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

Proceeding	91174972
Party	Plaintiff SolidWorks Corporation SolidWorks Corporation ,
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Submission	Opposition/Response to Motion
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Signature	/miriamlpogach/
Date	01/29/2007
Attachments	Solidworks' Opposition to Autodesk's Motion for Suspension of Proceedings.pdf (11 pages)(329366 bytes)

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

SOLIDWORKS CORPORATION, Opposer, v. AUTODESK, INC., Applicant.	Opposition No. 91174972 Application Serial No. 78852849 Mark: DWGX
SOLIDWORKS CORPORATION, Opposer, v. AUTODESK, INC., Applicant.	Opposition No. 91175197 Application Serial No. 78852836 Mark: REALDWG

SOLIDWORKS' OPPOSITION TO AUTODESK'S
MOTION FOR SUSPENSION OF PROCEEDINGS

Opposer, SolidWorks hereby opposes the motion for suspension filed by Applicant, Autodesk in Opposition Nos. 91174972 and 91175197. SolidWorks urges denial of the instant motion in favor of consolidating the pending related matters on an expedited schedule, as requested in a companion motion filed herewith.

A. History of the Dispute

SolidWorks is the owner of Application Serial No. 78651780 for the mark DWGGATEWAY and Registration No. 3134536 for the mark DWGEDITOR, both used in connection with its computer software for computer-aided design. Both applications were filed on June 16, 2005 and claim priority to Autodesk's applications for REALDWG (Application Serial No. 78852836) and DWGX (Application Serial No. 78852849).

Autodesk has opposed Application Serial No. 78651780 for the mark DWGGATEWAY (Opposition No. 91170857) and has petitioned to cancel Registration No. 3134536 for the mark DWGEDITOR (Cancellation No. 92046253). Both the notice of opposition and the petition for cancellation are based on Autodesk's assertion of some form of prior rights to the term "DWG" and claim that SolidWorks' marks are confusingly similar to that term. In its answers, SolidWorks raised affirmative defenses that the term DWG is generic and that to the extent either party has rights in marks incorporating DWG, SolidWorks has priority. On November 4, 2006, the Board granted SolidWorks' consented to motion for consolidation of these proceedings. Around this time, lead counsel for SolidWorks, John Welch, left Foley Hoag to practice at another law firm. Declaration of Miriam L. Pogach, ¶ 2. The parties did not exchange documents responsive to the first set of document requests until approximately a month ago, December 20, 2006. *Id.* Exs. A, B. Neither party has noticed a deposition nor have any depositions been taken. *Id.* ¶ 5.

In the meantime, Autodesk's applications to register the marks DWGX and REALDWG, Application Serial No. 78852849 and Application Serial No. 78852836 respectively, were published in the *Official Gazette*. SolidWorks opposed these applications on January 5, 2007 and January 18, 2007, Opposition Nos. 91174972 and 91175197, based on its prior rights in DWGGATEWAY and DWGEDITOR. In its answers to these notices of opposition, Autodesk asserted superior rights to "DWG" as an affirmative defense. On January 22, 2007, Autodesk moved to suspend Opposition Nos. 91174972 and 91175197, requesting that the Board delay those matters until resolution of the consolidated proceeding. SolidWorks hereby opposes Autodesk's motion for suspension in favor of consolidating the three proceedings as requested in SolidWorks' motion to consolidate.

B. Discussion

SolidWorks and Autodesk appear to be in agreement that the instant oppositions involve questions of fact and law common to the consolidated proceeding. SolidWorks argues in its Motion to Consolidate its oppositions to DWGX and REALDWG with the consolidated proceeding that

> determination of the parties' respective rights hinge on the same questions: whether Autodesk has any rights to the phrase "DWG" and if so, whether those rights are prior to those of SolidWorks. Furthermore, the proceedings all involve the same parties, closely related marks and identical or closely related goods, as all of the applications in question seek to register marks incorporating the term "DWG" used in connection with computer software for computer-aided design and manufacturing. The registration in question likewise pertains to a mark incorporating DWG for use in connection with computer software for computer-aided design and manufacturing.

(SolidWorks' Motion to Consolidate, at 3-4.) Autodesk similarly recognizes in its Motion for Suspension that the key issues to be determined in both the instant oppositions and the consolidated proceeding are "(i) whether the term 'DWG' is generic; and (ii) if not, whether [Autodesk] or [SolidWorks] has trademark priority." (Autodesk's Motion for Suspension of Proceedings, at 5.) Consequently, whether consolidation or suspension is preferable depends on which course of action is the most logical and efficient.

Here, consolidation is the prudent option over suspension, due to the relatively early stage of the other proceedings and the desirability of resolution of the related issues in one forum in which both Autodesk's and SolidWorks' arguments as respective applicants/registrants can be addressed together. The efficiency advantages are explained in further detail in SolidWorks Motion to Consolidate and to Set Accelerated Schedule for Discovery and Testimony Periods. In order to avoid duplicating the arguments therein in the instant brief, SolidWorks refers the Interlocutory Attorney to that Motion. Based on the arguments set forth therein, SolidWorks respectfully requests that the Board deny Autodesk's Motion for Suspension of Opposition Nos.

