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

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Applicant	Autodesk, Inc.
Applied for Mark	DWG
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Autodesk, Inc.

Serial No. 78852798 (DWG)

Serial No. 78852808 (DWG & DESIGN)

Serial No. 78852813 (DWG TRUEVIEW)

Serial No. 78852822 (DWG TRUECONVERT)

Serial No. 78852843 (DWG EXTREME)

Filed: April 3, 2006

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**APPLICANT'S BRIEF ON APPEAL**

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## I. INTRODUCTION

Applicant is a world leader in developing design software for a variety of industries, including the manufacturing, building and construction industries, and the media and entertainment industries. Since as early as the 1980's, Applicant has developed and distributed software enabling manufacturers, architects, engineers and other design professionals to build two-dimensional and three-dimensional virtual models of buildings, products and other physical objects. Applicant's computer-aided design ("CAD") software is used by industry leaders in manufacturing to design products of all kinds and by architects and engineers to design and build skyscrapers, bridges, aqueducts and other complex projects. Applicant has branded its software with DWG-related marks for years, and users of Applicant's software have created, edited or viewed billions of designs with the software file name ".dwg" for decades.

Applicant is appealing the Examining Attorney's refusal to register the marks DWG, DWG & DESIGN, DWG TRUEVIEW, DWG TRUECONVERT and DWG EXTREME.<sup>1</sup> The Examining Attorney has concluded that DWG is descriptive of the goods claimed in Applicant's applications (collectively, the "Applications") and that Applicant has failed to submit sufficient evidence to establish acquired distinctiveness of DWG under Section 2(f) of the Trademark Act. In particular, the Examining Attorney has refused registration of the mark DWG on the basis of Section 2(e)(i) and, as to the remaining applications, has refused to register them without a disclaimer of exclusive rights to "DWG" apart from the marks as shown.

The Applications were improperly refused. Applicant submitted more than sufficient evidence of acquired distinctiveness of the mark DWG.<sup>2</sup> This evidence includes, among other things, survey evidence, declarations from Applicant, third-party declarations, documentation of a series of DWG-related marks since the 1990's, evidence of DWG-related computer file icons used by millions of users in connection with Applicant's software, sales figures for Applicant's products sold under DWG-related marks and/or using

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<sup>1</sup> On January 25, 2012, the Board consolidated the five appeals together.

<sup>2</sup> Applicant does not concede that the mark DWG is merely descriptive of CAD software, but, given the compelling evidence of acquired distinctiveness in the USPTO record, is not appealing the Section 2(e)(1) refusal.

Applicant's DWG™ technology, evidence of extensive marketplace use of Applicant's .dwg file format for three decades, and repeated references to competing businesses using the designation "dwg" to suggest interoperability with Applicant's industry-leading technology.

"The ultimate test in determining whether a designation has acquired distinctiveness is applicant's success, rather than its efforts, in educating the public to associate the proposed mark with a single source." Trademark Manual of Procedure ("TMEP") § 1212.06(b). Here, as set forth in detail below, Applicant has overwhelmingly succeeded in conditioning the marketplace to associate DWG with Applicant and its software products. The Examining Attorney nonetheless dismisses the record evidence based on the notion -- wholly unsupported -- that trademark applicants cannot establish exclusive rights where, as here, their marks correspond to the name of a popular software file extension. Accordingly, Applicant respectfully requests the Board to reverse the Examining Attorney's refusal to register the five DWG-related marks.

## **II. FACTS**

### **a. AutoCAD® Software**

AutoCAD® software is Applicant's most successful and best-known product. Declaration of Mark Strassman ("Strassman Decl.") ¶ 5. AutoCAD® software is a CAD software program for design and drafting. *Id.* Applicant launched AutoCAD® software in December 1982 and has been developing and distributing the product since then. *Id.* Design professionals use AutoCAD® software to create, edit and view models or images of physical objects such as buildings and consumer products. *Id.* ¶ 6. There have been more than 10 million registered users of AutoCAD® software worldwide, and between 2008 and 2010, the cumulative U.S. total exceeded over 2.5 million. Strassman Decl. ¶ 7; February 23, 2011 Declaration of Shawn Gilmour ("Gilmour Decl. #1") ¶ 4. Applicant's cumulative sales have totaled over \$11 billion, and a substantial portion of that revenue is derived from AutoCAD® software. Strassman Decl. ¶ 8.

### **b. .dwg File Format**

Like many companies' software applications, Applicant's products, including AutoCAD® software, implement file formats for storing user data. A file format is a particular way to encode information for

storage in a computer file. AutoCAD® software and other applications offered by Applicant have created and stored user files in the .dwg computer file format since 1982. *See* Strassman Decl. ¶ 13, Exhibit (“Ex.”) 2; Gilmour Decl. #1 ¶ 18, Ex. 24; Declaration of B. Rustin Gesner (“Gesner Decl.”) ¶ 4.

