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February 9, 2009

Cheryl Goodman, Esq.
Interlocutory Attorney
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

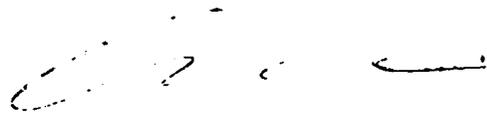
79/045, 616

RE: Franklin Loufrani v. Harvey Ball Smile Limited
Opposition No. 91186510
Opposition No. 91186653

Dear Attorney Goodman,

Enclosed for filing in the above-referenced cases is a Notice of Appearance of Counsel and Consent to Consolidation and Suspension on behalf of Harvey Ball Smile Limited.

Sincerely,



Charles P. Ball
CPB/jeb

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02-11-2009

TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK AND APPEAL BOARD

Opposition No. 91186510
Opposition No. 91186653

Franklin Loufrani, Opposer,

v.

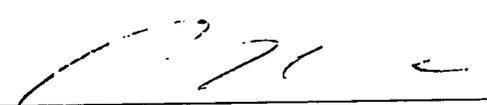
Harvey Ball Smile Limited, Applicant

Notice of Appearance of Counsel
And
Consent to Consolidation and Suspension

Now comes Attorney Charles P. Ball and files an appearance as attorney for the Applicant, Harvey Ball Smile Limited, in the above referenced cases, thereby replacing the current attorney(s) of record.

Further, Applicant hereby consents to consolidation and suspension of the above referenced cases.

Respectfully submitted,
Attorney for Applicant

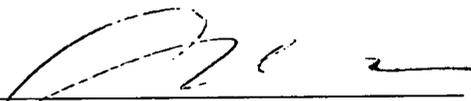


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CERTIFICATE OF SERVICE

I, Charles P. Ball, hereby certify that on the 9th day of February 2009, I served a copy of the foregoing Notice of Appearance and Consent to Consolidation and Suspension by first class mail, postage prepaid, upon:

Steven L. Baron, Esq.
Natalie A. Harris, Esq.
Mandell Menkes, LLC
333 W. Wacker Dr. Suite 300
Chicago, IL 60606



Charles P. Ball

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: January 22, 2009

Opposition No. 91186510

Franklin Loufrani

v.

Harvey Ball Smile Limited

Cheryl Goodman, Interlocutory Attorney:

On December 30, 2008, opposer filed a motion to consolidate this proceeding with Opposition no. 91186653 and to suspend, advising of consent by applicant's counsel.

While consolidation and suspension appear appropriate, it is unclear to the Board whether separate counsel for applicant in Opposition No. 91186653 consented to such motion and whether counsel was served.¹ Accordingly, opposer should provide proof of service on counsel for applicant in Opposition No. 91186653 within TWENTY DAYS of the mailing date of this order and file such with the Board. Additionally, opposer should advise whether applicant's

¹ The motion, which was filed in Opposition No. 91186510 (and related Opposition No. 91185409) reflects service on counsel Steven M. Rabin & M. Scott Alprin of Rabin & Berdo P.C. However, the motion does not reflect service on Martin Schwimmer, Law Office of Martin Schwimmer who is identified as counsel for applicant in Opposition No. 91186653. Counsel Schwimmer filed the answer in Opposition No. 91186653.

counsel in Opposition No. 91186653 consented to such consolidation and suspension.

As the parties are aware, the Board will not undertake double correspondence to two addresses for a single party. Accordingly, if these proceedings are to be consolidated, the Board requests that applicant's counsel appoint one lead counsel to whom the Board may send correspondence intended for the applicant. Lead counsel is not substituted for counsel in the other case, but is responsible for the conduct of the case as well as making and distributing copies of Board correspondence to other counsel. TBMP Section 117.02 (2d ed. rev. 2004).

In view thereof, applicant's counsel in Opposition No. 91186510 is allowed until TWENTY DAYS from the mailing date of this order to appoint lead counsel so that the Board may consolidate and suspend these proceedings.

