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

Proceeding	92056509
Party	Plaintiff Autodesk, Inc.
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Attachments	Petitioner Opposition to Respondent Motion to Compel Discovery.pdf(163154 bytes)

basis for this belated request, which comes well over four months since Respondent's last communication regarding Petitioner's discovery responses.

By its motion, Respondent seeks three broad categories of documents and information from Petitioner: (1) documents and information (including admissions, which, under TBMP § 523.01, are not properly the subject of a motion to compel) regarding the <.3ds> computer software file extension; (2) certain documents and information which Petitioner agreed to provide; and (3) a more detailed privilege log. Respondent's motion should be denied for the following reasons: (1) the <.3ds> computer software file extension is irrelevant to the claims and defenses in this cancellation proceeding; (2) after conducting a thorough collection and review of tens of thousands of documents, Petitioner has produced all non-privileged documents it agreed to provide, to the extent they exist within its custody, control, or possession and could be located after a reasonable search; and (3) although Petitioner believes the descriptions in its privilege log are sufficient, it has in any event provided Respondent with an amended privilege log with additional detail.

Respondent's attempt to reopen discovery is unfounded. Under the Discovery Order, discovery remained open for the limited purpose of allowing Respondent to produce documents and information it had improperly withheld, and to allow Petitioner to seek follow-up discovery as appropriate. Respondent waited six weeks to file this motion seeking additional discovery from Petitioner and yet has made no arguments justifying the reopening of discovery.

I. BACKGROUND

On November 29, 2012, over two years ago, Petitioner filed its Petition, seeking to cancel registration of Respondent's 3DS (and design) mark, Registration No. 4125612. Petitioner has sought cancellation on the basis that continued registration of Respondent's mark is likely to

cause confusion with Petitioner's pre-existing 3DS MAX mark, Registration No. 2733869. Pet. for Cancellation (Docket No. 1).

As to discovery, Respondent has propounded on Petitioner two sets of Interrogatories, two sets of Requests for Production, and two sets of Requests for Admission. Petitioner timely provided full responses and objections to all of these requests.²

On August 5, 2014, Respondent sent a letter to Petitioner raising complaints regarding perceived deficiencies in Petitioner's discovery responses; on August 7, a mere two days later, Petitioner provided formal supplemental responses to Respondent's first set of requests for production and interrogatories. With these supplemental responses, Petitioner included a letter explaining that Petitioner's position regarding any requests relating to the <.3ds> file extension had not changed from its original responses (a position unequivocally reiterated by Petitioner during the meet-and-confer discussions). Respondent did not correspond further with Petitioner regarding any perceived deficiencies with respect to Petitioner's responses. Petitioner filed a motion to compel on August 7, 2014, and Respondent made no attempt to raise any of these issues at that time, when the Board could have chosen to address the parties' discovery disputes simultaneously, thereby avoiding the kind of delay that has now slowed this proceeding. Furthermore, in opposition to Petitioner's August 7, 2014 Motion to Compel, Respondent never indicated to the Board that it would need additional time to conduct discovery; accordingly, in its Discovery Order on October 30, 2014, the Board did not extend Petitioner's time for taking discovery. Petitioner did not immediately seek relief from such order, and although it has filed a

² In March 2014, the parties exchanged correspondence concerning alleged deficiencies in their written discovery responses and objections. The parties met and conferred regarding these issues on May 2 and 5, 2014. Respondent sent a letter on June 7, 2014 summarizing its understanding of Petitioner's positions as articulated during the meet-and-confer phone conferences, and on June 18, 2014, Petitioner responded, setting forth its positions and clarifying portions of Respondent's letter that had not accurately summarized the parties' discussions.

motion for reconsideration challenging portions of that order, it did not take issue with the portions of the order establishing the schedule for the remainder of discovery. In sum, Respondent last voiced any dissatisfaction with Petitioner's discovery responses on August 5, 2014. Over four months later, only on the eve of the trial period, has Respondent filed this motion.

