ESTTA Tracking number: **ESTTA641706**
Filing date: **11/29/2014**

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

Proceeding	92056509
Party	Defendant 3D Systems, Inc.
Correspondence Address	JASON M SNEED SNEED PLLC 610 JETTON ST STE 120-107 DAVIDSON, NC 28036 9318 UNITED STATES jsneed@sneedlegal.com, clandrum@sneedlegal.com, sarah@sneedlegal.com, litigation@sneedlegal.com
Submission	Other Motions/Papers
Filer's Name	Jason M. Sneed
Filer's e-mail	jsneed@sneedlegal.com, sarah@sneedlegal.com, giacona@sneedlegal.com, litigation@sneedlegal.com
Signature	/Jason M. Sneed/
Date	11/29/2014
Attachments	2014-11-29 Respondent's Motion for Partial Reconsideration of October 30, 2014 Order.pdf(1317914 bytes)

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

Registrant: 3D Systems, Inc.
Mark: 3DS & Design
Reg. No.: 4,125,612 in Classes 1, 7, 9 and 40
Registered: April 10, 2012

Autodesk, Inc. Petitioner, v. 3D Systems, Inc., Respondent	)	Cancellation No. 92056509

RESPONDENT'S MOTION FOR PARTIAL RECONSIDERATION OF OCTOBER 30, 2014 ORDER

I. Introduction

Respondent moves for partial reconsideration of the Board's Order dated October 30, 2014, which granted the motion to compel of Petitioner filed August 7, 2014 (hereinafter, the "Order"). As set forth below, parts of the Order contradict the discovery guidelines set forth in the Trademark Board Manual of Procedure ("TBMP") and other parts of the Order are devoid of authority or precedent. The Order also does not take into account the burden to be placed on Respondent to comply with it. Respondent has taken steps to comply with the parts of the Order not subject to this motion for reconsideration, as described below. [1]

[1] Notably, Respondent has served supplemental discovery responses addressing elements of the Board's order not contested herein, and Respondent has served over 800 additional documents responsive to the Petitioner's requests for production.

Respondent respectfully requests that the Board reconsider its Order and withdraw the following five determinations:

- 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." (Order, p.1). Petitioner's filing of its motion to compel immediately following receipt of a letter from Respondent's counsel requesting a meet and confer and identifying Petitioner's own discovery deficiencies constitutes gamesmanship discouraged by the Board, and shows that Petitioner failed to make a "good faith effort" to resolve the parties' respective discovery disputes;

- That "Respondent's general objections Nos. 8 [defining "3DS" broadly to encompass marks *other than* the registered 3DS & cube design mark] and 9 [defining "3DS Product and Service" broadly to include goods and services sold under marks *other than* the registered 3DS & cube design mark] to Petitioner's Interrogatory Requests and Document Requests are overruled" (Order, p.2, internal footnote omitted);[2]

- That "Respondent must supplement" its response to Interrogatory No. 14 to "identify the specific efforts or plans to promote or expand consumer awareness of its 3DS mark and the goods and services provided thereunder," to the extent the order pertains to: (a) any mark other than the registered 3DS & cube design mark subject to this proceeding; or (b) as to Respondent, a publicly-traded company, any plans that have not been made public for expansion of the registered mark (the mark used with all of Respondent's goods and services), and that Respondent's objections to related Request for Production No. 9 [demanding production of marketing plans] and No. 12 [demanding production of documents pertaining to Registrant's "plans to promote" its goods and services] are overruled;

- With respect to Interrogatory No. 17 requiring a description of "any studies, tests, ratings, or surveys relating to the quality of the 3DS Products and Services," and corresponding Request for Production No. 18, that Respondent's general objection Nos. 1 (overly broad and unduly burdensome), 2 (not reasonably calculated to lead to the discovery of admissible evidence) and 9 (objecting to Petitioner's definition of "3DS Product or Services") "are overruled" and that "the information sought in this interrogatory is relevant to the issues of this proceeding."

- That Respondent "agreed to provided amended responses to" Interrogatory No. 3 and Requests for Production 28 and 31, when there is no support in the record for any such agreement other than the letter of Petitioner's counsel, which alleged agreement to amend (and the necessity to amend) certain discovery responses is contested by Respondent.

