

Exhibits

TTAB

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

SAINT-GOBAIN ABRASIVES, INC.,

BOX TTAB

Opposer,

Opposition No. 91150173

v.

UNOVA INDUSTRIAL AUTOMATION
SYSTEMS, INC.

Applicant.



06-21-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #71

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: BOX TTAB- ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513 ON JUNE 19, 2002.
<i>Dawn Large</i>
DAWN LARGE

MOTION FOR JUDGMENT ON THE PLEADINGS

Applicant moves for a motion on the pleadings in favor of Applicant in the above identified opposition for the following three reasons: 1) equitable defense as a matter of law; laches and acquiescence of Opposer; and 3) Opposer's failure to state a claim upon which relief can be granted.

TRADEMARK TRIAL AND
 APPEAL BOARD
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BRIEF IN SUPPORT OF MOTION

BACKGROUND FACTS

Applicant has owned the following U.S. Registrations all relating to a band applied to "the peripheries of abrasive wheels or disks adjacent the rear faces thereof and which is of less width than the thickness of the abrasive wheels or disc." See U.S. Registration 378,705.

<u>Registration No.</u>	<u>Miscellaneous Design Mark (Peripheral Band)</u>	<u>Date of Registration</u>	<u>Status</u>
378,705	"generic peripheral band"	June 18, 1940	Live
359,768	"yellow in color"	August 30, 1938	Expired 1998
359,766	"blue in color"	August 30, 1938	Expired 1998
374,465	"silver in color"	January 9, 1940	Expired 2000
747,776	"green in color"	April 9, 1963	Live
372,308	"red in color"	October 31, 1939	Live
2,516,176	"blue in color"	December 11, 2001	Live
Application No. 75/670,483	"yellow in color"	filed:	Pending

In addition, Applicant owns the accompanying Registration for the accompanying word marks:

<u>Registration No.</u>	<u>Word Mark</u>	<u>Date of Registration</u>	<u>Status</u>
360,043	BLUE-RIM	September 6, 1938	Expired
359,767	RED-RIM	August 30, 1938	Expired
359,769	YELLOW-RIM	August 30, 1938	Expired
374,464	SILVER-RIM	January 9, 1940	Expired 2000
729,024	GREEN-RIM	March 27, 1962	Live
2,454,504	BLUE-RIM	May 29, 2001	Live
2,443,800	RED-RIM	April 17, 2001	Live
2,443,799	YELLOW-RIM	April 17, 2001	Live

All these registrations were for the basic same goods. All the design marks were for the same shape band about the periphery of the goods adjacent a rear face thereof, and having a width less than the thickness of the wheels or discs.

In 1998, several of the above trademarks, namely: U.S. Registration 359,766 for the peripheral band that is blue in color; U.S. Registration 359,768 for the peripheral band that is yellow in color; and the listed word marks lapsed due to non-renewal. Applicant refiled to obtain new registrations for the identical marks and for the same goods. Applicant filed a §2(f) declaration for the present application indicating that usage was continuous for the past 5 years, i.e., usage never stopped. The Examining Attorney required an amendment for the goods to include "power operated" to more particularly define the goods to today's standards.

The present Opposer has also filed a cancellation for U.S. Registration 2,516,176 for the peripheral band that is blue in color and this opposition proceeding against the pending application present registration after 60 years of use and previously existing Federal Registrations for each of these marks.

EQUITABLE DEFENSE

Applicant first supports its motion because of an equitable defense as a matter of law. An equitable defense exists when as a matter of law the moving party cannot be further injured because there already exists an injurious registration, the petitioning party cannot object to an additional registration that does not add to the injury. See O-M Bread Inc. v. United States Olympic Committee 65 F.3d 933, 36 USPQ 2d 104 (Fed Cir. 1995).

