UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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swf

October 20, 2025

Cancellation No. 92088852

Walmart Inc.

v.

Harvey Ball Smile Limited[1]

Steven W. Ferrell Jr., Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held a discovery conference in this proceeding on October 15, 2025. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 401.01 (2025).[2] A member of the Board participated in the conference. *See* Trademark Rule 2.120(a)(2)(i), 37 C.F.R. § 2.120(a)(2)(i). Participating were Robert O'Connell Jr. and Ashlie Smith, counsel for Petitioner Walmart Inc.; Masaru Sato, counsel for Respondent Harvey Ball Smile Limited; and Interlocutory Attorney Steven Ferrell on behalf of the Board.

[1] Respondent's September 16, 2025 change of correspondence address is noted, and the Board's records have been updated accordingly.

[2] The TBMP is available electronically at the following link: https://tbmp.uspto.gov/RDMS/TBMP/current#/current

This order memorializes what transpired during the conference. Conferences with the Board may not be recorded.

I. Settlement

The Board encouraged the parties to discuss settlement and advised that the Board does entertain, and is liberal in granting, motions to suspend proceedings for settlement discussions. The parties were cautioned, however, that the parties must be actively engaged in settlement discussions to obtain a suspension and that requests to suspend or extend may be denied where there has been protracted suspension or extension without substantial progress towards settlement. *See* TBMP § 605.02. Further, proceedings may only be suspended for settlement with the consent of both parties and either party may request resumption of the proceedings at any time. *Id.*

The parties are reminded that stipulations to suspend the proceeding for settlement negotiations should be filed promptly because, absent suspension, the Board presumes the parties are preparing for trial and adhering to the disclosure, discovery, and trial deadlines set by the Board. *Atlanta-Fulton Cnty. Zoo Inc. v. De Palma*, No. 91098819, 1998 TTAB LEXIS 9, at *6 (TTAB 1998) ("[I]t is well established that the mere existence of settlement negotiations alone does not justify a party's inaction or delay."). Again, it should also be noted that either party has the right to request resumption at any time prior to the expiration of a suspension period. *See* TBMP § 510.03(b).

II. Board's Jurisdiction

The Board is an administrative tribunal that is empowered solely to determine the right to register, and has no authority to determine the right to use a mark or any infringement or unfair competition issues. *See* TBMP § 102.01. The Board also does not possess injunctive powers to prohibit a party from using its mark, and cannot award monetary damages or attorneys' fees. *See Gen. Mills Inc. v. Fage Dairy Proc. Indus. SA*, No. 91118482, 2011 TTAB LEXIS 280, at *8 (TTAB 2011).

III. Related Proceedings

The parties stated that they are not involved in any other Board proceedings, civil actions, arbitrations, or other proceedings concerning issues related to the marks involved in the current proceeding. As set forth in the Board's institution order, the parties must notify the Board promptly in writing if they become parties to another Board proceeding or a civil action involving the same or related marks or issues of law or fact that overlap with this proceeding.

IV. Electronic Filing and Service of Papers

The parties were informed that each submission filed with the Board must be served on the opposing party electronically and that all filings with the Board must be made via ESTTA, the Board's online electronic filing system. If email service is not possible because of technical problems or extraordinary circumstances and there is no stipulation, the serving party must show by written explanation accompanying the submission or paper that email service was attempted but could not be made. In

addition, the failure to file motions and other submissions via ESTTA requires a showing of technical difficulty or an explanation of extraordinary circumstances.

"Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the title or nature of the submission being served, (2) the method of service (*i.e.*, electronic mail), (3) the person being served and the email address used to effect service, and (4) the date of service. This written statement should take the form of a "certificate of service" which should read as follows:

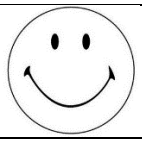
> The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon Petitioner/Respondent by forwarding said copy, via email to: [insert email address].

The certificate of service must be signed[3] and dated.

V. Pleadings

The Board conducted a review of the pleadings for purposes of the discovery conference.

Respondent is the record owner of the following registrations on the Principal Register (together, "Respondent's Registrations"):

Registration No.	Mark	Goods and Services
3700178[4]		International Class 25: Caps; Coats; Footwear; Gloves; Hats; Neckties; Pants; Pyjamas; Scarves; Shirts; Shorts; Skirts;

[3] An electronic signature comprises a forward slash, "*/*", placed before and after the typed name of the person actually signing the document. *See* Trademark Rule 2.193; *see also* TBMP §§ 106.02, 106.03.