---

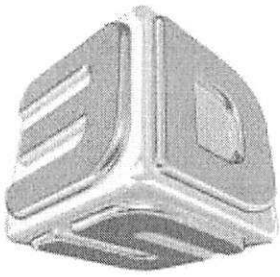
[2] Relatedly, the Board confusingly refers to Respondent's mark throughout the Order as "its 3DS mark," which, under the Petitioner's exceedingly broad definition adopted in the Order, now encompasses marks other than the 3DS & cube design mark subject to U.S. Reg. 4,125,612 and this Cancellation No. 92056509, even encompassing Petitioner's own 3DS MAX mark and marks of any third-party having "3DS" as a component. This vague and/or broad definition of "3DS mark" to encompass other marks violates Board precedent and the TBMP Rules.

Respondent respectfully submits that the Order is in error as to each of these parts, insofar as the Board's Order departs from established practice and precedent in many respects without a reasoned explanation. Respondent thus requests that its Motion for Partial Reconsideration of October 30, 2014 Discovery Order discussed herein be reversed or modified accordingly.

II. Background Facts and Procedural Posture

Respondent incorporates by reference the Background Facts and Procedural Posture from its Response to Petitioner's Motion to Compel. TTABVUE 27 at pp. 2-4. Respondent reiterates and emphasizes the following facts:

Petitioner Autodesk, Inc. ("Petitioner" or "Autodesk") initiated this cancellation proceeding on November 29, 2012, challenging Respondent 3D Systems, Inc.'s ("Respondent" or "3D Systems") registration of its 3DS & Design Mark (Reg. No. 4,125,612) on the basis of priority and likelihood of confusion and dilution in favor of Autodesk's 3DS MAX word mark. 3D Systems' registered mark subject to this proceeding is shown here:



Autodesk later dismissed its dilution claim in light of 3D Systems' motion to dismiss. TTABVUE 12, 13. Autodesk has no pending claim for dilution, by blurring or by tarnishment, in this cancellation proceeding. TTABVUE 1, 12, 13.

Respondent made its initial document production to Petitioner on June 11, 2014. On June 18, 2014, Counsel for Petitioner (Stephanie Brannen) wrote to Respondent indicating that Petitioner's counsel ***had not yet looked at Respondent's document production***. TTABVUE 27, pp. 3-4, Exhibit 5. ***This was the last communication counsel for Respondent received from counsel for Petitioner pertaining to Respondent's discovery responses and production prior to Petitioner's filing of its motion to compel***: not a single phone call, email, or letter was made or sent between June 18, 2014 and August 7, 2014 regarding the sufficiency of Respondent's production or discovery responses.

The parties, however, did have communications between June 11 and August 13 about Petitioner's discovery obligations. Petitioner produced documents on June 27 and July 10. On August 5, 2014, Respondent's counsel, Sarah Hsia, wrote to Petitioner's counsel to outline several deficiencies in Petitioner's discovery responses and production, <u>and requesting a meet and confer within the following eight days, by August 13, 2014</u>. In Ms. Hsia's August 5, 2014 letter, she stated that 3D Systems would like to meet and confer "to discuss the remaining deficiencies and to satisfy our obligation under Fed. R. Civ. P. 37(a)(1) and 37 C.F.R. §2.120(e)(1) to make a good faith effort to resolve these issues prior to filing a Motion to Compel." TTABVUE 27, p. 4, Exhibit 8.

The day after Ms. Hsia sent her request for the meet and confer, August 6, 2014, Respondent served its second set of discovery requests on Petitioner, and served several deposition notices to take the depositions of witnesses identified in Petitioner's initial disclosures. TTABVUE 27, at p.4.

Without responding to the request to meet and confer, and the day after receiving Respondent's second set of discovery requests and notices of deposition, on August 7, 2014,

Petitioner hastily filed its motion to compel. TTABVUE 27, at p.4. Petitioner made no further effort to inform Respondent what, if any, deficiencies remained in Respondent's discovery responses and production following their review of Respondent's production materials. Petitioner did not even respond to Ms. Hsia's August 5 request (served via email and mail) for a meet and confer before firing off the motion to compel. Petitioner's actions smack of gamesmanship of the first order. *See* TTABVUE 25.

