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

SAINT-GOBAIN ABRASIVES, INC.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 150,173
	:	
UNOVA INDUSTRIAL AUTOMATION SYSTEMS, INC.	:	
	:	
Applicant.	:	

REPLY MEMORANDUM IN SUPPORT OF OPPOSER'S MOTION TO COMPEL

Saint-Gobain filed the instant Motion to Compel to obtain responses to nine interrogatories requesting information as basic as the classes of purchasers and channels of trade for Unova's products bearing the subject mark. Tellingly, Unova does not even attempt to dispute that Saint-Gobain is entitled to the information sought in the nine interrogatories.

Unova has opposed Saint-Gobain's motion on two procedural grounds. First, Unova has argued that Saint-Gobain's motion is "premature" because Unova filed a motion for judgment on the pleadings nine days after Saint-Gobain filed its Motion to Compel, which Unova contends is dispositive of this proceeding. Second, Unova claims that Saint-Gobain's motion should be denied because it was filed five days after Unova flatly refused to supplement its interrogatory responses. Unova's arguments are without merit.

Unova's motion for judgment on the pleadings is a transparent attempt to stave off discovery and is not dispositive of this proceeding. First, Unova did not file its motion until over a week after Saint-Gobain filed its Motion to Compel and until after the close of discovery. Saint-Gobain's motion is obviously not "premature," indeed, it was filed first and was absolutely necessary given Unova's discovery delays and ultimate refusal to provide interrogatory

responses. Significantly, Unova has offered no explanation for its failure to file a purportedly dispositive motion based solely on the pleadings earlier on in the proceeding.

Second, Unova's motion attempts to rely upon documents and information outside the scope of the pleadings that were never produced to Saint-Gobain in discovery. Unova cannot deny Saint-Gobain the opportunity to obtain discovery to which it is indisputably entitled by filing a self-described "dispositive" motion, which relies upon documents and information that Unova has refused to produce to Saint-Gobain.

Third, Unova's motion for judgment on the pleadings is baseless. As set forth in Saint-Gobain's opposition papers and cross-motion, Unova cannot demonstrate that it is entitled to judgment as a matter of law based on the equitable defenses of laches, acquiescence and the Morehouse defense, because Unova is barred from raising these defenses in this proceeding. Unova also cannot demonstrate that it is entitled to judgment on the pleadings based on Saint-Gobain's alleged failure to state a claim because the Notice of Opposition adequately pleads numerous grounds for the opposition including that the alleged mark is functional and lacks distinctiveness.

Finally, Saint-Gobain timely filed its Motion to Compel. Saint-Gobain first wrote to Unova on May 24, 2002, demanding that Unova provide responses to the nine interrogatories. (Exh. D to Motion.) In that letter, Saint-Gobain stated that if the parties could not reach an agreement about the outstanding discovery issues by May 31, 2002, Saint-Gobain would file a motion to compel. (Id.) Unova did not respond to Saint-Gobain's letter until June 5, 2002. Unova responded by flatly refusing to provide interrogatory responses stating, "Those answers stand as is." (Exh. E to Motion.) Having nothing left to discuss or negotiate about the interrogatory responses, Saint-Gobain filed its Motion to Compel.

Unova's contention, that it believed the parties were "making progress," is devoid of evidentiary support. After June 5, 2002, there are no communications between the parties concerning Unova's failure to provide interrogatory responses. Unova's reference to subsequent communications between the parties blatantly confuses Saint-Gobain's efforts to obtain documents from Unova with Saint-Gobain's efforts to obtain interrogatory responses from Unova.

