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

Proceeding	91163013
Party	Plaintiff Franklin Loufrani Franklin Loufrani 114 Eaton Square London, SW1W 9AA UNITED KINGDOM
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Submission	Motion to Suspend for Settlement Discussions
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Attachments	Stipulation Motion to Consolidate and Suspend.pdf (4 pages)(170350 bytes)

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

FRANKLIN LOUFRANI,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91/163013
)	
B. MICHAEL PERLIN,)	
)	
Applicant.)	

**AGREED COMBINED MOTION TO CONSOLIDATE, SUSPEND AND,
RE-OPEN DISCOVERY PERIODS**

Applicant B. Michael Perlin (“Perlin”) and Opposer Franklin Loufrani (“Loufrani”), hereby move the Board to consolidate the instant proceeding (“No. ‘013”) and Opposition No. 91/171,270 (“No. ‘270”) pursuant to TMBP §511 and Fed. R. Civ. P. 42(a). Perlin and Loufrani further move the Board to suspend No. ‘013 and No. ‘270 for sixty days for the purposes of settlement negotiations pursuant to 37 CFR § 2.117(c). In the event that Perlin and Loufrani are unable to resolve No. ‘013 and No. ‘270 during the sixty day suspension, the parties move the Board to re-open the discovery periods in both proceedings as set forth below. In support of this combined motion, the parties state as follows:

1. On November 3, 2004, Loufrani filed opposition No. ‘013, related to Perlin’s application serial no. 78273402 for the mark “Smiley Tooth” (with “tooth” disclaimed) for dental floss in international class no. 21.

2. Loufrani’s opposition No. ‘013 arises from Loufrani’s various United States trademark registrations and applications involving the mark “SMILEY” in conjunction with a variety of goods and services.

3. Loufrani issued written discovery in opposition No. '013 on November 20, 2006, and Perlin's responses to the written discovery remain outstanding.

4. On June 7, 2006, Loufrani filed opposition No. '270 related to Perlin's application serial no. 78635440 for "SMILEY TOOTH" for a variety of clothing in international class no. 25.

5. Loufrani's opposition No. '270 also arises from Loufrani's various United States trademark registrations and applications involving the mark "SMILEY" in conjunction with a variety of goods and services.

6. In both oppositions No. '013 and No. '270, Loufrani alleges that Perlin's proposed mark "SMILEY TOOTH" so resembles Loufrani's "SMILEY" mark and other marks that contain "SMILEY" as an element that, when used on or in connection with Perlin's goods, Perlin's proposed mark is likely to cause confusion.

7. 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).

8. Oppositions No. '013 and No. '270 involve the same parties as well as common questions of law and fact. As a result, an order of consolidation is appropriate.

9. In addition, Perlin and Loufrani recently reinvigorated settlement negotiations in the hopes of resolving oppositions No. '013 and No. '270.

10. In an effort to foster negotiations and increase the possibility of settlement, Perlin and Loufrani request that the Board suspend oppositions No. '013 and No. '270 for 60 days, through March 12, 2007, for the purpose of settlement negotiations pursuant to 37 CFR § 2.117(c).

11. In the event that Perlin and Loufrani are unable to resolve oppositions No. '013 and No. '270 by March 12, 2007, the parties agree to re-open the discovery period for both oppositions for sixty days and to reset the remaining schedule as follows:

THE PERIOD FOR DISCOVERY TO CLOSE: **5/11/2007**

Thirty-day testimony period for plaintiff in the opposition to close: **8/9/2007**

Thirty-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close: **10/8/2007**

Thirty-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close: **12/7/2007**

Fifteen-day rebuttal testimony period for plaintiff in the counterclaim to close: **1/21/2008**

Briefs shall be due as follows:

Brief for plaintiff in the opposition shall be due: **3/21/2008**

Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due: **4/21/2008**

Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due: **5/20/2008**

Reply brief (if any) for plaintiff in the counterclaim shall be due: **6/4/2008**

Should the Trademark Trial and Appeal Board require adjustment of any of the above dates, the parties hereby mutually agree to such adjustment.


12. The order re-opening the discovery period for opposition No. '013 shall include a thirty day deadline, through including April 11, 2007, by which Perlin shall be required to respond to Loufrani's outstanding written discovery, without waiver of any right of objection or claim of privilege.

WHEREFORE, applicant B. Michael Perlin and Opposer Franklin Loufrani respectfully request that the Board enter an order (1) consolidating Opposition Nos. 91/163,013 and 91/171, 270 (2) suspending both proceedings for settlement negotiations

through and including March 12, 2007 and (3) re-opening the discovery periods as set forth above in the event that the parties are unable to resolve the subject oppositions by March 12, 2007.

Respectfully submitted,

Franklin Loufrani

By: 
One of his Attorneys

and

B. Michael Perlin

By: 
One of his Attorneys

January 15, 2007

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