**c. DWG Technology**

Applicant refers to the technology supporting many of its most successful software products, such as AutoCAD®, as “DWG™ technology.” Strassman Decl. ¶¶ 10 and 16, Ex. 6. Applicant does not share its DWG™ technology with others without a license. *Id.* ¶¶ 2, 10. Some third parties reverse-engineer Applicant’s DWG™ technology and incorporate the .dwg file format into their software products. *Id.* ¶ 18. They do this because, in the marketplace for CAD software, interoperability with Applicant’s industry-leading technology can be an important product feature. *See, e.g.*, Gesner Decl. ¶ 4 (noting that “other software providers may, like Autodesk, use the .dwg computer file format, primarily for the benefit of AutoCAD users, to write files in a format compatible with AutoCAD so they can easily be opened in AutoCAD”).

**d. Applicant’s Promotion and Use of DWG-related Marks**

Since the 1990’s, Applicant has used and/or promoted a number of marks featuring “DWG.” Examples of such marks include 100% PURE AUTOCAD® DWG (AND DESIGN), which was prominently featured on product packaging as early as 1997 (Strassman Decl. ¶ 11, Ex. 2), and the following marks, which were displayed on Applicant’s website as early as 1997: DWG ONLINE, DWG UNPLUGGED<sup>3</sup>, DWG LINKING, AUTODESK VIEW DWGX and 100% PURE AUTOCAD® DWG (Applicant’s May 12, 2008 Office Action Responses (“Response No. 3”), Ex. B; Gilmour Decl. #1 ¶¶ 14 and 15, Exs. 16 and 17). Applicant displayed these marks to millions of customers and potential customers. *Id.* Furthermore, since at

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<sup>3</sup> In its 1996 trademark applications for DWG UNPLUGGED and MAX DWG (Serial Nos. 75156336 and 75125408) Applicant, at the request of the USPTO, agreed to disclaim “DWG” apart from the marks as shown. This disclaimer does not preclude Applicant from demonstrating now that the disclaimed term has achieved acquired distinctiveness. *See, e.g.*, 15 U.S.C. § 1056(b) (“No disclaimer . . . shall prejudice or affect the applicant’s or registrant’s rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall become distinctive of his goods or service.”).

least as early as 2003 Applicant’s users have seen a distinctive file icon prominently displaying the DWG mark every time they open or view a .dwg file created or saved using Applicant’s software, as follows:

Beginning in 2003	Beginning in 2005
	

Gilmour Decl. #1 ¶ 5, Ex. 1. Significantly, these DWG icons have been displayed on the computer screens of millions of users of Applicant’s software. Gilmour Decl. #1 ¶ 5.

**e. Applicant’s Efforts to Police the DWG Mark**

Applicant protects its rights in the mark DWG and has taken actions against third parties who have used or applied to register confusingly similar marks:

- Autodesk, Inc. v. Dassault Sys. Solidworks Corp., Case No. 08-04397-WHA (N.D. Cal., filed Aug. 31, 2009).*** Applicant brought a federal lawsuit against Dassault Systems Solidworks Corporation (“Solidworks”) to, among other things, prevent its use of DWG-related marks. Applicant’s February 24, 2011 Office Action Responses (collectively, “Response No. 4”), Ex. A. The joint consent judgment issued by the Court stated the parties’ acknowledgment of Applicant’s ownership of the DWG mark.<sup>4</sup>
- Autodesk, Inc. v. Solidworks Corp., Case Nos. 91170857 & 92046253 (T.T.A.B., filed May 12, 2006 and Sept. 2, 2006).*** These consolidated proceedings before the Board concerned, among other things, Applicant’s petition to cancel Solidworks’ registration for the mark DWGEDITOR and Applicant’s opposition against Solidworks’ application for the mark DWGGATEWAY. *See* Response No. 4, Ex. D; June 22, 2008 Office Actions (collectively, “Office Action No. 4”). Solidworks surrendered its registration and abandoned its application. Response No. 4, Ex. D.

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<sup>4</sup> The Examining Attorney maintains that “this case is not relevant because it did not rule on trademark infringement nor on the genericness of DWG.” Final Office Action. In fact, recognition of Applicant’s trademark rights in DWG by a major industry competitor should be given considerable weight. Moreover, there is no basis in the record or elsewhere for the suggestion that DWG is somehow generic.

