

ESTTA Tracking number: **ESTTA508076**

Filing date: **11/29/2012**

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

**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Autodesk, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	111 McInnis Parkway San Rafael, CA 94903 UNITED STATES		

Attorney information	John L. Slafsky Wilson Sonsini Goodrich & Rosati 650 Page Mill Road Palo Alto, CA 94304-1050 UNITED STATES jslafsky@wsgr.com, trademarks@wsgr.com Phone:(650) 493-9300		
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**Registration Subject to Cancellation**

Registration No	4125612	Registration date	04/10/2012
Registrant	3D Systems, Inc. 333 Three D Systems Circle Rock Hill, SC 29730 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 001. First Use: 2011/05/26 First Use In Commerce: 2011/08/01 All goods and services in the class are cancelled, namely: Solid imaging materials, namely, plastic, metal, wax, silicone, urethane, ceramic or composite materials, used to create three-dimensional embodiments of computer generated designs
Class 007. First Use: 2011/05/26 First Use In Commerce: 2011/08/01 All goods and services in the class are cancelled, namely: Computer driven machine for making three-dimensional embodiments of computer generated designs
Class 009. First Use: 2011/05/26 First Use In Commerce: 2011/08/01 All goods and services in the class are cancelled, namely: Computer software for use in designing three-dimensional objects and controlling machines for making three-dimensional embodiments of the objects
Class 040. First Use: 2011/05/26 First Use In Commerce: 2011/08/01 All goods and services in the class are cancelled, namely: Manufacture of three-dimensional objects, namely, prototypes, models, patterns, molds, medical devices or finished goods, to the order and specification of others

**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

## Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2733869	Application Date	04/16/2001
Registration Date	07/08/2003	Foreign Priority Date	NONE
Word Mark	3DS MAX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/01/22 First Use In Commerce: 2001/01/22 COMPUTER PROGRAMS FOR ANIMATING, MODELING AND RENDERING IMAGES, FOR USE IN COMPUTER AIDED DESIGN, ANIMATION, GRAPHICS, GAME DESIGN AND DESIGN MODELING APPLICATIONS		

Attachments	76241195#TMSN.gif ( 1 page )( bytes ) Petition for Cancellation.pdf ( 6 pages )(143091 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/John L. Slafsky/
Name	John L. Slafsky
Date	11/29/2012



3. Petitioner is the well-known leader in the field of software for computer-aided design (“CAD”). CAD software is used in design applications by architects, engineers, manufacturers and others.

4. 3DS MAX is Petitioner’s name for its industry-leading computer graphics software for making animations, models and images. This software is used by architects, video and television producers, game developers and movie special-effects experts, among others.

5. Petitioner has been using the 3DS MAX mark in connection with its CAD software products since at least as early as 2001.

6. Petitioner has sold or licensed in commerce tens of millions of dollars of software products using the 3DS MAX mark.

7. Petitioner has distributed promotional materials, instruction manuals, and other documents featuring the 3DS MAX mark. Petitioner has included the 3DS MAX mark in the user interface of its software products. Petitioner has also promoted the 3DS MAX mark on its <autodesk.com> website.

8. Petitioner’s 3DS MAX mark has received considerable publicity. Upon information and belief, thousands of press reports have associated the 3DS MAX mark with Petitioner.

9. As a result of the significant sales and success of Petitioner’s products over a decade, users of CAD software have come to associate the 3DS MAX mark closely with Petitioner.

10. Petitioner’s 3DS MAX mark is symbolic of extensive goodwill and customer recognition built up by Petitioner.

11. Petitioner’s 3DS MAX mark is famous within the CAD software field. This fame pre-dates Respondent’s first use of 3DS as a trademark and Respondent’s application to register a trademark based on 3DS.

12. Petitioner owns the following federal trademark registration: Registration No. 2733869 for 3DS MAX for “computer programs for animating, modeling and rendering

images, for use in computer-aided design, animation, graphics, game design and design modeling applications” in International Class 9.

