

ttab

Attorney Reference No.: 60038.402901

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

Autodesk, Inc.)
Opposer)
v.)
Dassault Systemes S. A.)
Applicant)

Opposition No.: 91/1586258



02-05-2004

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

Opposer's Response to Motion for a More Definite Statement

Opposer, Autodesk, Inc. responds to the Motion for a More Definite Statement filed by Applicant Dassault Systemes S.A. on 12 January 2004.

Applicant takes the position that the Notice of Opposition in this matter is so vague and ambiguous that Applicant cannot answer effectively. Opposer disagrees. Through both prior communications and the clear wording of the Notice of Opposition itself, the meaning and thrust of the present proceeding have been made abundantly clear.

Nevertheless, in order to make the position of Opposer absolutely clear to the TTAB, as well as Applicant, Opposer sets forth the situation in simple terms, as shown below. If the TTAB desires that this be particularly pleaded in the Notice, so be it, but Opposer asserts that Applicant has already been put on more than adequate notice by the prior pleading.

Multiple Aspects of Applicant's Mark

The mark in issue in this matter, Serial No. 78/068,378, has multiple aspects. The first, and Opposer asserts, the only proper aspect, is the visual appearance itself. To the extent that the mark is a design only, it is unpronounceable, and has no alphanumeric or verbal equivalent.

A second aspect of the mark is the alphanumeric designation of the term. Unlike most logo marks, the present mark is not referred to as “design only” but is rather designated as “3DS” in the USPTO records, databases and search universes.

The third aspect of the mark is a verbal equivalent; being how it is perceived and pronounced. This is a matter of perception (and training) and varies. Some observers will not pronounce the logo at all, seeing it as only a random design. Some might see it as “DS” and pronounce it in this way. Others, particularly if encouraged in this by Applicant, might see and pronounce the term as “3DS”.

“3DS” Interpretation is Ground for Objection and Opposition

Opposer is the owner of a very well known mark **3DS MAX®**. This mark is very strongly associated with Opposer Autodesk, Inc. and is recognized in the field as designating goods of Opposer. Opposer has a strong motivation to prevent any encroachment on its market recognition. To the extent that Applicant’s mark is presented, perceived and pronounced as “3DS” it presents a significant likelihood of marketplace confusion, and registration in such a form must be opposed. Since Applicant and Opposer are direct competitors and the goods appear in the same marketplace the potential for likelihood of confusion and association is very high.

This means that the second aspect of Applicant’s mark, the alphanumeric transliterative aspect, presents a significant problem and is adamantly opposed by Autodesk, Inc. To the extent that it is designated officially as “3DS” and appears as such for search purposes, Applicant’s mark appears to be a third party usage which substantially weakens the scope of protection accorded Opposer as a result of its own registration and use of **3DS MAX®**.

Similarly, the third aspect of the mark, the verbal interpretation, presents a problem. To the extent that users either pronounce the mark as “3DS” or are encouraged to do so by Applicant, likelihood of confusion is introduced into the marketplace and the strength of Opposer’s **3DS MAX®** mark is eroded. This also provides ample ground for opposition.

While it could possibly be said that Opposer gives up too much by indicating that the visual aspect of the mark does not provide grounds for objection, this has been the position taken. To Opposer’s view and perception, the

visual aspect of the mark does not correspond to the transliterate or verbal aspects which cause problems. Rather, Opposer believes that, so long as there is no active effort by Applicant to cause to consumers to think of the mark as “3DS” then such an association is unlikely to form and confusion will be avoided.



The visual mark as it appears above is not, in Opposer’s view, readily seen as being “3DS”. The “S” portion is, of course, apparent. However, substantial imagination is required for an observer to determine that the left portion of the image can be interpreted as “3d”. It is for this reason that Opposer has charitably suggested that the present Opposition need not be treated as a total rejection of the mark, but rather as to the transliteration and the encouraged pronunciation of the mark.

