

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

In re Matter of U.S. Application Serial No. 75/302,439
Filed: June 3, 1997
Mark: "SMILEY and Happy Face Design"



Wal-Mart Stores, Inc.,)
)
Opposer)
)
v.)
)
Franklin Loufrani,)
)
Applicant.)

03-24-2003
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #01

Opposition No. 154,632

04 APR -1 AM 9:30
TRADEMARK TRIAL AND
APPEAL BOARD

**APPLICANT'S MEMORANDUM IN
OPPOSITION TO OPPOSER'S MOTION TO SUSPEND**

AND

APPLICANT'S MOTION TO CONSOLIDATE PROCEEDINGS

In the event that the Trademark Trial and Appeal Board ("the Board") construes Opposer Wal-Mart Stores, Inc. ("Wal-Mart") to have moved for a suspension of the above-referenced opposition proceeding pending the outcome of consolidated Opposition Number 150,278, applicant Franklin Loufrani ("Mr. Loufrani") hereby opposes any such Motion for Suspension. Furthermore, Mr. Loufrani hereby moves the Board to consolidate the above-referenced proceeding with consolidated Opposition No. 150,278.

In re Serial No. 75/302,439
Opposition No. 154,632

Procedural History

On February 20, 2003, Wal-Mart filed a Notice of Opposition against Mr. Loufrani's "SMILEY and Happy Face Design" Trademark Application Serial No. 75/302,439 for Classes 16, 25, 28, 29, 30, 41, and 42. In its Notice of Opposition, Wal-Mart correctly stated that (1) Mr. Loufrani also has filed to register "SMILEY and Happy Face Design" for Classes 3, 5, 8, 9, 14, 18, 21, 24, 31, 32, 33, 34, 35, 36, 38, and 39 under Trademark Application Serial No. 75/977,376; and (2) Wal-Mart has filed an opposition against that Trademark Application Serial No. 75/977,376, which is one of the two subject applications of consolidated Opposition No. 150,278. In its Notice of Opposition from February 20, 2003, Wal-Mart went on to submit that the proceeding against Trademark Application Serial No. 75/302,439 should be suspended pending the outcome of consolidated Opposition No. 150,278.

Argument

Suspension of a proceeding before the U.S. Trademark Trial and Appeal Board pending the outcome of another proceeding before the Board is discretionary with the Board. See 37 C.F.R. §2.117(a); see also TBMP §510.02(a). When cases involving common questions of law or fact are pending before the Board, the Board

In re Serial No. 75/302,439
Opposition No. 154,632

may order, upon its own initiative or by request of a party, the consolidation of the cases. See Fed. R. Civ. P. 42(a) and TBMP §511. In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. See TBMP §511.

The interests of judicial economy support consolidation of this proceeding with consolidated Opposition No. 150,278. The Board previously ordered on January 9, 2003, that the parties and the questions of fact and law in Opposition No. 150,278 and Opposition No. 152,145 were identical such that consolidation of those cases was warranted. Here, the parties are identical to the parties in consolidated Opposition No. 150,278. Moreover, this proceeding and consolidated Opposition No. 150,278 involve the same mark, Mr. Loufrani's "SMILEY and Happy Face Design" and Wal-Mart's "Happy Face Design." In addition, all proceedings involve common questions of law or fact, namely whether the "happy face design" is capable of functioning as a trademark or service mark.

Consolidation of these proceedings will avoid duplication of effort concerning the factual issues in common and will thereby avoid unnecessary costs and delays. By consolidating these proceedings, discovery from consolidated Opposition No. 150,278

In re Serial No. 75/302,439
Opposition No. 154,632

may be used in this proceeding. While the proceedings are at different procedural stages, any undue administrative burden on the parties can be mitigated by the Board's resetting of trial dates. Accordingly, in the interests of judicial economy, consolidation of these proceedings is necessary and proper.

Conclusion

Mr. Loufrani respectfully requests that the Board deny any motion Wal-Mart Stores, Inc. may have made to suspend this proceeding pending the outcome of consolidated Opposition No. 150,278. Furthermore, Mr. Loufrani moves that the Board consolidate this proceeding with consolidated Opposition No. 150,278.

Respectfully submitted,

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In re Serial No. 75/302,439
Opposition No. 154,632

CERTIFICATE OF MAILING BY EXPRESS MAIL

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Date of Deposit: March 24, 2003

I hereby certify that this correspondence is being deposited in triplicate with the United States Postal Service "Express Mail Post Office To Addressee" Service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, Box TTAB - NO FEE, 2900 Crystal Drive, Arlington, VIRGINIA 22202-3513

Mary Catherine Merz

(Typed or printed name of person mailing paper or fee)

Mary Catherine Merz

(Signature of person mailing paper or fee)

CERTIFICATE OF SERVICE

I hereby certify that a copy of this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to attorney for applicant as follows:

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Date: 3/24/03

TRADEMARKS

Attorney Docket No.: 21317
Date: March 24, 2003



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03-24-2003

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Transmitted for filing herewith is the:

- Trademark
- Service Mark
- Application
- Renewal Application
- Statement of Use
- Amendment to Allege Use
- Section 8 Declaration
- Combined Sections 8 & 15 Declaration
- Extension Request for More Time to File a Notice of Opposition
- Applicant's Memorandum in Opposition to Opposer's Motion to Suspend and Applicant's Motion Consolidate Proceedings

04 APR - 1 2003
TRADEMARKS
COMM. DIVISION

of Applicant: Franklin Loufrani

For: "SMILEY and Happy Face Design"(Opposition No. 154,632)

Also enclosed are:

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In the unlikely event that insufficient funds are submitted herewith to cover the filing fee in this Applicant's Memorandum in Opposition to Opposer's Motion to Suspend and Applicant's Motion to Consolidate Proceedings, please charge such funds against Deposit Account No. 50-0277.

Respectfully submitted,

By: Mary Catherine Merz

Enclosures

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