- ***Autodesk, Inc. v. Open Design Alliance, Case No. 92047002 (T.T.A.B., filed Jan. 18, 2007).***  
Applicant petitioned to cancel six registrations for OPENDWG marks owned by the Open Design Alliance (the “ODA”). *See* Response No. 4, Ex. E. The ODA subsequently surrendered its registrations. *Id.*
- ***Autodesk, Inc. v. Softelec GmbH, Case No. 92047083 (T.T.A.B., filed Feb. 14, 2007).***  
Applicant petitioned to cancel the registration for the mark RASTERDWG. *See* Response No. 4, Ex. C. The proceeding terminated in connection with Softelec’s assignment of the registration to Applicant. *Id.*
- ***Autodesk, Inc. v. Oridus, Inc., Case No. 92046492 (T.T.A.B., filed Oct. 18, 2006).*** Applicant successfully petitioned to cancel the registration for the mark DWGCRUISER. *See* Response No. 4, Ex. B.
- ***Autodesk, Inc. v. Open Design Alliance, Case No. C06-1637-MJP (W.D. Wash., filed Nov. 13, 2007).*** Applicant brought a federal lawsuit concerning, among other things, false designation of origin based on the defendant ODA’s unauthorized simulation of Applicant’s TrustedDWG software. Response No. 4, Ex. F. The lawsuit settled pursuant to a consent judgment enjoining the ODA from engaging in the challenged behavior. *Id.*

**f. Applicant’s Trademark Objectives**

Applicant seeks to register its DWG-related marks to secure recognition of its trademark rights and to deter brand confusion in the CAD marketplace. Applicant is not claiming trademark protection in the file format “.dwg” and has no intention of exercising its trademark rights to prevent or restrict others from using the “.dwg” software file format.

**III. PROSECUTION HISTORY**

On April 3, 2006, Applicant filed the Applications. On September 14, 2006, the Examining Attorney issued Office Actions against all five applications. In Office Action No. 1 issued against the application for DWG, the Examining Attorney refused registration based on, *inter alia*, alleged descriptiveness pursuant to

Trademark Act Section 2(e)(1). In Office Action No. 1 concerning the remaining applications, the Examining Attorney refused registration absent a disclaimer for DWG. On March 13, 2007, Applicant filed its responses to Office Action No. 1 (collectively, "Response No. 1"), claiming acquired distinctiveness of DWG under Section 2(f) and presenting survey and other evidence of secondary meaning.

On May 19, 2007, the Examining Attorney issued Office Actions against the Applications (collectively, "Office Action No. 2"). In Office Action No. 2 concerning the application for DWG, the Examining Attorney maintained the Section 2(e)(1) refusal. In Office Action No. 2 concerning the remaining Applications, the Examining Attorney maintained the disclaimer requirement. On September 4, 2007, Applicant submitted responses to Office Action No. 2.

On November 13, 2007, the Examining Attorney issued Office Actions against the Applications (collectively, "Office Action No. 3"), maintaining the determination concerning insufficiency of the evidence of acquired distinctiveness and posing specific questions to Applicant. On May 12, 2008, Applicant submitted Response No. 3. On June 22, 2008, the Examining Attorney issued Office Action No. 4, suspending the Applications pending the outcome of Board proceeding nos. 92047002 and 91170857.

On August 24, 2010, the Examining Attorney issued Office Actions against the Applications (collectively, "Office Action No. 5"), maintaining the Section 2(e)(1) refusal, rejecting Applicant's 2(f) evidence and requesting documentation and information related to certain Board proceedings and federal lawsuits involving Applicant. On February 24, 2011, Applicant filed Response No. 4.

On June 9, 2011, the Examining Attorney issued Final Office Actions against the Applications (collectively, the "Final Office Action"). In the Final Office Action against the application for DWG, the Examining Attorney maintained the descriptiveness refusal, and in the Final Office Action against the remaining Applications he maintained the disclaimer requirement. The Examining Attorney continued to hold that Applicant's Section 2(f) evidence was insufficient.

On October 13, 2011, Applicant filed Requests for Reconsideration (collectively, the “Request”) in which it submitted additional evidence of secondary meaning and evidence of third-party trademark registrations for file format names.

On November 29, 2011, the Examining Attorney issued letters denying the Request (collectively, the “Request Denial”). In the Request Denial issued against the application for DWG, the Examining Attorney maintained the 2(e)(1) refusal. In the Request Denial issued against the remaining Applications, the Examining Attorney maintained the disclaimer requirement. The Examining Attorney maintained the insufficiency of the Section 2(f) evidence.

On December 8, 2011, Applicant timely filed with the Board the Notices of Appeal.

#### **IV. ISSUES ON APPEAL**

1. Whether the name of a file format for computer software can also function as a trademark.
2. Whether Applicant’s claim of acquired distinctiveness for the mark DWG is supported by Applicant’s longstanding and continuous use and promotion of the .dwg file extension and of various DWG-related marks.
3. Whether Applicant has presented *prima facie* evidence of acquired distinctiveness to justify registration of the mark DWG and its other DWG-related marks without a disclaimer.

#### **V. STANDARD OF REVIEW**

The standard of review on appeal is “whether or not, based on the record before the examiner, the examiner’s action was correct.” *In re Bose Corp.*, 227 U.S.P.Q. 1, 4 (Fed. Cir. 1985) (citation omitted).

#### **VI. ARGUMENTS**

The Examining Attorney dismissed much of the record evidence and erroneously concluded that the evidence fails to show secondary meaning. As set forth below, however, there is compelling evidence that Applicant’s use and promotion of the .dwg file format and DWG-related marks for decades have conditioned the marketplace to associate DWG with Applicant’s goods.

