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

SAINT-GOBAIN ABRASIVES, INC.,

Box TTAB

Petitioner,

Cancellation No. 92040569

v.

UNOVA INDUSTRIAL AUTOMATION  
SYSTEMS, INC.

Respondent.



08-05-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #61

TRADEMARK TRIAL AND  
APPEAL BOARD  
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CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513 ON August 1, 2002.

*Dawn Large*  
DAWN LARGE

**RESPONDENT'S RESPONSIVE BRIEF TO PETITIONER'S  
CROSS-MOTION & REPLY BRIEF**

Respondent now hereby responds to the cross-motion and replies hereto in support of its original Motion for Dismissal.

**LACK OF STANDING**

Petitioner maintains that as a matter of law the Morehouse case no longer applies to this matter since Petitioner has now recently filed a Petition to Cancel against U.S. Reg. 378,705. While such a challenge may now have been recently filed, there was no such challenge at the time of the original filing of this cancellation. At the time of the original commencement of the cancellation, Petitioner did not have adequate standing because as a matter of law, it could not be damaged due to the existence of Respondent's unchallenged U.S. Registration 378,705.

The issue of proper standing is properly considered at the time of the filing of the complaint or start of the interpartes proceedings. See Moore's Federal Practice Section 101.32 and

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the cases therein. See also United States Parole Commission v. Geraghty 445 U.S.388, 397; 100 S. Ct. 1202, 1209; 63 L. Ed. 2d 479, (1980), Powder River Basin Resource Council, v. Babbitt 54 F. 3<sup>rd</sup> 1477, 1484, (10<sup>th</sup>. Cir. 1995) Senter v. General Motors Corp., 532 F. 2d 511, 520, (6<sup>th</sup>. Cir. 1976).

Petitioner is trying to correct its initial lack of standing by posing a late challenge to the other registration after the fact of its frivolous commencement of the Petition for Cancellation. Petitioner was aware of such an affirmative defense which was raised January 2, 2002 in a related Opposition 91150173 between the same parties. Even with this knowledge, Petitioner did not file a timely challenge against U.S. Registration 378,705 before filing the present Petition for Cancellation against U.S. Registration 2,516,176. Such correction of standing after the fact is not supported by any case law or by the Rules of Federal Civil Procedure. The Petitioner is trying to undo its lack of standing by a late filing of another Petition For Cancellation. However, Petitioner has not addressed its lack of standing at the time of the original filing of this Petition for Cancellation.

Petitioner is also attempting to state that the law as set forth in the Morehouse case does not apply by asserting the preposterous argument that the addition of color to an identical design mark provides a different commercial impression than the design registration *per se*. While a blue band may provide a different commercial impression than a yellow band as Petitioner contends, the colored peripheral bands, whether yellow and blue, do not provide a different commercial impression from the generic United States Registration that does not have a designated color. It is well settled that a registration for a design that does not designate color may be used in **any color** and not limited to any particular color. See In re F.C.F. Inc., 30 U.S.P.Q. 2d 1825 (TTAB, 1994), and Application of Data Packaging Corp. 453 F.2d 1300, 172 U.S.P.Q. 396, 59 C.C.P.A. 776 (1972). The argument that the inclusion of a particular color to a

design mark specifying no color creates a different commercial impression is nonsense and Petitioner has not supported its position by any case law or statute.

Petitioner strenuously states that it has adequate standing because it is a competitor. However, more is needed. It must show a "real" interest in the proceeding. See International Order of Job's Daughters v. Lindeburg and Company 220 U.S.P.Q. 1017 (Fed. Cir. 1984), and Selva & Sons, Inc. v. Nina Footwear, Inc 217 U.S.P.Q. 641 (Fed. Cir., 1983). However, if no damage is possible due to the law set forth in Morehouse the "real" nature of the interest disappears and no standing can be found.

Furthermore, Petitioner is characterizing the Morehouse case as an affirmative defense like laches. However, this defense goes to the heart of the Petitioner's standing. It is a matter of law whether the Petitioner can be further damaged by a second registration and as such if there is no possibility of damage then there is no standing as a matter of law. The determination of standing is at the time of filing the Petition for Cancellation, not at a point in time thereafter. Thus, this case should be dismissed without prejudice based on the law set forth in the Morehouse case.

