

No. 19-_____

In the Supreme Court of the United States

TODD C. BANK,

Petitioner,

v.

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

Respondent.

ON PETITION FOR WRIT OF *CERTIORARI*
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF *CERTIORARI*

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QUESTIONS PRESENTED FOR REVIEW

1. In *Matal v. Tam*, 137 S. Ct. 1744 (2017), this Court held that the disparagement clause of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), which “prohibit[s] the registration of trademarks that may ‘disparage ... or bring ... into contemp[t] or disrepute’ any ‘persons, living or dead,’” *Tam*, 137 S. Ct. at 1751, quoting 15 U.S.C. § 1052(a) (ellipses in original), violates the First Amendment. The question is whether *Tam* thereby precluded disparagement as the basis of one’s *standing* under Section 14 of the Lanham Act, 15 U.S.C. § 1064, to challenge the validity of a trademark where the basis of the *merits* of the challenge, *i.e.*, the challenger’s assertion as to *why* the mark is invalid, is unrelated to disparagement.

2. Whether a federal appeals court abuses its authority by sanctioning a party for arguing in favor of his position, even though: (i) the arguments and the position are meritorious; and (ii) the court claimed that the party had conceded that his position had been foreclosed by a decision of this Court, whereas the party, rather than having made such a concession, had argued that his position was *not* foreclosed by that decision.

**LIST OF PARTIES AND
RULE 29.6 DISCLOSURE**

The caption lists all of the parties. Petitioner, Todd C. Bank (“Bank”), is a natural person. Therefore, no corporate-disclosure statement is required under Supreme Court Rule 29.6.

**STATEMENT OF DIRECTLY
RELATED PROCEEDINGS**

There are no directly related proceedings.

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INTRODUCTION

Todd C. Bank respectfully petition this Court for a writ of *certiorari* to the United States Court of Appeals for the Federal Circuit.

ORDERS BELOW

The Order of the United States Court of Appeals for the Federal Circuit, dated December 9, 2019 (the “Subject Order”), which is not reported, is reprinted in the Appendix to this Petition (“Appx.”) at Appx. A, 1a-11a.

The Order of the Trademark Trial and Appeal Board of the United States Patent and Trademark Office (the “TTAB” or the “Board”), dated March 27, 2019, which is not reported, is reprinted at Appx. B, 12a-24a.

The Order of the TTAB dated May 2, 2019, which is not reported, is reprinted at Appx. C, 25a-26a.

The Order of the Court of Appeals denying Bank’s Petition for Rehearing with Suggestion for Rehearing *En Banc*, which is not reported, is reprinted at Appx. D, 27a-28a.

STATEMENT OF JURISDICTION

On December 9, 2019, the Subject Order was entered.

On December 20, 2019, Bank filed a Petition for Rehearing with Suggestion for Rehearing *En Banc*, which the Court of Appeals denied on January 31, 2020.

This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

15 U.S.C. § 1052(a)

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

15 U.S.C. § 1064(3)

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905: . . . (3) At any time if the registered mark . . . is functional

STATEMENT OF THE CASE

Bank brought the underlying action (the “TTAB Proceeding”) before the Trademark Trial and Appeal Board (the “TTAB” or the “Board”) of the United States Patent and Trademark Office (the “USPTO”), which had jurisdiction under 15 U.S.C. § 1064(3) and 37 C.F.R. § 2.111.

Bank petitioned the USPTO for the cancellation of Trademark Registration No. 2007624.

REASONS FOR GRANTING THE PETITION

As set forth below, the Court of Appeals, with respect to the question of standing: (i) decided an important Constitutional question that has not specifically been, but should be, settled by this Court; and (ii) disregarded relevant decisions of this Court.

As also set forth below, the Court of Appeals, in sanctioning Bank, so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's supervisory power.

I. PETITIONER HAS STANDING

A. The Court of Appeals Conflated Standing with the Merits

The Court of Appeals found that Bank did not sufficiently plead standing before the TTAB, *see* Appx. A, 5a-6a, explaining: “[t]o the extent that Mr. Bank relies upon disparagement . . . to establish his standing, the argument is without merit after *Tam*.” *Id.*, 6a.