**a. A File Format Name Can Function as a Trademark**

In refusing registration, the Examining Attorney apparently takes the position that registration of a trademark corresponding to the name of a file format is fundamentally unsound. In particular, the Examining Attorney refuses to permit registration of Applicant's marks (in some instances without a disclaimer) regardless of any acquired distinctiveness that Applicant may have established. Office Action No. 1 concerning DWG ("DWG is [a] type of format used in CAD design software . . . . As such, Applicant cannot have exclusive rights to it."); Office Action No. 1 ("Applicant must insert a disclaimer of DWG in the application because the phrase is merely descriptive of applicant's goods, DWG being a type of format used in CAD design software."); *see also* Final Office Action ("DWG is the legal equivalent of .dwg and therefore merely describes software which assists in the creation of drawings which use a .dwg file extension."); Request Denial (same). Significantly, the Examining Attorney cites no authority supporting these rationales.

In fact, trademark protection can be extended to a variety of non-traditional marks, including but not limited to: product configuration and design (*In re Weber-Stephen Prods. Co.*, 3 U.S.P.Q.2d 1659, 1670 (T.T.A.B. 1978) (the shape of the Weber grill)), store appearances (*Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776 (1992) (restaurant interiors)), colors (*Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (dry cleaning press pads featuring green gold color)), scents (*In re Clarke*, 17 U.S.P.Q.2d 1238, 1240 (T.T.A.B. 1990) (floral fragrance associated with thread and yarn)), sounds (*In re General Elec. Broad. Co.*, 199 U.S.P.Q. 560, 563 (T.T.A.B., 1978) (clock noise)), telephone number letter combinations (*Dial-A-Mattress Franchise Corp. v. Page*, 11 U.S.P.Q.2d 1644, 1646 (2nd Cir. 1989) (phone numbers ending in 628-8737 for MATTRES)) and Internet domain names (TMEP § 1209.03(m)). The USPTO has treated the names of software file extensions no differently, liberally granting trademark registrations for such names. In particular, the USPTO has registered many marks -- not on the Supplemental Register or based on Section 2(f) -- that also serve as software file extensions: e.g., FBX (Reg. No. 2676937), PAGES (Reg. No. 3044896), JAVA (Reg. No. 2178784), NES (Reg. No. 1721018), X3F (Reg. No. 2939661), DNG & DESIGN (Reg. No. 3484827), BSB (Reg. No. 3026152), SAT (Reg. No. 2342417), DPOF (Reg. No. 3245699), ACL & DESIGN

(Reg. No. 3234097), AIR (Reg. No. 35448718), SGI (Reg. No.2517897), SGI & DESIGN (Reg. No. 2517956), XSI (Reg. No. 2572022) and ZIP (Reg. No. 2806052). Request, Exs. B-P.<sup>5</sup>

Moreover, the Board previously held that a technical format name can function as a trademark. In *In re Fuji Photo Film Co.*, No. 75580709 (T.T.A.B., Dec. 19, 2006) (not precedential), the Board considered whether the mark DPOF, also a technical specification for a digital print order format, could function as a trademark for digital cameras, printers and other Class 9 goods. The Board rejected the Examining Attorney's contention that the term was not registrable due to being "a standardization of file organization," instead holding that "DPOF serves both as an initialism for a method of transferring digital images known as 'digital print order format' and as a mark used to identify goods." *Id.* at 8 and 17. The same rationale applies to Applicant's mark DWG.

Accordingly, the fact that DWG corresponds to the name of a software file extension should not negate its significance as a brand or trademark.

**b. Applicant's Claim of Acquired Distinctiveness Is Supported by Significant, Longstanding and Continuous Use and Promotion of the .dwg File Extension and of Various DWG-related Marks**

Applicant has spent decades conditioning consumers to associate DWG closely with Applicant and/or its software. Applicant's efforts include:

- Beginning with Applicant's first release of AutoCAD<sup>®</sup> software in 1982, Applicant's software has displayed the .dwg file extension every time a user saves a new file or opens a file using

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<sup>5</sup> The Examining Attorney attempts to distinguish the third-party registrations for FBX, PAGES, JAVA, NES, X3F, DNG, BSB, SAT and DPOF (collectively, the "Third-Party Registrations") from the Applicant's marks, stating "none [of the Third-Party Registrations are for marks that] are abbreviations of merely descriptive terms." Request Denial. No evidence is provided to support this contention. In fact, the registration for PAGES claims protection with word processing software, specifically "computer programs for creating, editing and printing documents comprised of text and graphics," strongly suggesting descriptiveness. Request, Ex. C. In any event, abbreviations of descriptive terms are, in fact, registrable. *See* TMEP § 1209.03(h) ("an acronym or initialism cannot be considered descriptive unless the wording it stands for is merely descriptive of the goods or services, and the acronym or initialism is readily understood by relevant purchasers to be "substantially synonymous" with the merely descriptive wording it represents"). There is thus no principled basis for distinguishing Applicant's marks from the Third-Party Registrations.

