

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Trademark Trial and Appeals Board

08/14/2003TAS
08/14/2003TAS

Opposition No. 150,278

Wal-Mart Stores, Inc.

v. Serial No. 75/977,376

~~Franklin Loufrani~~

Opposition No. 152,145

Franklin Loufrani

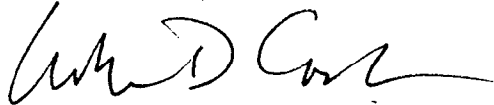
v. Serial No. 76/320,901

Wal-Mart Stores, Inc.

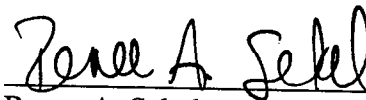
NOTICE OF APPEARANCE FOR WAL-MART STORES, INC.

Pursuant to 37 C.F.R. 10.1(c), William D. Coston and Renee A. Sekel hereby enter their appearances as counsel for Wal-Mart Stores, Inc. Mr. Coston is a member in good standing of the Bars of the United States District Courts in Maryland and the District of Columbia. Ms. Sekel is a member in good standing of the Bar of the United States District Court for the District of Maryland.

Respectfully submitted,



William D. Coston



Renee A. Sekel

VENABLE, BAETJER, HOWARD & CIVILETTI, LLP
1201 New York Ave., N.W., Suite 1000
Washington, DC 20005-3917
Phone: (202) 962-4800
Fax: (202) 962-8300

Dated: February 6, 2003

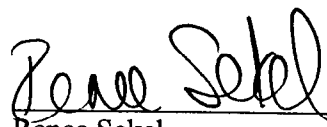
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CERTIFICATE OF SERVICE

I hereby certify that, on this 6th day of February, 2003, a true and accurate copy of the foregoing Notice of Appearance for Wal-Mart Stores, Inc., was sent, via regular mail, to:

Mary Catherine Merz, Esq.
Bruce Haraguchi, Esq.
MERZ & ASSOCIATES, P.C.
1140 Lake Street, Suite 304
Oak Park, IL 60301-1051



Renee Sekel

08/14/2003TAS
08/14/2003TAS

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Trademark Trial and Appeals Board**

Opposition No. 150,278

Wal-Mart Stores, Inc.

v. Serial No. 75/977,376

Franklin Loufrani

Opposition No. 152,145

Franklin Loufrani

v. Serial No. 76/320,901

Wal-Mart Stores, Inc.

**APPLICANT WAL-MART STORES, INC.'S ANSWER TO OPPOSER
FRANKLIN LOUFRANI'S NOTICE OF OPPOSITION
IN OPPOSITION NO. 152,145**

Applicant Wal-Mart Stores, Inc. ("Wal-Mart"), by and through its attorneys, hereby Answers Opposer Franklin Loufrani's Notice of Opposition ("Opposition") as follows:

As to the introductory paragraph of the Opposition, Wal-Mart is without knowledge or information sufficient to form a belief as to Mr. Loufrani's allegations of his principal place of business. Wal-Mart denies that Mr. Loufrani will be damaged by the registration of Wal-Mart's U.S. Trademark Application Serial No. 76/320,901.

1. Admitted.
2. Wal-Mart admits that it has sought to register a design it refers to as "Mr. Smiley" in Serial Number 76/320,901 for "retail department store services" in international class 35, and that notice of such application was published in the Official Gazette of March 5, 2002. Wal-Mart denies that its mark is called "Happy Face Design."

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3. Wal-Mart admits that Mr. Loufrani has filed an application, Serial No. 75/977,376 for the mark shown at Exhibit A to the Opposition, but Wal-Mart notes that the application disclaims all rights to the "design of a smiley face apart from the mark as shown" in Exhibit A to the Opposition.

4. Wal-Mart admits that the filing date of Mr. Loufrani's Intent-to-Use application, Serial No. 75/977,376 is earlier than that for Wal-Mart's application, Serial No. 75/977,376, but asserts that Wal-Mart's use in commerce of its "Mr. Smiley" design preceded Mr. Loufrani's Application.

5. Wal-Mart admits that through its retail department store services it offers or may offer many of the products and services listed in Mr. Loufrani's application, serial No. 75/977,376, but denies that Mr. Loufrani in fact offers in the United States any of the products listed in his application.

