UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: October 30, 2014

Cancellation No. 92056509

Autodesk, Inc.

v.

3D Systems, Inc.

George C. Pologeorgis,
Interlocutory Attorney:

This case now comes before the Board for consideration of Petitioner's motion (filed August 7, 2014) to compel written discovery. The motion is fully briefed.

The Board carefully considered the arguments raised by the parties in their respective motion papers, as well as the supporting correspondence and the record of this case, in coming to a determination regarding Petitioner's motion. Based on the foregoing, the Board makes the following findings and determinations:

Petitioner's Motion to Compel Written Discovery

Initially, the Board finds that Petitioner has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention and that Petitioner's motion is timely. *See* Trademark Rule 2.120(e)(1).

As to the merits of Petitioner's motion to compel written discovery, Petitioner's motion is **GRANTED** to the extent noted below.

First, Respondent's general objections Nos. 8 and 9[1] to Petitioner's Interrogatory Requests and Document Requests are overruled. Accordingly, to the extent Respondent has failed to produce non-privileged responsive documents or provide information responsive to ANY of Petitioner's written discovery requests based upon its general objections Nos. 8 and 9, (which have now been overruled by this order), Respondent is allowed until **thirty (30) days** from the mailing date of this order to produce and/or provide such withheld documents or information.

Interrogatory Requests

Interrogatory Request No. 14

Respondent's general objections to this interrogatory request are overruled. The Board finds that the information sought in this interrogatory is relevant to the issues in this proceeding. Accordingly, motion is **GRANTED** to the extent that Respondent must supplement its response to this interrogatory request and identify the specific efforts or plans to promote or expand

[1] Respondent's general objections Nos. 8 and 9 concern Petitioner's definition of the term "3DS" in Petitioner's written discovery. Essentially, Respondent objects to Petitioner's definition on the ground that it is not required to respond to any discovery that does not concern its subject mark, as identified in its subject registration. Respondent is mistaken. Respondent's use of the mark 3DS in other forms and on other goods and/or services not specifically identified in its subject registration is relevant to Petitioner's claim of likelihood of confusion, as well as Respondent's asserted defenses.

consumer awareness of its 3DS mark and the goods and services provided thereunder. *See* TBMP § 414(8) ("A party's plans for expansion may be discoverable under protective order.").

Interrogatory Request No. 15

Respondent's general objections to this interrogatory request are overruled. Motion is **GRANTED** to the extent that Respondent must supplement its response to this interrogatory by identifying any marks it considered while in the process of selecting its 3DS mark.

Interrogatory Request No. 17

Respondent's general objections to this interrogatory request are overruled. The Board finds that the information sought in this interrogatory is relevant to the issues in this proceeding. Accordingly, motion is **GRANTED** to the extent that Respondent must provide a full and complete response to this request.

Interrogatory Request No 27

Respondent's general objections to this interrogatory are overruled. Motion is **GRANTED** to the extent that Respondent must supplement its response to this interrogatory and identify the approximate date Respondent first became aware of Petitioner and the approximate date Respondent first became aware of Petitioner's pleaded 3DS MAX mark. *See e.g., Dan Robbins & Assocs., Inc. v. Questcor Corp.*, 202 USPQ 100, 104-05 (CCPA 1979).

Interrogatory Request Nos. 1, 3-5, 9, 12, 22, and 24

Based upon the motion papers before the Board, Respondent agreed to provide amended responses to the above-identified interrogatory requests in order to clarify or supplement its original responses, but Respondent has yet to do so. Accordingly, motion is **GRANTED** to the extent that Respondent is required to supplement it responses to the above-identified interrogatory requests, without objection (except for objection based on privilege), within the time provided below.

Document Requests

Document Request Nos. 9, 12, 22, and 25

Respondent's general objections to the above-identified documents requests are overruled, except for objections based on privilege. The Board finds that the information sought in these document requests are relevant to the issues in this proceeding. Accordingly, motion is **GRANTED** to the extent that Respondent must produce non-privileged responsive documents to each of the above-identified document requests. To the extent the production of all documents responsive to each of the requests is overly burdensome, Respondent may produce a representative sampling of the requested documents for each request.

Document Request Nos. 1, 14, 18, 23-24, and 27-32

Based upon the motion papers before the Board, Respondent agreed to supplement its production in regard to the above-identified document requests in order to clarify its original responses, but Respondent has yet to do so. Accordingly, motion is **GRANTED** to the extent that Respondent is required to produce non-privileged responsive documents, without objection (except for objection based on privilege), to each of the above-identified document requests within the time provided below.

Summary

Respondent is allowed until **thirty (30) days** from the mailing date of this order in which to provide responses to Petitioner's Interrogatory Request Nos. **1, 3-5, 9, 12, , 14-15, 17, 22, 24, and 27**, to the extent ordered herein, if it has not already done so. Additionally, Respondent is allowed the same **thirty (30) days** provided above to provide its verification of the interrogatory responses compelled by this order, if it has not already done so. *See* Fed. R. Civ. P. 33(b)(5) and TBMP § 405.04(c).

Respondent is also allowed until **thirty (30) days** from the mailing date of this order to copy and produce non-privileged documents responsive to Petitioner's Document Request Nos. **1, 9, 12, 14, 18, 22-25**, to the extent indicated herein. If there are no responsive, non-privileged documents in Respondent's possession, custody or control which are responsive to any of

the above-identified document requests, Respondent must so state affirmatively in its response to the corresponding document request. To the extent Respondent has already produced documents responsive to any of the above-identified document requests, Respondent must so state in its response to the particular document request and identify, by bates number, the documents which are responsive to each request.

Additionally, Respondent is required to provide Petitioner a privilege log within the same **thirty (30) days** provided above to the extent that Respondent claims privilege to any of Petitioner's discovery requests, if it has not already done so.[2]

In the event Respondent fails to provide Petitioner with full and complete responses to the outstanding discovery, as required by this order, Respondent will be barred from relying upon or later producing documents or facts at trial withheld from such discovery.[3] *See* Fed. R. Civ. P. 37(c)(1).

Trial Schedule

Proceedings are resumed. Trial dates are reset as follows:

Expert Disclosures Due	**11/30/2014**

[2] The Board expects the parties (and their attorneys) to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. TBMP § 408. Each party and its attorney have a duty to make a good faith effort to satisfy the discovery needs of its adversary. *Id.*

[3] If Respondent fails to comply with this order, Petitioner's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. *See* Fed. R. Civ. P. 26(e).

Discovery Closes for both parties[4]	**12/30/2014**
Plaintiff's Pretrial Disclosures	**2/13/2015**
Plaintiff's 30-day Trial Period Ends	**3/30/2015**
Defendant's Pretrial Disclosures	**4/14/2015**
Defendant's 30-day Trial Period Ends	**5/29/2015**
Plaintiff's Rebuttal Disclosures	**6/13/2015**
Plaintiff's 15-day Rebuttal Period Ends	**7/13/2015**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

[4] Although the Board, pursuant to its April 12, 2014, order, advised the parties that it would not entertain any further requests to extend the close of discovery, whether consented to or not, in light of the ruling herein, discovery will be extended in this instance only to allow Petitioner time in which to review Respondent's discovery responses compelled by this order and to conduct follow-up, if necessary.