AutoCAD<sup>®</sup> software (*see* Strassman Decl. ¶ 11);<sup>6</sup>

- Also since 1982, Applicant has displayed the .dwg file extension repeatedly in AutoCAD<sup>®</sup> instruction manuals Gilmour Decl. #1 ¶ 18, Ex. 24);
- Users of Applicant’s AutoCAD<sup>®</sup> software have collectively created, edited or viewed billions of files featuring the .dwg file format, and any such file names including the DWG suffix would have appeared on the users’ computer screens (*see* Strassman Decl. ¶ 11);
- Periodically since 1997, Applicant has used and/or promoted the marks DWG ONLINE, DWG UNPLUGGED, DWG LINKING, AUTODESK VIEW DWGX, 100% PURE AUTOCAD DWG (AND DESIGN) and 100% PURE AUTOCAD DWG (Strassman Decl. ¶ 11, Ex. 2; Response No. 3, Ex. B; Gilmour Decl. #1 ¶¶ 14 and 15, Exs. 16 and 17);
- Since 2003, millions of users of Applicant’s software have seen one of the following file icons prominently displaying the mark DWG every time they open from or view on their computer desktop a file created or saved using Applicant’s software (Gilmour Decl. #1 ¶ 5, Ex. 1):

<b>Beginning in 2003</b>	<b>Beginning in 2005</b>
	

- From 2002 to 2005 alone, the annual number of licensed U.S.-based users of Applicant’s software -- most of whom would have seen one of the two above-cited DWG file icons on their desktops -- consistently exceeded 535,000 users (*see* Gilmour Decl. #1 ¶ 4);
- Since as early as 2006, Applicant has continuously displayed its DWG & DESIGN mark on the product boxes for various software products featuring its DWG<sup>™</sup> technology:

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<sup>6</sup> The Examining Attorney claims, “[B]ecause applicant has no proprietary rights in .dwg as a file extension name, applicant’s use of DWG as a file extension name certainly cannot be used to support registration of DWG as a trademark.” Final Office Action; *see* Request Denial. The Examining Attorney provides no support for this statement.



(Strassman Decl. ¶ 14, Ex. 3; Gilmour Decl. #1 ¶ 7, Exs. 2-10; October 7, 2011 Declaration of Shawn Gilmour (“Gilmour Decl. #2”) ¶ 2, Exs. 1-11); and

- For many years, Applicant has prominently displayed many of the applied-for marks on its various websites, including its primary website at <www.autodesk.com> (Strassman Decl. ¶ 16, Ex. 7; Gilmour Decl. #1 ¶¶ 8-13, Exs. 11-15; *see also* Gilmour Decl. #1 ¶ 8 (noting over 4.7 million unique U.S.-based users visitors to Applicant’s websites between September 1, 2010 and October 30, 2010)).

The Examining Attorney nonetheless maintains that these longstanding and continuous efforts by Applicant are completely irrelevant. Office Action No. 2 (stating “Applicant’s statement that it has been using DWG continuously since the early 1980s *is irrelevant*” and that “use of ‘.dwg’ as a file format . . . *is not relevant* to the acquired distinctiveness of DWG as a trademark”) (emphasis added). There is no support for these extraordinary positions. In actuality, “the issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public. . . .” TMEP § 1212.06. There are no restrictions on how acquired distinctiveness can or should be established. Here, Applicant’s evidence of substantial and ongoing use and promotion of the .dwg file format, of promotion of a series of DWG-related brands, of promotion of DWG desktop icons since at least 2003 and other efforts pre-dating 2005 are of great consequence.<sup>7</sup>

Applicant’s pre- 2005 use of the .dwg file format and DWG-related marks are relevant, for example, as “use analogous to trademark use.” Courts have long-recognized the concept of “use analogous to trademark use,” permitting a party to establish proprietary rights in a mark even when its use falls short of the

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<sup>7</sup> Applicant’s pre-2005 promotion of “.dwg” and DWG-related marks is not inconsistent with its stated first use dates in its application for DWG (November 28, 2005). For the purpose of providing a first use date for the DWG application, Applicant has alleged a date indicating when (“at least as early as”) it first made technical trademark use per USPTO requirements. Applicant’s first use of DWG in other manners came years earlier.

technical use required to obtain a federal trademark registration. See *T.A.B. Sys. v. Pactel Teletrac*, 37 U.S.P.Q.2d 1879, 1881 (Fed. Cir. 1996) (“It is well settled that one may ground one’s opposition to an application on the prior use of a term in a manner analogous to service mark or trademark use.”). Illustrative examples of analogous use include use in advertising, as a trade name, in a grade mark or otherwise in a promotional sense “open and public [and] . . . directed to that segment of the relevant industry or potential consumers.” *Oromeccanica, Inc. v. Ottmar Botzenhardt GmbH & Co.*, 223 U.S.P.Q. 59, 64 (T.T.A.B. 1983).