### **LACHES AND ACQUIESCENCE**

The Petitioner has raised the cross-motion of striking Respondent's affirmative defenses. While the Petitioner has cited many cases in its responsive brief for citing that long use does not apply to notice of registration, these cases are not applicable to the case at hand. Petitioner is not aware of or at least has not cited Aquion Partners L.P. v. Envirogard Products Ltd 43 U.S.P.Q. 2d 1371 (TTAB, 1997) which clearly states that the registration for a previous mark that is substantially the same for goods that are the same or substantially similar can be used to show the defense of laches. While in that case, the facts were that the goods were not necessarily the same, in the case at hand, the same mark was filed for the identical goods as the previous registration, with the goods

amended by requirement of the examining attorney for specificity purposes. The previous registration, **US. Reg. No. 359, 766** for the blue band about the periphery of the goods was registered for **60 years**. This case is more than mere usage. The case at hand includes a previous Federal Registration with **notice** and all the rights given such a registration. Now after 60 years, the Petitioner's statement that it finds a reasonable basis for believing that it will be damaged by the new identical registration for the identical goods is just plainly untenable. There is no reasonable basis or fact alleged by Petitioner that its business cannot continue as it has in the past. Moreover, Petitioner has not alleged that any competitor of Respondent uses said mark in a functional manner. Moreover, Petitioner has not alleged that Respondent uses its own mark in a functional manner. There is not a single allegation that a band about the periphery of the product has a functional characteristic.

Petitioner also alleges in a footnote 4 that its delay is excused by the 1998 change in the law. Such a contention is plainly not supported in law or by any case. The Petitioner could have challenged on any grounds back in 1938 though to at least August 30, 1943 and afterwards the mark became incontestable through to its expiration in 1998.

While this petition relates to a new registration that is not incontestable, the Petitioner is labeling its claims as "functional" as a ploy to get around the laches and acquiescence defense. It argues in the responsive brief that the color blue is functional and thus with a great leap in logic the registration must be void *ab initio*.

It is true that the law changed to include functional trademarks as a grounds to cancel a mark at any time and to refuse a registration if the mark as a whole is functional. However the definition of "functional" as set forth in the 1998 law must be placed in the proper context. After all, all trademarks are "functional" by serving the purpose of identifying the source of the

goods -- so it appears certain that Congress did not intend all marks to be denied registration or to be allowed to be cancelled at any time.

The function must be *de jure*, i.e. the function must be inherent in the product or packaging that embodies a design feature which is superior to other available designs. It must be inherent in the design. The "functional" aspect of the mark must be an inherent function or a utility to the entire mark as a whole.

The Petitioner on the other hand is grasping for *de facto* functions to an otherwise arbitrary and non-functional mark. One, if creative, can always attribute a function to a mark. Even the most famous Coca-Cola mark placed on a clear bottle may have its bottom edge "indicate" that the bottle is approximately half filled. The top edge of the Coca-Cola mark may indicate another fill fraction of the bottle. Thus, finding a function attributable to the mark does not make the mark inherently functional. It is further unlikely that the Coca-Cola Company uses its trademark in a functional manner. Likewise, no allegations were made that Registrant uses its trademark in any "functional" manner.

Petitioner argues that its pleadings provide proper notice of function. However, the Petitioner has made up three different and unrelated functions, grit size, replacement, and speed, without alleging one iota of a real factual basis for such functional claims. It is indeed quite incredible and unbelievable that a single peripheral band can have all these functions. This searching and creating different attributes which may have a functional characteristic to bypass the incontestability aspect of section 15 is not what Congress had in mind. Nor should this searching and creating of functions be used to bypass any affirmative defenses of laches and acquiescence which may, and should, be raised if Respondent's pending Motion to Dismiss is denied.

Lastly, the Petitioner has contended that the Respondent is filing this motion to delay discovery. This argument should fall on deaf ears. Petitioner has delayed this proceeding for **60**

**years!!** During this delay, Respondent's marketing employees, CEOs, CFOs have come and gone, have made entire careers, retired and passed on. Records of historical age have been destroyed. Witnesses have come to the company, grew old and have passed on. The entire business has been bought and sold. Offices have been built and razed. All this has happened without a prior U.S. proceeding from Petitioner. With the **60 years** of delay, a few more months until this motion is decided should not now upset Petitioner.

Furthermore, more than a mere passage of time has taken place. Putting the Respondent in such a Petition to Cancel after 60 years of notice places the Respondent at a severe disadvantage due to destruction of records and passing of witnesses after this extreme delay.

As such, the affirmative defenses should not be stricken and in fact, this entire proceeding should be dismissed with prejudice due to this extreme and unreasonable delay.

Respectfully submitted,

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



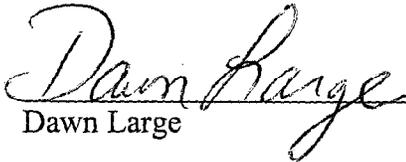
Date: August 1, 2002

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PROOF OF SERVICE

I hereby certify that a copy of the foregoing **RESPONDENT'S RESPONSIVE BRIEF**  
**TO PETITIONER'S CROSS-MOTION & REPLY BRIEF** was served by first class mail,  
postage pre-paid, on counsel of record for Petitioner and the Assistant Commissioner for  
Trademarks at the following addresses on **August 1, 2002**:

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