13. The first and predominant element of Petitioner’s 3DS MAX mark is 3DS.

14. Users of CAD software and related goods and services are likely to associate 3DS with Petitioner’s 3DS MAX mark or with Petitioner.

15. Petitioner is informed and believes, and therefore alleges, that Respondent nonetheless filed an application on September 21, 2011 to register 3DS as a trademark with the U.S. Patent and Trademark Office (“USPTO”), and this application matured into Registration No. 4,125,612.

16. According to public records of the USPTO, the current information concerning Registration No. 4,125,612 is as follows:

Registrant:	3D Systems, Inc.
Mark:	3DS AND DESIGN
Registration date:	April 10, 2012
International Classes:	1, 7, 9 and 40
Goods:	Solid imaging materials, namely, plastic, metal, wax, silicone, urethane, ceramic or composite materials, used to create three-dimensional embodiments of computer generated designs (International Class 1); computer driven machine for making three-dimensional embodiments of computer generated designs (International Class 7); computer software for use in designing three-dimensional objects and controlling machines for making three-dimensional embodiments of the objects (International Class 9); and manufacture of three-dimensional objects, namely, prototypes, models, patterns, molds, medical devices or finished goods, to the order and specification of others (International Class 40).

17. The predominant element of Registrant’s 3DS AND DESIGN mark is 3DS.

18. Respondent has registered the trademark 3DS AND DESIGN in connection with Class 9 goods that are substantially similar or identical to Petitioner’s Class 9 goods.

19. Respondent has registered the mark 3DS AND DESIGN in connection with goods and services in Classes 1, 7 and 40 that are directly related, or complementary with, to Petitioner’s goods and services.

20. In view of the substantially similar marks and goods and services of the parties, Respondent's 3DS AND DESIGN mark so resembles Petitioner's 3DS MAX mark as to be likely to cause confusion, to cause mistake, or to deceive.

21. As a result of the registration of 3DS AND DESIGN, confusion in the trade and in the public is likely to result. Confusion caused by Respondent will damage Petitioner and injure its reputation in the trade and with the public. That confusion will also injure the public, in that consumers, upon seeing Respondent's mark used in connection with Respondent's goods and services, are likely to believe that Respondent's goods and services are somehow associated with or approved by Petitioner.

22. As a result of Respondent's registration of 3DS AND DESIGN, the distinctiveness of Petitioner's 3DS MAX mark will be diluted.

23. Petitioner has been and will be damaged by the Respondent's registration of 3DS AND DESIGN because, among other reasons, the continued registration of this mark by Respondent may adversely affect the scope of Petitioner's rights to its 3DS MAX mark.

WHEREFORE, Petitioner prays that Registration No. 4,125,612 be cancelled and that this petition be sustained in favor of Petitioner.

Petitioner authorizes payment of the required filing fee of \$300.00 from its counsel's USPTO Deposit Account. Please charge the fee to Deposit Account No. 23-2415 ATTN: 5477.569.

Please address all U.S.P.T.O. communications concerning this Petition to Petitioner's

attorneys:

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Dated: November 29, 2012

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation



By: John L. Slafsky

Attorneys for Petitioner  
AUTODESK, INC.

**CERTIFICATE OF SERVICE BY NEXT-DAY DELIVERY**

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050. I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for next-day delivery by an express mail service. In the ordinary course of business, correspondence would be consigned to an express mail service on this date.

On this date, I served **PETITION FOR CANCELLATION** on the person(s) listed below by placing the document(s) described above in an envelope addressed as indicated below, which I sealed. I consigned the envelope(s) to an express mail service by placing it/them for collection and processing on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Keith Roberson  
3D Systems, Inc.  
333 Three D Systems Circle  
Rock Hill, South Carolina 29730-7811

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on November 29, 2012.

  
Elvira Minjarez