Unova refused to produce any documents until the parties entered into a confidentiality agreement. (See letter from Hara K. Jacobs, Esq. to Steven Permut, Esq. dated May 30, 2002, Exh. A hereto.) Saint-Gobain forwarded a draft protective order to Unova in mid-May 2002 and subsequently requested that Unova produce its non-confidential documents to Saint-Gobain. (Id.) At the time of Unova's June 5, 2002 letter, Unova had not produced any documents and contended that it was reviewing the draft protective order, which had been in its possession for three weeks. (Exh. E to Motion.) Saint-Gobain did not file a motion to compel the production of documents along with the instant motion because Saint-Gobain expected that Unova would execute the protective order as promised and would produce its documents shortly thereafter. Saint-Gobain's letter to Unova dated June 10, 2002, sets forth this expectation. (Letter from Hara K. Jacobs, Esq. to Steven Permut, Esq. dated June 10, 2002, Exh. B hereto.) Unova, however, never executed the protective order and never produced documents to Saint-Gobain. Obviously, no progress was made or has been made on any discovery issues.

CONCLUSION

For all the foregoing reasons, Saint-Gobain respectfully requests that the Board issue an Order compelling Unova to provide full and complete responses to the interrogatory requests set forth in Exhibit A to Saint-Gobain's Motion, without objection.

Dated: July 15, 2002

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

By: _____

Roberta Jacobs-Meadway
Hara K. Jacobs

1735 Market Street, 51st Floor
Philadelphia, PA 19103
(215) 665-8500

ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I, Hara K. Jacobs, hereby certify that on today's date, I caused a copy of the foregoing Reply Memorandum in Support of Opposer's Motion to Compel to be served by United States first class mail, postage prepaid, on counsel set forth below:

Steven L. Permut, Esq.
REISING, ETHINGTON, BARNES, KISSELLE,
LEARMAN & McCULLOCH P.C.
P.O. Box 4390
Troy, Michigan 48099
(248) 689-4071

Dated: July 15, 2002

Hara K. Jacobs

Certificate of Mailing by Express Mail

"Express Mail" mailing label No. EL 855263034 US

I, Sharon Felder-St.Clair, hereby certify that this correspondence is being deposited as "Express Mail" with the United States Postal Service addressed to: Trademark Trial and Appeal Board, United States Department of Commerce, Patent and Trademark Office, 2900 Crystal Drive, Arlington, VA 22202-2513 on the date indicated below.

Date of Deposit: July 15, 2002

Signed: Sharon Felder-St.Clair

LAW OFFICES
BALLARD SPAHR ANDREWS & INGERSOLL, LLP
1735 MARKET STREET, 51ST FLOOR
PHILADELPHIA, PENNSYLVANIA 19103-7599
215-665-8500
FAX: 215-864-8999
LAWYERS@BALLARDSPAHR.COM

BALTIMORE, MD
CAMDEN, NJ
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

HARA K. JACOBS
DIRECT DIAL: 215-864-8209
PERSONAL FAX: 215-864-9504
JACOBSH@BALLARDSPAHR.COM

May 30, 2002

Via Facsimile

Steven L. Permut, Esq.
Rising Ethington Barns Kisselle Learman &
McCullouch, P.C.
P.O. Box 4390
Troy, MI 48099

Re: Saint-Gobain Corporation v. Unova Industrial Automation Systems, Inc.
Opposition No. 150,173

Dear Mr. Permut:

I am writing to you concerning Applicant's Response to Opposer's First Request for the Production of Documents. Applicant has refused to produce responsive documents until a confidentiality stipulation is entered in this matter. This is not a valid ground for refusing to produce many of the documents sought in Opposer's document requests. For example, Request Nos. 1-5, 8-10, 25, 34, 48-49, and 54, seek documents that are either publicly disseminated by Applicant or that contain information that is not "confidential". Non-confidential documents responsive to these and other requests should have been produced weeks ago. Further, you have not responded to the draft protective order that we sent to you over two weeks ago. We request that Applicant immediately produce its non-confidential documents and execute the protective order so that it can be filed with the Board. Immediately following the execution of the protective order by the parties, Applicant's documents designated "confidential" must be produced. If we do not receive Applicant's documents by Friday, 7, 2002, we will be forced to make a motion to compel with the Board.

Applicant has also put forth a number of unfounded objections to Opposer's document requests. Applicant has asserted a global objection to Opposer's use of the phrase "documents sufficient to identify," claiming that Applicant has difficult understanding this phrase. This is an accepted method of requesting a considerably more narrow set of documents than the all-inclusive phrase "all documents relating to," which often results in an overly broad and unduly burdensome request. The phrase "documents sufficient to identify" is amply clear. There is no basis for Applicant's objection.

