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

Proceeding	92047002
Party	Defendant Open Design Alliance
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Date	07/28/2008
Attachments	Opp to Motion to Amend Public.pdf (96 pages)(3055176 bytes)

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

In the matter of
Trademark Registration Nos. 2517750, 2563976, 2656757, 2672409, 2719529, 2920269
Marks: OPENDWG and OPENDWG and Design

AUTODESK, INC. Petitioner, vs. OPEN DESIGN ALLIANCE Respondent.	Cancellation No. 92047002 **RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO AMEND PETITION FOR CANCELLATION**

INTRODUCTION

While the Open Design Alliance (the "ODA") is confident that Autodesk will be unable to meet its burden to prove any likelihood of confusion between RASTERDWG (or the other purported Autodesk DWG-related marks) and any OPENDWG mark, the ODA does not oppose Autodesk's amendment to identify these marks. However, Autodesk has already had more than enough time to pursue discovery with respect to these marks, having purportedly acquired rights in all but the RASTERDWG marks long before this petition was first filed, and having purportedly acquired the RASTERDWG mark in January of 2008. Since the alleged date of the RASTERDWG acquisition, Autodesk has had a 60 day period of re-opened discovery in which to explore its claims. Accordingly, the ODA opposes any attempt to reopen discovery on account of such claims. As to Autodesk's proposed amendments sounding in fraud, these lack any good faith basis, would be entirely futile, and serve only to unnecessarily delay resolution of this proceeding. Such amendments should not be permitted by the Board.

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BACKGROUND

A. Parties and Marks

Autodesk is a publicly-traded software and services company in the computer-aided design ("CAD") industry. Autodesk, as well as numerous other software providers, distribute software products and services in connection with a file format called DWG, a format which enables the storage of two and three dimensional design data. Rubel Decl. Ex. 1 (Van der Weide Decl.) at ¶ 4.[1] Such files are saved with the file extension ".dwg", which stands for "drawing." *Id.* DWG is a standard format used by most companies operating in the CAD industry to store drawing files, and it would be extremely difficult for a software developer to compete in the CAD market without being able to generate DWG files. *Id.* at ¶ 5. Autodesk did not create the DWG file format, but it does control the file specification and has refused to allow others access to that format. *Id.* at ¶ 4. Autodesk first sought trademark registration for DWG in 2006, and its applications remain unpublished by the United States Trademark Office, having been suspended pending resolution of this and other proceedings. Rubel Decl. ¶ 3, Ex. 2.

The ODA is a non-profit association of software developers and users formed in 1998 for the purpose of promoting the DWG format as an open standard, available to all. Rubel Decl. Ex. 1 (Van der Weide Decl.) at ¶ 6. To this end, the ODA develops and provides products and services that enable its members to read and write DWG files, a critical capability for those hoping to market CAD software. *Id.* The ODA's products and services include the OpenDWG Toolkits and Viewkits and support thereof, which the ODA has provided continuously to members via its members-only website and at times on distributed CDs since 1998. *Id.* at ¶ 7; Rubel Decl. ¶ 6, Ex. 5 (July van der Weide Depo. at 78:4-79:22); Yares Decl. ¶ 6. The ODA filed its OpenDWG applications with the United States Patent and Trademark Office in 1998, claiming a date of first use of February 1998. Rubel Decl. Ex. 1 (Van der Weide Decl.) at ¶ 8.

The ODA currently holds two registered marks incorporating OpenDWG: a Class 9 mark

[1] References to the "Van der Weide Decl." refer to the declaration of Arnold van der Weide submitted on January 16, 2008 in support of the ODA's Opposition to Autodesk's Motion for an Order regarding Various Discovery Issues. For the Board's convenience, a copy of this Declaration is resubmitted here. Rubel Decl. ¶ 2, Ex. 1.

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for software and a Class 42 service mark for software services. Rubel Decl. ¶¶ 7, 8, Exs. 6; 7.[2] The ODA submitted its original filing for a Class 42 service mark with the following description: "consulting services in the field of computer software and computer software tools and standards; providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information." This description was submitted in February of 1998, seven months before the release of the notes to the to the Trademark Acceptable Identification of Goods and Services Manual cited in Autodesk's Motion for Leave to Amend Petition for cancellation ("Motion for Leave"). Motion for Leave at 10.

At the time of its submission of a Statement of Use in support of its Class 42 service mark in 2001, the Examiner raised the very concern now cited by Autodesk – namely, that the ODA was a content provider rather than a link provider, hence could not qualify for a service mark under the given description. Rubel Decl. ¶ 10, Ex. 9 at p. 2. The ODA requested reconsideration, arguing that it "provides a method for its members to exchange data, specifically computer aided design drawings," hence should "sufficiently comply with providing a 'link' for the transfer of information." *Id.*; Rubel Decl. ¶ 11, Ex. 10 at 3). Hence, the Examiner was fully apprised of the nature of the ODA's services, and concluded that notwithstanding the fact that the ODA was not an ISP along the lines of an America Online, and notwithstanding the September 17, 1998 notes to the Trademark Acceptable Identification of Goods and Services Manual, the OpenDWG service mark could be registered. Rubel Decl. ¶ 8, Ex. 7. Autodesk has submitted no evidence suggesting that the description provided to the Examiner – that the ODA provides a "method for its members to exchange data" – was in any way false.

B. Procedural History

On December 11, 2007, Arnold van der Weide, President of the ODA and native of the Netherlands, was deposed by Autodesk. Rubel Decl. Ex. 1 (Van der Weide Decl.) at ¶¶ 1, 2, 19. As Mr. van der Weide testified in his deposition, he did not join the ODA until 2006, and as he indicated in many instances, he was unaware of what transpired prior to his tenure at the ODA.

[2] The ODA originally held a total of six marks, all filed in 1998, but has canceled four (bearing Registration Nos. 2656757, 2672409, 2563967, and 2920269). Rubel Decl. ¶ 9, Ex. 8.

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Rubel Decl. ¶ 4, Ex. 3 (December van der Weide Depo. 18:3-8, 51:9-24; 70:23-71:4; 146:12-18; 167:15-17). He referred Autodesk to the previous President, Evan Yares as one who would be more knowledgeable about pre-2006 events. *Id.* English is not Mr. van der Weide's first language, and upon review of his deposition transcript, he realized he had misunderstood certain questions, and had given responses that were inaccurate regarding the period preceding his time at the ODA. Rubel Decl. ¶ 6, Ex. 5 (July van der Weide Depo. 128:12-130:7). Upon completing his review and conferring with knowledgeable individuals, Mr. van der Weide submitted timely errata to his deposition. In those errata, Mr. van der Weide clarified that the ODA had indeed offered CDs containing its OpenDWG software since 1998, and that the ODA was not in the hands of Visio in 1998. Rubel Decl. ¶ 5, Ex. 4 at p. 2. *See also* Rubel Decl. ¶ 6, Ex. 5 (July van der Weide Depo. 79:1-22; 111:2-112:17).

In a June 10 Order from the TTAB, Mr. van der Weide was ordered to appear for a continuation of his deposition, which occurred July 22, 2008. At that deposition, Mr. van der Weide again clarified that the ODA had offered CDs containing its OpenDWG software during the early years of the organization, and that the ODA was not in the hands of Visio in 1998. Rubel Decl. ¶ 6, Ex. 5 (July van der Weide Depo. 79:1-22; 111:2-112:17). Mr. Yares, who was the President of the ODA from 1998 through 2006, further confirmed that the ODA was in existence in 1998, and that contrary to Autodesk's new allegations, the ODA did offer its OpenDWG software on CDs, as indicated in its 2001 Statement of Use. Yares Decl. ¶¶ 1-5. Accordingly, there is currently no evidence in the record, other than an erroneous and since repeatedly-corrected initial deposition transcript, to support Autodesk's allegations that the ODA did not exist in 1998 or did not offer CDs as represented to the Trademark Office.

Autodesk claims to have acquired trademark rights in RASTERDWG in January of 2008, and on that basis seeks leave to amend. On June 10, 2008, discovery in this matter was reopened through August 22, 2008, and Autodesk was free to seek additional discovery regarding RASTERDWG during that period. The ODA was also ordered to provide its 30(b)(6) witness for further deposition. On July 16, 2008, the ODA advised Autodesk that as the ODA was a non-profit organization with very limited resources, it would be prohibitively burdensome to

undertake a third trans-Atlantic deposition, and so Autodesk counsel should pose any questions regarding the proposed amended claims, including any questions about RASTERDWG, at the July 22 deposition. Rubel Decl. ¶ 12, Ex. 11. Mr. van der Weide did testify regarding RASTERDWG at his July 22 deposition. Rubel Decl. ¶ 6, Ex.5 (July van der Weide Depo. 138:4-139:16).

Autodesk has offered no explanation as to why it could not have named its other purported marks (DWG, DWG and Design, REALDWG, DWG TRUEVIEW, DWG TRUECONVERT, DWGX and DWG EXTREME) in its original Petition. TARR records reflect that all of these were filed before this Petition, and accordingly could have been included at the outset of this proceeding. Rubel Decl. ¶¶ 3, 13, Exs. 2; 12; 13; 14; 15; 16; 17.

ARGUMENT

Autodesk provides two bases to justify amending its petition. First, it cites to its acquisition in January of the rights to the RASTERDWG mark. Second, it alleges fraud by the ODA in the acquisition of the OPENDWG marks. While the ODA does not oppose Autodesk's proposed amendment regarding RASTERDWG, each of the arguments Autodesk makes in support of its allegations of fraud fails on its face, is entirely futile and should not be permitted. Even were the allegations of fraud disputable—which they are not—many of Autodesk's arguments have been rendered moot because the ODA has voluntarily abandoned its collective and design marks.

I. AUTODESK'S ALLEGATIONS OF FRAUD LACK ANY GENUNE FACTUAL BASIS AND ARE SO WHOLLY WITHOUT MERIT THAT THEY ARE FUTILE AND SHOULD NOT BE PERMITTED.

The general rule allowing free amendment of pleadings does not apply when the amendment would be an exercise in futility because the amended pleading would also be subject to dismissal or a motion to strike. *See, e.g., In re Fritz Cos. Secs. Litig.*, 282 F. Supp.2d 1105, 1111 (N.D. Cal. 2003). Futility includes "the inevitability of a claim's defeat on summary judgment." *State of Cal. v. Neville Chem. Co.* 358 F.3d 661, 673-674 (9th Cir. 2004), *cert. denied*, 543 U.S. 869 (2004). Futility of the amendment alone can justify the denial of a motion for leave to amend and the opposing party need not demonstrate that it will be prejudiced by the

amendment. *Nunes v. Ashcroft*, 375 F.3d 805, 808-810 (9th Cir. 2004), *cert. denied*, 543 U.S. 1188 (2005). Here, each of Autodesk's reasons for amending to allege fraud are completely without merit, and are futile upon even a cursory examination, as they rely entirely on a distortion of the record that directly contradicts the undisputable facts. The proposed claims are perfect exemplars of claims that would "inevitably" be defeated and thus should not be permitted to delay and unduly expand this proceeding.