Applicant is the owner of unchallenged incontestable U.S. Registration 378,705 issued on June 19, 1940 for a stripe or band which is applied to the peripheries of the abrasive

wheels or disks adjacent to the rear faces thereof, and which is less width than the width of the wheels or disks as applied to substantially the same goods. (See Exhibit A).

An equitable defense exists here because Applicant's present application is also for a stripe or band applied to the peripheries of the goods adjacent the rear face thereof, and which is of less width than the thickness of the wheel or disks. In addition, the present application specifies that the peripheral band is yellow in color. The same shape band with the same position and same orientation however, creates the same commercial impression as U.S. Registration 378,705 registered on June 19, 1940.

It is well settled that as a matter of law an opposer cannot be further damaged if there exists a previous unchallenged registration for the substantially same mark as applied to substantially the same goods. See Morehouse Manufacturing Corporation v. J. Strickland and Company 56 C.C.P.A. 946, 407 F2d 881, 160 USPQ 715, 717 (C.C.P.A. 1969). As a matter of law, the Opposer cannot be further damaged within the meaning of the statutes by maintenance or issuance to Applicant of the registration sought "in view of Respondent's ownership of the above noted registration which covers the same mark and encompasses the same good..." See Artichoke Industries Inc. v. Regina Grapes Products Co. 52 C.C.P.A. 1837, 138 USPQ 687, 688 (C.C.P.A., 1963).

In such a case, the Patent Office Trademark Trial and Appeal Board recognizes that the prior registration of the same mark, for closely related goods, precludes the Opposer from prevailing. See Western Leather Goods Company v. Blue Bell, Inc. 178 USPQ 382 (TTAB, 1973). In the case at hand, the marks are virtually identical. Both design marks have the same shaped band about the peripheries of the goods. Both marks have the bands in the same position adjacent the rear face of the abrasive wheel disk. Both marks have the bands in the

same orientation about the peripheries of the wheels or disks. Both marks have bands with less width than the thickness of the wheels or disks. The specificity of the color yellow in the present application does not change the shape, position, orientation, or overall commercial impression of the peripheral stripe or band. The described goods in the registration and the present application are abrasive wheels or disks. The present application more specifically states that these are power operated abrasive wheels or disks due to the change of the United States Patent and Trademark Office descriptive requirements that have occurred over the past 60 years. However, the goods listed in U.S. Registration 378,705 clearly encompass such power operated abrasive wheels or disks of the present application. There is no genuine issue of facts here because these facts are of record in the United States Patent and Trademark Office. As such, dismissal is proper.

LACHES AND ACQUIESCENCE

Applicant also supports its motion because of laches and acquiescence. Laches or Acquiescence exists where the moving party has “*a previous opportunity to oppose or cancel registrations of the same or similar goods by the same party who is not applicant.*” See McCarthy on Trademarks and Unfair Competition, 4th Edition Volume 3 §20.38, p. 20-81. Laches and acquiescence exists here because Applicant further has owned previous incontestable U.S. Registration 359,768 issued on August 30, 1938 (Exhibit B) until it was unintentionally not renewed in 1998. Opposer further has known and has had ample opportunity to cancel the previous mark.

The prior U.S. Registration 359,768 was for the identical mark having the same shape, position, orientation, and color as applied to substantially the same abrasive wheels and abrasive disks. The present application was filed for the identical description of “abrasive

wheels and abrasive disks.” The United States Patent and Trademark Office required the specification of these products be “power operated” due to a change of descriptive requirements that has occurred over the sixty year span. In effect, the products are identical and the mark is identical.

This prior U.S. Registration ‘768 was on the U.S. Federal Register for over sixty (60) years without Opposer filing any oppositions or cancellations against it.

No other U.S. litigation between the two parties occurred during this sixty year period. Applicant considers the present new registration as merely refiled of the previous lapsed U.S. Registration. After a sixty year span of being registered and being in use where this previous Registration 359,768 existed, laches and acquiescence clearly applies.

