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CERTIFICATE OF MAILING
I hereby certify that this APPLICANT'S RESPONSE TO OPPOSER'S COMBINED MOTION FOR LEAVE TO FILE APPEARANCE AND RESPONSE TO ORDER TO SHOW CAUSE is being deposited with the United States Postal Service on this date in an envelope, first class mail postage fully prepaid, addressed to:

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Dated: October 10, 2006

Donn K. Harms

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

In the Matter of Application Serial No. 78/273402
For the mark: SMILEY TOOTH
Filing Date: July 11, 2003
Publication Date: July 6, 2004

FRANKLY LOUFRANI,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.: 91163013
	)	
B. MICHAEL PERLIN,	)	
	)	
Applicant.	)	
	)	

APPLICANT'S RESPONSE TO OPPOSER'S COMBINED MOTION FOR LEAVE TO FILE APPEARANCE AND RESPONSE TO ORDER TO SHOW CAUSE

I. INTRODUCTION

On July 11, 2003, Applicant, B. Michael Perlin, filed his application to register the mark, SMILEY TOOTH. The application was published for opposition on July 6, 2004.

On July 27, 2004, Opposer filed an extension of time to oppose Mr. Perlin's application. On November 3, 2004, Opposer filed a Notice of Opposition against the mark.

On June 6, 2005, the last day of the Discovery period as originally set, Opposer requested, without consent of Applicant, an extension of the discovery period citing Opposer's "location out of the country" as the reason for needing more time to coordinate discovery with Opposer's Attorney. The board, having failed to serve Opposer with the Counterclaim filed by Applicant, reset the discovery period to close on September 5, 2005.

Just prior to the extended close of discovery, Applicant's Attorney was contacted by Opposer's attorney about possible settlement. Believing, at that time, that Opposer was acting in good faith, Applicant agreed to a sixty day extension of the discovery period and the Stipulated Motion to Extend the Discovery period was filed extending the Discovery period to November 5, 2005.

On November 1, 2005, just prior to the close of the second extended discovery period, Opposer's Attorney filed a motion to withdraw as counsel and ninety day suspension of the proceedings

to allow for appointment of new counsel and to allegedly continue settlement negotiations. This motion resulted in a nearly seven month automatic suspension of proceedings.

On May 16, 2006, the board granted the motion to withdraw and suspended the proceedings for an additional three month period to allow for Opposer to appoint counsel resulting in Opposer having nearly ten months to appoint new counsel.

Although Opposer was provided with nearly ten months to appoint new counsel, and Opposer had already engaged the law firm of Menkes and Mendell to file a Notice of Opposition against another of Applicant's applications which Notice of Opposition was filed on July 17, 2006, Opposer failed to appoint counsel during the allotted period and an Order to Show Cause was issued by the board.

On September 18, 2006, Opposer filed and served on Applicant by United States Mail his Combined Motion for Leave to File Appearance and Response to Order to Show Cause stating Opposer required "slightly more time" to procure counsel and the failure to timely respond do so was "inadvertent."

Opposer in his response to the Order to Show Cause falls short of the standards for responding to the Order to Show Cause in that Opposer has failed to establish "goods cause" as to why default should not be entered in this matter.

II. REGISTRANT HAS NOT ESTABLISHED "GOOD CAUSE" AS TO WHY DEFAULT SHOULD NOT BE ENTERED.

Under Federal Rule of Civil Procedure 60(b) and TBMP § 509.01, a party will not be entitled to reopening of a time to take action, unless the party's failure to take action was due to excusable neglect. *Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2D 1582, 2585 (TTAB 1997). According to the Supreme Court, four factors are particularly relevant in determining whether a party's failure to act was due to excusable neglect. The factors are as follows:

(1) The danger of prejudice to the non movant;

(2) The length of delay and its potential impact on the judicial proceedings;

(3) The reason for the delay, including whether it was within the reasonable control of movant; and

(4) Whether movant acted in good faith.

HKG Industries Inc. v. Perma-Pipe, Inc., 49 U.S.P.Q.2d 1156, 1157 (TTAB 1998) (*quoting Pioneer Investment Serv. Co. v. Brusnwick Assoc. Ltd. Partnership*, 507 U.S. 380, 395 (1993)). All of these factors weigh against the granting of Opposer's Combined Motion for Leave to File Appearance and Response to Order to Show Cause.

A. The danger of prejudice to Applicant if the Opposer's Motion is granted is substantial.

Applicant will be extremely prejudiced if the Motion is granted. The numerous and lengthy delays to date have been wholly due to Opposer. In addition to failing to appoint new

counsel during the ten month period provided, it has been nearly two years since the Opposition commenced and Opposer has yet to complete any discovery.

The uncertainty of pending litigation and the numerous delays are a serious impediment to Applicant's ongoing business ventures.

Applicant has been using the mark SMILEY TOOTH for many years in the dental care industry as evidenced by Applicant's incontestable registration for the mark, SMILEY TOOTH, Registration Number 2137533. Applicant has come to known in the dental care market place as the source of goods under the mark. Applicant is unaware of any instances of actual confusion between Applicant's mark and the alleged mark of Opposer.