A. Autodesk Misrepresents Deposition Testimony and Ignores Indisputable Public Documents Regarding the ODA's Early Existence.

First Autodesk alleges that the ODA (then-known as the OpenDWG Alliance) did not exist in 1998 and therefore could not have offered goods or services at the time of its trademark registrations. Motion at 9-10. Autodesk makes these arguments on the basis of its own selective interpretation of deposition testimony that cannot be given the slightest credence. Autodesk relies on the ODA's 30(b)(6) witness' testimony regarding when the organization became a "real organization" to suggest that it didn't exist in 1998. *Id.* This is absurd. The witness explains immediately thereafter that what he meant by a "real organization" is one that has its own internal software developers. Rubel Decl. ¶ 4, Ex. 3 (December van der Weide Depo. at 58:14-19). Clearly an organization can exist while relying on outside developers, and the ODA's witness did not testify otherwise. Moreover, the snippet of testimony that forms Autodesk's sole basis for this proposition was corrected. Autodesk hinges its argument on Mr. van der Weide's statement that the ODA was "in the hands of Visio" in 1998, but this was corrected in the errata to state 1997 rather than 1998. Rubel Decl. ¶ 5, Ex. 4 at p. 2.

Further, it is simply beyond dispute that the ODA existed in early 1998, as can be demonstrated by public press releases made at the time. Rubel Decl. ¶¶ 14, 15, Exs. 18; 19. One press release, issued on March 30, 1998, indicates that:

- the OpenDWG Alliance's membership had reached 2,000 members as of that date;
- the OpenDWG Alliance was founded on Feb. 11, 1998;
- the www.OpenDWG.org website had been visited by over 18,000 individuals in the five weeks since the Alliance was announced;

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- the OpenDWG Alliance's first board of directors meeting occurred on March 23, 1998;
- at the March 23, 1998 meeting, the OpenDWG Alliance elected a chairman, president, vice president, a secretary/treasurer, and a chief technologist;
- the OpenDWG Alliance was structured as a nonprofit Washington state corporation; and
- the OpenDWG Alliance's board of directors consisted of 15 elected individuals.

Rubel Decl. ¶ 14, Ex. 18. Another online publication similarly reported on February 17, 1998 of the creation of the ODA and its offerings of the OpenDWG Toolkit. Rubel Decl. ¶¶ 15, 6, Exs. 19; 5 (July van der Weide Depo. 111:2-112:17). The former President of the ODA has confirmed the existence of the ODA in 1998 as well, and the ODA's Washington state incorporation documents, which are publicly available, also make clear that the ODA was incorporated on February 4, 1998. Yares Decl. ¶¶ 1-2; Rubel Decl. ¶ 16, Ex. 20. Autodesk's far-flung argument that the ODA did not exist in 1998 rests entirely on an error in deposition testimony, since corrected by the deponent both in errata to the first transcript and in his subsequent deposition. Rubel Decl. ¶¶ 4, 5, 6, Exs. 3 (December van der Weide Depo. 58:4-21); 4 at p.2; 5 (July van der Weide Depo. 111:2-112:17). Autodesk's proposed new fraud allegation to this effect flies in the face of all evidence and is so utterly unsupported that it is a futile basis upon which to argue for amending its petition for cancellation. No amendment should be permitted on such grounds.

B. Autodesk Ignores Corrected Deposition Testimony Regarding Distribution of CDs.

Autodesk also argues it should be permitted to amend based on fraud because the ODA previously submitted affidavits of use showing use of the OPENDWG marks on CD labels. Motion for Leave at 10. Autodesk's allegation is that the ODA never distributed CDs and thus that some of the ODA's specimens of use showing CD labels are fraudulent. *Id.* Autodesk relies on deposition testimony in which the ODA's 30(b)(6) witness, who was not involved with the organization prior to 2006, explained that all software distributed by the ODA is downloaded from its website, not distributed by CD. *Id.* While the ODA, *now*, only provides software via

internet downloads, it *did* provide CDs at the time of the relevant statements of use, something made plain both by the 30(b)(6) witness' errata and during the continuation of his deposition in July of 2008. Rubel Decl. ¶¶ 5, 6, Exs. 4 at p.2; 5 (July van der Weide Depo. 79:1-22). Moreover, the President of the ODA at the time, Mr. Yares, has confirmed that CDs containing the ODA software were in fact distributed in the early years of the organization, as represented to the trademark Office. Yares Decl. ¶ 3-5. Autodesk thus attempts to take advantage of a simple confusion over the time period at issue—which was already repeatedly corrected—in order to make a baseless claim of fraud. Such an amendment is futile and should not be permitted to waste Respondent's or the Board's time.

C. Autodesk Ignores Documents Filed Publicly Before the Trademark Office.

Autodesk also alleges that the ODA committed fraud by registering services in Class 42 under the description "Providing multiple user access…" Over the years, the Trademark Office's Acceptable Identification of Goods and Services Manual has undergone significant changes with respect to that category of marks. However, the ODA could not have been more clear as to what services it provided when making these applications, and indeed, its application was initially denied for precisely the reason now raised by Autodesk – that the ODA is a content provider and not a traditional ISP. Rubel Decl. ¶ 10, Ex. 9.

In a public filing, available on the USPTO website, the ODA made a motion for reconsideration in response to the Examiner's concern surrounding precisely the language highlighted in Autodesk's motion for leave to amend. Rubel Decl. ¶ 11, Ex. 10; Yares Decl. ¶ 5. That motion for reconsideration made plain what the ODA's services entailed, but argued that notwithstanding the fact that the ODA was not a traditional ISP, it nevertheless did provide "a method for its members to exchange data, specifically computer aided design drawings." Rubel Decl. ¶ 11, Ex. 10 at 3. The ODA argued that this "should sufficiently comply with providing a 'link' for the transfer of information," and the Trademark Office ultimately granted the ODA the OPENDWG marks on that basis. Autodesk has presented no evidence to contradict that the ODA indeed provided a method for its members to exchange data.

There could be nothing further from fraud than the openness with which the ODA

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represented its services before the Trademark Office. The nature of the ODA's services was made extremely clear to the Examiner, the Examiner raised Autodesk's new concern about the parameters of a service mark based on "providing multiple user access," but was ultimately satisfied upon further briefing that the ODA's services did qualify for a Class 42 service mark. Autodesk has simply failed to read the publicly-available documents regarding this issue. Any amendment on this basis would be futile. While Autodesk may disagree with the Examiner's decision to grant the registration, it can hardly charge the ODA with fraud simply because the Examiner found that the ODA's fully disclosed services qualified for service mark registration. It is plain from the complete case history that the ODA was completely forthright in describing what services it rendered and in arguing that such services were rightly described by the "Providing multiple user access..." description, thus no claim of fraud can possibly succeed and amendment on such basis would be futile.

II. AUTODESK'S ARGUMENTS REGARDING THE ODA'S COLLECTIVE OPENDWG MARKS ARE MOOT.

Finally, Autodesk makes several arguments based on the ODA's collective marks. There is no substance to these allegations either, but more importantly, those arguments are moot, as the ODA has abandoned its collective and design marks.[3] Rubel Decl. ¶ 9, Ex. 8. Thus it would be futile for Autodesk to amend in order to allege such claims.

III. DISCOVERY SHOULD NOT BE REOPENED

Autodesk has had ample time during reopened discovery to conduct discovery relating to RASTERDWG and its other newly identified marks, and was in fact explicitly invited to depose Mr. van der Weide regarding the proposed amended claims. Indeed, most of these marks were purportedly in Autodesk's control since well before the original Petition was filed, although Autodesk for some reason elected initially to allege simply that it held unspecified "DWG-related" marks. Autodesk has not explained why it could not have already conducted any necessary discovery relating to these marks, which (with the possible exception of RASTERDWG) it has presumably been well aware of for years. It is wholly unnecessary at this

[3] Lest Autodesk in its Reply suggest there was some sinister intent behind the ODA's recent abandonment of certain marks, this was simply an attempt to narrow these proceedings in the interest of preserving scarce resources.

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point to reopen discovery for these newly-identified marks when Autodesk has been free for months to pursue any discovery necessary. Another extension of discovery on account of these marks would simply provide Autodesk with another opportunity to exploit its cash advantage over the ODA by allowing Autodesk to continue to inflict unending and unnecessary discovery expense upon its non-profit, lesser-funded adversary.

CONCLUSION

The ODA does not oppose the amendment of Autodesk's petition to add RASTERDWG and to specify its alleged marks, although the ODA is confident that no likelihood of confusion between these marks and the OpenDWG marks exists or can be proven by Autodesk. However, the ODA does oppose any reopening of discovery on the basis of Autodesk's decision to identify these marks. As to Autodesk's other bases for seeking leave to amend, Autodesk has made frivolous and dilatory arguments in support of its fraud claims that have no sound evidentiary basis whatsoever. Autodesk should not be granted leave to amend on such grounds, as such amendments would be futile and would unduly waste the Board's valuable time and resources.

Dated: July 28, 2008

Respectfully Submitted,

FENWICK & WEST LLP

By: Ilana S. Rubel

Ilana S. Rubel, Esq.

Attorneys for Open Design Alliance

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Declaration of Evan Yares

I. Evan Yares, declare as follows:

1. I served as the Executive Director of the Open Design Alliance ("the ODA," formerly known as the OpenDWG Alliance) from 1998 to November 2006. and served as President from approximately 1999 to November of 2006. I have personal knowledge of the facts set forth herein.

2. The ODA was a fully formed, autonomous organization as of February 1998. It had approximately 14 founding members, an independent board of directors and contracted with software developers for the development of the ODA's software libraries and with other professionals for other services.

3. Since February of 1998, the ODA offered software known as the OpenDWG Toolkit as well as the OpenDWG ViewKit as well as related services to members. Since 1998, this software was made available by download or on CDs, and the services were provided by email and by online forum.

4. I personally would carry CDs containing the OpenDWG Toolkit software with me to trade shows in 1998 and in subsequent years, and would distribute the CDs to attendees at those events.