The Examining Attorney has disregarded Applicant’s evidence of analogous use on the grounds that the theory is inapplicable to *ex parte* proceedings. Final Office Action. Indeed, application of the analogous use doctrine in an *ex parte* proceeding concerning secondary meaning is appropriate because in both an *ex parte* secondary meaning inquiry and in an *inter partes* proceeding, the key issue is whether a brand owner can show it has promoted a term such that the public now associates the term with the owner’s products and services. See *In re Mine Safety Appliances Co.*, 66 U.S.P.Q.2d 1694, 1700 (T.T.A.B. 2002) (reversing refusal to register because applicant’s evidence showed that the relevant market had “come to regard or perceive [applicant’s mark] as identifying and distinguishing a source for such goods”); *National Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 19 U.S.P.Q.2d 1424, 1429 (Fed. Cir. 1991) (noting that “prior public identification” of a party with a mark is required for analogous use). To determine whether a party’s use of a term rises to the level of analogous use, courts ask whether the “use is of such a nature and extent as to create public identification of target term with the [party’s] product or service.” *T.A.B. Sys.*, 37 U.S.P.Q.2d at 1881 (citations omitted). Likewise, in a secondary meaning analysis courts consider whether a party has presented evidence showing “an association formed in the minds of the consumers between the mark and the source or origin of the product.” *Tone Bros., Inc. v. Sysco Corp.*, 31 U.S.P.Q.2d 1321, 1327 (Fed. Cir. 1994) (citations omitted). In fact, at least one federal court has acknowledged the similarities between the analogous use and secondary meaning inquiries. *Archer Daniels Midland Co. v. Narula*, No. 99 C 6997, 2001 WL 804025, \*9 (N.D. Ill. July 12, 2001) (noting whether analogous use achieved a priority right is “another way of saying

that a trade name . . . must be inherently distinctive, or have attained secondary meaning, to be entitled to protection”).

In any event, even if Applicant’s pre-2005 use of the .dwg file format and DWG-related marks is not deemed analogous use, it remains compelling circumstantial evidence of the evolution of secondary meaning for the DWG mark. There is no basis for the Examining Attorney’s extraordinary position that such use -- spanning over two decades -- is “irrelevant” and should be disregarded.

**c. Third-Party Use of “dwg” Enhances the Association of the Mark DWG with Applicant**

Some third parties reverse-engineer Applicant’s DWG™ technology and incorporate the .dwg file format into their CAD software products. Strassman Decl. ¶ 18. “CAD users may sometimes use non-Autodesk packages to create the .dwg file, but if so they typically choose the .dwg format so they can transfer the files to others using Autodesk’s AutoCAD technology.” Declaration of Donnia Tabor-Hanson (“Tabor-Hanson Decl.”) ¶ 4; *see also* Gesner Decl. ¶ 4 (noting that such third-party use of the .dwg file format is “primarily for the benefit of AutoCAD users, to write files in a format compatible with AutoCAD”). These third-party software developers affirmatively use the designation “dwg” to promote to consumers the compatibility of their products with Applicant’s industry-leading technology. Declaration of Larry Swinea ¶ 4 (“I understand that other software providers may, like Autodesk, use the .dwg computer file format. It is my personal opinion that they do this to be compatible with AutoCAD. And I have seen this as a marketing approach.”); *see* Tabor-Hanson Decl. ¶ 4 (“The .dwg file format has always, to my knowledge, been spoken as meaning ‘compatible with AutoCAD.’”). As a result, third-party use of the .dwg file format actually emphasizes the close association of the mark DWG with Applicant.

**d. Applicant Has Presented *Prima Facie* Evidence of Acquired Distinctiveness**

Section 2(f) of the Lanham Act provides that “nothing in this chapter shall prevent the registration of a mark used by applicant which has become distinctive of applicant’s goods in commerce.” 15 U.S.C. § 1052(f). The proper standard for a showing of acquired distinctiveness for publication is merely a *prima facie* showing of distinctiveness. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 6 U.S.P.Q.2d 1001, 1004 (Fed. Cir.

1988) (quoting *In re Industrial Washing Machine Corp.*, 201 U.S.P.Q. 953, 956 (T.T.A.B. 1979) (“A *prima facie* showing of distinctiveness is all that is necessary for publication of the application.”); *In re Capital Formation Counselors, Inc.*, 219 U.S.P.Q. 916, 919-20 (T.T.A.B. 1983) (“[A]n applicant need not conclusively establish distinctiveness but need only establish a *prima facie* . . . warranting publication of the mark. . . .”).

“The ultimate test in determining whether a designation has acquired distinctiveness is applicant’s success, rather than its efforts, in educating the public to associate the proposed mark with a single source.” TMEP § 1212.06(b). To find acquired distinctiveness, the Board may consider, among other things, advertising and promotional materials, sales success, length of use, declarations, unsolicited media coverage and consumer studies. *See In re Steelbuilding.com*, 75 U.S.P.Q.2d 1420, 1424 (Fed. Cir. 2005). “There is no set amount of proof necessary to demonstrate acquired distinctiveness.” *In re Black & Decker Corp.*, 81 U.S.P.Q.2d 1841, 1842 (T.T.A.B. 2006). Instead, determination as to acquired distinctiveness must be based upon a totality of the evidence and excessive weight should not be given to any one factor. *Id.* at 1845.