On October 30, 2014, the Board issued an Order summarily granting Petitioner's Motion to Compel (the "Order"). TTABVUE 29. The Board overruled Respondent's objections to the discovery requests, including their vastly overbroad definitions, while the Order contained little to no legal support or explanation for the conclusions reached therein. While the Respondent appreciates that the Board has a duty to advance proceedings and often has to make difficult decisions about contested discovery disputes, Respondent respectfully states that the Order contradicts Board precedent and the TBMP guidelines in several respects, and fails to take into account the real-world challenges to be faced in complying with its terms, as understood.

III. Standard of Review of Motion for Reconsideration

"The premise underlying a request for reconsideration is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued." *Sterling Jewelers Inc. v. Romance & Co., Inc.*, Opposition No. 91207312, 2014 WL 4407973, at *2 (TTAB Aug. 29, 2014); *see also* TBMP § 518 ("the motion should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change.").

Proceedings before the Board are governed by the Lanham Trademark Act of 1946, as amended, the Trademark Rules of Practice, Federal Rules of Civil Procedure and decisional law,

including decisions of the Board itself and the Court of Appeals for the Federal Circuit. TBMP §§ 101.01 – 101.03. Furthermore, decisions of the Board itself that are not designated as "citable as precedent" may still be entitled to persuasive weight, and may be cited therefor. TBMP § 101.03. It is standard practice for the Board to cite to authority to support its decisions and orders, and indeed, if it "departs from established precedent without a reasoned explanation, its decision will be vacated as arbitrary and capricious." *Fred Beverages, Inc. v. Fred's Capital Mgmt. Co.*, No. 2010-1007 (Cancellation No. 92048454), 605 F.3d at 967 (Fed. Cir. 2010).

IV. Argument Supporting Reconsideration and Amendment of the Order

A. The Board Erred in Finding that Petitioner Made a Good Faith Effort to Resolve the Parties' Discovery Dispute prior to Seeking Board Intervention

The Board ruled, without explanation, that Petitioner "made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention." TTABVUE 29 at p. 1. Respondent respectfully submits that this decision was in error. Board precedent provides that the Board requires more effort than a "single, non-substantive communication" prior to filing a motion to compel. *Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, at *7 (TTAB 2014). Here, there is no dispute that the parties had discussions about the sufficiency of Respondent's discovery responses in May 2014. Respondent subsequently produced documents to Petitioner in June 2014, received and reviewed Petitioner's production materials in June and July 2014, then, on August 5, articulated by letter its concerns with the deficiencies in Petitioner's discovery responses and production. On August 6, Respondent served, via email and mail, its second set of discovery requests on Petitioner, along with deposition notices for Petitioner's witnesses. Without uttering another word about any alleged deficiencies in Respondent's production, or having a single substantive conversation about Respondent's production after receiving Respondent's discovery documents, on August 7

Petitioner filed its own motion to compel. Petitioner ignored Respondent's request for a meet-and-confer about the parties' respective discovery obligations made just two days before, instead running to the Board to be first in line with its motion to compel. Such acts fly in the face of Board guidelines and precedent, and the Order's findings 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" are in error. TTABVUE 29 at p. 1.

The Order departs from the established practice of the Board as illustrated by *Hot Tamale Mama*, and the Board has provided no explanation for such a departure. *See Hot Tamale Mama*, 110 USPQ2d 1080, at *7 (TTAB 2014); *see also Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 U.S.P.Q. 626, at *8 (TTAB Oct. 3, 1986) (Denying a motion to compel on the grounds that movant had not complied with Trademark Rule 2.120(e) and noting that "[t]he only evidentiary support of applicant's efforts...consisted of a copy of a February 8, 1985 letter to opposer's counsel in which applicant characterized opposer's responses to certain interrogatories..."). To date, there has been ***no communication*** from counsel for Petitioner responding to Respondent's letter requesting a conference to discuss any outstanding discovery deficiencies, and apart from filing Petitioner's Motion to Compel, counsel for Petitioner has yet to indicate that Petitioner considered Respondent's document production to be deficient in any way. *See* TTABVUE 27 at pp. 5-6.