5. I reviewed and approved the ODA's 2001 submissions to the U.S. Trademark Office in connection with the OpenDWG marks. The descriptions appearing on the 2001 applications appeared accurate to me. With respect to the service mark applications, I believed that the ODA was in fact providing multiple user access to its services as I understood that phrase. The ODA was providing a website, an online forum, an FTP site and an email server by which multiple users could access the support services and exchange information, which appeared to meet the plain language description that was being provided. The ODA further employed the law firm of Perkins Coie to assist with the filing, which reviewed and submitted specimens of the ODA's products and services in connection with the 2001 applications. At no time did I review any information that would cause me to believe the ODA's applications were inaccurate, and at no time did I, or to my knowledge anyone else acting on behalf of the ODA, seek to deceive the U.S. Trademark Office.

6. During the time that I served with the ODA, the ODA continuously offered software and services under the OpenDWG marks.

7. During the time that I served with the ODA, I communicated regularly with Autodesk employees, including executive managers, who were fully aware of the ODA's use of the OpenDWG marks. In fact, in 1998, Autodesk was invited to become a member of the organization when it was still called the "OpenDWG Alliance." Autodesk was subsequently extended the same offer repeatedly in the following years.

Evan Yares DATED JULY 27, 2008

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

In the matter of
Trademark Registration Nos. 2,517,750, 2,563,976, 2,656,757, 2,672,409, 2,719,529, 2,920,269
Marks: OPENDWG and OPENDWG and Design

AUTODESK, INC., Petitioner, v. OPEN DESIGN ALLIANCE, Respondent.	Cancellation No. 92047002 **DECLARATION OF ILANA RUBEL IN SUPPORT OF ODA'S OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO AMEND PETITION FOR CANCELLATION**

CONFIDENTIAL

This document contains information that is subject to a protective order or agreement. The confidentiality of the material is to be maintained and the document is not to be revealed to any individual, except by order of the Board.

I, Ilana S. Rubel, declare as follows:

1. I am a partner of the law firm of Fenwick & West, counsel for Respondent Open Design Alliance ("ODA"). I have personal knowledge of the facts set forth in this declaration.

2. Attached hereto as Exhibit 1 is a true and correct copy of Arnold van der Weide's Declaration in support of the ODA's Opposition to Autodesk's Motion for an Order regarding Various Discovery Issues submitted on January 16, 2008.

3. I have reviewed the online records available through the Trademark Application and Registration Retrieval (TARR) service of the United States Patent and Trademark Office. These records reflect that Autodesk first submitted an application to register DWG as a mark in 2006. Attached hereto as Exhibit 2 is a true and correct printout of the TARR website reflecting Autodesk's DWG application and showing that the application is suspended pending resolution of this proceeding and others.

4. Attached hereto as Exhibit 3 are true and correct copies of relevant pages from the transcript of the December 11, 2007 deposition of Arnold van der Weide in this action.

5. Attached hereto as Exhibit 4 is a true and correct copy of the ODA's January 13, 2008 errata to the December 11, 2007 deposition transcript of Arnold van der Weide.

6. Attached hereto as Exhibit 5 are true and correct copies of relevant pages from the transcript of the July 22, 2008 deposition of Arnold van der Weide in this action.

7. Attached hereto as Exhibit 6 is a true and correct copy of the registration for ODA's Class 9 OpenDWG mark for software, Registration No. 2719529.

8. Attached hereto as Exhibit 7 is a true and correct copy of the registration for ODA's Class 42 OpenDWG service mark for software services, Registration No. 2517750.

9. Attached hereto as Exhibit 8 is a true and correct copy of the Voluntary Surrender of Registration Nos. 2656757, 2672409, 2563976 and 2920269 filed with the United States Trademark Office on July 25, 2008.

10. Attached hereto as Exhibit 9 is a true and correct copy of the Examiner's Office Action No. 02 mailed February 15, 2001 rejecting the ODA's application for the Class 42 OpenDWG service mark (later registered as Registration No. 2517750).

11. Attached hereto as Exhibit 10 is a true and correct copy of the OpenDWG Alliance's Request for Reconsideration of the Class 42 OpenDWG service mark, later registered as Registration No. 2517750, filed on June 7, 2001.

12. Attached hereto as Exhibit 11 is a true and correct copy of email correspondence sent from Ilana Rubel, Attorney for Respondent, to John Slafsky, Attorney for Petitioner, sent on July 16, 2008.

13. Attached hereto as Exhibits 12,13,14,15,16 and 17 are true and correct printouts of the TARR website reflecting filing dates of the marks DWG and Design, REALDWG, DWG TRUEVIEW, DWG TRUECONVERT, DWGX and DWG EXTREME.

14. Attached hereto as Exhibit 18 is a true and correct copy of a press release issued by Visio Corporation on March 30, 1998 regarding OpenDWG Alliance membership.

15. Attached hereto as Exhibit 19 is a true and correct copy of an archived announcement from upfront.eZine.com from February 17, 1998 announcing creation of the OpenDWG Alliance, which is publicly available at: http://www.upfrontezine.com/1998/upf-095.htm.

16. Attached hereto as Exhibit 20 is a true and correct copy of the ODA's Washington state record of Corporation Registration, showing date of incorporation as February 4, 1998. This document is publicly available at: http://www.secstate.wa.gov/corps/search_detail.aspx?ubi=601851088.

I declare under penalty of perjury that the foregoing is true and correct. Executed at Mountain View, California on July 28, 2008.

Ilana S. Rubel

Ilana S. Rubel

Attorneys for Respondent

EXHIBIT 1

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

In the matter of
Trademark Registration Nos. 1517750, 2563976, 2656757, 2672409, 2719529, 2920269
Marks: OPENDWG and OPENDWG and Design

AUTODESK, INC. Petitioner, vs. OPEN DESIGN ALLIANCE Respondent.	Cancellation No. 92047002 **DECLARATION OF ARNOLD VAN DER WEIDE IN SUPPORT OF THE OPEN DESIGN ALLIANCE'S OPPOSITION TO AUTODESK INC.'S MOTION FOR AN ORDER REGARDING VARIOUS DISCOVERY ISSUES, AND FOR AN EXTENSION OF TIME FOR AUTODESK TO TAKE DISCOVERY**

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I, Arnold van der Weide, hereby declare:

1. I am the President of the Open Design Alliance (the "ODA") and have served in that role since mid-2007. Unless otherwise noted, I make this declaration of my own personal knowledge.

2. I reside in and am a citizen of the Netherlands.

3. I have worked in the computer-aided design ("CAD") industry for over 20 years and am extremely familiar with that industry. Prior to my current position, I was President of IntelliCAD, a technology consortium of CAD developers, and prior to that I have worked for several other companies in the CAD industry. I am familiar with Autodesk, Inc.'s

("Autodesk's") products, its file format, and the role that Autodesk plays within the CAD industry.

4. Autodesk, as well as numerous other software providers, distributes software products and services in connection with a file format called DWG, a format which enables the storage of two and three dimensional design data. Such files are saved with the file extension ".dwg", which stands for "drawing." Autodesk did not create the DWG file format, but it does control the file specification and has refused to allow others access to that format.

5. DWG is a standard format used by most companies operating in the CAD industry to store and exchange drawing files, and it would be extremely difficult for a software developer to compete in the CAD market without being able to generate DWG files.

6. The ODA is a non-profit association of independent software developers and users formed in 1998 for the purpose of promoting the DWG format as an open standard, available to all. To this end, the ODA develops and provides products and services that enable its members to read and write DWG files.

7. While the ODA itself has only five employees, it has over 2,500 members. The ODA's products and services include the OpenDWG Toolkits and Viewkits and support thereof, which the ODA has provided continuously to members via its members-only website and at times via CD distribution since 1998.

8. The ODA filed its OpenDWG applications with the United States Patent and Trademark Office claiming a date of first use of February 1998.

9. ODA's products effectively permit other companies to compete with Autodesk in the CAD industry. Without the ODA, Autodesk's competitors would not be able to easily read and write DWG files and consumers would largely be forced to turn to Autodesk for such functionality.

10. I have reviewed a 1997 announcement by the Federal Trade Commission (FTC) concluding that, at least as of that time, Autodesk held a 70% share of the CAD market. Attached hereto as Exhibit A is a copy of the press release I have reviewed. This is consistent with my experience in the industry that Autodesk has the largest installed software base with

FENWICK & WEST LLP
ATTORNEYS AT LAW
SAN FRANCISCO

CAD consumers. The ODA believes that Autodesk's market share (as well as prices to companies and consumers) would likely be much higher still if not for the libraries and support offered by ODA to Autodesk's competitors that permit the reading and writing of DWG files.

11. According to Autodesk's website, the DWG file format is "the world's most commonly used design data format." Attached hereto as Exhibit B is a printout of Autodesk's website making this claim. Indeed, the ODA estimates based on market information it has reviewed there are in excess of two billion DWG files in existence. However, Autodesk is not the only company that creates these DWG files. Due to the availability of the ODA's libraries, thousands of ODA member companies are able to read and write DWG files without the need for Autodesk's software.

12. Because of the ODA's unique role in the CAD market as a facilitator of competition to Autodesk, the ODA is concerned that Autodesk is highly incentivized to take steps that would diminish the ODA's ability to continue to provide its products and services or to shut ODA down completely. Such a blow to the ODA would effectively be a blow to virtually every Autodesk competitor.

13. Indeed, when Autodesk's Cancellation Petition was filed in January of 2007, Autodesk was simultaneously suing the ODA in Federal District Court in Seattle, a case which has since settled.

14. Due to Autodesk's enormous size, revenue and market share, Autodesk has considerable power to take adverse actions against ODA and its members. Many of the ODA's members have expressed concern that Autodesk will retaliate against them upon learning of their membership in the ODA, and accordingly have required that their membership status not be disclosed. Attached hereto as Exhibit C is a form ODA Associate Membership agreement reflecting that membership status for such members may not be disclosed.

15. Even when a member's ODA membership status is disclosed on the ODA's website, information such as the nature and extent of that member's participation and the

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SAN FRANCISCO

ODA products used by that member is not public and is treated by the ODA as confidential.

16. In light of the relationship between the parties and the overwhelming imbalance of resources, ODA by necessity must be extremely vigilant in preventing information of a sensitive nature from falling into Autodesk's hands. This includes, among other things, information regarding the ODA's products, how they are developed, who develops them, the identity of certain members, the nature of members' involvement in the association, revenues, and strategic planning. The ODA considers such information commercially sensitive and trade secret information and accordingly takes steps to maintain its secrecy.

17. Because history has shown that an attack from Autodesk is likely to take the form of legal action, the ODA's concern regarding disclosure of internal information to Autodesk extends fully to Autodesk's in-house counsel.

18. The ODA conducted a comprehensive search for documents responsive to Autodesk's requests, and produced documents containing highly sensitive internal information only on condition that such information would be seen only by Autodesk's outside counsel.

19. Autodesk served a Rule 30(b)(6) deposition notice on the ODA requesting a deposition on certain topics on December 11, 2007. I was designated as the witness to testify on the agreed-upon topics.

