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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Kuhlke

Mailed: March 4, 2003

Opposition No. 150,173  
Cancellation Nos. 40,569  
40,794

Saint-Gobain Abrasives,  
Inc.

v.

Unova Industrial  
Automation Systems, Inc.

Before Simms, Seeherman and Rogers, Administrative Trademark  
Judges.

By the Board:

These above-listed proceedings now come up for  
consideration of several motions.<sup>1</sup> The motions have been  
fully briefed.<sup>2</sup>

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<sup>1</sup> Defendant's motion to dismiss filed in Cancellation No. 40,569 on June 21, 2002; plaintiff's cross-motion to "dismiss" defendant's affirmative defenses filed in Cancellation No. 40,569 on July 17, 2002; defendant's motion for judgment on the pleadings filed in Opposition No. 150,173 on June 21, 2002; plaintiff's cross-motion for partial judgment on the pleadings filed in 150,173 on July 17, 2002; defendant's motion to dismiss filed in Cancellation No. 40,794 on September 3, 2002; and plaintiff's cross-motion to "dismiss" defendant's affirmative defenses filed in Cancellation No. 40,794 on September 18, 2002.

<sup>2</sup> Plaintiff's consented motion (filed on July 10, 2002 in Opposition No. 150,173) to extend time to respond to defendant's motion to dismiss is approved.

Defendant has moved for dismissal or, in the alternative, for judgment based on: (1) plaintiff's failure to state a claim; (2) the prior registration defense commonly referred to as the *Morehouse* defense;<sup>3</sup> and (3) the equitable defenses of laches and acquiescence. Defendant's motions are essentially combined motions to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6) and motions for judgment on the defenses of laches and acquiescence. Plaintiff responded with cross-motions to "dismiss [defendant's] affirmative defenses" in all three cases.

With regard to plaintiff's cross-motions, generally these motions would be construed as motions to strike defendant's affirmative defenses; however, in these cases, defendant has not pleaded these affirmative defenses.<sup>4</sup> Plaintiff's cross-motions are, therefore, in the nature of preemptive strikes. Normally, we would not consider matter that had not been pleaded; however, in order to avoid future motion practice and to provide clarification on these issues we will address the applicability of the affirmative defenses now.

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<sup>3</sup> *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

<sup>4</sup> An answer has only been filed in Opposition No. 150,173 and these defenses were not pleaded in that case.

Background

Plaintiff filed its notice of opposition on September 4, 2001 and its petitions for cancellation on May 2, 2002 and June 10, 2002. The mark in the subject application in Opposition No. 150,173 is described as "a yellow color stripe or band applied to the peripheries of the goods adjacent the rear face thereof and which is of less width than the thickness of the wheel or disks" for goods identified as power-operated abrasive wheels and abrasive disks.<sup>5</sup> The mark in the subject registration in Cancellation No. 40,569 is described as "a blue stripe or band applied to the peripheries of the goods adjacent the rear face thereof and which is of less width than the thickness of the wheel or disks" for goods identified as power-operated abrasive wheels and disks.<sup>6</sup> The mark in the subject registration in Cancellation No. 40,794 is described as "a stripe or band which is applied to the peripheries of the abrasive wheels or disks adjacent to the rear faces thereof and which is of less width than the thickness of the

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<sup>5</sup> Application Serial No. 75/670,483 claiming acquired distinctiveness under Section 2(f) of the Trademark Act, claiming the color yellow as a feature of the mark, and claiming a first use date of March 1932.

<sup>6</sup> Registration No. 2,516,176 issued on December 11, 2001 under Section 2(f) of the Trademark Act claiming the color blue as a feature of the mark and claiming a first use date of January 1932.

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wheels or disks" for goods identified as abrasive wheels or disks.<sup>7</sup>

In all three proceedings, plaintiff alleges that: (1) plaintiff has been manufacturing and distributing power operated abrasive wheels and disks for many years; (2) plaintiff uses stripes and bands of various colors including the colors yellow and blue; and (3) in the abrasives industry colors of stripes across an abrasive wheel designate speed.