Respondent posits that the Board's finding that Petitioner has made a good faith effort is in error, as it departs from Trademark Rule 2.120(e)(1) and established Board precedent without a reasoned explanation. *Fred Beverages,* No. 2010-1007 (Cancellation No. 92048454), 605 F.3d at 967 (Fed. Cir. 2010). The Board's order does not acknowledge or state what acts, if any, allegedly constituting "good faith efforts" on the part of Petitioner, and the acts themselves – or

lack thereof – demonstrate a lack of good faith effort. Respondent requests that the Board's decision be reconsidered and reversed.

B. The Board Erred in Ordering Respondent to Produce Documents and Information Concerning Marks not at Issue in this Proceeding

The Board overruled 3D Systems' general discovery objection Nos. 8 and 9, objecting to the overbreadth of Petitioner's definition of the "3DS mark" and the "3DS Products and Services" to be applicable to marks not subject to this cancellation proceeding. The Board ruled, without explanation, "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." TTABVUE 29 at n.1. Such ruling is in error, both due to its lack of support and due to its overbreadth.

The Board provided no explanation as to why or how ***Respondent's*** other marks containing the letters "3DS" are relevant to either Petitioner's claims or Respondent's defenses. The Board provides no explanation or controlling authority to depart from its precedent in the *Volkswagenwerk* case where marks not at issue in a proceeding were found not to be relevant to the issue of likelihood of confusion. *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*, 176 USPQ 493 (TTAB 1973) (denying a motion to compel discovery about marks not at issue in a proceeding on the grounds that they are not relevant to the issue of likelihood of confusion).

Petitioner's main argument in support of its motion to compel on this point is that "Respondent's use of '3DS' beyond the specific mark in the Registration is key to understanding...the full scope of goods and services promoted by Respondent under its 3DS-related marks generally." TTABVUE 25 at p. 8. However, Respondent has made it abundantly clear that the 3DS and Design Mark that is named in the Petition for Cancellation is used as a house mark, in connection with ***every product and service provided by Respondent.*** TTABVUE

27 at p. 7. Thus, when producing representative samples of its marketing and advertising materials in which the registered mark is used, Respondent already is providing Petitioner with materials sufficient to identify "the full scope of goods and services promoted by Respondent." To the extent that the Board accepted Petitioner's argument as the basis for its Order, the Board's order is silent.

Moreover, to the extent that the Board accepted Petitioner's argument that Respondent's discovery requests to Petitioner concerning ***Petitioner's*** use of the term "3DS" somehow render Respondent's other marks relevant to the cancellation proceeding, Respondent respectfully maintains that any reliance by the Board thereon was misplaced and in error. Respondent is entitled, for purposes of a likelihood of confusion analysis, to attack the strength of Petitioner's mark, and to seek discovery on other, similar marks coexisting with Petitioner's mark, and/or to obtain information and materials showing how Petitioner has used its 3DS MAX mark and the component elements of that mark. Discovery may reveal, for example, that Petitioner has used the 3DS and MAX terms in a generic fashion, or in a functional manner, and/or that Petitioner is incapable of enforcing any putative rights in the 3DS MAX mark, by virtue of Petitioner's use of the .3ds and .max file extensions for software, the very goods for which Petitioner has registered the 3DS MAX mark.[3] Thus, Respondent's inquiry into Petitioner's use of 3DS-formative terms and marks do not make relevant any use by Respondent of any other 3DS-formative term not subject to this cancellation action.

---

[3] See, e.g., *Autodesk, Inc. v. Lee,* 1:13-cv-01464-AJT-JFA, E.D.Va. Oct. 30, 2014 (Memorandum Opinion granting summary judgment in favor of the USPTO on Autodesk's appeal to the District Court following the PTO's denial of registration to Autodesk's DWG, DWG & Design, DWG TRUEVIEW, DWG TRUECONVERT and DWG EXTREME marks for failure to establish acquired distinctiveness in light of Autodesk's use of .dwg as a file extension). The Eastern District of Virginia characterized the "DWG" mark as "at best, a descriptive mark." *Id.* at 4. Similarly, Autodesk uses and freely permits others to use the terms .3ds and .max as software file extensions, yet seeks to cancel 3D Systems' registration of its extensively-used 3DS & Design mark (indeed, its house mark since 2011) in multiple classes based on Autodesk's own tenuous claim of rights.