[4] The underlying application was filed on November 9, 2008, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), and the registration issued on October 20, 2009, under Trademark Act Section 1(d), 15 U.S.C. § 1051(d), with a claimed date of first use anywhere and first use

		Socks and stockings; Sweaters; Swimsuits; T-shirts; Trousers; Underwear
3700179[5]		International Class 25: Caps; Coats; Footwear; Gloves; Hats; Neckties; Pants; Pyjamas; Scarves; Shirts; Shorts; Skirts; Socks and stockings; Sweaters; Swimsuits; T-shirts; Trousers; Underwear
3710258[6]		International Class 25: Caps; coats; footwear; gloves; hats; neckties; pants; pyjamas; scarves; shirts; shorts; skirts; socks and stockings; sweaters; swimsuits; T-shirts; trousers; underwear
3880715[7]	SMILEY FACE	International Class 14: Alarm clocks; Bracelets; Bracelets of precious metal; Brooches; Chronometers; Clocks; Cuff-links; Earrings; Figures of precious metal; Figurines of precious metal; Insignias of precious metal; Key holders of precious metals; Key rings of precious metal; Necklaces; Precious gemstones; Tie clips; Tie pins; Watch bands; Watches; Wrist watches International Class 16: A series of books and written articles in the field of culture, artistry, history, literature, languages and geography; Artists' pastels; Bookbindings; Drawing rulers; Envelopes; Exercise books; General purpose plastic bags; Gift cards; Glue for stationery or household use;

in commerce of February 27, 2009. Color is not claimed as a feature of the mark. The mark consists of a circular smiley face.

[5] The underlying application was filed on November 10, 2008, under Section 1(b), and the registration issued on October 20, 2009, under Section 1(d), with a claimed date of first use anywhere and first use in commerce of February 27, 2009. Color is not claimed as a feature of the mark. The mark consists of a circular smiley face.

[6] The underlying application was filed on November 9, 2008, under Section 1(b), and the registration issued on November 10, 2009, under Section 1(d), with a claimed date of first use anywhere and first use in commerce of February 27, 2009. Color is not claimed as a feature of the mark. The mark consists of a circular smiley face.

[7] The underlying application was filed on March 25, 2009, under Section 1(b), and the registration issued on November 23, 2010, under Section 1(d), with a claimed date of first use anywhere and first use in commerce of February 27, 2009. Color is not claimed as a feature of the mark. The mark consists of the stylized wording "SMILEY FACE".

		Journals concerning culture, artistry, history, literature, languages and geography; Magazines featuring culture, artistry, history, literature, languages and geography; Magnetic boards; Newspapers in the field of culture, artistry, history, literature, languages and geography; Office hole punchers; Paint brushes; Pamphlets in the field of culture, artistry, history, literature, languages and geography; Paper clips; Paper cutters; Paper fasteners; Paper ribbons; Paperweights; Pen cases; Pencil cases; Pencil sharpeners; Pencils; Pens; Photograph albums; Punches; Rubber erasers; Scratch pads; Writing paper International Class 18: Leather and imitation leather bags; Leather bags and wallets; Leather briefcases; Parasols; Traveling bags; Trunks; Umbrellas International Class 21: Bath sponges; Combs; Cups; Drinking glasses; Hair brushes; Pet brushes; Plates; Serving platters International Class 24: Bath linen; Bed linen and table linen; Canvas for tapestry or embroidery; Cloth labels; Curtain fabric; Curtains made of textile fabrics; Household linen; Textile fabrics for lingerie; Towels International Class 28: Action skill games; Children's multiple activity toys; Dolls; Play figures; Play houses; Stuffed toys International Class 30: Beverages made of coffee; Biscuits; Bread; Candy; Caramels; Chewing gum; Chocolate; Chocolate food beverages not being dairy-based or vegetable based; Cones for ice cream; Cookies; Crackers; Cream puffs; Doughnuts; Honey; Ice candies; Ice cream; Pancakes; Pasta; Pies; Sauces; Seasonings; Sherbet; Sponge cakes; Sugar; Wafers