Here, Applicant has met its burden of presenting a *prima facie* case that relevant consumers view the DWG mark as coming from a single source. Especially in light of the Board’s practice of taking a more permissive stance with respect to the probative value of evidence in an *ex parte* proceeding as compared to in *inter partes* proceeding, the Board should find Applicant’s evidence more than sufficient to establish the required *prima facie* case of secondary meaning. *See* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 1208.

To establish acquired distinctiveness, an applicant may submit direct and circumstantial evidence. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 15:30 (2011) (“*McCarthy*”). Direct evidence “means the actual testimony of buyers as to their state of mind” and includes consumer testimony and surveys. *Id.* Circumstantial evidence addresses the mark owner’s efforts in promoting the mark and can involve length and manner of use, advertising efforts, sales figures, number of customers and

established placed in the market. *Id.* Applicant has introduced into the record both direct evidence and circumstantial evidence.

**i. Direct Evidence of Acquired Distinctiveness**

Applicant submitted significant direct evidence in support of its claim of acquired distinctiveness, namely survey evidence (February 8, 2007 Declaration of E. Deborah Jay (“Jay Decl.”)), and five third-party declarations from accomplished individuals in the CAD field (Response No. 3, Ex. A).

**1. Applicant’s survey strongly supports a *prima facie* case of secondary meaning**

“An expert survey of purchasers can provide the most persuasive evidence of secondary meaning.” *McCarthy* at § 15.30 (quoting *Vision Sports, Inc. v. Melville Corp.*, 12 U.S.P.Q.2d 1740, 1744 (9th Cir. 1989)). Applicant’s survey evidence found that 43% of the relevant consumers associate “DWG” with design software from a single company or source and that 42% of the relevant consumers exclusively associate “DWG” with design software from Applicant and/or with its leading software product, AutoCAD®. Jay Decl. ¶ 3. Such strong results clearly demonstrate a *prima facie* case of secondary meaning. Indeed, secondary meaning has been found in situations where surveys results yielded lower percentiles. *See McNeil-PPC, Inc. v. Granutec, Inc.*, 37 U.S.P.Q.2d 1713, 1716 (E.D.N.C. 1995) (finding a “strong association” sufficient for secondary meaning where a survey revealed 41% of respondent associated the product with a single brand, and 38% of respondents recognized the source at issue); *Shuffle Master Inc. v. Awada*, 83 U.S.P.Q.2d 1054, 1057 (D. Nev. 2006) (finding secondary meaning when survey revealed that 35% of respondents associated the mark with a single source); *see also Thomas & Betts Corp. v. Panduit Corp.*, 46 U.S.P.Q.2d 1026, 1040 (7th Cir. 1988) (holding survey results as low as 30% are probative).

The Examining Attorney erred by giving the survey only “little weight” or “virtually no weight.” *See* Office Action No. 2; Final Office Action. Courts typically consider various factors, such as survey design, experience and reputation of the surveyor and the nature of the questions asked, when assigning how much weight to afford to a survey. *Stuhlberg Int’l Sales Co., v. John D. Brush & Co.*, 240 F.3d 832, 840 (9th Cir. 2001). “The Board is somewhat more lenient in its approach in consideration of surveys in *ex parte*

proceedings than *inter partes* proceedings.” *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929, 1934 (T.T.A.B. 1996); TBMP § 1208. Here, the survey design by a prominent trademark expert employed well-recognized survey standards including but not limited to use of a control group, rotating questions, interviewer training and the use of relevant purchasers as respondents. Jay Decl., Ex. A at 6-10. The firm that performed the survey holds over 25 years of experience conducting large-scale surveys and is considered “one of the oldest and most respected marketing and public opinion research firms in the United States.” Jay Decl., Ex. A at 3.

The Examining Attorney has challenged the nature of certain questions in the survey. These questions are “Do you associate the name or term ‘D-W-G’ with design software from any particular company or companies?” and “Do you associate the name or term ‘D-W-G’ with design software from one company or more than one company?” Jay Decl., Ex. A at 10 (emphasis in original). The Final Office Action states, “[b]ecause the words ‘name’ and ‘term’ used in the survey question could encompass use of DWG as a file format name, this survey does not serve to establish whether consumers of applicant’s goods recognize DWG as a trademark.” Nothing in the survey would suggest to respondents that they were being asked about file formats. Furthermore, even if some of the respondents associated the surveyor’s use of “name or term ‘D-W-G’” with the file extension .dwg, the survey evidence would still be appropriate and compelling. Section VI.a. *supra*. See *McCarthy* § 7.2 (4th Ed. 2006) (“The fact that the owner of a mark uses it in association with accessory symbols or words does not deprive him of what the public recognizes as a mark.”).<sup>8</sup>

