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

Proceeding	92056509
Party	Defendant 3D Systems, Inc.
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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.)	Cancellation No. 92056509
)	
3D Systems, Inc.,)	
)	
Respondent)	

**RESPONDENT’S REPLY TO PETITIONER’S OPPOSITION TO RESPONDENT’S
MOTION FOR PARTIAL RECONSIDERATION OF
OCTOBER 30, 2014 ORDER**

I. Respondent Has Complied with Aspects of the Board’s Order Not in Dispute

Contrary to Petitioner’s suggestion that Respondent has failed to comply with the Board’s Order, and that Respondent’s Motion for Reconsideration is nothing more than an attempt “to avoid the Board-determined consequences” of such a failure, Respondent notes that it has served supplemental discovery responses addressing the aspects of the Board’s order not contested in its Motion for Reconsideration, along with over 800 additional documents, totaling more than 2,000 pages, in compliance with said Order. TTABVUE 34 at p. 2; *see also* TTABVUE 37, Exhibits 1 and 2.

II. The Likelihood of Confusion Analysis is Limited to the Marks at Issue in the Proceeding

No one – not the Board, and not Petitioner – has explained how other marks used by Respondent, that are not at issue in the proceeding are relevant to the likelihood of confusion factors set forth in the seminal *DuPont* decision. *See In Re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). Neither the Board nor Petitioner has identified a single *DuPont* factor to which Respondent’s other marks are relevant. Moreover, Petitioner points to TBMP § 414(11) as explaining how such other marks are relevant to the likelihood of confusion analysis, but § 414(11) merely states that: “[a] party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. However, the information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion *for purposes of establishing the relationship between the goods or services of the parties.*” TBMP § 414(11) (emphasis added). It is not in dispute that the goods and services in the two registrations at issue in this Cancellation Proceeding partially overlap as to the parties’ respective goods in International Class 009, and Petitioner thus does not need the discovery to “establish[] the relationship between the goods and services of the parties.” TBMP § 414(11). Moreover, Respondent has made it abundantly clear that the registered 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***, and thus Respondent has already produced materials sufficient to identify “the full scope of goods and services promoted by Respondent.” TTABVUE 27 at p. 7.

Petitioner's arguments that Respondent "is refusing to limit its defense to the registered 3DS & Design mark," and that Respondent "reserves its right to argue that '3DS' is an abbreviation of its business name that it has used for years, allegedly without confusion," are misleading. For example, Respondent fails to see the connection between Petitioner's sought-after discovery into all marks used by Respondent containing the term "3DS" and Respondent's business name, 3D Systems, which does not contain the term "3DS."

Respondent thus respectfully urges the Board to reconsider its 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, on the grounds that this decision was in error. *See Sterling Jewelers Inc. v. Romance & Co., Inc.*, Opposition No. 91207312, 2014 WL 4407973, at *2 (TTAB Aug. 29, 2014); *see also* TBMP § 518.

III. The Quality of Respondent's Goods and Services is Not Relevant to the Likelihood of Confusion Analysis

Again, neither the Board nor Petitioner has identified how information relating to the "quality" of Respondent's goods and services is relevant to the *DuPont* Factors considered in a likelihood of confusion analysis. Quality of a respondent's goods is not explicitly identified as a likelihood of confusion factor by the *DuPont* decision, and Petitioner has made no showing that the quality of Respondent's goods are a "fact probative of the effect of use" for purposes of the *DuPont* factors. *See In Re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361 (CCPA 1973). To identify and produce responsive documents and information relating to "any studies, tests, ratings, or surveys relating to the quality of the 3DS Products and Services" would require the review of a vast amount of material pertaining 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 for hundreds of products, a feat that would be extremely burdensome on Respondent. The Board's decision provides no basis or authority for its finding that the quality of Respondent's goods and services is relevant to the likelihood of confusion analysis, and Respondent respectfully submits that it is thus in error and should be reconsidered and withdrawn.

