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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

Opposer,

v.

Opposition No. 911

UNOVA INDUSTRIAL AUTOMATION
SYSTEMS, INC.

Applicant.



06-28-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #26

150,173

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 JUNE 25, 2002.

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TRADEMARK TRIAL AND
APPEAL BOARD

APPLICANT'S BRIEF ARGUMENT TO OPPOSER'S MOTION TO COMPEL

Applicant requests that the Board not grant Opposer's Motion to Compel for two basic reasons. Firstly, the Motion is premature and secondly, Opposer, contrary to its allegation of good faith, has not made a good faith effort to resolve the discovery situation.

The Motion is premature in that there is a now a pending and dispositive Motion for Judgment on the Pleadings filed by Applicant which if granted, will dispose of the entire proceeding. The pending dispositive Motive is based on the Morehouse defense based on a prior U.S. Registration 378,705; and 36 years of acquiescence by the Opposer. Applicant had a prior registration U.S. Registration 359,768 for a sixty (60) year period without a single instance of opposition or litigation from Opposer.

For a long period of time Opposer has been a competitor of Applicant. Until recently, Opposer has also been a supplier of raw materials to Applicant. Opposer, since it was cut off as a supplier to Applicant, has become litigious with three interparties matter against Applicant:

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(1) a patent litigation in the U.S. District Court, District of Delaware, Norton Company v. Gardner Grinding & Abrasive Systems (a Division of UNOVA, Inc.) Case No. 98-430 (now settled); (2) A cancellation proceeding for 92040569 (now pending); and (3) the present opposition proceeding 91150173.

Secondly, the Motion to Compel comes as a surprise to Applicant because the Applicant thought it was making significant progress regarding the exchange of information pursuant to the discovery requests.

Applicant promised to review the rather long and complex Protective Order proposed by Opposer (see Exhibit A) per Applicant's letter of June 5, 2002. However, within 5 days Opposer prepared and filed this Motion to Compel without even sending out an inquiry as to the status of our review. However, simultaneous with the filing of this Motion, Opposer sends out a fax letter dated June 10 (see Exhibit C) stating they "look forward to receiving your response to the proposed order this week." No other demands were made but they filed this Motion to Compel on the same day while making progress on discovery matters.

Apparently Opposer also misinterprets Applicant's letter of June 5, 2002. The "The answers stand as is" only refers to the interrogatories that were answered! Applicant specifically and fully answered Interrogatory 20. Applicant says "It does not have specific knowledge of it's competitor's trademarks" as requested. Applicant does not know the "marks" of its competitors. The fact that Opposer thinking this is "incredible" does not make it untrue, nor does it make the declaration with the trademark application untrue. We do not know what the Opposer wants or where he is going with this ridiculous disbelief.

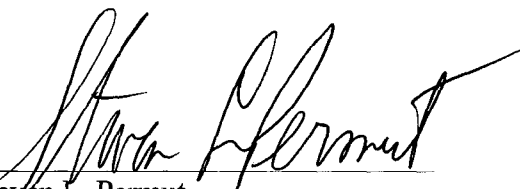
At least, due to the quick preparation of the Motion to Compel and its filing a mere 5 days after the previous correspondence it appears Opposer's letter was a mere pro forma letter to give the appearance of a good faith negotiation to provide discovery. Such a sham should be called

what it is – a sham and thus no good faith requirement has been fulfilled. The negotiation must be played out to completion and not just started to justify a "good faith requirement."

For the above two reasons, prematurity and lack of good faith, this Motion to Compel should be denied.

Respectfully submitted,

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

A handwritten signature in black ink, appearing to read "Steven L. Permut", written over a horizontal line.

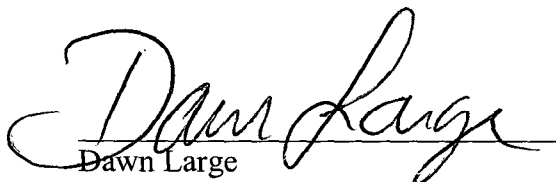
Date: June 25, 2002

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PROOF OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S BRIEF ARGUMENT TO OPPOSER'S MOTION TO COMPEL was served by first class mail, postage pre-paid, on counsel of record for Opposer and the Assistant Commissioner for Trademarks at the following addresses on **June 25, 2002**:

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