ARGUMENT

II. THE BOARD SHOULD UPHOLD PETITIONER'S OBJECTIONS TO DISCOVERY REQUESTS DIRECTED AT THE <.3DS> SOFTWARE FILE EXTENSION

Respondent seeks an order compelling Petitioner to produce documents and information relating to Petitioner's use of the computer software file format <.3ds>. Petitioner maintains that such documents and information are outside the scope of the parties' claims and defenses in this proceeding and, accordingly, has served objections to Respondent's discovery demands directed at this issue.³ As set forth below, there is no basis for such additional discovery.

By way of background, computer software file extensions such as <.jpeg> or <.pdf> or <.3ds> indicate to computers the manner in which data in a computer file has been stored or encoded. They are often associated with particular computer programs (for example, <.doc> is associated with the Microsoft Word computer software program).

Petitioner has not used <.3dsmax> — the letter-string corresponding to its registered mark — as a computer software file format. Petitioner's design software does, though, enable users — typically design professionals — to transfer their designs using, among other file formats, <.3ds>, <.dwg>, <.dxf>, <.w3d> and <.shp>.

³ For example, Autodesk has formally asserted relevance objections (among others) to each interrogatory or request for production directed at this issue.

Significantly, Petitioner is not basing its likelihood of confusion claim against Respondent's trademark registration on Petitioner's use of any software file format; rather, Petitioner is basing its claim on its incontestable federal trademark registration for the mark 3DS MAX, together with the associated goodwill. *See* Reg. No. 2733869; Pet. for Cancellation ¶¶ 4-14 (Docket No. 1). Petitioner will not rely at trial on trademark rights, if any, arising from its use of <.3ds> or any other computer software file format.

Respondent maintains that Petitioner's 3DS MAX mark is "at best, descriptive" and argues that the discovery it now seeks is somehow relevant to the strength of Petitioner's mark. However, because Petitioner's 3DS MAX registration (Reg. No. 2733869) is incontestable, Respondent cannot now assert that the mark is descriptive and lacks secondary meaning. 15 U.S.C. § 1065.⁴

Respondent calls the Board's attention to *Autodesk v. Lee*, No. 1:13-cv-01464-AJT-JFA, 2014 U.S. Dist. LEXIS 154124 (E.D. Va. Oct. 30, 2014), a secondary-meaning case that is inapplicable to this proceeding. In that case, Autodesk sought registration for its mark DWG, and sought, in particular, to demonstrate that it had established trademark rights in the mark DWG (through acquired distinctiveness), in part through the reputation arising from its longstanding use and promotion of the corresponding computer software file format <.dwg>. Both the Board and a federal district court rejected Autodesk's file-format "reputation" argument and declined to recognize secondary meaning. In this proceeding, in contrast, Petitioner is *not* claiming that its rights to the 3DS MAX mark arise in any way from use of <.3ds> or any other

⁴ Respondent also seeks to justify its discovery demand by arguing now, for the first time, that Petitioner's 3DS MAX® mark somehow "has a functional purpose." There is no basis for this argument and, moreover, Respondent has not at any time pled functionality as a defense in this proceeding. *See* Answer (Docket No. 14). Functionality is outside the scope of the parties' claims and defenses.

software file format, nor is Petitioner seeking to apply its 3DS MAX-related trademark rights to use of the <.3ds> file format by Respondent or anyone else.

Respondent seeks to hold Petitioner's cooperation against it — claiming that because Petitioner responded to a single interrogatory regarding the “.3ds” file extension, it has now waived its repeated, clear objections to producing documents and information regarding that topic.⁵ Notably, when responding to that interrogatory, Petitioner made very clear that it was not waiving its objections:

INTERROGATORY NO. 1:

Describe the nature of the “.3ds” filename extension, including, without limitation, what it signifies, what goods it may be used in connection with, who may use it, and what software programs recognize it.