4261640[8]		International Class 14: Alarm clocks; bracelets; bracelets of precious metal; brooches; chronometers; clocks; cuff-links; earrings; figures of precious metal; figurines of precious metal; insignias of precious metal; key holders of precious metals; key rings of precious metal; necklaces; precious gemstones; tie clips; tie pins; watch bands; watches; wrist watches International Class 20: Cushions; furniture, mirrors, picture frames; non-metal key rings; pillows International Class 21: Bath sponges; combs; cups; drinking glasses; hair brushes; pet brushes; plates; serving platters International Class 24: Bath linen; bed linen; bed linen and table linen; canvas for tapestry or embroidery; cloth labels; curtain fabric; curtains made of textile fabrics; household linen; textile fabrics for lingerie; towels International Class 25: Caps; footwear; hats; pants; shirts; shorts; skirts; T-shirts; underwear; visors International Class 28: Action skill games; children's multiple activity toys; dolls; parlor games; play figures; play houses; stuffed toys International Class 30: Beverages made of coffee; biscuits; bread; candy; caramels; chewing gum; chocolate; chocolate food beverages not being dairy-based or vegetable based; cones for ice cream; cookies; crackers; cream puffs; doughnuts; honey; ice candies; ice cream; pancakes; pasta; pies; sauces;

[8] The underlying application was filed on December 8, 2008, under Section 1(b), and the registration issued on December 18, 2012, under Section 1(d), with a claimed date of first use anywhere and first use in commerce of February 27, 2009. Color is not claimed as a feature of the mark. The mark consists of a circular smiley face.

		seasonings; sherbet; sponge cakes; sugar; wafers
4481363[9]		International Class 24: Bath linen; bed linen and table linen; canvas for tapestry or embroidery; cloth labels; curtain fabric; curtains made of textile fabrics; household linen; textile fabrics for lingerie; towels
4568462[10]		International Class 25: Caps; Coats; Footwear; Gloves; Hats; Neckties; Pajamas; Pants; Scarves; Shirts; Shorts; Skirts; Socks and stockings; Sweaters; Swimsuits; T-shirts; Trousers; Underwear

A. Petition for Cancellation

The Board explained that the petition for cancellation includes a claim of abandonment of each of Respondent's Registrations.[11] In support of its entitlement to a statutory cause of action and its claims, Petitioner claims ownership of common law rights in the marks  ,  , and  and ownership of application

[9] The underlying application was filed on January 23, 2010, under Section 1(b), and the registration issued on February 11, 2014, under Section 1(d), with a claimed date of first use anywhere and first use in commerce of February 27, 2009. Color is not claimed as a feature of the mark. The mark consists of a circular smiley face.

[10] The underlying application was filed on July 23, 2009, under Section 1(b), and the registration issued on July 15, 2014, under Section 1(d), with a claimed date of first use anywhere and first use in commerce of February 27, 2009. Color is not claimed as a feature of the mark. The mark consists of a circular smiley face.

[11] 1 TTABVUE. Citations to the Board record refer to TTABVUE, the Board's online docketing system. The number preceding "TTABVUE" corresponds to the docket entry number, and any number following "TTABVUE" refers to the page number of the docket entry where the cited materials appear.

The parties' future submissions, including trial briefs, motions, responses, and replies, should cite to the TTABVUE record created throughout the proceeding and during trial to facilitate the Board's review of the evidence throughout the proceeding and at final hearing. *See Made in Nature, LLC v. Pharmavite LLC*, No. 91223352, 2022 TTAB LEXIS 228, at *40-41 (TTAB 2022); TBMP § 801.03.

Serial Nos. 86857218[12] and 86857245[13] for the marks  and  , respectively, for use in connection with various retail store services featuring a wide variety of goods in International Class 35 and money transfer and financial transaction service in International Class 36.[14]

1. Entitlement and Likelihood of Confusion Sufficiently Pleaded

The Board also explained that Petitioner adequately pleaded its entitlement to a statutory cause of action based on, inter alia, its allegation that the United States Patent and Trademark Office ("USPTO") has refused registration of its marks because of Respondent's registrations.[15] S*ee Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 1274 (Fed. Cir. 2014) (plaintiff's application refused based on defendant's registrations); *Hole In 1 Drinks, Inc. v. Lajtay*, No. 92065860, 2020 TTAB LEXIS 9, at *11 (TTAB 2020) (evidence of record showing petitioner's pending application refused registration based on respondent's registration). Additionally, the Board explained that Petitioner's claim of abandonment is sufficiently pleaded. *See* 15 U.S.C. § 1127; *Lewis Silkin LLP v. Firebrand LLC*, No. 92067378, 2018 TTAB

[12] The application was filed on December 22, 2015, under Section 1(b). Color is not claimed as a feature of the mark. The mark consists of a circle with two eyes and a smiling shaped mouth.