Finally, to the extent that the Board accepted Petitioner's argument that "Respondent...reserves its right to argue that "3DS" is an abbreviation of its business name that it has used for years" and that this renders Respondent's other marks relevant to this proceeding, it is respectfully submitted that this finding is also in error. The only evidence cited by Petitioner in support of this contention, is a letter written by Counsel for ***Petitioner*** which does not even mention the proposition for which it is cited. TTABVUE 25, Brannen Declaration, Exhibit 9. The Board cites no reason for any relevance determination.

Respondent seeks reconsideration of the decision that Respondent's general objection Nos. 8 and 9 are overruled, and that Respondent must produce materials pertaining to any uses of Respondent's other marks than the design mark subject to this cancellation proceeding.

C. <u>The Board Erred in Ordering Respondent, a Publicly-Traded Company, to Produce Marketing Plans and Projections for Its Use of Its House Mark</u>

Respondent also seeks reconsideration of the Board's order that "Respondent must supplement" its response to Interrogatory No. 14 to "identify the specific efforts or plans to promote or expand consumer awareness of its 3DS mark and the goods and services provided thereunder," to the extent the order pertains to: (a) any mark other than the registered 3DS & cube design mark subject to this proceeding; or (b) any plans that have not been made public for expansion of the registered mark (the mark used with all of Respondent's goods and services) by Respondent, a publicly-traded company. Similarly, the Board's overruling of Respondent's objections to related Request for Production No. 9 [demanding production of marketing plans] and No. 12 [demanding production of documents pertaining to Registrant's "plans to promote" its goods and services] is in error as unsupported, and overly broad and unduly burdensome.

First, the Board has provided no reasoning or explanation for its order that Respondent's response to Interrogatory No. 14 was insufficient, or that the production made in response to

request for production Nos. 9 or 12 was deficient, other than by citing to TBMP § 414(8) ("A party's plans for expansion may be discoverable under protective order."). There are two reasons the Board's order is overbroad and should be reconsidered.

First, as to the subject registered 3DS & Design mark, which Respondent uses as its primary or house mark for all of its goods and services, the Board's order as understood would require 3D Systems, a publicly traded company, to inform Autodesk of 3D Systems' plans for expansion of its business generally. There is no dispute that 3D Systems uses the 3DS & Design mark broadly across its entire product line. 3D Systems, a publicly-traded technology company, also has been active in recent years in acquiring other companies and/or their assets. The Board's order thus may conflict with U.S. securities laws by requiring 3D Systems to produce in this proceeding any non-public information and materials about its "specific efforts or plans to promote or expand consumer awareness," such as non-public information about merger and acquisition activities. 3D Systems already has identified, in response to Interrogatory No. 1, over 60 products and services for which the 3DS & Design mark currently is used, together with the accompanying product line mark references, and with which the 3DS & Design mark is used as a house mark. To the extent other business lines are acquired in the future, it is likely that the registered 3DS & Design mark would be used with the marks under which those products are sold as well. *See* TTABVUE 25, at Exh. 11 and p.111. But to inform Autodesk or any person about 3D Systems' *plans* for expansion of its house mark necessarily would involve informing them of 3D Systems' non-public information about merger and acquisition activities, placing the company in the position of having to choose between compliance with the Board's discovery ruling or security laws impacting disclosure of non-public information about a publicly-traded entity.