Applicant's unjustified objections and inadequate responses to specific document requests are set forth below.

1. Request No. 10: This request seeks one example of Applicant's packaging, labels, advertising and promotional materials displaying the mark that Applicant seeks to register. Applicant's packaging, advertising and promotional materials are directly relevant to the issues of distinctiveness and functionality. Applicant cannot satisfy its discovery obligation by referring Opposer to its website and hand-picking materials for production. Further, to the extent that Applicant intends to reply upon its purported seventy-years of use of the mark as evidence of acquired distinctiveness, Opposer is entitled to take discovery of Opposer's basis for this claim. All responsive documents in Applicant's possession, custody or control must be produced.

2. Request Nos. 23-24: These requests seek documents sufficient to establish Applicant's first use of the color yellow and first use of a stripe or band on its abrasive products. To the extent that Applicant intends to reply upon its purported seventy-years of use of a yellow stripe on its abrasive products as evidence of acquired distinctiveness, Opposer is entitled to take discovery of Opposer's basis for this claim. All responsive documents in Applicant's possession, custody or control must be produced.

3. Request No. 27: This request seeks product manuals, instructional materials and educational materials for Applicant's abrasive products displaying a stripe or band. Applicant responded to the request by referring to (but not producing) one guidebook published by Applicant in 1998. Applicant's published guidebook is not confidential and should be produced immediately. In addition, any other responsive documents in Applicant's possession, custody or control must be produced.

4. Request No. 28: This request seeks all documents supporting, refuting or concerning Applicant's claim it has exclusively used the mark that it seeks to register. Applicant responded to the request by referring to its expired trademark registration for a yellow stripe or band applied to abrasive products. If Applicant has any documents in its possession, custody or control that are responsive to this request, they must be produced.

5. Request No. 54: This request seeks documents sufficient to identify the colors used by Applicant for its abrasive products for the past ten years. Applicant responded by, inter alia, referring to non-confidential brochures and Applicant's website but not producing these materials. All responsive documents in Applicant's possession, custody or control must be produced.

6. Request Nos. 57-58: These requests seek documents concerning Applicant's attempt to register the subject mark in any country. Applicant objected to these requests on the ground of relevance. These requests are relevant for two reasons. First, the requests encompass documents concerning Applicant's attempt to register the subject mark in the United States. These documents are obviously relevant to this proceeding. Second, documents concerning Applicant's attempt to register the subject mark in a foreign country are relevant to the issue of

functionality. All responsive documents in Applicant's possession, custody or control must be produced.

7. Request No. 60: This request seeks documents in Applicant's possession, custody or control referring to Opposer. Applicant objected to this request on the grounds of breadth and relevance and further asserted that Opposer has equal access to such documents. This request is directly relevant to Applicant's knowledge of Opposer's use of a stripe or band applied to the periphery of its abrasive products and is not overly broad. Further, in the context of this request, Opposer cannot have "equal access" to documents that may or may not reside in Applicant's files. All responsive documents in Applicant's possession, custody or control must be produced.

8. Request No. 72: This request seeks Applicant's trademark enforcement policy and all documents concerning any actual or proposed changes to the policy. Applicant responded to the request by referring to but not producing its Corporate Policy Manual. Applicant's manual and any other responsive documents in Applicant's possession, custody or control must be produced.

Finally, Applicant objected to several requests citing the attorney-client privilege and work product doctrine. Any documents withheld on these grounds should be summarized in a privilege log in accordance with Opposer's Instruction "L".

Given the impending commencement of the testimony period, if we cannot reach an agreement about the issues raised in this letter by June 7, 2002, we will be forced to file a motion to compel with the Board.

Very truly yours,

Hara K. Jacobs

HKJ/sfs
cc: Roberta Jacobs-Meadway, Esq.
Alexander Plache, Esq.