20. I spent several days preparing for this deposition, consulted with all of the ODA's officers and several employees regarding the agreed-upon topics, and spent at least 8 hours reviewing documents in preparation for the deposition. However, due to management turnover within the ODA and its small size, it was not possible to learn every detail regarding the history of the OpenDWG marks and their registration. There is simply no personnel remaining at the ODA that participated in the initial registration process occurring in 1998.

21. I flew from the Netherlands to San Francisco in order to appear on December 11, 2007 at the offices of Autodesk's counsel as requested by Autodesk.

22. During my deposition, I testified regarding the noticed topics relating to the use of the ODA's OpenDWG marks, informing Autodesk's counsel that the ODA has continuously

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offered products and services under the OpenDWG marks since 1998.

23. I further testified regarding the agreed-upon topics relating to consumer confusion, informing Autodesk's counsel that I was unaware of any instance in which any consumer was confused about the source of the ODA's OpenDWG products and services.

I declare under penalty of perjury that the foregoing is true and correct and was executed in the Netherlands on January 16, 2008.

Arnold van der Weide

24861/00402/LIT/1278719.4

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ATTORNEYS AT LAW
SAN FRANCISCO

EXHIBIT 2

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-07-28 15:33:46 ET

Serial Number: 78852798 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

DWG

(words only): DWG

Standard Character claim: Yes

Current Status: Applicant's response to a non-FINAL office action has been entered in application.

Date of Status: 2008-07-25

Filing Date: 2006-04-03

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
FAHRENKOPF PAUL E

Current Location: L50 -TMEG Law Office 105

Date In Location: 2008-07-25

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Autodesk, Inc.

Address:
Autodesk, Inc.
111 McInnis Parkway
San Rafael, CA 94903
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

EXHIBIT 3

REDACTED

EXHIBIT 4

REDACTED

EXHIBIT 5

REDACTED

EXHIBIT 6

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,719,529

United States Patent and Trademark Office

Registered May 27, 2003

TRADEMARK
PRINCIPAL REGISTER

OPENDWG

OPENDWG ALLIANCE (WASHINGTON CORPORATION)
1420 FIFTH AVENUE, 22ND FLOOR
SEATTLE, WA 98101

FOR: COMPUTER SOFTWARE FOR THE EXCHANGE OF INFORMATION REGARDING COMPUTER AIDED DESIGN AND COMPUTER SOFTWARE CONTAINING STANDARDS FOR THE APPLICATION OF COMPUTER AIDED DESIGN, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 2-0-1998; IN COMMERCE 2-0-1998.

SN 75-429,699, FILED 2-5-1998.

DARLENE BULLOCK, EXAMINING ATTORNEY

EXHIBIT 7

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

Reg. No. 2,517,750

United States Patent and Trademark Office

Registered Dec. 11, 2001

SERVICE MARK
PRINCIPAL REGISTER

OPENDWG

OPENDWG ALLIANCE (WASHINGTON CORPORATION)
1420 FIFTH AVENUE, 22ND FLOOR
SEATTLE, WA 98101

FOR: CONSULTING SERVICES IN THE FIELD OF COMPUTER SOFTWARE AND COMPUTER SOFTWARE TOOLS AND STANDARDS; PROVIDING MULTIPLE-USER ACCESS TO A GLOBAL COMPUTER INFORMATION NETWORK FOR THE TRANSFER AND DISSEMINATION OF A WIDE RANGE OF INFORMATION, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 2-0-1998; IN COMMERCE 2-0-1998.

SN 75-429,692, FILED 2-5-1998.

DARLENE BULLOCK, EXAMINING ATTORNEY

EXHIBIT 8

Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA226395**

Filing date: **07/25/2008**

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

Proceeding	92047002
Party	Defendant Open Design Alliance
Correspondence Address	R.J. Heher Fenwick & West LLP Silicon Valley Center, 801 California Street Mountain View, CA 94041 UNITED STATES rjheher@fenwick.com
Submission	Voluntary Surrender Of Registration
Filer's Name	Ilana S. Rubel
Filer's e-mail	trademarks@fenwick.com
Signature	/Ilana S. Rubel/
Date	07/25/2008
Attachments	Vol Surrender.pdf (3 pages)(125473 bytes)

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

In the matter of
Trademark Registration Nos. 2656757, 2672409, 2563976 and 2920269
Marks: OPENDWG and OPENDWG (and design)
Int. Cls.: 9 and 42

Autodesk, Inc. Petitioner, v. Open Design Alliance, Registrant.	)	Cancellation No. 92047002

BOX TTAB NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

VOLUNTARY SURRENDER OF REGISTRATION, WITH PREJUDICE

Pursuant to 37 C.F.R. Sections 2.134(a) and 2.172, Registrant, Open Design Alliance, ("Registrant"), hereby surrenders its above-referenced registrations (U.S. Registration Nos. 2656757, 2672409, 2563976 and 2920269 for the marks OPENDWG and OPENDWG (and design), with prejudice.

Registrant has searched its files and storage but could not locate the original certificate of registration.

Therefore, because it has been lost, Registrant is not providing the original registration certificate to the Board at this time.

Respectfully submitted,

Dated: July 25, 2008

Ilana S. Rubel

Ilana S. Rubel, Esq.
Attorneys for Registrant
Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041

PROOF OF SERVICE

I declare that:

I am employed in the County of Santa Clara, California. I am over the age of eighteen years and not a party to the within cause; my business address is Silicon Valley Center, 801 California Street, Mountain View, California 94041. On the date indicated below, I served the within VOLUNTARY SURRENDER OF REGISTRATION, WITH PREJUDICE, on the interested parties in said cause, by placing a true copy thereof enclosed in a sealed envelope with postage thereon fully prepaid, in the United States mail at Mountain View, California, addressed as follows:

John L. Slafsky
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304

☑ **BY US MAIL:** by placing the document(s) listed above in a sealed envelope for collection and mailing following our ordinary business practices. I am readily familiar with our ordinary business practices for collecting and processing mail for the United States Postal Service, and mail that I place for collection and processing is regularly deposited with the United States Postal Service that same day with postage prepaid.

I declare under penalty of perjury that the foregoing is true and correct, and that this declaration was executed at Mountain View, California, this 25th day of July 2008.

Deborah A. Shaw

Cancellation Action No. 92047002
Mark: OPENDWG and OPENDWG (and design)
Reg. Nos.: 2656757, 2672409, 2563976 and 2920269

EXHIBIT 9

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO.	APPLICANT	PAPER NO.
75/429692	OpenDWG Alliance	

MARK

OPENDWG

ADDRESS

HEIDI L SACHS
PERKINS COIE
1201 3RD AVE 40TH FL
SEATTLE WA 98101-3099

ACTION NO. 02

MAILING DATE 02/15/01

REF. NO.

FORM PTO-1525 (5-90) U.S. DEPT. OF COMM. PAT. & TM OFFICE

ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
www.uspto.gov

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
2. Mailing date of this Office action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and ZIP code.

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID *ABANDONMENT.* *For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.*

RE: Serial Number: 75/429692

This letter responds to the applicant's communication filed on December 29, 2000.

SPECIMENS

The examining attorney has carefully considered the substitute specimens. However, the substitute specimens still fail to show use of the mark for services stated in the Statement of Use. Accordingly, the refusal under TMEP section 905.10 is repeated and made FINAL.

A specimen is unacceptable if it does not show use of the service mark in relation to the identified service. *Intermed Communications, Inc. v. Chaney,* 197 USPQ 501 (TTAB 1977). The specimen must show use of the mark "in the sale or advertising of services." Trademark Act Section 45, 15 U.S.C. Section 1127; *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973); TMEP section 1301.02. Therefore, the specimen must show the mark in reference to the particular services identified. The applicant's specimens are unacceptable for two reasons. First, the applicant's specimens do not refer to the services set out in the applicant's Statement of Use. Secondly, the applicant's second specimen appears to be a news release.

Failure to Reference Services

The applicant's services are identified as "consulting services in the field of computer software and computer software tools and standards; providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information." The applicant's specimens do not show use of the mark with any of the services identified. The language which deal with the dissemination of a wide range of information, covers those services that enable a computer user to access the data bases and home pages of others. These entities are considered 'link providers' in that they provide the computer connection needed for a computer user to access a content provider. The applicant however, appears to be a content provider, as such the applicant's specimens do not demonstrate the services stated. The remaining services set out in the applicant's Statement of Use are consultation services. The applicant in there response has argued that the specimens are acceptable because the flyer submitted points to the Applicant's website www.opendwg.com as a place to turn if the customer needs help in software tools. The examining attorney has carefully considered this line of reasoning but is not persuaded. The phrase "Need help with" is not a synonym for consultation services. The phrase does not convey the impression that the applicant's is performing consultation services. Moreover, the examining attorney has carefully reviewed the applicant's actual website in search of any reference to consultation services and can find none offered on the applicant's website that would support the applicant's arguments and the specimens of record that have been submitted. Accordingly, the applicant's specimens are unacceptable because they fail to demonstrate use of the mark for the services set out in the Statement of Use.

Unacceptable Specimen Format

The applicant's specimens are also unacceptable because they appear to be a new release. Acceptable specimens may include newspaper and magazine advertisements as well as other types of advertising such as brochures, billboards, handbills, direct-mail leaflets, menus (for restaurants), and the like. However, printer's proofs for advertisements, publicity releases to news media, or printed articles resulting from such releases, are not accepted because they do not show use of the mark by the applicant in the sale or advertising of the services. The applicant must submit a specimen that shows how the applicant uses the mark in commerce with the services. A mark is deemed to be used in commerce "on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...." Trademark Act Section 45, 15 U.S.C. Section 1127. The applicant must demonstrate how the mark is used with the services by submitting an acceptable specimen. *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975); 37 C.F.R. Section 2.56

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Commissioner if permitted by 37 C.F.R. Section 2.63(b). 37

C.F.R. Section 2.64(a). Regarding petitions to the Commissioner, see 37 C.F.R. Section 2.146; TMEP sections 1702 and 1704. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. Section 2.65(a).

Darlene D. Bullock
Examining Attorney
Law Office 111
(703) 308-9111 ext. 145

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	OpenDWG Alliance	LAW OFFICE 111
Serial No.:	75/429,692	Examining Attorney: Darlene Bullock
Filed:	February 5, 1998	
Mark:	OPENDWG	REQUEST FOR RECONSIDERATION

17

Applicant has received and reviewed Office Action No. 02, mailed February 15, 2001, and responds as follows:

I. REQUEST FOR RECONSIDERATION

The Examining Attorney has issued a final refusal for the registration of the proposed mark on the ground that the substitute specimens submitted in Applicant's response filed December 29, 2000 still failed to show use of the mark for the claimed services.

