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

Proceeding	91150278
Party	Defendant Franklin Loufrani
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Date	12/31/2008
Attachments	Notice of Related Subsequent Decision.pdf (3 pages)(45588 bytes) Smith v. Wal-Mart Stores, Inc. 537 F. Supp. 2d 1302.pdf (33 pages)(6025686 bytes) Smith v. Walmart Counterclaim.pdf (45 pages)(325504 bytes) Wal-Mart Brief In Support Of Summary Judgment.pdf (44 pages)(366310 bytes)

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

_____)	
WAL-MART STORES, INC.)	
)	
Opposer.)	OPPOSITION NO. 91/150,278
)	OPPOSITION NO. 91/154,632
v.)	
)	
FRANKLIN LOUFRANI)	Trademark:
)	SMILEY & Design Serial No. 75/302,439
Applicant.)	SMILEY & Design Serial No. 75/977,376
_____)	
FRANKLIN LOUFRANI)	
)	
Opposer.)	OPPOSITION NO. 91/152,145
)	
v.)	
)	
WAL-MART STORES, INC.)	Trademark:
)	Smiley Design Serial No. 76/320,901
Applicant.)	
_____)	

NOTICE OF RELATED SUBSEQUENT DECISION

Franklin Loufrani, by and through his attorneys Steven L. Baron and Natalie A. Harris of Mandell Menkes LLC, hereby provide notice to the Trademark Trial and Appeal Board of the related subsequent decision captioned *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Georgia 2008), a copy of which is attached hereto as Exhibit A. Related materials, including counter-claimant Wal-Mart Stores, Inc.'s Counterclaim and Brief In Support of Motion for Summary Judgment are attached as Exhibits B and C, respectfully.

Respectfully submitted,

FRANKLIN LOUFRANI

By: /s/ Natalie A. Harris

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CERTIFICATE OF SERVICE

The undersigned, an attorney, hereby certifies that I caused this *Notice of Related Subsequent Decision* to be served on:

Mr. Gary J. Rinkerman
Drinker Biddle
1500 K Street, N.W.
Washington, DC 20005-1209

via First Class Mail, postage prepaid and properly addressed and placed in the mail chute at 333 West Wacker Drive, Chicago, Illinois 60606 before the hour of 5:00 p.m. on Tuesday, December 31, 2008.

/s/ Natalie A. Harris
Natalie A. Harris

H
 United States District Court, N.D. Georgia, Atlanta Division.
 Charles SMITH, Plaintiff,
 v.
 WAL-MART STORES, INC., Defendant.
 Civil Action No. 1:06-cv-526-TCB.

March 20, 2008.


Background: Internet website owner brought action against retailer seeking declaratory judgment that his domain names and website merchandise, analogizing retailer to Nazis and al Qaeda, were lawful. Retailer counter-claimed asserting various federal trademark claims and related state law claims. Owner brought motion for summary judgment.

Holdings: The District Court, Timothy C. Batten, Sr., J., held that:

- (1) retailer did not establish that smiley face icon had acquired secondary meaning or that it otherwise was protectible trademark;
- (2) retailer's trademarks "WALMART," "WAL-MART," and "WAL MART" and its word mark "ALWAYS LOW PRICES. ALWAYS" likely would not be confused with "WALOCAUST," "WAL-QAEDA," "FREEDOM HATER MART," or "BENTON VILLEBULLIES ALWAYS" concepts;
- (3) owner successfully parodied trademarks of retailer;
- (4) survey conducted for retailer that had overinclusive universe and did not approximate real-world marketplace conditions in its design was of dubious value as proof of consumer confusion;
- (5) extensive experience of owner's expert in studying Internet user behavior and designing social science surveys qualified him to provide reliable testimony regarding Internet-related deficiencies in survey methodology of retailer's expert;
- (6) appropriate universe was consumers most likely to purchase owner's parodying merchandise;
- (7) survey universe was overbroad that included purchasers that did not have any potential to purchase owner's products; and
- (8) successful parodic work using Walocaust and Wal-Qaeda concepts promoted through designs that were sold to public on t-shirts and other novelty merchandise was noncommercial speech.

Motion granted.

West Headnotes

[1] Trademarks 382T  1136(2)

382T Trademarks

382TIV Creation and Priority of Rights


382Tk1132 Use of Mark

382Tk1136 Nature and Extent of Use

382Tk1136(2) k. Particular Cases. Most

Cited Cases

Internet website owner's use of smiley face to evoke retailer in minds of consumers through parody did not establish by itself that smiley face was defensible trademark or that owner had trademark rights in it, although parody usually uses strong mark to evoke particular image in minds of viewers.

[2] Trademarks 382T  1030

382T Trademarks


382TII Marks Protected

382Tk1029 Capacity to Distinguish or Signify;

Distinctiveness

382Tk1030 k. In General. Most Cited Cases

Trademark protection is available under the Lanham Act only to distinctive marks, which are those that serve to identify the source of goods or services. Lanham Trade-Mark Act, § 32(1), 15 U.S.C.A. § 1114(1).

[3] Trademarks 382T  1032

382T Trademarks

382TII Marks Protected

382Tk1029 Capacity to Distinguish or Signify;

Distinctiveness

382Tk1032 k. Acquired Distinctiveness and

Secondary Meaning in General. Most Cited Cases

Under the Lanham Act, a mark that is not inherently distinctive may acquire distinctiveness or secondary meaning by becoming associated in the minds of the public with the products or services offered by the proprietor of the mark. Lanham Trade-Mark Act, § 32(1), 15 U.S.C.A. § 1114(1).

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