ESTTA Tracking number: **ESTTA258054**

Filing date: **12/30/2008**

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

Proceeding	91185409
Party	Plaintiff Franklin Loufrani
Correspondence Address	Steven L. Baron Mandell Menkes LLC 333 West Wacker Drive, Suite 300 Chicago, IL 60606 UNITED STATES sbaron@mandellmenkes.com
Submission	Other Motions/Papers
Filer's Name	Natalie A. Harris
Filer's e-mail	nharris@mandellmenkes.com, sbaron@mandellmenkes.com, llavine@mandellmenkes.com
Signature	/NAH/
Date	12/30/2008
Attachments	Combined Motion to Consolidate and Suspend.pdf (5 pages)(332809 bytes)



("Harvey Ball Happy Face Mark 1")



HARVEY BALL

("Harvey Ball Happy Face Mark 2")

2. On September 17, 2008 and September 24, 2008, Loufrani filed Opposition Nos. '510 and '653, related to Harvey Ball's application serial nos. 79045616 and 77347604 for the following marks, respectively:



("Harvey Ball Eyes and Mouth Mark 1")



("Harvey Ball Eyes and Mouth Mark 2")

and

3. Loufrani's Opposition Nos. '409, '562, '510 and '653 (the "Oppositions") arise from Loufrani's various United States trademark registrations and applications involving the marks "SMILEY" and the happy face design in conjunction with a variety of goods and services.

4. In the Oppositions, Loufrani alleges that Harvey Ball's Happy Face Marks and Eyes and Mouth Marks so resemble Loufrani's "SMILEY" mark and other marks that contain "SMILEY" as an element that, when used on or in connection with Harvey Ball's intended goods, Harvey Ball's proposed marks are likely to cause confusion.

5. When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. See Fed. R. Civ. P. 42(a); see also, *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ 2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ 2d 1382 (TTAB 1991).

6. Opposition Nos. '409 and No. '562 ("Happy Face Oppositions") involve the same parties as well as common questions of law and fact and Opposition Nos. '510 and '653 ("Eyes and Mouth Oppositions") involve the same parties as well as common questions of law and fact. As a result, an order consolidating the Happy Face Oppositions into a single opposition and the Eyes and Mouth Oppositions into a single opposition is appropriate.

7. In addition, the parties are aware of a pending opposition, namely, Consolidated Opposition No. 91/150278 (comprising Opposition Nos. 91/ 150278, 91/154632 and 91/152145 and captioned *Wal-Mart Stores, Inc. v. Franklin Loufrani*) ("Wal-Mart Opposition") scheduled for oral argument before the Board on January 14, 2008.

8. The parties believe that the Board's ruling on the Wal-Mart Opposition may provide guidance and streamline the issues raised in the Happy Face Oppositions and the Eyes and Mouth Oppositions.

9. Therefore, for the sake of efficiency and in an effort to simplify the disputes at issue in the Happy Face Oppositions and the Eyes and Mouth Oppositions, Loufrani requests that the Board suspend Opposition Nos. '409 and '562 (following consolidation) and Opposition Nos. '510 and '653 (following consolidation), until the Board issues a final ruling in the Wal-Mart Opposition following the January 14, 2008 oral argument pursuant to TBMP 510.03(a) and 37 CFR § 2.117(c), with the opening of the discovery periods and remaining schedule for the Oppositions to be uniformly reset at the expiration of the suspension.

10. On December 10, 2008, counsel for Harvey Ball consented to the consolidation of all four Oppositions. Harvey Ball also agreed to suspension of the Oppositions pending the outcome of the Wal-Mart Opposition. However, as of the date of this filing, Harvey Ball has not responded to Loufrani's subsequent proposal to consolidate the Happy Face Oppositions into one consolidated opposition and the Eyes and Mouth Oppositions into a separate consolidated opposition.

WHEREFORE, Opposer Franklin Loufrani respectfully requests that the Board enter an order (1) consolidating Opposition Nos. 91/185409 and 91/186562; (2) consolidating Opposition

Nos. 91/186510 and 91/186653; and (3) suspending all four Oppositions (i.e. two consolidated oppositions) until the Board issues a final ruling in Consolidated Opposition No. 91/150278, with the opening of the discovery periods and remaining schedule for both newly consolidated oppositions to be uniformly reset at the expiration of the suspension.

Respectfully submitted,

Franklin Loufrani

By: Natalie A. Harris
One of his Attorneys

December 30, 2008

Steven L. Baron
Natalie A. Harris
Mandell Menkes LLC
333 W. Wacker Dr., Ste. 300
Chicago, IL 60606
Attorneys for Opposer
(312) 251-1000

CERTIFICATE OF SERVICE

I hereby certify that on this 30th day of December, 2008, I caused a copy of the foregoing *Combined Motion to Consolidate and Suspends* to be served, via first class mail and electronic mail upon:

Steven M. Rabin
M. Scott Alprin
Rabin & Berdo, P.C.
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Washington, D.C. 20005

Isao Takahashi
Harvey Ball Smile Limited
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By: Natalie A. Harris
Natalie A. Harris