[13] The application was filed on December 22, 2015, under Section 1(b). The colors yellow and black are claimed as a feature of the mark. The mark consists of a yellow circle outlined in black with two eyes and a smiling shaped mouth in black.

[14] 1 TTABVUE 7-10.

[15] *Id.* at 12.

LEXIS 436, at *8-20 (TTAB 2018); *ShutEmDown Sports Inc. v. Lacy*, No. 92049692, 2012 TTAB LEXIS 44, at *21-22 (TTAB 2012).

B. Answer

The Board explained Respondent filed a legally sufficient answer to the extent it denies the salient allegations in the petition for cancellation.[16] Furthermore, the Board explained that the allegations in Respondent's "General Defenses" are construed as amplifications of Respondent's denials of Petitioner's claim.[17] *See Topco Holdings, Inc. v. Hand 2 Hand Indus., LLC*, No. 91267988, 2022 TTAB LEXIS 3, at *13-14 (TTAB 2022). These defenses give Petitioner more complete notice of Respondent's position; accordingly, there is no prejudice to Petitioner if the allegations are allowed to remain. *See id.*; *Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, No. 91173806, 2009 TTAB LEXIS 445, at *3 (TTAB 2009) (applicant's "affirmative defenses" for the most part amplified its denials of opposer's allegations regarding likelihood of confusion); *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, No. 91093618, 1995 TTAB LEXIS 9, at *8 (TTAB 1995).

However, Respondent's reservation of the right to assert additional defenses[18] is improper under the Federal Rules of Civil Procedure, inasmuch as it does not give Petitioner fair notice of such defenses. *See Philanthropist.com, Inc. v. The Gen. Conf. Corp. of Seventh-Day Adventists*, No. 92065178, 2021 TTAB LEXIS 205, at *4-6 n.6

[16] *See* 4 TTABVUE.

[17] *See id.* at 3-5.

[18] *Id.* at 5.

(TTAB 2021). Whether Respondent may, at some future point, assert additional affirmative defenses would be resolved by way of a motion for leave to amend. *See* Fed. R. Civ. P. 15(a). Accordingly, this reservation is **stricken**.

VI. ACR

The Board next advised the parties of the option to utilize the Accelerated Case Resolution ("ACR") process.[19] While the parties did not stipulate to pursue ACR at this time, the parties may reserve the right to pursue ACR at a future date. The parties may contact the assigned Interlocutory Attorney by telephone if they have any further questions about ACR, or if they require assistance in crafting an ACR stipulation.[20]

VII. The Board's Standard Protective Order

The Board advised the parties of the automatic imposition of the Board's two-tiered standard protective order pursuant to Trademark Rule 2.116(g); the parties will control which tier of confidentiality applies. Because the Board's standard protective order is automatically imposed on this proceeding, the parties are precluded from objecting to any discovery on the ground of confidentiality.

[19] Additional information regarding ACR may be found on the Board's website at: https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/ttab-acr-options

[20] By way of example only, the parties may view ACR related stipulations and orders in the following cases: Opposition No. 91222612 (see no. 14); Opposition No. 91227798 (see no. 8); Opposition No. 91253886 (see nos. 22-23). The parties may also review *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015) (Opposition No. 91214266, nos. 5 and 21).

Also, under the Board's standard protective order, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. According to the terms of the Board's protective order, within thirty days following termination of a proceeding, the parties must return to each disclosing party the protected information disclosed during the proceeding, including any briefs, memoranda, summaries, and the like, that discuss or in any way refer to such information. Alternatively, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

It is unclear, however, whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007). Thus, it may be advisable for the parties to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract that will survive the proceeding; and that there may be a remedy at court for any breach of that contract that occurs after the conclusion of the Board proceeding.[21] Nonetheless, any determination of whether the agreement establishes contractual rights or is enforceable outside of the Board proceeding is for a court to decide should such matter come before it.

[21] While it may be advisable for the parties to sign a stipulated protective order, it is not necessary for the Board's protective order to take effect.