6. Wal-Mart admits, on information and belief, that on April 27, 2000 the Administrator for Trademark Classification and Practice sent a memorandum to a senior attorney concluding that Mr. Loufrani's application did not function as a mark for the reason stated in the memo. The memo did not comment on Wal-Mart's mark and, in fact, on March 5, 2002, the Patent and Trademark Office published for opposition the Wal-Mart mark that is the subject of this proceeding.

7. Wal-Mart admits that its "Mr. Smiley" design in Serial No. 76/320,901 is similar to that portion of Mr. Loufrani's application Serial No. 75/977,376 which was disclaimed. Wal-Mart affirmatively avers that its long and continued use of its design preceded Loufrani's application.

8. Denied.

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9. Admitted in part and denied in part. Wal-Mart admits that if its "Mr. Smiley" design is permitted to register on the Principal Register, Wal-Mart will be granted an exclusive right under the cited statutory provisions to use the design in connection with retail department store services. Wal-Mart denies that the design does not serve a trademark function under the Trademark Act section 1, 2 and 45, 15 U.S.C. sections 1051, 1052 and 1127.

10. Admitted in part and denied in part. Wal-Mart admits that if its "Mr. Smiley" design is permitted to register on the Principal Register, Wal-Mart will be able to rely on its registered rights, in addition to any other rights, in challenging or contesting Mr. Loufrani's use or registration of his Happy Face Design. Wal-Mart further denies that its "Mr. Smiley" design does not serve a trademark function under the Trademark Act section 1, 2 and 45, 15 U.S.C. sections 1051, 1052 and 1127.

11. Wal-Mart denies that Mr. Loufrani will be damaged by the registration of Wal-Mart's design in Serial No. 76, 320,901. Wal-Mart further denies that its mark is in the public domain and that the mark does not serve a trademark function under the Trademark Act section 1, 2 and 45, 15 U.S.C. sections 1051, 1052 and 1127. Wal-Mart admits that, if its design in Serial No. 76/320,901 is registered, it will be entitled to own and enforce its registered rights in its "Mr. Smiley" design.

As to the concluding paragraph of the Opposition, to the extent that a response is required, Wal-Mart denies that Mr. Loufrani is entitled to the relief he seeks.

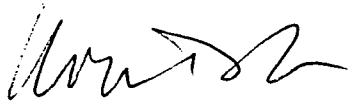
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AFFIRMATIVE DEFENSES TO THE NOTICE OF OPPOSITION

1. Mr. Loufrani is barred from the relief sought by the doctrine of unclean hands.
2. Mr. Loufrani is barred from the relief sought by the doctrine of estoppel.
3. Mr. Loufrani is barred from the relief sought by the doctrine of acquiescence.
4. Mr. Loufrani is barred from the relief sought by the doctrine of laches.

WHEREFORE, Applicant Wal-Mart Stores, Inc. hereby prays that Opposer Franklin Loufrani's Notice of Opposition be dismissed with prejudice.

Respectfully Submitted,



William D. Coston
Renee A. Sekel
Venable, Baetjer, Howard & Civiletti, L.L.P.
1201 New York Avenue, NW Suite 1000
Washington, DC 20005
(202) 962-4800

Attorneys for Applicant

February 6, 2003

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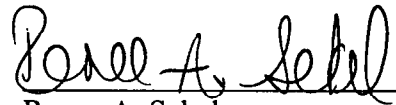
08/14/2003TTAB

CERTIFICATE OF SERVICE

The undersigned, attorney for Applicant, hereby certifies that he served, by first class mail, postage prepaid, a copy of the foregoing APPLICANT'S ANSWER upon

Mary Catherine Merz, Esq.
Bruce Haraguchi, Esq.
MERZ & ASSOCIATES, P.C.
1140 Lake Street, Suite 304
Oak Park, IL 60301-1051

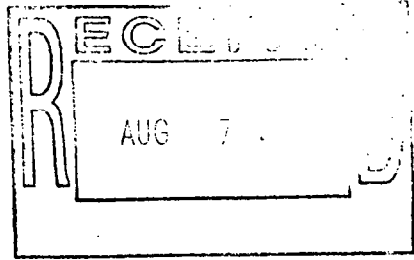
this 6th day of February 2003.


Renee A. Sekel

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08/14/2003TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: August 1, 2003

Opposition No. 91/150,278

Opposition No. 91/154,632

Wal-Mart Stores, Inc. ("Wal-Mart")

03 AUG -7 AM 9:07

03 AUG -7 AM 9:07

Pat Donegan
frani ("Loufrani")
202. 962-4895 o. 91/152,145
Question?