First, the court ignored the axiomatic principle that standing is distinct from the merits. *See Whitmore v. Arkansas*, 495 U.S. 149, 155 (1990) (“[o]ur threshold inquiry into standing ‘*in no way depends on the merits*’ of the [petitioner’s] contention that particular conduct is illegal,” quoting *Warth v. Seldin*, 422 U.S. 490, 500 (1975) (emphases added)); *accord, Ariz. State Legislature v. Ariz. Indep. Redistricting Comm’n*, 135 S. Ct. 2652, 2663 (2015). Whereas Bank asserted

standing based upon disparagement, he alleged, with respect to the merits, that the challenged trademark, which “consists of goats on [a] grass roof,” Appx. A, 2a (additional quotation marks omitted), is functional because of factors unrelated to disparagement, *i.e.*, that, “[t]he primary use of the [m]ark[] is as a form of entertainment that increases, to customers, the appeal of [Respondent]’s [restaurant],” Bank’s TTAB Petition, ¶ 5, that, “[t]o whatever extent the [m]ark[] serve[s] as identification with respect to [Respondent’s restaurant], such service is not the primary effect of the [m]ark[], and such service pales in comparison to the provision, by the [m]ark[], of entertainment that increases, to customers, the appeal of the [restaurant],” *id.*, ¶ 6, that, “[t]he use of the [m]ark[] as a form of entertainment that increases, to customers, the appeal of the [restaurant] is unique[,] . . . functional[,] . . . [and] superior to other methods.” *id.*, ¶¶ 7, 8, 9, and that, “[t]he placement of goats on a grass roof negates or ameliorates, due to the goats’ grazing, the need to cut the grass, and is thus economically advantageous.” *Id.*, ¶ 10.

Second, the Court of Appeals disregarded the plain language of the private-right-of-action provision that Bank invoked, *i.e.*, Section 14 of the Lanham Act, 15 U.S.C. § 1064, the first paragraph of which states: “[a] petition to cancel a registration of a mark, stating the grounds relied upon, may . . . be filed . . . by any person who believes that he is or will be damaged . . . by the *registration* of [the] mark.” 15 U.S.C. § 1064 (emphasis added). Thus, by its plain language, Section 14 does not require that any *particular* aspect of a trademark

be the source of alleged damage, but, rather, that the *mere existence* of a mark *i.e.*, its *registration*, be that source.

In *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999), the court held in favor of the standing of the petitioner, who had opposed the applications to register certain trademarks and had relied upon the marks' alleged disparagement as the basis of both his standing *and* the merits of his opposition (the standing of a petitioner opposing the registration of a mark is governed by Section 13 of the Lanham Act, 15 U.S.C. § 1063, which contains the same relevant requirements as does Section 14, *i.e.*, that “[a]ny person who believes that he would be damaged by the registration of a mark . . . may . . . file an opposition.” 15 U.S.C. § 1063. Accordingly, the requirements for petitions for opposition are the same as the requirements for petitions for cancellation. *See Ritchie*, 170 F.3d at 1095, n.2; *Young v. AGB Corp.*, 152 F.3d 1377, 1379-1380 (Fed. Cir. 1998)). Although, in *Ritchie*, the basis of the challenger's standing correlated to the basis of the merits of his challenge, the plain language of Sections 13 and 14 of the Lanham Act, 15 U.S.C. §§ 1063 and 1064, makes clear, as set forth above, that such correlation is not required.

Example: a petitioner for cancellation argues, with respect to the *merits*, that the challenged mark is being used “so as to misrepresent the source of the goods or services on[,] or in connection with[,] which the mark is used.” 15 U.S.C. § 1064(3). With respect to standing, the petitioner does not allege that he was harmed by

that *misrepresentation*, but, rather, by the existence, *i.e.*, the *registration*, of the mark because *he wants to use the mark*, but the registration prohibits him from doing so and he is therefore damaged “by the registration of [the] mark.” 15 U.S.C. § 1064. The petitioner clearly would have standing even though the basis of his standing does not correlate to the basis of the merits of his challenge.