Applicant respectfully disagrees with this determination and requests that the Examining Attorney reconsider her refusal to register Applicant's mark for the reasons set forth below.

1. Applicant's Substitute Specimens Are Acceptable

Applicant has applied for "consulting services in the field of computer software and computer software tools and standards; providing multiple user access to a global computer information network for the transfer and dissemination of a wide range of information," in Class 42. The substitute specimens comprised a flyer and pages from Applicant's website showing Applicant's mark with both consulting and access provider services. Applicant pointed to sections of its webpages, specifically language that talked about providing solutions and inviting companies and individuals

to visit Applicant's website for information on software tools and finally, (pursuant to the Examining Attorney's requirement to show support for consulting services) indicated the name and contact information for those interested to call for Applicant's services. See Applicant's response filed December 28, 2001 submitted as Exhibit A.

The Examining Attorney has taken the position that the "Need help with" language does not sufficiently meet the standard of what is required for evidencing "consulting" services. The dictionary definition of the word *consult* is "to ask the advice or opinion" and *consulting* is to provide "professional and expert advice." See online dictionary definitions from *Merriam-Webster's Collegiate Dictionary* submitted as Exhibit B. The Examining Attorney has further explained that the phrase "Need help with" is not synonymous with consultation services. Applicant finds it curious that the PTO has taken the role of prescribing to Applicants exactly what language should be contained in a specimen to sufficiently comply with any given service. This term is one that is broadly understood to mean the giving of professional advice. It is therefore unclear to Applicant why software professionals who "need help with" software and software tools and seek Applicant's advice by turning to its website would not considered requesting "consulting" services.

In fact, all indications are that this is *not* the standard enumerated by the Trademark Trial and Appeal Board and followed by the PTO. In the recent case, *In re Ralph Mantia Inc.*, 54 USPQ 1284 (TTAB 2000) involving a specimen issue, the Board reversed the Examining Attorney who, as in this case, had taken a very strict view of the specimens. See copy of case submitted as Exhibit C. The Board held that the word "design" appearing on the letterhead without specifying the field of design was sufficient to support the claimed commercial art services of applicant. *Id* at 1286. Given this broad standard, Applicant submits that the language, "need help with" should be considered sufficient for consulting services without further dissection and analysis. Accordingly, the substitute specimens should be accepted.

The Examining Attorney further contends that Applicant is not a "link" provider but a "content" provider based on the specimens submitted. Entities like AOL clearly are both and Applicant fails to see the strenuous distinction made by the Examining Attorney with regard to its services. Applicant provides a method for its members to exchange data, specifically computer aided design drawings. This should sufficiently comply with providing a "link" for the transfer of information. Applicant submits that its substitute specimens should be accepted for both its consulting services and access provider services.

2. Format for Substitute Specimen is Acceptable

The Examining Attorney has also refused to accept the substitute specimens because they appear to be news releases. The Examining Attorney takes as her support language from TMEP 1301.04, which in part, states that "publicity releases to news media" are not acceptable as specimens. This may have had relevance when such releases were distributed only to the print media. In today's online information age, however, press releases are posted on the websites. These press releases become information on the website that people can read and understand the nature of Applicant's services. In this sense, they do perform the function of any other advertisement that will qualify as a proper specimen. Users are just as capable of viewing these press releases as they are any advertisement on the website. It is archaic to hold on to distinctions that may have made sense before the onset of the Internet era and still believe that the same standards should still apply. Since services are not tangible items to which labels and tags may be affixed, the specimen requirements for services are more flexible and have generally kept up with the times. Clearly, online press releases are generally available for all to see and serve as advertising material to the user. Accordingly, the substitute specimens were in proper format.

3. Supplemental Specimens with Declaration

In an effort to comply with the stringent standards set by the Examining Attorney for acceptable specimens and to expedite the prosecution of this application, Applicant submits a supplemental specimen for the Examining Attorney's consideration. Applicant has supported this with the required Declaration under 37 C.F.R. Sections 2.20 and 2.59(b) verifying that it was in use in commerce prior to the expiration of the time allowed for the filing of the Statement of Use. The specimen is an advertising flyer which provides information about Applicant, its expert services, the costs and other relevant information and finally indicates "We are happy to provide support and **consulting** to help you get running" in answer to the question "What do I do?" (Emphasis added). Clearly this indicates that Applicant provides "support" meaning expert advice to its users and the public and identifies the nature of its services as being "consulting." It also goes on to provide how the interested party might reach Applicant for a follow up consultation. This should be acceptable to the Examining Attorney even with the higher standard of scrutiny.

The function of a service mark is to be able to distinguish Applicant's services from those of another and indicate the source of Applicant's services. See TMEP section 1301-04. The substitute specimens earlier submitted as well as the supplemental specimen submitted along with this request clearly show that Applicant's mark is the source of the claimed services and distinguishable from that of others. The press releases available to all users online serve as advertisements for Applicant's services much like any other information posted on Applicant's website. The supplemental specimen is in the nature of an advertising flyer which comes within PTO's traditional definitions of what constitutes an advertisement. Applicant has clearly pointed out language that indicates that Applicant provides consulting (expert advice per the definition provided above) to software professionals who want to seek

technical assistance and want to utilize Applicant's standard for creation and storage of CAD data. Accordingly, all the ingredients of "consulting" as envisioned by the Examining Attorney are present in the supplemental specimen and therefore should be acceptable to show Applicant's mark in association with the recited services.

II. CONCLUSION

Applicant respectfully requests that the Examining Attorney reconsider and withdraw the final refusal to register based on the arguments presented and the supplemental specimen submitted with this filing and allow the mark to proceed to registration.

DATED: June 7, 2001.

OpenDWG Alliance.

By _____

Lalitha Mani
Attorneys for Applicant

PERKINS COIE
607 Fourteenth Street, N.W., Suite 800
Washington, DC 20005-2011
(202) 434-1614

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	OpenDWG Alliance	LAW OFFICE 111
Serial No.:	75/429,692	Examining Attorney: Darlene Bullock
Filed:	February 5, 1998	DECLARATION IN SUPPORT OF SUBSTITUTE SPECIMENS
Mark:	OPENDWG	
Class:	42	

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares as follows:

1. I am the President of Applicant's corporation, and I am authorized to execute this declaration on its behalf.

2. The substitute specimens were in use in commerce prior to the expiration of the time allowed to the Applicant for filing a Statement of Use.

All statements made of my own knowledge are true and statements made on information and belief are believed to be true.

EXECUTED at Phoenix, Arizona, on JUNE 5, 2001.

OpenDWG Alliance

By: _____
Evan Yares, President

[SL011560177.DOC]

PERKINS COIE LLP

607 FOURTEENTH STREET, N.W. · WASHINGTON, D.C. 20005-2011
TELEPHONE: 202 628-6600 · FACSIMILE: 202 434-1690

LALITHA MANI
(202) 434-1614
manil@perkinscoie.com

June 7, 2001

VIA U.S. MAIL

Darlene Bullock
Law Office 111
U.S. Patent and Trademark Office
BOX RESPONSES/NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Re:	**Applicant:**	**OpenDWG Alliance**
	Serial No.:	**75/429,692**
	Mark:	**OPENDWG**
	Class:	**42**
	Our Ref.:	**28226-0500**

Dear Darlene:

Enclosed is Applicant's Request for Reconsideration.

Very truly yours,

Lalitha Mani

LM:kw
Enclosures

cc: OpenDWG Alliance
Nicholas May, Paralegal

[28226-0500/DA011580.012]

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	OpenDWG Alliance	LAW OFFICE 111
Serial No.:	75/429,692	Examining Attorney: Darlene Bullock
Filed:	February 5, 1998	
Mark:	OPENDWG	RESPONSE TO OFFICE ACTION NO. 1
Class:	42	

Applicant has received and reviewed Office Action No. 1, mailed August 15, 2000, and responds as follows:

SUBSTITUTE SPECIMENS

The Examining Attorney had required substitute specimens that support the services claimed under the mark. Applicant submits a flyer and pages from its website as its substitute specimen that clearly associates the mark OPENDWG with Applicant's consulting and Internet services. The flyer points to Applicant's website, *www.opendwg.com* as the place to turn to if the customer needs help with the software tools. The pages from Applicant's website talk of Applicant's "Software Development Team" providing solutions for companies and individuals. Further down, under the "About the OpenDWG Alliance" section, the text states, "Companies and individuals interested in information about ... the OpenDWG Toolkit/Viewkit ... may visit the ODA web site at *http://www.opendwg.org.*" Finally, there is a contact provided if the customer wants to get more information regarding the software tools and consultation.

Applicant believes that these substitute specimens clearly establish the software consulting services provided by Applicant. The Examining Attorney, in a telephone

conversation, had indicated that the services should be presented in advertising material with contact information provided if the customer needed to avail of such consulting services. Applicant believes that it has provided specimens that meet the Examining Attorney's standards.

In support of the substitute specimens, Applicant has provided a declaration under 37 C.F.R. Section 2.20 stating that the specimens were in use in commerce prior to the expiration of the time allowed for filing a Statement of Use. 37 C.F.R. Section 2.59(b); TMEP section 905.10.

CONCLUSION

The foregoing response complies with the requirements of Office Action No. 1. Applicant believes its specimens clearly establish use of the mark with the recited services. Applicant respectfully requests that the Examining Attorney accept the substitute specimens and that the application be approved for registration. If any questions remain, Applicant requests that the Examining Attorney contact the undersigned at the telephone number listed below.

DATED: December 28, 2000.

OpenDWG Alliance

By _____
Lalitha Mani
Attorneys for Applicant

PERKINS COIE LLP
607 Fourteenth Street, NW, Suite 800
Washington, DC 20005-2011
(202) 434-1614

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail on 12/28, 2000, in an envelope addressed to the Law Office 111, U. S. Patent & Trademark Office, BOX RESPONSES, 2900 Crystal Drive, Arlington, VA 22202-3513

Signature: Jandie L. Brown

Printed Name: JANDIE L. BROWN

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	OpenDWG Alliance	LAW OFFICE 111
Serial No.:	75/429,692	Examining Attorney: Darlene Bullock
Filed:	February 5, 1998	DECLARATION OF MARK AND SPECIMEN USE
Mark:	OPENDWG	
Class:	42	

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares as follows:

1. I am the President of Applicant corporation, and I am authorized to execute this declaration on its behalf.

2. The specimens attached to this Declaration of Mark and Specimen Use represent Applicant's use of the mark, and the use shown in these specimens is a use made of the mark in commerce at least as early as the filing date of the trademark application.

All statements made of my own knowledge are true and statements made on information and belief are believed to be true.

