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

Saint-Gobain Corporation, Petitioner/Plaintiff, v. UNOVA Industrial Automation Systems, Inc. Registrant/Defendant.	Box TTAB Opposition No. 150,173 Cancellation No. 40,794 Cancellation No. 40,569 **ANSWER**

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Kristina Pijanowski
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In response to the Petition for Cancellation No. 92/040,569 issued by the Board on May 2, 2002 the Registrant, UNOVA Industrial Automation Systems, Inc., answers the Petition for Cancellation identified above as follows:

1. In response to the allegation of paragraph 1, Registrant admits to the first sentence. However, Applicant denies the second sentence.

2. Registrant has insufficient knowledge thereof and therefore denies the allegations in paragraph 2.

3. Registrant has insufficient knowledge thereof and therefore denies the allegations in paragraph 3.

4. Registrant has insufficient knowledge thereof and therefore denies the allegations of a paragraph 4.

5. Registrant admits the allegations of paragraph 5.

6. Registrant denies the allegations of paragraph 6.

7. Registrant denies the allegations of paragraph 7.

8. Registrant denies the allegations of paragraph 8.

9. Registrant denies the allegations of paragraph 9.

10. Registrant has insufficient knowledge thereof and therefore denies the allegations of paragraph 10.

11. Registrant denies the allegations of paragraph 11.

12. This claim has been stricken by the Board and need not be answered.

13. Registrant denies the allegations of paragraph 13.

14. Registrant denies the allegations of paragraph 14.

Wherefore, Registrant believes the present Cancellation should be dismissed and the registration of Registrant should be maintained.

AFFIRMATIVE DEFENSES

1. Registrant claims the defense of laches and acquiescence as to claims of lack of acquired distinction. Registrant has long owned a previously incontestable U.S. registration 359,766 for the identical mark as applied to the same goods, which already showed prima facie exclusive right to the mark. Although that previous registration was inadvertently not renewed, Registrant considers the present application a re-filing of the same trademark for the same goods. Registrant never abandoned its common law rights and Federal rights under § 43(a) in the present mark. Furthermore, Petitioner has never opposed or filed a cancellation proceeding against the previous Registration 359,766 for 60 years, even though it long had knowledge of Registrant's U.S. usage and U.S. Registration 359,766. Registrant has long relied on Petitioner's silence and acquiescence and has built many years of goodwill in the mark relying on Petitioner's silence and acquiescence.

2. While the Board has denied the raising of *Morehouse* defense at this time, Registrant reserves its right to raise the "*Morehouse* defense" if Registration 378,705 registered on June 18, 1940 survives the consolidated cancellation proceeding. See *Morehouse Mfg., Corp. v. J. Strickland & Co.*, 407 F.2d 887; 160 U.S.P.Q. 715 (CCPA 1969). Even in the famous case of *Morehouse*, the parent trademark was contested and survived. Accordingly, if the parent mark survives, Registrant reserves the right to assert the *Morehouse* defense.

Respectfully Submitted,

REISING, ETHINGTON, BARNES, KISSELLE,
LEARMAN & MCCULLOCH, P.C.

Date: April 7, 2003

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **ANSWER IN RESPONSE TO CONSOLIDATED PETITION FOR CANCELLATION** was served by first class mail, postage pre-paid, on counsel of record for Petitioner at the following address on April 7, 2003.

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