If the Opposer's Motion is granted, given the current trend, Applicant is unlikely to see resolution of the matter for several more years. Because of the above, Applicant would be extremely prejudiced by granting of Opposer's Motion.

B. The length of delay in this proceeding is significant and was wholly within Opposer's control.

Opposer was provided nearly ten months to appoint new counsel to represent him following the withdrawal of his previous counsel. Opposer failed to appoint counsel during this time and did not appoint counsel until an Order to Show Cause was issued by the Board.

Still further, during the nearly ten month period Opposer was provided to appoint new counsel, Opposer hired the counsel now trying to appear on his behalf to file a Notice of Opposition and represent him in a separate opposition against another of Applicant's marks.

Still further, despite the discovery period having been extended on three different occasions, Opposer has completed no discovery but has instead repeatedly requested extensions or filed documents which resulted in extensions, suspensions or other delays.

In addition to the above delays, the calculation of the length of the delay for purposes of evaluating this factor also must take in to account the additional delay arising from the time required for briefing and deciding the Combined Motion for Leave to File Appearance and Response to Order to Show Cause.

The cumulative impact of such delays in this proceeding, and on Board proceedings in general, is considerable. The Board and the parties clearly have an interest in minimizing the amount of the Board's time and resources that must be expended on matters such as contested motions that come before the Board solely as a result of "inadvertence." The Boards interest in deterring such practices strongly suggests that this factor weighs against a finding of excusable neglect in this case. *Pumpkin Ltd. v. the Seeds Corps*, 43 U.S.P.Q.2d 1582, 1587-1588 (TTAB 1997).

The length of the delay has been great and has resulted in the needless wasting of the Board's resources and time, as well as the resources and time of Applicant.

C. Opposer's reason for his failure to respond to the Motion to Dismiss is not excusable and was solely in Opposer's control.

Under the third factor, Opposer must provide a reason for his failure to act, including whether such failure was within his control. This third factor has been considered the most important factor in the excusable neglect analysis. *Id.*

In this case, Opposer's inadequate Combined Motion for Leave to File Appearance and Response to Order to Show Cause contains no information upon which the Board could find any reason for the delay, let alone any justification that would excuse Opposer's neglect. In fact, Opposer's Motion states only that Opposer's failure to timely appoint new counsel was "inadvertent" and due to "the press of business."

Opposer is under an obligation to diligently pursue the opposition. It would seem that any party before the Board faces "the press of business" and as such the reason for the delay does not reach the levels of excusable neglect, especially when one considers that Opposer was able to hire counsel to pursue separate opposition proceedings during the ten month period he had to appoint new counsel in this opposition.

Furthermore, as Opposer admits, its negligent failure to appoint new counsel during the time allotted was solely within the control of Opposer. Consequently, the third factor weighs heavily against a finding of excusable neglect. *See Pumpkin ltd. v. The Seeds Corps,* 43 U.S.P.Q.2d 1582, 1587-1588 (TTAB 1997).

D. Oposer has not acted in good faith.

Finally, under the fourth factor, the Board should consider whether Opposer has acted in good faith in this proceeding. Opposer cannot establish that he has done so.

Throughout the Opposition proceeding, Opposer has continually taken actions to the delay the proceeding. Opposer has requested at least two extensions of the Discovery period, each of these extension requess having been filed at the end of the applicable discovery period. Despite the discovery period having been extended on three separate occasions, Opposer has completed no discovery.

Similarly, despite being provided with ten months to appoint new counsel, it was not until the Board issued its Order to Show Cause that Opposer's Attorney filed a Motion to Appear as Counsel. Still further, although Opposer did not appoint new counsel in this opposition during the considerable amount of time allotted, he was able to hire the same counsel now attempting to appear to represent him in a separate opposition against Applicant.

Considering the numerous delays that have resulted from Opposer's actions, including Opposer's failure to timely appoint counsel and failure to complete any discovery, Opposer's assertion that he intends to "vigorously pursue" the Opposition seems disingenuous at best. Additionally, Opposer has made no attempt to address, let alone satisfy, its burden of showing excusable neglect. Opposer thus cannot establish that he has acted in good faith during the course of this opposition.

III. CONCLUSION

All four factors to be taken in account in determining excusable neglect weigh against such a finding in this case. Under Federal Rule of Civil Procedure 6(b) and TBMP § 509.01, Opposer therefor has not established that his failure to timely appoint new counsel was the result of excusable neglect. Accordingly, Opposer's Combined Motion for Leave to File Appearance and Response to Order to Show Cause should be denied.

Respectfully submitted,

Dated: October 10, 2006

DONN K. HARMS, Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S COMBINED MOTION FOR LEAVE TO FILE APPEARANCE AND RESPONSE TO ORDER TO SHOW CAUSE was served upon Opposer, Franklin Loufrani, by mailing the same, first-class mail, to:

Steven L. Baron
Natalie A. Harris
MANDELL MENKES LLC
333 West Wacker Drive, Suite 300
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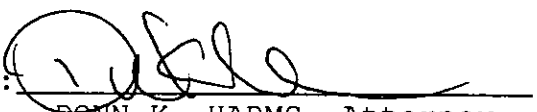
this 10th Day of October, 2006.

By: 
DONN K. HARMS, Attorney
for Applicant