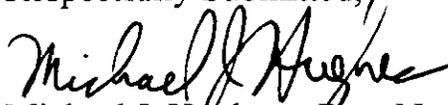
Of course, to the extent that either Applicant or the TTAB insists that the mark really does mean “3DS” then Opposer must take the position that such is too similar to Opposer’s mark and is unworthy of registration. Accordingly, if Applicant chooses to defend the transliteration and refuses to agree to avoid fostering treatment of the mark as being the equivalent of “3DS” then Opposer must reluctantly pursue complete opposition to the mark, rather than the less disruptive partial opposition suggested in the original Notice.

Conclusion

Opposer believes that its position and the grounds for opposition have been sufficiently clearly stated such that no “more definite statement” is required under the applicable federal procedures. Further, Opposer asserts that the meaning and scope of the procedure are clearly understood by Applicant.

Nonetheless, Opposer recognizes that the requested remedy in the this case, the removal of the misleading and conflicting transliteration from the mark in question, is not one of which Opposer is aware of precedent. Accordingly, if the Board believes that an alternative wording of the pleadings is required, Opposer seeks guidance in how such can be crafted. It is submitted that the meaning and intent is clear to all, so the only issue may be to articulate it properly. On the other hand, if objection to the transliterative and verbal aspects alone is not deemed permissible, then Opposer will oppose the mark in its entirety.

Respectfully Submitted,



Date: 02 February 2004

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Opposition No. 91/158625
Logo mark ("3DS"?)
Response to Motion for More Definite Statement

Serial No.: 78/069378
Filed: 15 June 2001
Att. Ref.: 60038.402901

OPPOSITION NAME: Autodesk, Inc. vs. Dassault Systemes S.A.
OPPOSITION NO.: 91/1586258

PROOF OF SERVICE

The undersigned certifies and declares as follows:

I am over 18 years of age and am not a party to this action. My business address is 1901 South Bascom Avenue, Suite 660, Campbell, California 95008, which is located in the county where any non-personal service described below took place.

On 02 February 2004, a copy of the following document:

Opposer's Response to Motion for a More Definite Statement

was served on the following:

Served on:

Howard S. Michael
BRINKS HOFER GILSON & LEONE
P.O. Box 10395
Chicago, Illinois
60610

Represented party:

Applicant: Dassault Systemes S.A

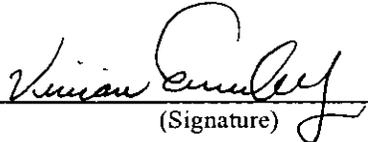
Service was accomplished as follows:

[xx] By First Class Mail, Postage Prepaid, According to Normal Business Practices. On the above date, at my place of business at the above address, I sealed the above document(s) in an envelope addressed to the above, and I placed that sealed envelope for collection and mailing following ordinary business practices, for deposit with the U.S. Postal Service. I am readily familiar with the business practice at my place of business for the collection and processing of correspondence for mailing with the U.S. Postal Service. Correspondence so collected and processed is deposited with the U.S. Postal Service the same day in the ordinary course of business, postage fully prepaid.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on 2 February 2004.

Vivian Emberley



(Signature)

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On 02 February 2004, an original and three copies of the following document:

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were served on the following:

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Commissioner for Trademarks
BOX: TTAB, NO FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

Service was accomplished as follows:

[xx] **By First Class Mail, Postage Prepaid, According to Normal Business Practices.** On the above date, at my place of business at the above address, I sealed the above document(s) in an envelope addressed to the above, and I placed that sealed envelope for collection and mailing following ordinary business practices, for deposit with the U.S. Postal Service. I am readily familiar with the business practice at my place of business for the collection and processing of correspondence for mailing with the U.S. Postal Service. Correspondence so collected and processed is deposited with the U.S. Postal Service the same day in the ordinary course of business, postage fully prepaid.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on 2 February 2004.

Vivian Emberley


(Signature)