VIII. Discovery and Motion Practice

The Board apprised the parties of the general procedural rules and guidelines that govern inter partes proceedings, including the requirement that a party serve its initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) prior to serving discovery requests. *See* Trademark Rule 2.120(a)(3). The Board further instructed that the parties may not take discovery or file a motion for summary judgment until they have made their initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1).

Discoverable material includes electronically stored information and the parties are advised to identify any potential problems with the production of electronically stored information in advance. The parties are encouraged to consult TBMP § 414 when preparing and responding to discovery requests and to consult Chapter 400 for other questions concerning discovery.

The Board explained that if any party plans to file a motion to compel discovery, the moving party must demonstrate a good faith effort has been made to resolve the discovery dispute before filing its motion.[22] A motion to compel must be filed prior to the day of the deadline for pretrial disclosures for the first testimony period. The parties are advised to consult Chapter 500 of the TBMP for more information on motions practice before the Board.

The parties were further advised of the following matters concerning discovery: (1) all discovery requests must be served early enough in the discovery period so that

[22] The Board advised that parties that it expects the parties to cooperate with one another in the discovery process and looks with disfavor on those who do not so cooperate. *See* TBMP § 408.01.

responses will be due no later than the close of discovery;[23] and (2) interrogatories, requests for production of documents and things and requests for admission are limited to seventy-five, including subparts.[24]

IX. Initial Disclosures

Initial disclosures are governed under Fed. R. Civ. P. 26(a) and should include the following information:

> the name and, if known, the address and telephone number of each individual likely to have discoverable information—along with the subjects of that information—that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment [and] a copy—or a description by category and location—of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii). The parties **should not** file their respective initial disclosures with the Board.

X. Expert Witness Disclosures

To the extent either party retains an expert witness, such party must make their expert witness disclosure by the set deadline, as well as provide the Board with notification that the party will be employing an expert. Depending upon when such notification is made with the Board, the Board, in its discretion, may suspend proceedings for the sole purpose of allowing the parties to take discovery of a designated expert witness.

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[23] Trademark Rule 2.120(a)(3).

[24] Trademark Rules 2.120(d), (e) and (i).

XI. Pretrial Disclosures

Pretrial disclosures are governed by Fed. R. Civ. P. 26(a)(3) with one exception: the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as provided by Fed. R. Civ. P. 26(a)(3)(A)(iii). Disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses.

In making its pretrial disclosures, the party must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises. The party must disclose general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things that may be introduced as exhibits during the testimony of the witness.

Pretrial disclosure of a witness under Trademark Rule 2.121(e), however, does not substitute for issuance of a proper notice of examination under Trademark Rules 2.123(c) and 2.124(b). Further, if a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure.

For further information regarding pretrial disclosures, the parties should consult TBMP § 702.01.

XII. Testimony

The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony or trial periods and written transcripts thereof, together with any exhibits thereto, are then filed with the Board. The parties may elect to submit testimony via affidavit or declaration, subject to a right by the other side to cross-examine the witness. Trademark Rule 2.123.

XIII. Trial

The parties are advised to consult Chapter 700 of the TBMP for information on trial procedure and the proper introduction of evidence. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules. *See* Trademark Rules 2.122 and 2.123. The parties may utilize stipulations of fact and evidence to realize cost and procedural efficiencies. Finally, an oral hearing is set only upon request as provided by Trademark Rule. 2.129.

XIV. Schedule

This proceeding is **resumed**. The remaining dates are **reset** as follows:

Discovery Opens	**10/20/2025**
Initial Disclosures Due	**11/19/2025**
Expert Disclosures Due	**3/19/2026**
Discovery Closes	**4/18/2026**
Plaintiff's Pretrial Disclosures Due	**6/2/2026**
Plaintiff's 30-day Trial Period Ends	**7/17/2026**
Defendant's Pretrial Disclosures Due	**8/1/2026**
Defendant's 30-day Trial Period Ends	**9/15/2026**

Plaintiff's Rebuttal Disclosures Due	**9/30/2026**
Plaintiff's 15-day Rebuttal Period Ends	**10/30/2026**
Plaintiff's Opening Brief Due	**12/29/2026**
Defendant's Brief Due	**1/28/2027**
Plaintiff's Reply Brief Due	**2/12/2027**
Request for Oral Hearing (optional) Due	**2/22/2027**

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. Note: Parties are strongly encouraged to check the entire document before filing.[25] The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the ESTTA help webpage.

[25] To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.