank,
>
> This email provides you with Notice under Federal Circuit Rule 27(a)(5) that, on behalf of Al Johnson's Restaurant, I will be filing a motion for sanctions under Rule 38 of the Federal Rules of Appellate Procedure against you for filing and arguing a frivolous appeal.

In accordance with Federal Circuit Rule 27(a)(5), please respond as to whether you (1) consent to this motion for sanctions; and (2) will file a response to the motion for sanctions.

Regards,

Katrina

Katrina G. Hull, Esq.
Of Counsel, Admitted in Wisconsin
t: 202-888-2047 (Direct)
KatrinaHull@MarkeryLaw.com

<image001.png>

t: 202-888-7892 (Main)
f: 202-803-7953
1200 G St., N.W., Suite 800
Washington, DC 20005

www.MarkeryLaw.com

EXHIBIT B

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 5, 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:

On November 1, 2019, you sent an email to me that stated, in full:

> This email provides you with Notice under Federal Circuit Rule 27(a)(5) that, on behalf of Al Johnson's Restaurant, I will be filing a motion for sanctions under Rule 38 of the Federal Rules of Appellate Procedure against you for filing and arguing a frivolous appeal. In accordance with Federal Circuit Rule 27(a)(5), please respond as to whether you (1) consent to this motion for sanctions; and (2) will file a response to the motion for sanctions.

On November 1, 2019, I responded to the above with an email to you that stated, in full:

> As the rule requires that "the movant has discussed the motion with the other parties," please let me know your availability to discuss the motion.

Notwithstanding the unambiguous requirement to discuss the motion, you began our conversation, which we had on November 1, 2019, by claiming that I had requested to have that conversation, as if the rule did not require it. You then spent the bulk of the approximately one-hour conversation by repeating that the motion would be based on your brief, to which you alluded, while refusing further explanation in response to my questions regarding the motion. You also spent a significant amount of the time insisting that the conversation was not productive, rather than engaging in a good-faith attempt to make it productive so as to comply with the rule in good faith. Ultimately, you stated that you needed to end the conversation in order to attend to a personal matter, to which I responded by proposing to resume on November 5, 2019. You not only agreed to this, but stated that you anticipated the participation of your colleague, Jacqueline Patt.

I have spent a considerable amount of time reviewing our discussion and preparing for the resumption of it to which we had agreed.

Please confirm that you will comply with your good-faith obligation under Federal Circuit Rule 27(a)(5) and, to that end, your representation that we would resume our conversation today. Accordingly, please note that I will be available at 3:00 today (during the window of time that we had agreed upon) provided that you confirm your availability by 1:00.

Sincerely,

s/ *Todd C. Bank*

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 5, 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 third email of today:

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.

You have not explained, nor appear able to explain, why the obviously arbitrary time period of 15 minutes would be sufficient, and, again, your claim to have complied with Rule 27(a)(5) during our conversation on November 1 is simply false; nor does your statement that you had "already dialed in to the conference line for the additional call you requested, and we were waiting for you to join the call," indicate otherwise, as I explained in my last letter.

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).

Sincerely,

s/ ***Todd C. Bank***

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 5, 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 today:

Your claim, with respect to Local Rule 27(a)(5), that you are "not aware of any requirement that the discussion must occur by phone instead of email," is inconsistent with your acknowledgment, made during our conversation on November 1, 2019, that your initial email regarding this matter, dated November 1, 2019, in which you stated, "[i]n accordance with Federal Circuit Rule 27(a)(5), please respond as to whether you (1) consent to this motion for sanctions; and (2) will file a response to the motion for sanctions" did not comply with the requirement, of Local Rule 27(a)(5), that the discussion be a live discussion. Your acknowledgment, rather than what appears to now be your retraction of it, remains correct, as the meaning of the term "discuss" clearly denotes a live discussion, not email correspondence. *See*, *e.g.*, *Hawkins v. Davis*, No. 00-cv-01077, 2001 WL 1548961, *1 (C.D. Calif. Oct. 19, 2001).

As I previously stated, throughout our conversation you "refus[ed] further explanation in response to my questions regarding the motion." 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.

I cannot agree to artificially limit the time of our discussion, especially given your clear representations in your email that you will, once again, refuse to comply with Rule 27(a)(5). Should you agree to comply with that rule, 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.

Sincerely,

s/ *Todd C. Bank*

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 5, 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 second email of today:

As you have given no indication that you intend to comply with Local Rule 27(a)(5), I do not accept your proposal. 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.

Sincerely,

s/ ***Todd C. Bank***

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 6, 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 today:

You are correct in stating that you "have already stated, ad nauseum, that our hour-long call is sufficient for compliance with Federal Circuit Rule 27(a)(5)." Your repetition of that assertion, however, does not make it true; and, indeed, it is not true. On the contrary, I have repeatedly made clear how you have not complied with the rule, *i.e.*, by refusing to respond to numerous questions other than by stating that your arguments will be repeated from the briefs.

I agree with you, of course, that "[n]othing in the Rule requires us to have anything more than a discussion of the motion." Again, however, you have refused to discuss the motion in a manner that even arguably constitutes good faith.

As the rule requires discussion, I decline to "provide [you] with [my] questions/discussion requests ahead of time"; and, of course, given the nature of a discussion, I might have follow-up questions, etc. (as might you), and do not wish to have disputes over which questions I presented "ahead of time" and which I did not, which follow-up questions pertain to those questions, and so on.

It has been clear since you first attempted to avoid even purporting to comply with the rule (that is, by seeking to bypass a discussion altogether), that you have sought to treat the rule as a mere formality.

Finally, I am concerned that you chose 2:30 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).

Sincerely,

s/ *Todd C. Bank*

Todd C. Bank

CERTIFICATE OF SERVICE

I hereby certify that on November 6, 2019, I filed this document with the Court's CM/ECF filing system, which delivered notice of this filing to the below email address for Appellant Todd C. Bank:

tbank@toddbanklaw.com
ecf@toddbanklaw.com

I also certify that on November 6, 2019, I sent a copy of this document by U.S. mail to Appellant Todd C. Bank, as follows:

Todd C. Bank
119-40 Union Turnpike
Fourth Floor
Kew Gardens, New York 11415

/s/ Katrina G. Hull
Katrina G. Hull

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION, TYPEFACE REQUIREMENTS AND TYPE STYLE REQUIREMENTS

1. This motion complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B) or Federal Rule of Appellate Procedure 28.1(e) because the motion contains **4298** words, excluding the parts of the motion exempted by Federal Rule of Appellate Procedure 27(d)(2) and Fed. Cir. R. 27(d)

2. This motion complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6) because it has been prepared in a proportionally spaced typeface using MS Word in a 14-point Times New Roman font.

Signed November 6, 2019

/s/ Katrina G. Hull
Katrina G. Hull