EXECUTED at Phoenix, Arizona, on DECEMBER 19, 2000

OpenDWG Alliance

By

Evan Yares
President

[SL003774.086]

75/429,692

SUBSTITUTE SPECIMEN

[/LETTER.01]

OpenDWG™
ALLIANCE

Need help with DWG?
Now there is a place to turn.
www.opendwg.org

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For Release 12 p.m. PDT – April 5, 1999

OpenDWG™ Alliance Announces Establishment of Software Development Team

Senior Programmers hired to provide more tools and solutions for CA customer file interoperability

PHOENIX – April 4, 1999 – The OpenDWG Alliance announced today that it has hired two senior programmers to focus fu time on the continual development and upgrading of software tools an technical offerings for use by Alliance membership. Neil Peterson and John Rulifson will lead a software development team to provide supp and expertise to the over 6,000 members of the Alliance. The formati of the development team brings increased value to the Alliance membership as well as providing increased resources to promote interoperability for the AEC industry.

The development team, which will include Matt Richards, creator of th OpenDWG Toolkit and Viewkit, will provide support to the membersh through the Alliance web site (www.opendwg.org). In addition, the team will continue to develop and expand the Alliance's current technical offerings to include additional utilities and sample applications, making it easier for members to incorporate DWG supp in their applications. The development team will also be involved in documenting and supporting the new release of Autodesk's AutoCAD 2000 (A2K) DWG file format, which will be published free of charge o the Alliance web site.

"The establishment of a full-time software development team is an important step in providing our members with the tools they need to access DWG files -- both now and in the future," said Evan Yares, Executive Director of the OpenDWG Alliance. "The knowledge and experience that Neil and John bring to the table is impressive and, in light of the release of A2K, their hiring further demonstrates the Alliance's commitment to provide value to its members."

With the release of A2K, both CAD users and developers will face ne challenges with file compatibility. The development team will be leadi the Alliance's efforts to provide vendor-independent tools to help

developers integrate DWG support in their applications. Their efforts will help assure that CAD users will be able to access their DWG files no matter which application software they choose to use.

The development team's initial focus will be on upgrading the OpenDWG Toolkit and Viewkit to be compatible with A2K, which first shipped to commercial customers on March 29th. The Toolkit and Viewkit upgrades are expected to be released to Alliance members in 2Q99.

Senior Programmers' Background

Neil Peterson has been involved full time in the development of advanced graphics conversion and viewing software since 1996, and holds an M.S. degree in Computer Science from the University of Kansas. John Rulifson has been involved full time in the developmen of advanced graphics conversion and viewing software since 1988, a holds a B.A. degree in Computer Science from Bethany College. Both Neil and John have extensive experience with AutoCAD, and togethe have reverse-engineered releases 12, 13, and 14 of the DWG file format.

About the OpenDWG Alliance

Established in February 1998, the OpenDWG Alliance is an association of more than 6,000 members committed to the promotion the DWG file format as an open standard for CAD drawing data. The DWG file format was originally developed by Autodesk for their AutoCAD software, and has become a ubiquitous de facto standard. Autodesk estimates more than 2,000,000,000 AutoCAD files are in existence. The OpenDWG Alliance is in no way affiliated with Autodesk. Companies and individuals interested in information about OpenDWG Alliance membership, the OpenDWG Toolkit/Viewkit, or o the Alliance and its activities may visit the ODA web site at http://www.opendwg.org. Questions or comments may be sent via em to feedback@opendwg.org, or to 1845 E. Whitton Ave, Phoenix AZ 85016, 602/263-7666, 602/263-5578 (fax).

For more information, contact:
OpenDWG Alliance Inc.
Evan Yares, evan@opendwg.org
(602) 263-7666

For press information, contact:
MacKenzie Kesselring, Inc.
Laurie Johnson, lauriej@mkinc.com
Sean Egusa, seane@mkinc.com
(503) 225-0725
(503) 225-0765 fax

EXHIBIT B

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consult[1,verb]
consulting

Main Entry: **con·sult·ing**
Pronunciation: `k&n-'s&l-ti[ng]`
Function: *adjective*
Date: 1801
1 : providing professional or expert advice <a *consulting* architect>
2 : of or relating to consultation or a consultant <the *consulting* room of a psychiatrist>

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Pronunciation Symbols

\&\ as **a** and **u** in **abut**	\e\ as **e** in **bet**	\o\ as **aw** in **law**
\^&\ as **e** in **kitten**	\E\ as **ea** in **easy**	\oi\ as **oy** in **boy**
\&r\ as **ur/er** in **further**	\g\ as **g** in **go**	\th\ as **th** in **thin**
\a\ as **a** in **ash**	\i\ as **i** in **hit**	\[th]\ as **th** in **the**
\A\ as **a** in **ace**	\I\ as **i** in **ice**	\ü\ as **oo** in **loot**
\ä\ as **o** in **mop**	\j\ as **j** in **job**	\u\ as **oo** in **foot**
\au\ as **ou** in **out**	\[ng]\ as **ng** in **sing**	\y\ as **y** in **yet**
\ch\ as **ch** in **chin**	\O\ as **o** in **go**	\zh\ as **si** in **vision**

For more information see the Guide To Pronunciation.

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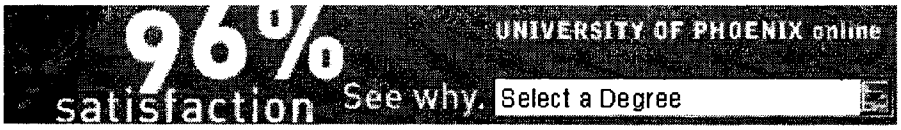

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2 entries found for **consult**.
To select an entry, click on it. (Click 'Go' if nothing happens.)

consult[1,verb]
consulting

Main Entry: **[1]con·sult**
Pronunciation: `k&n-'s&lt`
Function: *verb*
Etymology: Middle French or Latin; Middle French *consulter,* from Latin *consultare,* frequentative of *consulere* to deliberate, counsel, consult
Date: 1527
transitive senses
1 : to have regard to **:** CONSIDER
2 a : to ask the advice or opinion of <*consult* a doctor> **b :** to refer to <*consult* a dictionary>
intransitive senses
1 : to consult an individual
2 : to deliberate together **:** CONFER
3 : to serve as a consultant
- con·sult·er *noun*

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- **Parents – give your child the gift of language!**
  Visit Word Central – the award-winning language site for kids!

Pronunciation Symbols

\&\ as **a** and **u** in **abut**	\e\ as **e** in **bet**	\o\ as **aw** in **law**
\ᵊ\ as **e** in **kitten**	\E\ as **ea** in **easy**	\oi\ as **oy** in **boy**
\&r\ as **ur/er** in **further**	\g\ as **g** in **go**	\th\ as **th** in **thin**
\a\ as **a** in **ash**	\i\ as **i** in **hit**	\[th]\ as **th** in **the**
\A\ as **a** in **ace**	\I\ as **i** in **ice**	\ü\ as **oo** in **loot**
\ä\ as **o** in **mop**	\j\ as **j** in **job**	\u\ as **oo** in **foot**
\au\ as **ou** in **out**	\[ng]\ as **ng** in **sing**	\y\ as **y** in **yet**
\ch\ as **ch** in **chin**	\O\ as **o** in **go**	\zh\ as **si** in **vision**

For more information see the Guide To Pronunciation.

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EXHIBIT C

Paper No. 18
PTH

THIS DISPOSITION IS CITABLE
AS PRECEDENT OF THE TTAB FEB. 25, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ralph Mantia, Inc., d/b/a Zē Design

Serial No. 74/657,328

B. Joseph Schaeff of Killworth, Gottman, Hagan & Schaeff for Ralph Mantia, Inc. d/b/a Zē Design.

Andrew P. Baxley, Trademark Examining Attorney, Law Office 114 (Mary Frances Bruce, Managing Attorney).

Before Quinn, Hairston and Walters, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Ralph Mantia, Inc., doing business as Zē Design, seeks to register the mark set forth below for "commercial art design services." The intent-to-use application was filed on April 7, 1995. The word "design" has been disclaimed apart from the mark as shown.

On September 24, 1996 applicant filed a statement of use pursuant to Trademark Rule 2.88 wherein he states that "[t]he mark is used on letterhead [stationery], in advertising literature, business cards and other ways common in the industry." Applicant submitted as specimens letterhead stationery, an envelope and a business card.

The Trademark Examining Attorney, in an Office Action mailed March 28, 1997, stated that:

> The specimens do not show use of the mark for any services identified in the statement of use. Specimens are unacceptable if they do not show use of the service mark in relation to the identified service. The specimens must show use of the mark "in the sale or advertising of services." (citations omitted).

The Examining Attorney then required that applicant submit specimens showing use of the mark for the identified services. Also, applicant was required to submit an

affidavit or declaration in support of the substitute specimens.

Applicant, in its September 30, 1997 response to the Office Action, argued that the specimens were acceptable because "[they] all prominently feature the word 'design.'" However, to further assist in the examination, applicant submitted as "supplemental" specimens printouts from applicant's web site and a post card.

The Examining Attorney, in an Office Action mailed February 12, 1998, stated that, while the later-filed specimens appeared to be acceptable in that they showed use of the mark in relation to the identified services, they were "substitute" rather than "supplemental" specimens and, therefore, an affidavit or declaration supporting the specimens was necessary. The Examining Attorney made final the requirement for an appropriate affidavit/declaration.

Applicant, on August 17, 1998, filed an appeal and request for reconsideration. In its request for reconsideration, applicant argued that the original specimens were indeed acceptable and that along with the later-filed specimens, there could be no doubt that applicant renders commercial art design services.

The Examining Attorney, in an Office action mailed December 30, 1998, continued to maintain that the original

specimens were unacceptable and that an affidavit/ declaration in support of the later-filed specimens was necessary.

Both applicant and the Examining Attorney have filed briefs in connection with the appeal, but no oral hearing was requested.

We turn first to the issue of whether the specimens filed with the application are acceptable. The relevant portions of applicant's letterhead, envelope and business card are reproduced below.