Section 14 of the Lanham Act *does* address the merits of a petition for cancellation, *i.e.*, the question of why a mark is not valid and should therefore be canceled, but does so only with respect to the *timing* of the filing of a petition; that is, if a petition is based upon certain allegations regarding a challenged mark, including, as Bank alleges, that the mark is “functional,” the petition may be filed “[a]t any time,” 15 U.S.C. § 1064(3), whereas, except for petitions that seek cancellation based upon functionality or any of the other enumerated bases set forth in Section 1064(3), or in the circumstances set forth in Sections 1064(4) or (5), petitions for cancellation must be filed “[w]ithin five years from the date of the registration of the mark,” 15 U.S.C. § 1064(1), or “[w]ithin five years from the date of publication under [15 U.S.C. §] 1062(c) . . . of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.” 15 U.S.C. § 1064(2). Accordingly, “[Section] 1064 has been described as a kind of statute of limitations for actions seeking cancellation of marks registered for more than five years,” *Shakespeare Co. v. Silstar Corp. of America, Inc.*, 9 F.3d 1091, 1096 (4th Cir. 1993); *see also Pinkette Clothing, Inc. v. Cosmetic Warriors Ltd.*,

894 F.3d 1015 (9th Cir. 2018):

Although . . . a petition [for cancellation] may be filed “[a]t any time,” § 1064 limits the grounds for cancellation after five years have passed from the date of registration—i.e., after the mark becomes *incontestable*. [] § 1064.

There is no question that § 1064 is not a statute of limitations in the usual sense of barring an action entirely once a defined period expires. Incontestability merely limits the grounds on which cancellation may be sought. A petition brought *within* five years of registration (against a *contestable* mark) *may assert any ground that would have prevented registration in the first place*—most commonly that the registered mark creates a likelihood of confusion with the petitioner’s preexisting mark. 15 U.S.C. § 1064. *By contrast*, a petition brought five years *after* registration (against an *incontestable* mark) may only assert *one of several enumerated grounds for cancellation, including genericism, functionality, abandonment, or fraudulent procurement. Id.*

Id. at 1018, 1023 (emphases added).

In contrast to Sections 13 and 14 of the Lanham Act, Section 38, 15 U.S.C. § 1120, *does* require a correlation between standing and the merits, as that provision states: “[a]ny person who shall procure registration . . . of a mark *by a false or fraudulent declaration or representation . . . or by any false means*, shall be liable in a civil action by any person *injured thereby* for any damages sustained *in consequence thereof*.” 15 U.S.C. § 1120 (emphases added). Thus, “it is not enough for the plaintiff merely to establish fraud in the registration of the trademark; the plaintiff must also show that [it] sustained some damage *in consequence of the fraud*.” *Virginia Polytechnic Inst. & State Univ. v. Hokie Real Estate, Inc.*, 813 F. Supp. 2d 745, 755 (W.D. Va. 2011) (emphasis added; citation and quotation marks omitted).

The Court of Appeals deemed, albeit *sub silentio*, *Ritchie* to have been abrogated by *Tam*. More specifically, the Court of Appeals implicitly, and erroneously, found that, as a result of *Tam*, the petitioner in *Ritchie* would have been precluded from basing his standing upon disparagement even if the *merits* of his claims had been unrelated to disparagement.

B. Petitioner was not Deprived of Standing Merely Because, According to His Theory of Standing, There Might be a Large Number of Trademarks that he Could Challenge

The Subject Order states:

Finally, Mr. Bank contests the TTAB's *alleged conclusion* that "the mark in question *[must be] part of a class of marks* to which the petitioner *might also object.*" Appellant's Br. 9 (capitalization altered); *see* A.A. 8 [(Appx. B, 19a-20a)] (asserting that Mr. Bank's "pleading of standing is vague and *does not relate specifically to the involved service mark*"). To the extent that Mr. Bank is challenging the statement as one which *creates a "class of marks" requirement*, such an interpretation *strains the meaning* of the cited portion of the TTAB's opinion.

Appx. A, 9a (emphases added; brackets by the Court of Appeals). The Court of Appeals' insertion of "must be" should have been "must *not* be." That is because Bank argued that the TTAB had wrongly found that one of the reasons why Bank *lacked standing* was that the challenged mark was part of a larger class of trademarks, *i.e.*, "mark[s] involving the use of animals . . . in connection with any services," Bank's Principal Brief ("Bank Pr. Br."; Fed. Cir. No. 2019-1880, Doc. 21)

at 9, quoting Appx. B, 20a, all of the marks of which Bank would have standing to challenge if he had standing to challenge the mark at issue. First, Bank quoted the following from the TTAB's Order:

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

Bank Pr. Br. at 9, quoting Appx. B, 19a-20a (emphases added; additional quotation marks omitted).