LAW OFFICES
BALLARD SPAHR ANDREWS & INGERSOLL, LLP
1735 MARKET STREET, 51ST FLOOR
PHILADELPHIA, PENNSYLVANIA 19103-7599
215-665-8500
FAX: 215-864-8999
LAWYERS@BALLARDSPAHR.COM

BALTIMORE, MD
CAMDEN, NJ
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

HARA K. JACOBS
DIRECT DIAL: 215-864-8209
PERSONAL FAX: 215-864-9504
JACOBSH@BALLARDSPAHR.COM

June 10, 2002

Via Facsimile

Steven L. Permut, Esq.
Rising Ethington Barns Kisselle Learman &
McCullouch, P.C.
P.O. Box 4390
Troy, MI 48099

Re: Saint-Gobain Corporation v. Unova Industrial Automation Systems, Inc.
Opposition No. 150,173

Dear Mr. Permut:

I am writing in response to your letter dated June 5, 2002, concerning outstanding discovery issues in this matter.

Saint-Gobain objected to Applicant's First Set of Interrogatories because they exceeded the permissible limit under 37 C.F.R. § 2.120(d). The maximum number of interrogatories permitted is seventy-five (75), including subparts. Each subpart within an interrogatory, whether or not separately designated, is counted as a separate interrogatory. TBMP § 406.03(d).

Several of Applicant's sixty-nine interrogatories contain multiple subparts, even though Applicant did not separately letter or number the subparts. For example, Interrogatory Nos. 12 and 13 each contain six subparts. Interrogatory Nos. 14 and 15 each contain three subparts. Interrogatory No. 66 contains four subparts. Other interrogatories, such as numbers 4, 22, 23, and 24 also contain multiple subparts. As a result, Applicant's First Set of Interrogatories number well in excess of seventy-five.

Notwithstanding the foregoing, if Applicant serves a revised set of interrogatories that is compliant with the applicable discovery rules, Saint-Gobain will respond to the revised requests.

Your reference to Applicant's First Request for the Production of Documents is puzzling. This document, along with Applicant's First Set of Interrogatories, was not served until May 8, 2002. Thus, no response is due from Saint-Gobain until June 12, 2002. We will respond to Applicant's document requests as appropriate.

Finally, we forwarded the proposed protective order to you over three weeks ago. We look forward to receiving your response to the proposed protective order this week.

Kindly contact me if you have any questions about Saint-Gobain's positions set forth herein or if Applicant will not be prepared to execute the protective order this week. Please be advised that my direct fax number is (215) 864-9504.

Very truly yours,

Hara K. Jacobs

HKJ/sfs
cc: Roberta Jacobs-Meadway, Esq.
Alexander Plache, Esq.

TTAB

LAW OFFICES
BALLARD SPAHR ANDREWS & INGERSOLL, LLP
1735 MARKET STREET, 51ST FLOOR
PHILADELPHIA, PENNSYLVANIA 19103-7599
215-665-8500
FAX: 215-864-8999
LAWYERS@BALLARDSPAHR.COM

BALTIMORE, MD
CAMDEN, NJ
DENVER, CO
SALT LAKE CITY, UT
VOORHEES, NJ
WASHINGTON, DC

HARA K. JACOBS
DIRECT DIAL: 215-864-8209
PERSONAL FAX: 215-864-9504
JACOBSH@BALLARDSPAHR.COM

July 15, 2002

VIA EXPRESS MAIL
Trademark Trial and Appeal Board
United States Department of Commerce
Patent and Trademark Office
2900 Crystal Drive
Arlington, VA 22202-2513
Box: TTAB NO FEE

07-17-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #74

Re: Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc., Opposition No. 150,173

Dear Sir or Madam:

On behalf of Opposer, Saint-Gobain Abrasives, Inc., I am enclosing Opposer's Reply Memorandum in Support of its Motion to Compel and an accompanying postcard, which we request that you stamp and return to us.

Thank you for your consideration in attending to this matter.

Respectfully submitted,

Hara K. Jacobs

HKJ/sfs
Enclosures

cc (w/encl.): Steven L. Permut, Esquire

TRADEMARK TRIAL AND APPEAL BOARD
02 JUL 23 AM 8:33

1.a