IV. The Volkswagenwerk Case is Precedential

Petitioner's only response to Respondent's citation of the *Volkswagenwerk* case for the proposition that Petitioner failed to meet its burden of showing that commercially sensitive business information is both "relevant and necessary" to its claims is to argue that the *Volkswagenwerk* case is not controlling authority, and that the TBMP provides for commercially sensitive information to be produced within the confines of the Board's standard protective order. This is beside the point. The Board errs when it deviates from precedent without explanation. If the Board's intention was to deviate from the holding of the *Volkswagenwerk* case – regardless of how many years ago *Volkswagenwerk* was decided – the Board ought to distinguish the facts of that case from this one in its decision and explain the basis for its decision, which it did not do. And Petitioner's claim that "there are relevant TBMP provisions (and other Board decisions) that direct the Board otherwise (which the Board cited in its decision)" is simply incorrect: apart from one citation to a CCPA decision from 1979 on page 3 of its Order, the Board's decision *did not cite to any Board decisions or other caselaw*. TTABVUE 29, at p. 3. The Board's ruling stands, for the most part, devoid of authority and explanation, and it is on that basis that Respondent moves for reconsideration, in part. *See Fred*

Beverages, Inc. v. Fred's Capital Mgmt. Co., No. 2010-1007 (Cancellation No. 92048454), 605 F.3d at 967 (Fed. Cir. 2010).

V. Respondent Did Not Agree to Supplement the Discovery Responses at Issue

Respondent respectfully submits that the Board also errs by assuming, without support, that Respondent had agreed to supplement its responses to Interrogatory Nos. 1, 3, 4 and 5 and Requests for Production Nos. 28 and 31; even Petitioner's own evidence shows that this is not correct. For example, Petitioner's letter of June 18, 2014 states with regard to Request for Production No. 31: "You asserted that it is premature to formulate a final response to this request and will revert with a final answer once you have completed review of 3D Systems' documents...." TTABVUE 25 at Exhibit 9, p. 6. And, Respondent once again notes that, between this June 18, 2014 letter and Petitioner's August 7, 2014 motion to compel, there was not a single letter, email or telephone call to follow up with Counsel for Respondent as to the responses to those discovery requests that were taken under advisement.

With respect to Interrogatory No. 3, Petitioner keeps pointing to its June 18, 2014 correspondence purporting to memorialize the discovery conference held between the parties on May 2 and 6, 2014 as fact, despite Respondent's disagreement with the "facts" as stated therein. Yet Ms. Brannen, who signed and transmitted the June 18, 2014 letter by email, and submitted a declaration for purposes of Petitioner's First Motion to Compel, did not even participate in the call on May 6, 2014 during which Respondent's responses to Interrogatories No. 1, 4 and 5, and Document Requests 28 and 31 were discussed. *See* TTABVUE 25 at Exhibit 9. Respondent has repeatedly stated that it did not agree to supplement the response to this Interrogatory, and it is incorrect to state that the June 18 letter "is an accurate reflection of what occurred, what was

discussed, and what was decided,” or to imply that it was incumbent on Respondent to write a letter in response to clarify Petitioner’s misstatements.

VI. The Board Erred in Depriving Respondent of Time to Conduct Discovery

Finally, to the extent that the Board’s Order is intended to deprive Respondent of any further time to conduct discovery, Respondent submits that it is in error. As further detailed in its Motion to Compel (TTABVUE 33), on August 7, 2014, at the time Petitioner’s Motion to Compel was filed, and with more than two weeks left in the discovery period, Respondent was about to file its own Motion to Compel; however, Petitioner’s Motion to Compel caused the proceedings to be suspended pursuant to 37 C.F.R. § 2.120(e)(2), and Respondent was unable to file any papers with the Board that were not germane to Petitioner’s motion, including Motions to Compel relating to Petitioner’s refusal to produce witnesses for deposition on oral examination, and Petitioner’s refusal to produce certain documents and information. It is manifestly unfair that Respondent should be prevented from completing discovery by Petitioner’s premature motion to compel and continued refusal to produce documents. Thus, to the extent that the Board’s Order of October 30, 2014 terminates Respondent’s ability to conduct discovery, Respondent respectfully requests that the discovery period be reopened to permit it to complete its discovery in this matter.

VII. 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 by the instant Motion.

Dated: January 8, 2015

Respectfully Submitted,

/s/ Jason M. Sneed

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Certificate of Filing / Certificate of Service

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

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This the 8th day of January, 2015.

/s/ Gina Iacona

An Attorney for Respondent