In Cancellation No. 40,794, plaintiff further alleges that: (1) in the abrasives industry, stripes and bands of various colors applied on wheels and disks function to indicate abrasive grit size and/or application and to know when a product should be used or replaced; (2) applicant's mark is functional; (3) stripes and bands of various colors have been used in a commercially significant manner by plaintiff and others in the industry on abrasive wheels and abrasive disks to indicate function, application and wear; and (4) defendant's registration covers more than one mark because it covers all colors of stripes.

In Opposition No. 150,173, plaintiff further alleges that: (1) in the abrasives industry, colors used on and in connection with products function as an indicator of

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<sup>7</sup> Registration No. 378,705 issued on June 18, 1940, last renewed on February 16, 2001, and claiming a first use date of February 1931.

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abrasive grit size and/or application and to know when a product should be replaced; (2) defendant's mark is not distinctive under Section 2(f) of the Trademark Act; (3) the color yellow has been used in a commercially significant manner by plaintiff and others in the industry in connection with abrasive wheels and abrasive disks; (4) defendant's mark is not distinctive because defendant uses a variety of "colors of stripes" on abrasive wheels and abrasive disks and each color, including the yellow stripe, serves a functional purpose; and (5) defendant's application covers more than one mark because the application fails to include a clear and specific description of the shade of color of the alleged mark.

In Cancellation No. 40,569, plaintiff further alleges that: (1) in the abrasives industry, colors used on and in connection with products such as wheels and disks function as an indicator of abrasive grit size and/or application; (2) in the abrasives industry colors used on and in connection with products function to assist operators to know when a product should be replaced; (3) defendant's mark is not distinctive of its goods under Section 2(f); (4) the color blue has been used in a commercially significant manner by plaintiff and others in the industry in connection with abrasive wheels and abrasive disks; (5) defendant uses a variety of "colors of stripes," including a blue stripe,

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on abrasive wheels and abrasive disks, and each of such colors serves a functional purpose; and (6) defendant's registration covers more than one mark because it fails to include a clear and specific description of the shade of color of the alleged mark.

In the answer filed in connection with Opposition No. 150,173, defendant has denied the salient allegations. Motions to dismiss were filed in Cancellation Nos. 40,569 and 40,794 in lieu of answers.

Failure to State a Claim

We first address the sufficiency of the complaints under Fed. R. Civ. P. 12(b)(6) (Cancellation Nos. 40,569 and 40,794) and 12(c) (Opposition No. 150,173). After a careful review of the pleadings and taking into account the parties' arguments, we find that plaintiff has set forth sufficient allegations to support the claim of functionality in all three proceedings and the claim of lack of acquired distinctiveness in Opposition No. 150,173 and Cancellation No. 40,569. However, with regard to plaintiff's purported claims that the descriptions of marks in the application and registrations are indefinite and therefore cover more than one mark (hereafter "indefiniteness" claim) set forth respectively, in paragraph nos. 10 (Cancellation No. 40,794), 11 (Opposition No. 150,173), and 12 (Cancellation No. 40,569), we find that they are insufficient.

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To state a proper claim, plaintiff must allege facts in its pleading which, if proved, establish that (1) it has standing to challenge the application or registration, and (2) a valid ground preventing or cancelling a registration exists. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). For purposes of the motion to dismiss, all well-pleaded allegations of the nonmoving party must be accepted as true. See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992). In reviewing a complaint, the Board construes the allegations therein liberally, as required by Fed. R. Civ. P. 8(f). See TBMP 503.02.

In order to properly plead its standing, plaintiff need only allege that it has a real interest in the outcome of the proceeding. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Here, plaintiff has alleged the interest necessary to bring these proceedings by asserting its competitive uses of stripes and bands in various colors including the colors yellow and blue on abrasive wheels and disks. See *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1089, 1094 (TTAB 2001).

Further, accepting all well-pleaded allegations in the pleadings as true, plaintiff has sufficiently set forth claims of functionality and lack of acquired distinctiveness in Opposition No. 150,173 and Cancellation No. 40,569, and a

claim of functionality in Cancellation No. 40,794.<sup>8</sup> See TBMP § 312.03.