Letterhead

Envelope

Business Card Front/Back

In support of his position that the specimens are unacceptable, the Examining Attorney relies on TMEP Section 1301.04 which states, in relevant part, that:

> Letterhead stationery or business cards bearing the mark may be accepted if the services are ***clearly indicated*** thereon. (emphasis added) . . . However, letterhead or business cards which bear only the mark and a company name and address are not adequate specimens (unless the mark itself has a descriptive portion which identifies the service), because such items are not evidence that the mark is used in the sale or advertising of the particular services recited in the application. (citations omitted)

The Examining Attorney contends that the nature of applicant's services are not clearly indicated on the specimens filed with the application and, thus, the specimens are unacceptable. In particular, the Examining Attorney argues that:

> Although design services of some sort are indicated by the specimens, the examining attorney submits that one must inquire further to determine the field or industry in which the applicant renders its design services. Based on the specimens of record, the examining attorney submits that one could not determine without further inquiry whether the applicant designs commercial art, computer software, clothing, architecture, landscaping, etc.
> (Brief, p. 5)

Applicant, however, contends that neither the Lanham Act nor the Trademark Rules require that specimens such as letterhead stationery specifically spell out the type of services rendered. Applicant argues that it is enough that the letterhead stationery, envelope and business card contain the word "design" because that is applicant's business.

In this case, we agree with applicant that the specimens filed with its application are acceptable evidence of service mark use. We do not view TMEP Section 1301.04 as requiring that specimens such as letterhead stationery and the like indicate the specific nature of an applicant's services. Stated differently, in this case, it is enough that the word "design" appears on applicant's letterhead stationery, envelope and business card. It is not necessary that the specific field of design, i.e., commercial art, also appear thereon. Here, the word "design" alone is sufficient to create in the minds of purchasers an association between the mark and applicant's commercial art services.

Without deciding the question of whether the later-filed specimens are substitute or supplemental specimens, we nonetheless note that the Examining Attorney has indicated that these additional materials demonstrate that

applicant renders commercial art design services. We agree with this finding inasmuch as the wording "a creative graphic design studio" appears thereon. Thus, there is no question that applicant renders the particular services identified in its application.

Decision: The refusal to register is reversed.

T. J. Quinn

P. T. Hairston

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board

From: Ilana Rubel
Sent: Wednesday, July 16, 2008 2:48 PM
To: 'Slafsky, John'
Subject: Van der Weide Deposition

John -
I am confirming that, as Autodesk is unwilling to defer the deposition of Mr. van der Weide until the pending motion is resolved or until the Solidworks petition is resolved, we are planning to proceed as scheduled next Tuesday. As you know, the ODA is a non-profit organization with limited resources, and having already absorbed the cost of two trans-Atlantic depositions, they do not wish to be burdened with a third in the event that Autodesk is permitted to add its new proposed claims. Accordingly, we request that you ask Mr. van der Weide any questions you have regarding the proposed new claims so as to avoid any request for an additional deposition. While I understand that Autodesk may seek additional discovery if the TTAB so allows, please make every effort to ask your questions on these topics next week, as it would be prohibitively burdensome to have to produce Mr. van der Weide a third time.
Regards,
Ilana

EXHIBIT 12

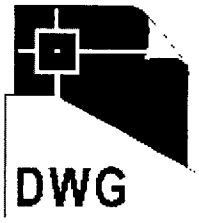
Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-07-28 15:32:22 ET

Serial Number: 78852808 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark



(words only): DWG

Standard Character claim: No

Current Status: An office action suspending further action on the application has been mailed.

Date of Status: 2008-06-22

Filing Date: 2006-04-03

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
FAHRENKOPF PAUL E

Current Location: L1X -TMEG Law Office 101 - Examining Attorney Assigned

Date In Location: 2008-06-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Autodesk, Inc.

Address:
Autodesk, Inc.
111 McInnis Parkway
San Rafael, CA 94903
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

EXHIBIT 13

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-07-28 15:34:40 ET

Serial Number: 78852836 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

REALDWG

(words only): REALDWG

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2007-01-18

Filing Date: 2006-04-03

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
FAHRENKOPF PAUL E

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-12-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Autodesk, Inc.

Address:
Autodesk, Inc.
111 McInnis Parkway
San Rafael, CA 94903
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

EXHIBIT 14

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-07-28 15:35:23 ET

Serial Number: 78852813 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

DWG TRUEVIEW

(words only): DWG TRUEVIEW

Standard Character claim: Yes

Current Status: An office action suspending further action on the application has been mailed.

Date of Status: 2008-06-22

Filing Date: 2006-04-03

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
FAHRENKOPF PAUL E

Current Location: L1X -TMEG Law Office 101 - Examining Attorney Assigned

Date In Location: 2008-06-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Autodesk, Inc.

Address:
Autodesk, Inc.
111 McInnis Parkway
San Rafael, CA 94903
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

EXHIBIT 15

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-07-28 15:36:58 ET

Serial Number: 78852822 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

DWG TRUECONVERT

(words only): DWG TRUECONVERT

Standard Character claim: Yes

Current Status: An office action suspending further action on the application has been mailed.

Date of Status: 2008-06-22

Filing Date: 2006-04-03

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
FAHRENKOPF PAUL E

Current Location: L1X -TMEG Law Office 101 - Examining Attorney Assigned

Date In Location: 2008-06-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Autodesk, Inc.

Address:
Autodesk, Inc.
111 McInnis Parkway
San Rafael, CA 94903
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

EXHIBIT 16

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-07-28 15:38:40 ET

Serial Number: 78852849 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

DWGX

(words only): DWGX

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2007-01-05

Filing Date: 2006-04-03

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
FAHRENKOPF PAUL E

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-10-12

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Autodesk

Address:
Autodesk
111 McInnis Parkway
San Rafael, CA 94903
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

EXHIBIT 17

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-07-28 15:37:58 ET

Serial Number: 78852843 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

DWG EXTREME

(words only): DWG EXTREME

Standard Character claim: Yes

Current Status: An office action suspending further action on the application has been mailed.

Date of Status: 2008-06-22

Filing Date: 2006-04-03

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
FAHRENKOPF PAUL E

Current Location: L1X -TMEG Law Office 101 - Examining Attorney Assigned

Date In Location: 2008-06-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Autodesk, Inc.

Address:
Autodesk, Inc.
111 McInnis Parkway
San Rafael, CA 94903
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

EXHIBIT 18

F- Visio
OpenDWG

Visio Corporation 520 Pike Street, Suite 1800, Seattle, WA 98101 TEL 206-521-4500, FAX 206 521-4501

OpenDWG Alliance Membership Reaches 2,000

New Members, Leadership Signal Growing Acceptance of DWG As an Open Format for Exchanging CAD Drawings

SEATTLE, March 30 /PRNewswire/ -- The OpenDWG Alliance announced today that since its founding on Feb. 11, the number of OpenDWG Alliance members has grown to over 2,000 as of March 23. The OpenDWG Alliance disclosed details regarding the status of its membership after convening its first board of directors meeting on March 23 in Seattle. An association of users and vendors committed to the promotion of Autodesk's DWG drawing file format as an open industry standard for the exchange of computer aided design (CAD) drawings, the alliance to date has recruited 20 Founding members, 53 Sustaining members, and over 2,000 Associate members from the CAD user community at large. The OpenDWG Alliance Web site, at http://www.opendwg.org/, has been visited by over 18,000 individuals in the five weeks since the alliance was announced, with more than 25 percent of the visitor traffic coming from outside the United States.

At the March 23 meeting, the OpenDWG Alliance board of directors elected Asa Trainer of Parametric Technology Corp. as chairman, Ted Johnson of Visio Corp. as president, Brent Straka of Eagle Point Software as vice president, and Paul Richards of Visio as secretary/treasurer. Matt Richards of Visio was appointed chief technologist. The alliance also admitted ANDOR Company Ltd., Engineering Animation Inc., Nacos Computer Systems Company Inc., Rasterex International AS, and ViaGrafix Corp. as new Founding members and amended the organization's charter to offer Founding member status to new applicants indefinitely. The OpenDWG Alliance continues to recruit software vendors and CAD users to jointly share and disseminate knowledge about the composition of DWG, to date a proprietary undocumented format that encapsulates valuable CAD data created by governments, corporations and users worldwide.

"The growing number of Founding, Sustaining and Associate members in the OpenDWG Alliance shows there is a real need and demand in the CAD community for a better understanding of DWG and for better-quality tools for accessing the valuable data contained within DWG," said Asa Trainer, chairman of the OpenDWG Alliance and product line manager, interface products at Parametric Technology Corp. "The OpenDWG Alliance isn't about making new or different DWG standards because there can be only one DWG, and Autodesk defines it. The OpenDWG Alliance merely seeks to document and promote the DWG file format as it exists as an open standard."

(more)

"CAD users are telling us that the OpenDWG Alliance's efforts will help them to get more value out of the CAD data they own that's captured in the DWG format," said Brent Straka, vice president of the OpenDWG Alliance and vice president of marketing for Eagle Point Software. "The alliance is fully focused on providing the information and tools that CAD users can draw on when dealing with the DWG standard, be it for better DWG compatibility from vendors other than Autodesk, or for better custom software and free utilities for managing DWG files."

The OpenDWG Toolkit -- C-language programming libraries that provide read and write access to DWG files -- has been downloaded by over 1,800 alliance members for use in private and noncommercial applications. The Toolkit has already been incorporated by Associate alliance members into software tools now being made freely available to the CAD community at large.

"The OpenDWG Toolkit is a complex package, intended for CAD developers or users with software development expertise," said Matt Richards, chief technologist for the OpenDWG Alliance and DWG development manager at Visio Corp. "The number of OpenDWG Toolkit downloads that have occurred to date has been astonishing, given that it is not a prepackaged application. This supports our belief in the widespread need for programming libraries that directly access the valuable data contained within DWG files, and hints at an even wider demand for complete DWG software tools that can make the drawing management chores of CAD users easier."

OpenDWG Alliance Structure and Membership Information

The OpenDWG Alliance has been structured as a nonprofit Washington state corporation. The alliance offers varying levels of participation for members: the Founding level, where members receive source code to the OpenDWG Toolkit and the right to incorporate the OpenDWG Toolkit into commercial products; the Sustaining level, for members who intend to use the OpenDWG libraries within a commercial software product for resale but do not receive source code; and Associate members, those members of the CAD user community who support the objectives of the alliance and may choose to use the OpenDWG Toolkit for corporate or noncommercial purposes. A 15-member board of directors, elected annually by the Founding membership, oversees the alliance's activities and elects its officers. The first-year board consists of one representative from each of the alliance's 15 original Founding members. Directors and officers are elected for one-year terms.

The OpenDWG Alliance continues to solicit membership in the alliance, provides information regarding the alliance and its activities, and distributes software based on OpenDWG technology via its Web site at http://www.opendwg.org/. The mailing address of the OpenDWG Alliance is OpenDWG Alliance, 1420 Fifth Ave., 22nd Floor, Seattle, WA 98101; the telephone number is 206-224-5655, and the fax number is 206-224-2880.

NOTE: OpenDWG is a trademark of OpenDWG Alliance in the United States and/or other countries. All other trademarks, trade names or company names referenced herein are used for identification only and are the property of their respective owners.