Applicant has relied on this sixty year period of silence and acquiescence and has built a substantial business in that long expanse of time. Through the sixty years Applicant filed §12 (now analogous to §8 declaration but to pre-Lanham Act registrations) and §15 declarations, a renewal in 1958, and filed a second renewal in 1978. Applicant also refiled the present application all during the inexcusable silence and acquiescence of Opposer.

Opposer has competed against Applicant for many years as set forth in its pleadings ¶¶ 2 and 3. Opposer had actual knowledge of all of Applicant’s previous U.S. registrations at least as early as the year 1967 as evidenced by the previous legal correspondence (Exhibits C, D and E). Exhibit C is a letter from Opposer’s Canadian Attorney giving notice to the present Applicant about a Canadian Publication of a corresponding Canadian Trademark Application. Exhibit D is a response from Applicant’s informing Opposer’s attorney of U.S. Registration 378,705. U.S. Registration 378,705 clearly lists the ownership of U.S. Reg. 359,766. Exhibit E shows that Opposer’s legal counsel in Canada acknowledged receipt of such

notice and that he gave this information to Opposer. **He also indicated a colored band would probably pose no problem with his client.** (As a note of explanation, Norton is the predecessor in interest to Opposer and Landis and Gardner Machine are both predecessors in interest to Applicant). Opposer sat quiet in the United States for over 35 additional years. Cases showing much shorter time periods have provided a laches and acquiescence defense. See Gerstendorfer Bros. v. United Supply Co. 26 F.2d 564 (D.C. 1928) (15 years); Lightnin Chemical Co. v. Royal Home Products, Inc. 39 C.C.P.A. 1031, 197 F.2nd 668 94 USPQ 178 (C.C.P.A. 1952) (18 years); Willson et al. v. Graphol Products Co., Inc. 38 C.C.P.A. 1030 188 F.2d 498, 89 USPQ 382 (C.C.P.A. 1951) (10 years)

Opposer has not alleged any recognized causes that negate laches in its Petition. Opposer has not alleged any 1) a likelihood of confusion; 2) descriptiveness; 3) genericness; 4) fraud; or 5) abandonment that have been recognized to negate laches. Opposer has not alleged any legitimate cause of action against the particular shape, orientation and position of the peripheral stripe or band. Hence, laches and acquiescence based on a 60 year old registration and its refiling should apply.

INSUFFICIENT PLEADINGS

Opposer's pleadings do not state a proper cause of action. If we assume all allegations are true, they do not support any attack on the shape, orientation or position of a peripheral band as set forth in previous U.S. Registration 378,705 or the present application.

Allegation 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 or 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.

Allegation 1, if proved true, does not render the application defective. No Pantone number is required in the CFR or in any TMEP provision. See TMEP §807.06(a), (b), 808.04, 808.05, and 37 CFR § 2.37.

Allegation 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.

Allegation 2, if proved true, has no bearing on the Registered mark.

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

Allegation 3, if proven true, has no bearing on the registerability of peripheral stripes or bands. It is noted that allegation 3 does not allege that the Opposer alleges prior use of a band about the periphery of an abrasive wheel or disc adjacent the rear face thereof and having a width less than the thickness of the disc. Applicant has not alleged that they use any stripe or band like this.

Allegation 4: Saint-Gobain has used and uses yellow stripes, and other colors in connection with abrasive products for many years.

Allegation 4 does not allege prior use of “stripes” nor does it specify that its “stripes” are in fact about the peripheries of its wheels or disks, or are adjacent the rear face of the disc or have a width less than the thickness of the disc.

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

Allegation 5, if proven true, has no bearing on this petition. The function of color *per se* is not a sufficient pleading for the case at hand.

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

Allegation 6 pertains to the use of colors as an indicator of grit size. Allegation 6, if proven true, still does not pertain to the registered mark. The mark is directed to a peripheral band and no such function is alleged toward the peripheral band shape, orientation, or position.