91174972 and 91175197 in favor of consolidation and accelerated discovery as requested in SolidWorks' Motion to Consolidate and to Set Accelerated Schedule for Discovery and Testimony Periods.

Respectfully submitted,

SOLIDWORKS CORPORATION

Charles E. Weinstein
Michael P. Boudett
Miriam L. Pogach
Foley Hoag LLP
155 Seaport Blvd.
Boston, MA 02210
(617) 832-1000

Dated: January 29, 2007

CERTIFICATE OF SERVICE

I hereby certify that a true copy of SolidWorks Opposition to Autodesk's Motion for Suspension of Proceedings and the supporting Declaration of Miriam L. Pogach were served on upon

John Slafsky
Brian Mendonca
Wilson Sonsini Goodrich & Rosati PC
650 Page Mill Road
Palo Alto, CA 94304

by first class mail on this date of January 29, 2007.

Geraldine MacLellan

Geraldine MacLellan

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

SOLIDWORKS CORPORATION, Opposer, v. AUTODESK, INC., Applicant.	Opposition No. 91174972 Application Serial No. 78852849 Mark: DWGX
SOLIDWORKS CORPORATION, Opposer, v. AUTODESK, INC., Applicant.	Opposition No. 91175197 Application Serial No. 78852836 Mark: REALDWG

DECLARATION OF MIRIAM L. POGACH IN SUPPORT OF SOLIDWORKS' OPPOSITION TO AUTODESK'S MOTION FOR SUSPENSION OF PROCEEDINGS

I, Miriam L. Pogach, declare:

1. I am an attorney at law licensed to practice in the Commonwealth of Massachusetts. I am associated with the law firm of Foley Hoag LLP, counsel of record for SolidWorks Corporation. I make this declaration based on personal knowledge of the following facts.

2. On or about November 1, 2006, John Welch, Esq. left his employment as counsel at Foley Hoag LLP. He is currently employed at Lowrie, Lando & Anastasi, LLP in Cambridge, Massachusetts. Up until his departure, Attorney Welch handled Opposition No. 91170857 (regarding DWGGATEWAY) and Cancellation No. 92046253 (regarding DWGEDITOR) on

behalf of SolidWorks. Neither myself nor Michael Boudett, a partner at Foley Hoag, had any involvement in these proceedings until approximately a week and a half following Attorney Welch's departure.

3. Exhibit A is a true and accurate copy of a letter dated December 20, 2006 that I sent to counsel for Autodesk enclosing documents that SolidWorks produced in response to Autodesk's First Request for Production of Documents and Things.

4. Exhibit B is a true and accurate copy of a letter dated December 20, 2006, received by counsel for SolidWorks from Brian Mendonca enclosing documents that Autodesk produced in response to SolidWorks' Requests for the Production of Documents and Things.

5. As of January 29, 2007, the date of this declaration, SolidWorks has neither noticed nor taken any depositions in Opposition No. 91170857 or Cancellation No. 92046253. As of this date, counsel for SolidWorks has not been served with any notices of depositions by counsel for Autodesk nor has Autodesk taken any depositions in either of those proceedings.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct. This declaration was executed on January 29, 2007.

Miriam L. Pogach

EXHIBIT A

FOLEY
HOAG LLP
ATTORNEYS AT LAW

Miriam Pogach
Boston Office
617.832.3025

December 20, 2006

John Slafsky
Wilson Sonsini Goodrich & Rosati PC
650 Page Mill Road
Palo Alto, CA 94304-1050

Re: Autodesk v. SolidWorks: TTAB Nos. 91170857, 92046253

Dear John:

Enclosed for production in the above-mentioned proceedings, please find documents bearing Bates numbers SD-000001 through SD-000704. These documents have been produced in response to Autodesk's First Request for Production of Documents and Things to SolidWorks.

Several of these documents are marked "confidential" or "commercially sensitive" in accordance with Provision (1) of the Protective Order between the parties. Thus, they are to be treated in accordance with the guidelines set forth in the Protective Order.

Sincerely,

Miriam Pogach

cc: Mike Boudett

B3295058.1

EXHIBIT B

WSGR Wilson Sonsini Goodrich & Rosati
PROFESSIONAL CORPORATION

650 Page Mill Road
Palo Alto, CA 94304-1050
PHONE 650.493.9300
FAX 650.493.6811
www.wsgr.com

December 20, 2006

Via Overnight Delivery

Michael P. Boudett
Miriam L. Pogach
Foley Hoag, LLP
Seaport World Trade Center West
155 Seaport Boulevard
Boston, Massachusetts 02210-2600

Re: Autodesk v. SolidWorks (TTAB No. 91170857)

Dear Michael and Miriam:

Enclosed please find Autodesk's first production of documents in response to SolidWorks' Requests for the Production of Documents and Things. The enclosed documents are numbered A000001-A009101. Please note that many of the documents in Autodesk's production have been designated "trade secret/commercially sensitive" pursuant to the Protective Order in this matter and should be treated accordingly.

Our investigation in this matter is ongoing, and we will promptly produce any additional responsive documents we discover.

Very truly yours,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

Brian G. Mendonca