With regard to the functionality claims, Section 2(e)(5) of the Trademark Act bars registration of matter that is functional and functionality is listed as a ground for cancellation at any time under Section 14(3) of the Trademark Act. 15 U.S.C. Sections 1052(e)(5) and 1064(3). Defendant's central argument in its motions for judgment is that plaintiff did not direct its allegations to defendant's marks as a whole, i.e., to "the band shape, orientation, or position, or size." However, plaintiff's allegations, liberally construed, are deemed to refer to the entirety of defendant's marks. The absence of a specific allegation that plaintiff and others use bands in the specific position, orientation and size of defendant's marks does not render the pleading insufficient. Moreover, the functionality of color alone may render a mark unregistrable. See *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), cert. denied, 514 U.S. 1050 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985); *Kasco Corp. v.*

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<sup>8</sup> We note that contrary to plaintiff's statements in its brief in Cancellation No. 40,794, plaintiff did not assert a claim of lack of acquired distinctiveness against Registration No. 378,705, nor could it have inasmuch as the registration is more than five years old. See Section 14(3) of the Trademark Act, 15 U.S.C. Section 1064(3).

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*Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993). Much of defendant's argument focuses on the merits of the cases rather than the legal sufficiency of the complaints, which is all that is now in issue; questions of fact must be dealt with at trial, not at the pleading stage.

With regard to the claims of lack of acquired distinctiveness in Opposition No. 150,173 and Cancellation No. 40,569, the allegations are sufficient. Indeed, the subject application and registration were applied for under Section 2(f) of the Trademark Act which serves, at least for procedural purposes, as a concession that matter is not inherently distinctive. TMEP Section 1212.02(b). *See also, Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact.")

Regarding the allegations of "indefiniteness," opposer asserted that, because the descriptions of the marks in the respective application and registrations do not specify the exact shade of yellow or blue, or any color, the application and registrations are for more than one mark. These allegations address an ex parte examination issue, namely, whether the description of the mark is adequate, and fail to state a proper ground for an inter partes proceeding. *See*

*Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057 (TTAB 2000) (failure to enforce requirement of filing of foreign registration is examination error and not a ground for opposition); *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the issue of the adequacy of the specimens is solely a matter of ex parte examination). Fairness dictates that the ex parte question of the sufficiency of the description of the mark not be a ground for opposition or cancellation. Defendant complied with all examination requirements.<sup>9</sup> Had the Examining Attorney objected to the description during examination, defendant would have had an opportunity to submit an acceptable description of the mark. See *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989). It would be manifestly unfair to penalize defendant for non-compliance with a requirement that was never made by the Examining Attorney. *Id.*

Moreover, with regard to the claim of "indefiniteness" in Cancellation No. 40,794, plaintiff is barred from asserting this purported claim. It is undisputed that defendant's Registration No. 378,705 had been registered more than five years prior to the filing of the petition.

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<sup>9</sup> We note that there is no requirement set forth in the Trademark Manual of Examining Procedure to specify the exact shade of a color claimed as a mark, or feature thereof. See TMEP Section 1202.05(e).

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Under Section 14 of the Trademark Act, the grounds that may be asserted against a registration that has been registered more than five years are limited and do not include indefiniteness. See 15 U.S.C. Section 1064(3).

In view thereof, defendant's motions to dismiss and for judgment based on a failure to state a claim are granted only to the extent that paragraph no. 10 in Cancellation No. 40,794, paragraph no. 11 in Opposition No. 150,173, and paragraph no. 12 in Cancellation No. 40,569 are hereby stricken.

Cross-Motions on the Defenses of Laches and Acquiescence

We turn now to the question of the applicability of the affirmative defenses of laches and acquiescence. As a preliminary matter, we note that the *Morehouse* defense is unavailable to defendant inasmuch as plaintiff has petitioned to cancel the registration upon which defendant was relying. See *Estate of Ladislao Jose Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In view thereof, the *Morehouse* defense will not be further considered.

Defendant essentially argues that under the doctrines of laches and acquiescence plaintiff is barred from attacking defendant's marks due to its inexcusable delay in bringing an action against these marks. In support of its motions in Opposition No. 150,173 and Cancellation No. 40,569, defendant has submitted copies of expired

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registrations issued to a registrant identified as Gardener Machine Company. Defendant states that the Gardener Machine Company is a predecessor in interest and argues that the marks and goods in these expired registrations are the same as those in the application and registration that are the subjects of Opposition No. 150,173 and Cancellation No. 40,569.