RESPONSE TO INTERROGATORY NO. 1:

Autodesk objects to this request on the ground that it calls for information not relevant to the claims or defenses in this proceeding.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: the “.3ds” filename extension can be used for exporting files created or viewed in Autodesk's 3DS MAX-related software products.

Pet'r's Resps. to Resp't's First Set of Interrogs. (Jan. 27, 2014) (emphasis added). Petitioner's willingness nearly a year ago to respond to a discrete interrogatory concerning the nature of the

⁵ Petitioner notes that, contrary to Respondent's characterization, it did *not* agree to produce a witness to testify regarding the <.3ds> file extension. Rather, in response to Interrogatory No. 22, which asks Autodesk to identify the persons most knowledgeable about the <.3ds> file extension, Autodesk responded as follows:

. . . Autodesk further objects to this request on the ground that it calls for information not relevant to the claims or defenses in this proceeding.

Subject to and without waiving the General Objections and specific objections above, Autodesk responds: The individual that is most knowledgeable about the adoption of “.3ds” as a filename extension by Autodesk is Chris Young, VP Engineering, Media & Entertainment, for Autodesk.

Pet'r's Resps. to Resp't's First Set of Interrogs. (Jan. 27, 2014).

<.3ds> file extension should not now mean at the eleventh-hour that it is compelled to produce voluminous documents and serve additional interrogatory responses and admissions concerning a technical issue well outside the scope of the parties' trademark claims and defenses.⁶

III. THE BOARD SHOULD DENY THE REMAINDER OF RESPONDENT'S MOTION AS MOOT

A. Petitioner Has Fulfilled Its Discovery Obligations Regarding Requests for Production Nos. 7, 9, 10, 14, 15, 17, 48, and 50-52

Much of the remainder of Respondent's motion concerns its allegations that Petitioner has failed to produce documents which it has agreed to produce.⁷ However, after an extensive search, collection, and review effort, Petitioner has now produced everything it agreed to produce, to the extent it exists and could be located within Petitioner's custody or control. Accordingly, any requests set forth in section II.B of Respondent's motion should be denied as moot. Any such documents and information have already been produced; if no such documents and information have been produced thus far, they do not exist or could not be located after a (more than) reasonable effort on Petitioner's part.

Specifically, Petitioner has produced numerous marketing and advertising documents; if any such documents identify advertising agencies, they would have been produced. Similarly, with its latest production, Petitioner has produced any relevant, non-privileged documents concerning licensing and enforcement efforts related to the 3DS MAX mark, documents

⁶ And finally, TBMP § 523.01 is clear that "The motion to compel procedure is not applicable to requests for admission." To the extent that Respondent seeks to have the Board order Petitioner to "admit or deny Requests for Admission Nos. 1, 2, and 7," the Board should deny such request not only for the substantive reasons set forth above, but also on procedural grounds.

⁷ Petitioner asks the Board to order Petitioner "produce all documents responsive to Respondent's Requests for Production Nos. 7, 9, 10, 14, 15, 17, 48, 50, 51, and 52." As Respondent very well knows, Petitioner raised objections to each of those requests, and Petitioner has not set forth any arguments as to why the Board should overrule those objections.

pertaining to third-party use of trademarks or trade names containing the term “3DS,” and any documents concerning the similarity or dissimilarity of the marks at issue in this proceeding, to the extent any of the foregoing exist and could be located within Petitioner’s custody or control after a reasonable search. And finally, Petitioner has already produced whatever non-privileged documents it has relied on or referred to in responding to Respondent’s discovery requests.

Given that, subject to the objections it has set forth regarding Requests for Production Nos. 7, 9, 10, 14, 15, 17, 48, and 50-52, Petitioner has produced any non-privileged, responsive documents that were located in its custody, control, or possession after a reasonable search, Respondent’s motion with respect to such Requests for Production should be denied as moot.