Second, in light of the Board's overruling of Respondent's general objection Nos. 8 and 9, the Board's order as to Interrogatory No. 14 and RFP Nos. 9 and 12 is exceedingly broad. The Board has provided no explanation for how it reached the conclusion that Petitioner met its burden to show that "[a]ll marketing plans, marketing projections [and] other marketing documents prepared by or for [Respondent] relating to the sale, proposed sale, rendering or proposed rendering of any ["product or service offered for sale, offered for distribution, sold, distributed, advertised, marketed, or promoted in the United States by [Respondent] or by [Respondent's] licensees – in connection with ["any word, name, symbol or device or other designation of origin incorporating the letter string 3DS"]]]" are relevant and necessary to its claims. The Board's failure to articulate any basis for its relevance conclusion deviates from precedent such as *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*, 176 USPQ 493 (TTAB 1973) without a reasoned explanation. *See* TTABVUE 25 at p. 7 (setting forth definitions of "3DS Product or Service" and "the mark 3DS").

The *Volkswagenwerk* case is clear that in order to compel the production of commercially sensitive business information such as that called for by Document Request No. 9, the burden is on Petitioner to show that this information is both "relevant ***and necessary***" to its claims. *Volkswagenwerk*, 129 USPQ 493, at *2 (TTAB 1973) (*citing Hartley Pen Co. v. United States District Court for the Southern District of California*, 129 USPQ 152 (CA 9, 1961)) (emphasis added). Here, the Board summarily found that "the information sought in these document requests are [sic] relevant to the issues in this proceeding." TTABVUE 29 at p. 4. But the Board did NOT make a finding – nor did Petitioner even argue - that Petitioner has met its burden of showing that the information sought by Document Request No. 9 is ***necessary*** to Petitioner's claims, thus departing from the established precedent of *Volkswagenwerk* without explanation.

Volkswagenwerk, 129 USPQ 493 (TTAB 1973). It is respectfully submitted that the Board's decision is thus in error, as Petitioner has not shown, as is its burden, that this information is "relevant and necessary" to its claim for cancellation.

Moreover, Respondent submits that the Board's finding of relevance of these materials is in error. Petitioner cites, in its motion to compel, the *Johnston Pump/General Valve* case for the proposition that "opposer's intent to expand business to include manufactured products similar to applicant's is relevant." TTABVUE 25, at p. 10. It is unclear whether the Board relied on this case. To the extent that it did, however, the *Johnston Pump* case does not support the proposition. *Johnston Pump* stands for the proposition that ***Petitioner's*** plans for expansion could be relevant, not Respondent's. *See Johnston Pump/Gen. Valve, Inc. v. Chromalloy Am. Corp.*, 10 USPQ2d 1671, at *4 (TTAB 1988); *J. Wiss & Sons Co. v. W.E. Bassett Co.*, 174 USPQ 331 (CCPA 1972) ("The natural scope of expansion inquiry focuses on whether a "***prior user's*** [e.g. Petitioner] line of goods would normally or reasonably expand to include [another] line of goods.") (emphasis added).

The Board should withdraw its order with respect to Interrogatory No. 14 and related Request for Production Nos. 9 and 12.

D. <u>The Board Erred in Ordering Respondent to Produce All Documents Pertaining to the Quality of Respondent's Goods and Services</u>

The Board ordered Respondent to respond to Interrogatory No. 17 by requiring a description of "any studies, tests, ratings, or surveys relating to the quality of the 3DS Products and Services," and that Respondent produce documents in response to related Request for Production No. 18. The Board overruled Respondent's objections that these discovery requests are overly broad and unduly burdensome (general objection No. 1) and not reasonably calculated to lead to the discovery of admissible evidence (general objection No. 2), and Respondent's

objections to Petitioner's definition of "3DS Product or Services" to include reference to goods and services sold under marks not at issue in this proceeding (general objection No. 9), stating, without explanation, that "the information sought in this interrogatory is relevant to the issues of this proceeding." TTABVUE 29 at p. 3.

There is no relevance to the information sought in Interrogatory No. 17 and the documents sought in response to RFP No. 18, and the Board certainly has provided no explanation for its Order, such as by indicating ***how*** information relating to the quality of Respondent's products is relevant to this proceeding. There is no dilution by tarnishment claim pending in this proceeding, for example. *See, e.g., Devries v. Ncc Corp.*, 227 U.S.P.Q. 705, at n.3 (TTAB 1985) (noting that tarnishment is "not [a] matter[] which may be entertained by the Board as grounds for cancellation, nor is it necessary that petitioner prove either dilution or tarnishment in order to prevail on his claim of likelihood of confusion.").

