

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: Carole Andres
DATE: 06/06/02

BOX TTAB - FEE

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



SAINT-GOBAIN ABRASIVES, INC.

Petitioner,

v.

UNOVA INDUSTRIAL AUTOMATION SYSTEMS, INC.

Respondent

06-10-2002

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

Cancellation No.

PETITION FOR CANCELLATION

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

In the matter of Trademark Registration No. 378,705 issued June 18, 1940:

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 by the registration issued for the goods therein identified and hereby petitions to cancel the registration of said trademark. The grounds for cancellation are as follows:

1. Unova Industrial Automation Systems, Inc. ("Unova") has secured registration of a stripe or band, of any color, 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 Registration No. 378,705.

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.

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

4. Saint-Gobain has used and uses stripes, and bands of various colors, on abrasive wheels.

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

6. In the abrasives industry, stripes or bands of colors and colors applied in a variety of like ways used on products such as wheels and disks function as an indicator of abrasive grit size and/or application.

7. In the abrasives industry, stripes or bands of colors and colors applied in a variety of like ways used on products such as wheels and disks 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. Unova's alleged mark is functional. Stripes and bands of various colors have been used in a commercially significant manner by Saint-Gobain and by others in the industry, on abrasive wheels and abrasive disks and like abrasive products, to indicate function, application, and to indicate wear.

10. Unova's alleged mark is not entitled to registration because it in face covers more than one mark. The registration covers all colors of stripes, not a single mark but multiple marks.

11. If Unova is able to maintain its registration for the mark which is the subject of this Petition, Saint-Gobain and others would be damaged insofar as there would be a cloud on their ability to use and to continue to use colored stripes and bands on abrasive wheels and disks for functional purposes.

12. The registration which is the subject of this petition accords a *prima facie* exclusive right to Unova to use the mark. Such registration is a source of damage and injury to Saint-

Gobain and its customers and others who use such colored stripes on such abrasive products for reasons of functionality having nothing to do with source identification.

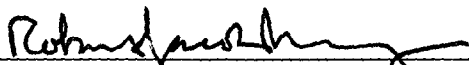
WHEREFORE, Saint-Gobain prays that Registration No. 378,705 be cancelled.

A duplicate of this Petition for Cancellation is enclosed herewith.

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

Date: 6/6/02

Respectfully submitted,

By: 
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June 6, 2002

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

Enclosures: Petition to Cancel

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

Reg. No.: 378,705

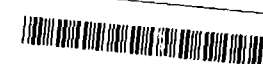
Fee: \$300.00

Attorney Docket No. 893460

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By: Candice Andress
DATE: 06/06/02

RJM/cda


06-10-2002
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TRADEMARK TRIAL AND APPEAL BOARD

