

TTAB

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

By: C. A. Cludus

DATE: 09-01-01

BOX TTAB - FEE

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

SAINT-GOBAIN ABRASIVES, INC.

Opposer,

v.

UNOVA INDUSTRIAL AUTOMATION SYSTEMS, INC.

Applicant

:  
:  
:  
:  
: Opposition No.  
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**NOTICE OF OPPOSITION**

Honorable Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

09/13/2001 TSMITH 00000124 020755 75670483  
01 FC:377 300.00 CH

In the matter of Trademark Application Serial No. 75/670,483 filed March 30, 1999 and published for opposition in the Official Gazette of February 6, 2001:

Saint-Gobain Abrasives, Inc., a Massachusetts corporation with a place of business at One New Bond Street, Worcester, Massachusetts 01615 ("Saint-Gobain"), believes that it will be damaged if a registration issues for the goods therein identified and hereby opposes the registration of said trademark. The grounds for opposition are as follows:

1. Applicant seeks to register a yellow colored stripe or band, applied to the peripheries of the goods adjacent the rear face thereof and which is less width than the thickness of the wheel or disks, as a trademark for power operated abrasive wheels and abrasive disks, as evidenced by the publication of said mark in the Official Gazette of February 6, 2001. No specific shade of yellow is identified, by Pantone number or otherwise.

2. Saint-Gobain is and has for many years been engaged in the manufacture and distribution of abrasives, including power operated abrasive wheels and disks and has built a large and profitable business in connection therewith.

3. Saint-Gobain has used stripes and bands of various colors in connection with abrasive products for many years.

4. Saint-Gobain has used and uses yellow stripes, and other colors of stripes, on abrasive wheels in the same and similar manners as Applicant.

5. Other companies that make abrasive products, including abrasive wheels and abrasive disks, use various colors for such goods.

6. In the abrasives industry, colors used on and in connection with products function as an indicator of abrasive grit size and/or application.

7. In the abrasives industry, colors used on and in connection with products function to assist operators to know when a product should be used or should be replaced with another.

8. In the abrasives industry, colors of stripes across an abrasive wheel designate speed.

9. Applicant's alleged mark is not distinctive of the Applicant's goods under Section 2(f) of the Trademark Act because the Applicant has not had substantially exclusive use of the alleged mark. The color yellow has been used in a commercially significant manner by Opposer and by others in the industry, in connection with abrasive wheels and abrasive disks and like abrasive products.

10. Applicant's alleged mark is not distinctive of the Applicant's goods because Applicant uses a variety of colors of stripes on abrasive wheels and abrasive disks, and each of such colors serves a functional purpose, including the yellow stripe which is the subject of the application herein opposed.

11. Applicant's alleged mark is not entitled to registration because the Applicant is seeking registration of more than one mark; the application fails to include a clear and specific description

of the shade of color of the alleged mark, and the registration as sought would cover a variety of different yellow colors.

12. If Applicant is granted a registration for the mark herein opposed, Saint-Gobain and others would be damaged insofar as there would be a cloud on their ability to use and to continue to use the color yellow for stripes and bands on abrasive wheels and disks for functional purposes.

13. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Saint-Gobain and its customers.


WHEREFORE, Saint-Gobain prays that registration of the mark of Application Serial No. 75/670,483 be refused and that this opposition be sustained.

A duplicate of this Notice of Opposition is enclosed herewith.

The \$300.00 filing fee for this Opposition may be charged to Deposit Account No 02-0755.

Date: 9/4/01

Respectfully submitted,

By:   
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ATTORNEYS FOR OPPOSER

/cda

TTAB

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September 4, 2001

BOX TTAB - FEE  
Commissioner Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

We are enclosing herewith the following documents set forth below, which are to be filed in the Patent and Trademark Office.

Please charge all government filing fees with respect to the enclosed documents to our Miscellaneous Account No. 02-0755.

Very truly yours,

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

ROBERTA JACOBS-MEADWAY

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TRADEMARKS AND PATENT

Enclosures: Notice of Opposition

Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.

Opposing: Serial No. 75/670,483 for "Miscellaneous Design" (yellow stripe)

Fee: \$300.00

Attorney Docket No. 887598

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By: Carol Anderson  
DATE: 09-04-01

RJM/cda