## **2. Third-party declarations strongly support a *prima facie* case of secondary meaning**

Applicant’s five third-party declarations, submitted by individuals who have been using CAD software as far back as 1975, strongly support Applicant’s claim of acquired distinctiveness. The Examining Attorney misreads Applicant’s five third-party declarations in order to arrive at the conclusion that they are

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<sup>8</sup> The Examining Attorney also claims that the survey should be given “little weight because ‘.dwg’ is a well-recognized file format for CAD that has been in use for over twenty years” and is now in use by others. Office Action No. 2. In fact, the manner of this third-party use of “dwg” reinforces the marketplace association of DWG with Applicant. See Section VI.c. *infra*.

“hardly compelling evidence of acquired distinctiveness.” *See* Final Office Action. For example, the Final Office Action incorrectly states, “none [of the declarations] distinguish between use of DWG as a file extension name and as a trademark for applicant’s goods.” In actuality, the declarations of Donnia Tabor-Hanson, Thomas Short, Larry Swinea and B. Rustin Gesner all expressly distinguish between, on the one hand, the “term DWG” and, on the other hand, the “.dwg files,” the “.dwg file format” and/or the “.dwg computer file format.” Response No. 3, Ex. A.

**ii. Circumstantial Evidence of Acquired Distinctiveness**

Applicant has also submitted extensive circumstantial evidence of acquired distinctiveness. Some of the circumstantial evidence is highlighted as follows:

- **Use and promotion of .dwg file extension since 1982.** *See* section VI.b. *supra*.
- **Use of DWG-related marks since as early as 1997.** *See id.*
- **Use of DWG file icons on users’ computers since 2003.** *See id.*
- **Placement of DWG & DESIGN mark on Applicant’s packaging.** *See id.*
- **Use of DWG-related marks on Applicant’s website.** *See id.* Traffic on these websites is substantial. From September 1, 2010 to October 30, 2010 alone, over 4.7 million unique users located in the U.S. visited Applicant’s websites. Gilmour Decl. #1 ¶ 8.
- **Third-party use of the .dwg file extension and of “dwg” to communicate compatibility with Applicant’s technology.** Section VI.c. *supra*.
- **Market position.** One hundred percent of Fortune 100 companies use Applicant’s products. Strassman Decl. ¶ 4. Applicant is a Fortune 1000 company, providing software products to over 7 million registered users in all 50 states and worldwide. *Id.* Most of these software products are based on Applicant’s DWG™ technology and incorporate the .dwg file format. *See* Strassman Decl. ¶ 5. Applicant routinely refers to “.dwg” or DWG or some variation in connection with these products. *See, e.g., Id.* ¶ 13.
- **Applicant revenue.** Since 1985, Applicant has realized over \$10 billion in revenue, and a

substantial portion of that revenue is derived from software featuring DWG™ technology, including Applicant’s flagship product, AutoCAD® software. *Id.* ¶ 12.

- **Applicant’s revenue attributed to products featuring DWG™ technology.** The following table shows Applicant’s recent net revenue in the U.S. per fiscal year attributed to Applicant’s products featuring DWG™ technology:

<b>Fiscal Year Ending January 31</b>	<b>Net Revenue in Million USD (to the Nearest Million)</b>
2002	301
2003	238
2004	259
2005	338
2006	409
2007	478
2008	507
2009	464
2010	370

Gilmour Decl. #1 ¶ 3.

- **Number of users of Applicant’s products featuring DWG™ technology.** In order to use Applicant’s software, a customer must obtain a license -- which may grant multiple “seats” -- from Applicant authorizing use of the software. The following table shows the number of seats for products featuring DWG™ technology which Applicant granted to customers in the U.S. per fiscal year:

<b>Fiscal Year Ending January 31</b>	<b>Number of Seats (to the Nearest Thousand)</b>
2002	664,000
2003	535,000
2004	576,000
2005	760,000
2006	847,000
2007	994,000

Fiscal Year Ending January 31	Number of Seats (to the Nearest Thousand)
2008	1,018,000
2009	836,000
2010	690,000

Gilmour Decl. #1 ¶ 4.

- **Dictionary definitions.** Definitions in a number of dictionaries associate DWG and .dwg with Applicant and/or Applicant's software product, AutoCAD®. Gilmour Decl. #2 ¶ 6, Exs. 20-24.

This circumstantial evidence -- in combination with the direct evidence described above -- makes very clear that Applicant has met its burden of establishing a *prima facie* showing of acquired distinctiveness. There is no reason to dismiss this showing, as the Examining Attorney did below.

In sum, the Board should give considerable weight to both Applicant's direct evidence and its circumstantial evidence of acquired distinctiveness. The record covers decades and is exceptional in scope. There should be no question concerning the strong marketplace association of DWG with Applicant and its technology.

## VII. CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board reverse the refusal to register the Applications.

Dated: March 23, 2012

Respectfully submitted,

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