It is well established that the equitable defenses of laches and acquiescence are not available against claims of genericness, descriptiveness, fraud, and abandonment. *Yankee, Inc. v. Geiger*, 216 USPQ 996 (TTAB 1982) (genericness); *Care Corp. v. Nursecare International, Inc.*, 216 USPQ 993 (TTAB 1982) (descriptiveness); *Bausch & Lomb, Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497, 1499 (TTAB 1986) (fraud); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311 (TTAB 1989) (abandonment). The oft-stated rationale for this principle is that it is within the public interest to have certain registrations stricken from the register and that this interest or concern cannot be waived by the inaction of any single person or concern no matter how long the delay persists. *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 USPQ 313, 316 (TTAB 1965), *aff'd*, 377 F.2d 1001, 153 USPQ 749 (CCPA 1967). *See also, Yankee, Inc. v. Geiger, supra*. The rationale, itself, embodies equitable concerns, that is, to remove from the register matter that

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should be available to all, marks no longer in use, or marks that were registered by means of fraud on the Office. For the same reason, we hold that where the proposed ground for opposition and cancellation is functionality, the defenses of laches and acquiescence are unavailable.

With regard to the claims of lack of acquired distinctiveness in Opposition No. 150,173 and Cancellation No. 40,569, we decline at this juncture to determine whether the defense of laches and/or acquiescence would be available. First, as noted above, these defenses have not been pleaded. Second, the parties have not briefed the specific issue of whether laches and/or acquiescence would apply against a claim of lack of distinctiveness in general and, in particular, under the facts of this case. It should be noted that, although laches generally is not applicable in an opposition proceeding, *National Cable Television Assn, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1431 (Fed. Cir. 1991), in a circumstance where there is a prior expired registration for the same or substantially similar mark and goods and the claim is likelihood of confusion, the Board has applied the defense of laches, based upon an opposer's failure to object to an applicant's earlier registration that inadvertently expired. *Aquion Partners L.P. v. Envirogard Products Ltd.*, 43 USPQ2d 1371 (TTAB 1997).

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In view of the above, defendant's motions for judgment on the defenses of laches and acquiescence are denied and plaintiff's cross-motions to preemptively strike these defenses are granted to the extent that defendant is barred from raising the defenses of laches and acquiescence against the functionality claims.

Summary

In summary, the claims remaining in plaintiff's pleadings are: functionality in Cancellation No. 40,794; functionality and lack of acquired distinctiveness in Opposition No. 150,173; and functionality and lack of acquired distinctiveness in Cancellation No. 40,569.

Defendant may not raise the *Morehouse* defense at all, nor may defendant raise the defenses of laches and acquiescence against the functionality claims. In the event defendant intends to raise the laches or acquiescence defenses against the claims of lack of acquired distinctiveness in Opposition No. 150,173 or Cancellation No. 40,569, defendant must act to plead those defenses.

Consolidation

It is noted that Opposition No. 150,173 and Cancellation Nos. 40,569 and 40,794 involve the same parties and common questions of law and fact.

Accordingly, Opposition No. 150,173 and Cancellation Nos. 40,569 and 40,794 are hereby consolidated and may be

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presented on the same record and briefs.<sup>10</sup> *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991). The Board file will be maintained in Opposition No. 150,173 as the "parent" case, but all papers filed herein must include the proceeding numbers of the consolidated cases, as set forth above.

Suspension

These consolidated proceedings remain suspended pending decision on the motion to compel filed in Opposition No. 150,173. Upon resumption, defendant will be allowed time in which to file answers in Cancellation Nos. 40,569 and 40794 and to file an amended answer, if desired, for the sole purpose of adding the laches and/or acquiescence defense against the lack of acquired distinctiveness claim in Opposition No. 150,173.

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<sup>10</sup> In view of the consolidation of the above-identified proceedings, the parties should no longer file separate papers in connection with each proceeding, except for the answers.