Second, Bank explained:

The fact that the basis of Bank's assertion of harm, *i.e.*, that [Respondent]'s mark, in "appl[ying] to the activity of an animal (as opposed to a trademark that is merely a representation of such activity) is demeaning to the type of

animal that is the subject of such mark,” [Bank’s TTAB Petition], ¶ 1 [], and that “[t]he demeaning of animals in the manner set forth in the previous paragraph is offensive to Bank and denigrates the value he places on the respect, dignity, and worth of animals,” *id.*, ¶ 2 [], might also apply to *other* marks does not deprive Bank of standing. In *Ritchie*, this Court held that the petitioner had standing to oppose “the trademarks O.J. SIMPSON, O.J., and THE JUICE,” *Ritchie*, 170 F.3d at 1093, based upon:

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

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

Bank Pr. Br. at 8-10 (emphases in original).

II. THE IMPOSITION OF SANCTIONS WAS SUCH AN ABUSE OF AUTHORITY THAT THIS COURT SHOULD EXERCISE ITS SUPERVISORY AUTHORITY IN ORDER TO VACATE IT

The Subject Order, referring to the TTAB proceeding and to *Doyle v. Al Johnson’s Swedish Restaurant & Butik, Inc.*, 101 U.S.P.Q.2d 1780, 2012 WL 695211 (T.T.A.B. 2012), in which Bank represented the petitioner, states:

We conclude that this appeal and Mr. Bank’s motion for sanctions are frivolous. Mr. Bank filed *multiple petitions with the TTAB* regarding the Goats on the Roof Registration, all of which were dismissed

for, inter alia, standing. Mr. Bank was *afforded the opportunity to revise his petition and remedy the standing defect, which he did not do*. Despite the fact that Mr. Bank was *informed by the TTAB that his disparagement claim was based on an unconstitutional and stricken section of the Lanham Act*, he *raises it again before this court*. Based on these facts and our analysis, Mr. Bank's appeal is frivolous. *See Finch v. Hughes Aircraft Co.*, 926 F.2d 1574, 1583 (Fed. Cir. 1991) Accordingly, *we grant Swedish Restaurant's motion for costs and attorney fees, including the costs and fees incurred in relation to the parties' sanctions motions, and deny Mr. Bank's motion for sanctions*.

Appx. A, 10a-11a (emphases added).

First, and most importantly, the appeal was not frivolous; indeed, it was meritorious. The same is true of Bank's motion for sanctions (Doc. 33).

Second, Rule 38 of the Federal Rules of Appellate Procedure, pursuant to which the court imposed sanctions, *see* Appx. A, 9a-10a, does not even authorize sanctions based on the *proceeding from which the appeal is taken, let alone a separate proceeding*, such as *Doyle*. *See Boyer v. BNSF Railway Co.*, 824 F.3d 694, 711 (7th Cir. 2016) ("Rule 38 necessarily focuses on *what a party has done in the appellate court* rather

than the district court,” citing *Roth v. Green*, 466 F.3d 1179, 1188 (10th Cir. 2006), and *In re 60 E. 80th St. Equities, Inc.*, 218 F.3d 109, 118, n.4 (2d Cir. 2000) (emphasis added)).

Third, the alleged basis of standing in *Doyle* had nothing to do with disparagement in any event. See *Doyle*, 2012 WL 695211 at *1.

Fourth, *Doyle* was not binding on the Court of Appeals.

Fifth, the notion that sanctions were supported by the fact that Bank did not “revise his petition and remedy the standing defect” wrongly assumes that there was such a defect and that it was so great that Bank’s decision not to amend the petition rendered the appeal frivolous.

Sixth, in *Finch v. Hughes Aircraft Co.*, 926 F.2d 1574 (Fed. Cir. 1991), the court found that an attorney who was a “member[] of the bar of th[e] court,” *id.* at 1583, and had “litigated in th[e] court previously,” *id.* at 1583, n.7, “ha[d] made no attempt to address the overwhelming authority against his position, much less rebut that authority,” *id.* at 1580, as a result of which the court, as a Rule 38 sanction, “award[ed] to [the] appellee [] *double its cost.*” *Id.* at 1583 (emphasis added).

Unlike the attorney in *Finch*, Bank is not admitted to the bar of the Federal Circuit and had not previously litigated in that court (in any capacity).