B. Petitioner’s Privilege Log Includes Sufficient Descriptions

As Respondent itself acknowledges, Petitioner is not obligated to describe the nature of the withheld documents, communications, or things not disclosed in such detail that it would reveal privileged or protected information. However, in keeping with its obligation to cooperate with Respondent in discovery matters, Petitioner has reviewed its privilege log, supplemented same, and amended some descriptions to provide more detail, to the extent it can do so without revealing privileged or protected information (the amended log was served on Respondent on January 2, 2015). Accordingly, Respondent’s motion with respect to Petitioner’s privilege log should be denied as moot.

IV. THE BOARD SHOULD DENY RESPONDENT’S REQUEST TO REOPEN DISCOVERY

As set forth above, the last communication Petitioner had from Respondent regarding Petitioner’s discovery responses was August 5, 2014. Petitioner provided supplemental responses immediately thereafter, and it very clearly reiterated its position regarding the <.3ds> computer software file extension. If Respondent had continuing complaints, it had ample

opportunity to alert Petitioner and/or the Board to any perceived continuing deficiencies. Similarly, either during the pendency of Petitioner's Motion to Compel or immediately following the Board's October 30, 2014 order, Respondent could have sought to have its discovery extended so that it could resolve these issues.⁸ Respondent, however, took none of these steps, all of which were easily within its "reasonable control." *See, e.g., Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1892 (TTAB 2010) (denying motion to reopen discovery, noting that the "failure to seek an extension of the discovery period before it closed, [was] entirely within [movant's] reasonable control."). Further, Respondent has not demonstrated the required "excusable neglect"⁹ in seeking additional documents and information after its time for discovery has expired. *See* Fed. R. Civ. P. 6(b); TBMP § 509(1(B) (both requiring that a party show "excusable neglect" when seeking an extension of time post-expiration); *see also Luster Prods. Inc. V. Van Sandt.*, 104 USPQ2d 1877, 1880 (TTAB 2012) (denying motion to reopen discovery where "applicant's failure to timely act before the close of the discovery period did not result from excusable neglect").

Given the length that this proceeding has been pending and Respondent's unexcused delay in filing this motion, the Board should deny Respondent's request to reopen discovery in this proceeding.

⁸ Although Respondent points to the Board's suspension of proceedings (from August 8 to October 30, 2014) as a justification for its inaction, Petitioner respectfully submits that such suspension would not have foreclosed Respondent from timely pursuing any of the above-listed obvious courses of action, and further points out that Respondent continued to take no action regarding these alleged deficiencies for well over a month after the suspension was lifted.

⁹ While Respondent's motion requests that the Board reopen discovery, Respondent does not address any of the factors with respect to its excusable neglect, if any. They are: (1) the danger of prejudice to the non-moving party; (2) the length of the delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the moving party; and, (4) whether the moving party has acted in good faith. *See Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P'ship*, 507 U.S. 380, 395 (1993). Respondent cannot make the required showing.

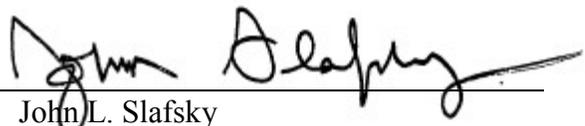
CONCLUSION

For the reasons stated above, Petitioner respectfully submits that the Board should deny Respondent's Motion to Compel Discovery in its entirety, and, in particular, the Board should deny Respondent's request to reopen the discovery period.

Dated: January 2, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE BY MAIL

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 with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I caused to be personally served:

**PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION
TO COMPEL DISCOVERY**

on the person(s) listed below by placing the document(s) described above in an envelope addressed as indicated below, which I sealed. I placed the envelope(s) for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Jason M. Sneed
SNEED PLLC
610 Jetton St., Suite 120-107
Davidson, North Carolina 28036

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 January 2, 2015.


Elvira Minjarez