3D Systems is a high tech company that makes and sells 3D printers and related products and services having a wide variety of applications in fields as diverse as medical devices, consumer products and even food preparation. 3D Systems uses its registered 3DS & Design Mark broadly across all of its products and services, and has conducted, as a regular part of its business, quality testing and review, much of which is subject to federal government oversight. The Board's order that it describe any and all quality testing, and produce related documents, for literally hundreds of products and services, would require the description of, and review and production of documents pertaining to a vast amount of material, at a cost of tens – if not hundreds – of thousands of dollars. Moreover, Petitioner's discovery requests concerning the quality of Respondent's good and services are so overbroad that they would include information pertaining to ***each and every test performed on every product and service provided*** by

Respondent before it is offered to the public. For example, Respondent's quality control processes include, but are not limited to, safety testing, product life testing, European Conformity (CE) testing, Technical Inspection Organization testing, Underwriters Laboratories testing, American Society for Testing and Materials testing, and various regulatory testing, including testing to ensure FDA and OSHA compliance. To identify responsive materials and produce relevant documents would be extensively burdensome on Respondent. Still further, the production of such documents and information would also require the production of vast amounts of trade secret and highly confidential information about 3D Systems' goods and services, since much of the testing performed on the company's products and services is secretive and subject to non-disclosure agreements with various third-party testing agencies and organizations. In any event, these materials cannot be produced short of sensitive contract negotiations with other companies involved in production and testing of Respondent's products.

Meanwhile, none of this quality testing and review material would be expected to be relevant to this proceeding, and neither Petitioner nor the Board has explained any basis for such relevance argument. Petitioner's sole argument for the relevance of information pertaining to the quality of goods and services offered under the 3DS & Design mark is that it "sheds light on the relationship between the parties' goods and businesses and how consumers perceive Respondent and the goods and services it offers under the [3DS & Design] mark [and] therefore it unquestionably is a 'fact probative of the effect of use'" for purposes of a likelihood of confusion analysis, and cites to *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). But the *du Pont* case, as cited by Petitioner, stands only for the proposition that the Board, in considering likelihood of confusion under the Lanham Act, §2(d), must consider "any other fact probative of the effect of use." *Id.* The *du Pont* case does

not support the proposition that the quality of Respondent's goods and services is a fact probative of the effect of use, nor does it support the proposition that the quality of Respondent's goods and services is relevant to any issue or claim in this Cancellation Proceeding where tarnishment is not at issue. It is thus respectfully submitted that the Board's Order is in error in finding information relating to the quality of Respondent's goods and services to be relevant.

E. The Board Erred by Misapprehended Respondent's Agreement to Supplement Certain Discovery Responses

1. Respondent Did Not Agree to Supplement Interrogatory No. 3

Respondent has discharged its responsibility to respond to Interrogatory No. 3 (which sought identification of "the time period (including month and year) during which [Respondent] offered each of [its] products and services") except for the portion on which Respondent moves for reconsideration. Respondent responded to Petitioner's interrogatory by stating:

> General Objection No. 1. Subject to, and without waiving the foregoing objections, Respondent states that it has used continuously its 3DS & Design Mark in connection with solid imagining materials since at least August 1, 2011, computer drive machines for making three-dimensional embodiments of computer generated designs since at least August 1, 2011, computer software for use in designing three-dimensional objects and controlling machines for making three-dimensional embodiments of the objects since at least August 1, 2011, and manufacturing services pertaining to three-dimensional objects since at least August 1, 2011.

Respondent also, in response to Interrogatory No. 1, provided a listing of over 60 specific products and services sold in conjunction with the 3DS & Design mark and the respective product or services' respective marks.