More importantly, however, Bank addressed each of the bases upon which the TTAB made its ruling and neither ignored, nor failed to rebut, authority against his position, the only such authority having been *Doyle*, which, again, was not binding on the Court of Appeals. *See* Bank Pr. Br. at 12-13. Indeed, Bank should have prevailed on the appeal.

Seventh, *Finch* also found that the attorney had sought to litigate claims that were precluded by *res judicata*, *see Finch*, 926 F.2d at 1577, and duplicative of another pending action, *see id.*, and that the attorney “[had] not oppose[d] the [district court’s] dismissal [of the claims] and therefore waived his right to appeal,” *id.*, at 1580, but, “argue[d], for the first time [on appeal], that th[e] dismissal was improper,” *id.*, at 1577, even though “[i]t is well-settled that, absent exceptional circumstances, a party cannot raise on appeal legal issues not raised and considered in the trial forum.” *Id.*

Finally, *Finch* found:

Not one word is offered in [the attorney’s] reply brief in defense of his opening brief. Nor did he make a credible defense of the statements in his briefs or the basis of his appeal when explicitly invited to do so at oral argument before the court. [The attorney]’s *failure to explain and defend* his reasons for appealing and his post-filing conduct, *even when asked to do so*, further confirms our view that his frivo-

lous appeal and misconduct before us merit sanctions.

Id. at 1582 (emphases added).

The Subject Order, further confusing the question of standing with the question of the merits, states:

[T]he *sole standing argument* that Mr. Bank raised before the TTAB, A.A. 6-8 [(Appx. B, 16a-20a)], and recites on appeal, [Bank Pr. Br. at] 9, is that the Swedish Restaurant’s trade dress was *disparaging* to himself as it “is demeaning to” goats, A.A. 15 [(Bank’s TTAB Petition, ¶ 1)]. Yet as Mr. Bank *conceded before the TTAB*, the Supreme Court’s decision in *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017), *foreclosed his argument*, as it held unconstitutional the *prohibition on the registration of disparaging marks under the Lanham Act*. A.A. 31-32 [(Appx. B, 18a)] (explaining that, following the issuance of *Tam*, Mr. Bank “*acknowledge[d] that disparagement [wa]s no longer a cognizable claim* under the [Lanham Act]”). In *Tam*, the Court held as unconstitutional 15 U.S.C. § 1052(a) of the Lanham Act, concluding that its prohibition on disparaging marks was invalid under the First Amendment protection of speech. *See Tam*, 137 S. Ct. at 1765. To

the extent that Mr. Bank relies upon disparagement *either as the grounds for his petition or . . . to establish his standing*; the argument is without merit after *Tam*.

Appx. A, 6a (emphases added; brackets in original). First, the extent to which “Bank relie[d] upon disparagement . . . as the grounds for his petition,” as opposed to having done so “to establish his standing,” is *none*, both before the TTAB and the Court of Appeals.

Second, the Court of Appeals’ claim that Bank “conceded,” before the TTAB, that Bank’s “sole standing argument” was “foreclosed” by *Tam* is perfectly false. Although the TTAB rejected Bank’s position on the question of whether *Tam* precluded disparagement as the basis of Bank’s standing, the TTAB, unlike the Court of Appeals, accurately characterized Bank’s argument; indeed, the TTAB did so on the very pages that the Court of Appeals cited as containing the TTAB’s finding of Bank’s ‘concession,’ *see* Appx. B, 17a-19a, and, specifically, *id.*, 18a (“Petitioner acknowledges that disparagement is *no longer a cognizable claim* under the [Lanham] Act. *Petitioner argues, however*, that his allegations that the mark is offensive to him *are sufficient to support a pleading of standing*. Accordingly, Petitioner argues that although he ‘may not rely upon the offensiveness of [Respondent’s] trademark in order to prevail **on the merits** . . . the foreclosure upon such reliance has **nothing to do with standing**....” (emphases added,

except bold-only emphases; citations omitted)); *id.* (“as acknowledged by Petitioner, the *only ground for cancellation* is the *claim of functionality*” (emphases added)); *id.*, 19a (“Petitioner may not rely upon allegations that the involved mark is *personally offensive* to him to plead his *standing* to assert a *claim that the involved mark is functional*” (emphases added; footnote omitted)).

As the TTAB understood, Bank, far from having “conceded” that *Tam* had foreclosed disparagement as the basis of Bank’s standing, had argued the *exact opposite*.

CONCLUSION

This Petition should be granted.

Respectfully submitted,

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