SOURCE OpenDWG Alliance

-0- 03/30/98

/CONTACT: alliance, Asa Trainer of OpenDWG Alliance Inc., 206-224-5655, or atrainer@ptc.com; or media, Rob Curran of Waggener Edstrom, 425-637-9097, or robc@wagged.com/

/Web site: http://www.opendwg.org//

- 30 -

EXHIBIT 19

upFront.eZine

Issue #95: 17 February, 1998

- Prev: Upfront #94
- Curr: **Upfront #95**
- Next: Upfront #96

Visio Forms OpenDWG Alliance

As predicted in ***upFront.eZine*** #94, an open DWG foundation was announced last Tuesday. In a stunning announcement, **Visio** has made the recently-acquired **MarComp** AutoDirect2 DWG read/write API library freely available -- that's right: free for non-commercial and in-house use. Commercial licenses are US$5,000. The API has been renamed **The OpenDWG Toolkit** and can be downloaded now from http://www.opendwg.org

The purpose of the Alliance is to collect the DWG translation experience of dozens of software vendors. In a conference call to CAD industry analysts, Visio vp **Ted Johnson** described the OpenDWG Alliance as "committed to publicly sharing the knowledge its members possess about the DWG format in order to provide millions of CAD users with better technology and better access to their own data."

These are the 15 CAD vendors who ponied up US$25,000 apiece to become Founding Members, with a seat on the board of directors:

- Baystate Technologies (CADkey)
- DATACAD LLC (DataCAD)
- Diehl Graphsoft (MiniCAD)
- Eagle Point Software (vertical market CAD apps) + IMSI (TurboCAD)
- Informative Graphics (Myriad)
- Inso (a provider of translators)
- Intergraph (Imagineer Technical, APLOT, etc) + Ketiv Technologies (vertical market CAD apps) + MicroCADAM
- Nemetschek (allPlan)
- Parametric Technology Corporation (Pro/Engineer) + Robert McNeel & Associates (Rhino)
- SolidWorks (SolidWorks)
- Visio (Visio and IntelliCAD)

However, not all founding members currently have DWG translation in their product. PTC said their first implementation would have to wait until Pro/Engineer Release 20. The most significant company missing from the list is Bentley Systems, a MarComp licensee. Their reaction is noted below.

Autodesk Says, "No!"

The **OpenDWG Alliance** has a standing invitation to Autodesk to join. However, in an exclusive interview with ***upFront.eZine***, Autodesk's emphatic reply is, "No!" **Amar Hanspal**, director of AutoCAD product marketing, says Autodesk sees no benefit in joining and will not join the OpenDWG Alliance; Autodesk does not see OpenDWG as a threat.

During the interview, Autodesk turned the tables on Visio. Said CTO **Carl Bass**, By forming this alliance, Visio is

admitting that IntelliCAD is *not* 100% compatible with AutoCAD. OpenDWG is an admission by Visio that they need help from 13 other companies in decoding DWG.

We agree with Autodesk's assertion that it is not the DWG data that other CAD vendors have problems with. Rather, the problem lies in trying to map unique-to-AutoCAD objects (such as the splined polyline and unlimited layers) to similar-but-different objects in the destination CAD software. Said Autodesk, "It's not the data; it's what you do with the data."

In what is perhaps most damning statement against OpenDWG, Autodesk wonders why it should open up DWG when companies like Visio and PTC have not done that with their VSD and Pro/E file formats. Autodesk calls DWG "our intellectual property." It sees DWG as 'merely' (our term) a compressed, secure, fast-loading variant of DXF. Autodesk pr person **Barbara Brown** provided this list of ten open data exchange standards Autodesk already supports:

- DXF
- IGES
- IAI
- IFC
- AutoCAD OEM
- PDES
- STEP
- DWF
- OGC
- OLE for D&M

The overriding theme of the interview was: The DWG format is already open -- via DXF. Said Mr Bass, "Our customers own their data -- via DXF." To answer those detractors who insist DXF is missing objects found in DWG, Mr Bass provided these responses:

+ OLE is not present in DWG nor DXF.
+ ACIS data is encrypted in DXF but the encryption is easily decoded. In any case, ACIS data is freely available via SAT export/import.
+ Application-generated objects are not necessarily stored in DWG or DXF. It is up to the ARx application to generate and work with app-specific data.

We got the impression Autodesk will continue to modify DWG in upcoming releases of AutoCAD, such as "R14+1", Autodesk's internal term for The Next Release of AutoCAD. Mr Bass said that after ballooning in size with Release 13, DWG will get smaller and that authentication will be added.

Bentley Says, It's the Wrong Approach!

We asked Bentley Systems about their reaction to the OpenDWG Alliance. In an telephone interview, **Greg Bentley** emphasized, "The MarComp libraries are the least of what is required for living in a world of multiple file standards. OpenDWG does not approach the problem of dealing with data sets." This would have been a great solution in the early 90s, says Mr Bentley, but CAD data is moving beyond static data files.

Like Autodesk, Bentley is saying "No" to participating; however, they would see merit in joining if Autodesk joined. Until then, Bentley Systems see OpenDWG as "a claim at the marketing level only" and perhaps as an attempt by Visio to create momentum for itself in the low price levels (under $500) of CAD. Bentley doesn't operate in that region.

Like Autodesk, Bentley sees the future in application- generated data. In MicroStation's case, this will come from Java applets (ARx in AutoCAD's case). [With so much in common with Autodesk, perhaps the two companies should form the "AOA," the Anti-OpenDWG Alliance! -- Ed.]

Summed up Bentley vp Yoav Etiel <Yoav.Etiel@bentley.com>: "As the leading developer of software for large-scale engineering projects, Bentley relies -- as it has always been relying -- on its own developers rather than development by a committee, to deliver translation to/from the Autodesk proprietary drawing formats.

"The real issues for the approaching millennium is that data will rarely exist without accompanying programs. With Java we are now working on some breakthrough multi-platform interoperability, including what can be done BEYOND translators, such as our announced plans to develop a 'DWG mode' for MicroStation/J."

Reaction to OpenDWG

"Wow! So what do you think about all this?" asks an ***upFront.eZine*** reader. We consider the announcement of OpenDWG as the most important CAD event of 1998. But will the **OpenDWG Alliance** work?

- We wonder whether the alliance will fall apart, as have some other alliances. **Autodesk** chuckles over the thought of **SolidWorks** and **PTC** sharing information with each other. And members of the CAD media scratched their heads at the OpenDWG Alliance blowing most of its seed money on a full- page ad in the *Wall Street Journal.*
- We wonder how long it will take for OpenDWG to come out with a 100% DWG API. As an example, the STEP effort is more than 10 years old. The company with the most experience, Bentley, has spent six years on the problem. OLE for D&M is progressing at a snail's pace. Even Autodesk's own IFC/IAI is nearly two years old with no shipping product.
- While you can download the OpenDWG Toolkit from http://www.opendwg.org , it is not a trivial exercise to implement it. **Bentley Systems**, who has the longest experience at implementing the nee-MarComp API, admits they still doesn't have a perfect implementation -- after six years of programming effort.
- Autodesk changes the DWG file format with every major release of AutoCAD, and sometimes with intermediate releases, as well. Says *CADdesk* editor **Martyn Day**, "AutoCAD is on an 18-month development cycle. Does this mean DWG is guaranteed to change every 18 months from now on?"
- Sometimes the question is asked, "Who owns the DWG data?" as an argument in favor of opening up DWG. But DXF expert **Dietmar Rudolph** replies by asking another question, "Who owns the DOC data in your Word document? Is it documented?"

There is one prior example of opening up a CAD data format, whose experience we can draw on. Several years ago, **Intergraph** placed its IGDS file format in the public domain. Despite that, IGDS failed to become ubiquitous; Intergraph no longer uses IGDS for its new CAD products. Bentley Systems used IGDS as the basis for MicroStation's DGN file (in fact, MicroStation v1.0 was simply an IGDS file viewer) but Bentley has been adding undocumented, proprietary extensions.

Despite the fact that Autodesk and Bentley Systems dismiss the importance of the DWG file, there is much valuable data stored in the two billion drawing files -- as estimated by Autodesk. Take something as "trivial" as cataloging all blocks (symbols) in all drawings stored on your network. With the OpenDWG Toolkit, it will be easier for a third- party developer to implement such an application -- think of the horror of having to convert all drawings to DXF, first!

Market News

PTC is set for a 2-for-1 stock split.
Visio has completed its acquisition of the technology and assets of **InfoModelers**, Inc.

Letters to the Editor

"Your UpFront.eZine is a classy product -- definitely one of the very best of its kind. Keep up the good work."
-- *Bruce Brown*

"Let me congratulate you on publishing upFront.eZine, it's been great source of information for me in past few months."
-- *Viktor Sanek*

"Please add me to your subscribers list, I look forward to more informative issues -- good job guys!"
-- *Stacy Hammond*

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EXHIBIT 20

Corporations

Corporations Division - Registration Data Search

OPEN DESIGN ALLIANCE

UBI Number	601851088
Category	Regular Corporation
Profit/Nonprofit	Nonprofit
Active/Inactive	Active
State Of Incorporation	WA
Date of Incorporation	02/04/1998
License Expiration Date	02/28/2009
Registered Agent Information	
Agent Name	NATIONAL REGISTERED AGENTS INC
Address	1780 BARNES BLVD SW BLDG G
City	TUMWATER
State	WA
ZIP	985120410
Special Address Information	
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PROOF OF SERVICE

The undersigned declares as follows:

I am a citizen of the United States and employed in Santa Clara County, State of California. I am over the age of eighteen years and not a party to the within-entitled action. My business address is Fenwick & West LLP, Silicon Valley Center, 801 California Street, Mountain View, California 94041. On the date set forth below, I served the within

RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO AMEND PETITION FOR CANCELLATION

DECLARATION OF EVAN YARES

DECLARATION OF ILANA RUBEL IN SUPPORT OF ODA'S OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO AMEND PETITION FOR CANCELLATION

on the interested parties in the subject action by placing a true copy thereof as indicated below, addressed as follows:

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

☒ **BY US MAIL:** by placing the document(s) listed above in a sealed envelope for collection and mailing following our ordinary business practices. I am readily familiar with our ordinary business practices for collecting and processing mail for the United States Postal Service, and mail that I place for collection and processing is regularly deposited with the United States Postal Service that same day with postage prepaid.

☐ **BY OVERNIGHT COURIER:** by placing the document(s) listed above in a sealed envelope with a prepaid shipping label for express delivery and causing such envelope to be transmitted to an overnight delivery service for delivery by the next business day in the ordinary course of business.

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I declare under penalty of perjury under the laws of the State of California and the United States that the above is true and correct.

Date: July 28, 2008

Deborah A. Shaw

Deborah A. Shaw