Wal-Mart

Andrew P. Baxley, Interlocutory Attorney:

OPPOSITION NO. 152,145: NOTICE OF DEFAULT

Wal-Mart's answer was due (as last reset) in Opposition No. 152,145 on February 10, 2003. Inasmuch as neither an answer in Opposition No. 152,145 nor a motion to extend time to answer in Opposition No. 152,145 of record in any of the above captioned proceeding files, notice of default is hereby entered against Wal-Mart under Fed. R. Civ. P. 55(a) in Opposition No. 152,145.

Wal-Mart is allowed until **thirty days** from the mailing date of this order to show cause why judgment by default

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Opposition Nos. 150,278, 152,145, and 154,632

should not be entered against it in Opposition No. 152,145 in accordance with Fed. R. Civ. P. 55(b).

CONSOLIDATION ORDERED

Loufrani's motion (filed March 24, 2003) to consolidate the above-referenced proceedings is hereby granted.¹ The Board hereby orders the consolidation of the above-referenced proceedings inasmuch as the parties are the same and the three proceedings involve common questions of law or fact.² In view thereof, Opposition Nos. 150,278, 152,145, and 154,632 are hereby consolidated.³

The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board filed will be maintained in Opposition No. 150,278 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear all three proceeding

¹ Although Loufrani refers to a motion to suspend that Wal-Mart filed in Opposition No. 154,632, no motion to suspend is of record in that proceeding.

² 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 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

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Opposition Nos. 150,278, 152,145, and 154,632

numbers in its caption. Exceptions to the general rule involve stipulated extensions of the discovery and trial dates, see Trademark Rule 2.121(d), and briefs on the case, see Trademark Rule 2.128.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

PROCEEDINGS SUSPENDED

The newly consolidated proceedings are **suspended** pending resolution of the notice of default in Opposition No. 152,145. Upon such resolution, the Board will issue an order resuming proceedings and resetting trial dates, including a brief time for discovery.⁴

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.

³ It is noted that the Board had already consolidated Opposition Nos. 150,278 and 152,145 in a January 8, 2003 order.

⁴ It is noted that discovery had not yet closed in Opposition No. 154,632, the most junior of the consolidated proceedings, and that, when resetting the discovery and trial schedule in an order consolidating proceedings, the Board generally adopts the schedule of the most junior of the consolidated proceedings.

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SVL11000C/7 1700

FILING RECEIPT NO. 110997

TO: SUPERINTENDENT AND
DIRECTOR, PATENT AND
TRADEMARK OFFICE
03 AUG -7 AM 9:07



(PTO Receipt Stamp Here)

Date: February 6, 2003

Due Date: February 7, 2003

Receipt for Documents Filed

In re Trademark Application of:

Wal-Mart Stores, Inc.

Serial No.: 76/320,901

Examining Attorney:

Mark:

Law Office:

Filed: March 5, 2002

DOCUMENTS FILED:

-
1. Notice of Appearance for Wal-Mart Stores, Inc.
 2. Answer to Opposer Franklin Loufrani's Notice of Opposition
-

CLIENT/MATTER NO.: 21188-174021

CLIENT NAME: WAL-MART STORES, INC.

ATTORNEY/SECRETARY: Renee A. Sekel/eba

*Venable, Baetjer, Howard & Civiletti, LLP
1201 New York Avenue, N.W., Suite 1000
Washington, D.C. 20005
Telephone No. (202) 962-4800 - Facsimile: (202) 962-8300*

DC2/433320

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OFFICES IN

WASHINGTON, D.C.
MARYLAND
VIRGINIA



February 6, 2003

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

BOX TTAB NO FEE

Re: U.S. Trademark Application Serial No. 76/320,901
Applicant: Wal-Mart Stores, Inc.
Mark:
Attorney Reference: 21188-174021

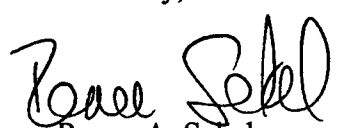
Dear Sir or Madam:

We enclose the following for filing:

- 1. Notice of Appearance for Wal-Mart Stores, Inc.; and
- 2. Answer to Opposer Franklin Loufrani's Notice of Opposition

Please charge any fees or credit any overpayments to Deposit Account No. 22-0261, and notify the undersigned.

Sincerely,


Renee A. Sekel

RAS/eba
Enclosures
DC2/433322