The Board has presumed, erroneously, that Petitioner's counsel accurately recited what Respondent agreed to produce and/or supplement in her June 18 letter. To the contrary, Petitioner filed its premature motion to compel after Counsel for Respondent requested a Rule 37 conference to discuss the outstanding discovery obligations, which discussion would have

addressed Respondent's responsive obligations pertaining to Interrogatory No. 3. It is incorrect that Respondent had agreed to provide a more detailed response this interrogatory than is originally provided in the response. Moreover, the documents already produced further identify specific products and services offered and sold under the subject mark, and a good-faith discussion among counsel could have isolated what Petitioner's counsel sought to have addressed and identified any production materials that may have been responsive to the request. Had a supplementation been necessary after such a good faith conference, one could have been offered or provided. The Board erred in ordering Respondent to supplement its response to this interrogatory based on an alleged agreement that did not exist.

2. Respondent DidNot Agreed to Supplement Interrogatory Nos. 1, 4 and 5 Because the Responses Already Were Complete.

Contrary to the Board's order, Respondent never agreed to supplement its responses to Petitioner's Interrogatory Nos. 1, 4 and 5 as Respondent provided complete and accurate responses to these requests on January 17, 2014. TTABVUE 25, Exhibit 11. For example, in response to Interrogatory No. 1 (which requests identification of every product and service [Respondent has] offered in connection with the mark 3DS.") Respondent listed over 60 products and services currently sold in conjunction with the 3DS & Design mark. Respondent further provided information regarding Respondent's annual sales (in response to Interrogatory No. 4) and the time periods indicating Respondent's continuous use of the 3DS & Design mark (in response to Interrogatory No. 5), and Respondent has produced documents further identifying Respondent's sales figures for the relevant time periods. Counsel for Petitioner even acknowledged, in its only communication to Respondent's Counsel before filing its motion to compel, that Counsel for Respondent clarified its interrogatory responses during the parties'

discovery conference and that the only issue remaining regarding these interrogatories is "a dispute over the definition of the term '3DS'." TTABVUE 25, Exhibit 9.

Respondent also never agreed to supplement its responses to Petitioner's Requests for Production Nos. 28 and 31, a fact which Petitioner's Counsel again acknowledges in its June 18th letter. TTABVUE 25, Exhibit 9. As with the interrogatories, the remaining dispute dealt with the definition of individual terms, including "mark 3DS" and "3DS Product or Service." TTABVUE 25, Exhibit 9. Specifically, Respondent's Counsel never agreed to produce documents in response to Request for Production No. 31 (requesting documents "relating to studies, tests, ratings, or surveys in connection with consumer recognition of any 3DS Product or Service") as this issue, highlighted above as irrelevant, overly broad and unduly burdensome. Respondent further never agreed to produce documents in response to Request for Production No. 28 asking for "all investigations conducted by [Respondent] or on [Respondent's] behalf in connection with the availability, registrability, or use of the mark 3DS" as this information calls for the production of documents or information protected from discovery by the attorney-client privilege. TTABVUE 25, Exhibit 14.

If there exists any other dispute between the parties as to these discovery requests, Petitioner's Counsel never articulated this dispute to Counsel for Respondent prior to filing its motion to compel. Respondent's Counsel also never agreed to supplement its responses as they believed the prior disputes were resolved during the discovery conference. As such, Respondent should not be ordered to supplement its responses to which Petitioner's counsel already agreed were sufficient.

V. Conclusion

For the foregoing reasons, Respondent respectfully requests that the Board reconsider the parts of its Order on Petitioner's Motion to Compel discussed above, and amend its Order as sought herein.

Dated: November 29, 2014

Respectfully Submitted,

/s/ Jason M. Sneed

Jason M. Sneed, Esq.
Sarah C. Hsia, Esq.
Gina Iacona, Esq.
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, NC 28036
Tel.: 704-779-3611
Email: JSneed@SneedLegal.com

Attorneys for Respondent 3D Systems, Inc.

Certificate of Filing / Certificate of Service

The undersigned hereby certifies that the foregoing *Respondent's Motion for Partial Reconsideration of October 30, 2014 Order* was filed via ESTTA, and that a copy was placed in U.S. Mail, postage prepaid, addressed to the following counsel of record:

John L. Slafsky
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, California 94304-1050
Attorneys for Petitioner Autodesk, Inc.

This the 29th day of November, 2014.

/s/ Jason M. Sneed
An Attorney for Respondent