Allegation 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.

Allegation 7 again, is solely directed to color as a function to assist operators. No such allegation is directed to the shape, orientation, or position of the peripheral band.

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

Allegation 8 is directed to stripes of color. As such, straight stripes or other vertically oriented stripe or stripes, placed on the flat back of disk, if proven true, are not directed to the shape, position or orientation of the peripheral band as set forth in the instant application.

Allegation 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 other in the industry, in connection with abrasive wheels and abrasive disks and the like abrasive products.

Allegation 9 is directed only to the color yellow which is not the sole aspect of the present application. No allegation against §2f is made to the shape, position or orientation of the peripheral band of the registered mark.

Allegation 10: Applicant's alleged mark is not distinctive of 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.

Allegation 10 is directed to "each of such colors serves a functional purpose." However, Opposer never alleges that the peripheral band serves a functional purpose. If Opposer cannot allege that the peripheral band of the present application is functional, Opposer should be estopped, from contesting the present mark merely because Applicant specifies the color yellow to a previous incontestable mark of a peripheral band. If the color yellow *per se* is proven functional, it still has no bearing on the rest of Applicant's mark of a band ably serving as a trademark.

Allegation 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.

Allegation 11, if proven true, is irrelevant. Applicant has followed all the requirements of CFR and TMEP as to the necessary identification of color. Opposer is attempting to place a requirement of specificity that plainly does not exist in any of the rules or regulations. The color yellow is adequately descriptive of the color taking into account the submitted specimens.

Allegation 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.

Allegation 12 is conclusory and without support. This allegation never alleges what peripheral bands it would not be able to use for functional purposes. Opposer would not be allowed to use a peripheral band that is listed and Registered in U.S. Registration 378,705. No further damage can be incurred because Applicant happens to color its peripheral band to be yellow.

Allegation 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.

Allegation 13 is again broadly directed to colored stripes that include different shapes, position and orientation than Applicant's peripheral band. Such functional purpose for these other stripes of different shapes, orientation and position have no pertinence to the present U.S. application.

Registration 378,705 for the same goods. The band of the previous incontestable registered mark has been specified to be the color yellow in the present application.

Secondly, Opposer has waited for at least 35 years to file such a inter partes proceeding and should be precluded on the grounds of laches and acquiescence.

Lastly, the pleadings are so vague and indefinite that even if proven entirely true, they still do not support adequate grounds for opposition.

In the entire opposition, only the color has been attacked as functional. No permissible grounds for cancellation have been directed to the incontestable features of the present mark.

As such, this opposition should be dismissed.

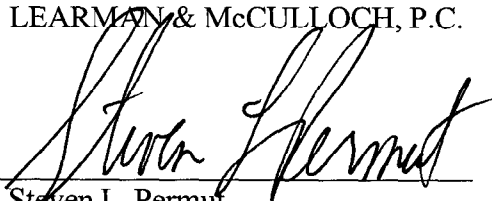
ACCOMPANYING REQUEST TO SUSPEND

Because the above motion, if granted is dispositive of the entire opposition, Applicant requests that the Board suspend the proceeding pending its disposition of this Motion.

If it is determined that any fees are due with this submission, the Commissioner is hereby authorized and respectfully requested to charge such fee to our deposit account No. 50-0852.

Respectfully submitted,

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



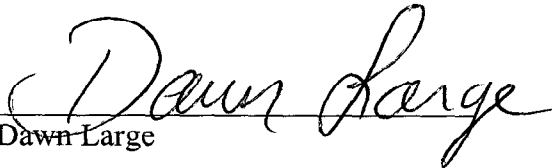
Date: June 19 2002

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PROOF OF SERVICE

I hereby certify that a copy of the foregoing MOTION TO FOR JUDGMENT ON THE PLEADINGS was served by first class mail, postage pre-paid, on counsel of record for Opposer at the following addresses on **June 19, 2002**:

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