

ESTTA Tracking number: **ESTTA651768**

Filing date: **01/22/2015**

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
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Signature	/Gina R. Iacona/
Date	01/22/2015
Attachments	2015-01-22 3D Systems Reply Brief - Motion to Compel Discovery Exhibits A-B.pdf(357619 bytes) 2015-01-22 3D Systems Reply Brief - Motion to Compel Discovery final.pdf(127184 bytes)

EXHIBIT A

January 2, 2015

Via First Class Mail

Jason M. Sneed, Esq.
Sneed PLLC
610 Jetton St., Suite 120-107
Davidson, NC 28036

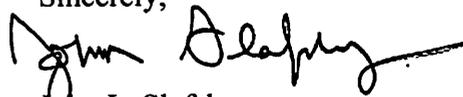
**Re: Autodesk, Inc. v. 3D Systems, Inc.
TTAB Cancellation No. 92056509**

Dear Jason:

Enclosed please find two discs containing documents produced by Autodesk, Inc. and bearing Bates numbers ADSK 0001830 through ADSK 0010371. Also enclosed is a supplemented and amended privilege log.

Please note that the vast majority of the documents included in this production constitute versions or drafts of marketing materials already produced to you, or otherwise similar materials. Insofar as your client has specific questions about select documents contained in this production, and insofar as the Board does decide to reopen your client's discovery period, 3D Systems may direct its questions concerning those documents via interrogatories or depositions on written questions, and Autodesk will not object to any such questions based on timeliness.

Sincerely,


John L. Slafsky

Enclosure

EXHIBIT B

Re: Autodesk, Inc. v. 3D Systems, Inc.

Jen Sawtell-Day

Tue 1/13/2015 2:33 PM

Inbox

To: Brannen, Stephanie <sbrannen@wsgr.com>;

Cc: Slafsky, John <JSlafsky@wsgr.com>; Liss, Luke <lliss@wsgr.com>; Sarah Hsia <Sarah@SneedLegal.com>; Jason M. Sneed <jsneed@SneedLegal.com>; Gina Iacona <GIacona@SneedLegal.com>;

Thanks, will do.
Jen

Jen Sawtell-Day, CP
Certified Paralegal

SNEED PLLC
(704) 591-9318, direct
jsawtellday@sneedlegal.com

From: Brannen, Stephanie <sbrannen@wsgr.com>
Sent: Tuesday, January 13, 2015 2:08:02 PM
To: Jen Sawtell-Day
Cc: Slafsky, John; Liss, Luke; Sarah Hsia; Jason M. Sneed; Gina Iacona
Subject: RE: Autodesk, Inc. v. 3D Systems, Inc.

Jen,

The password should be !!!1412315477!!!

Please let us know if you have any further problems.

Regards,
Stephanie
Stephanie S. Brannen
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304
[650-849-3385](tel:650-849-3385)
sbrannen@wsgr.com

From: Jen Sawtell-Day [<mailto:JSawtellDay@SneedLegal.com>]
Sent: Tuesday, January 13, 2015 10:01 AM
To: Slafsky, John
Cc: Gina Iacona; Sarah Hsia; Jason M. Sneed
Subject: Autodesk, Inc. v. 3D Systems, Inc.

Good Afternoon,

We are in receipt of 2 production discs bearing bates numbers ADSK 001830 - ADSK 009411 and ADSK

009412 - ADSK 010371.

Both discs prompted us for a password in order to download them. Your cover letter did not provide a password and we have not received one via email or other communication.

Please provide passwords for these discs as soon as possible.

Thank you,
Jen

Jen Sawtell-Day, CP
Certified Paralegal

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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 TO COMPEL DISCOVERY**

Respondent, 3D Systems, Inc., herein replies in support of its Motion to Compel Discovery (TTABVUE 33) and in opposition to Petitioner’s response (TTABVUE 35).

A. Respondent Would be Prejudiced Without Additional Time to Review and Follow Up on Materials Produced by Petitioner on January 2, 2015

Twenty days *after* Respondent filed the instant motion to compel Petitioner to produce additional documents and a sufficiently detailed privilege log (and on the same day Petitioner filed its brief in opposition), Petitioner produced *by U.S. mail* a supplemental document production consisting of over 8,500 pages as well as an amended privilege log.¹ *See* Exhibit A. Upon attempting to review the discs containing Petitioner’s production materials, Counsel for Respondent was required to input a password, which Petitioner failed to provide or even mention

¹ Respondent is satisfied with Petitioner’s supplemental and amended privilege log, and as such, the portion of Respondent’s motion seeking to have Petitioner provide a more detailed privilege log is hereby withdrawn.

was necessary in its cover letter. *Id.* In fact, it was not until January 13, 2015—after Counsel for Respondent emailed Counsel for Petitioner regarding Respondent’s inability to access the documents—that Counsel for Petitioner provided Respondent’s Counsel with the password sufficient to access Petitioner’s January 2015 document production. Exhibit B.

Petitioner’s continued gamesmanship with respect to the discovery process, preventing Respondent from timely completing discovery, is unfair and should not be rewarded. Respondent cannot possibly be expected to sufficiently review Petitioner’s voluminous document production within the week between the time Respondent gained access thereto, and the time this reply brief was due, to determine whether Petitioner has adequately supplemented its initial document production of June 27, 2014.

Respondent should be allowed time to review and follow up on the materials produced by Petitioner after Respondent filed the instant Motion to Compel, or, to the extent that the Board intended to prematurely limit Respondent’s discovery period by its Order of October 30th, Respondent respectfully requests that the discovery period be reopened to permit Respondent to complete its discovery in this matter and allow Respondent time to review all 8,500 pages to determine whether Petitioner did in fact produce the documents it agreed to produce seven months prior, and to identify any remaining deficiencies and confer with opposing counsel pursuant to Rule 37, FRCP. *See* TTABVUE 33 at Exhibit 3 at pp. 2-3.

B. The Board Should Order Petitioner to Produce Documents and Information

Regarding the “.3ds” File Extension

Respondent is entitled to discovery concerning Petitioner’s use of the .3ds file extension. Respondent could use such information to show that the common element of both marks at issue in this proceeding is weak, or used by Petitioner in a functional manner, or otherwise has become

incapable of serving as a valid and enforceable trademark as used by Petitioner. *See, e.g., Beiersdorf Aktiengesellschaft v. Southwest Technologies, Inc.*, 1998 WL 574340, at *9 (TTAB 1998) (“Whether a mark is classified as ‘strong’ or ‘weak’ is a very important element in deciding likelihood of confusion.”); *Qualitex Co. v. Jacobsen Prods. Co., Inc.*, 514 U.S. 159, 165 (1995)(explaining that “[t]he functionality doctrine prevents trademark law...from [] inhibiting legitimate competition by allowing a producer to control a useful product feature.”); *Pizzeria Uno Corp. v. Temple*, 566 F.Supp. 385, at *13 (D.S.C. 1983) (holding that “the evidence indicates that the word “uno” as used by the plaintiff was a ‘weak mark’ and the inclusion of this term in the marks of the two parties does not weigh in favor of a finding of likelihood of confusion.”); *Autodesk Inc. v. Dassault Systemes Solidwords Corp.*, 3:08-cv-04397-WHA, at *6 (N.D. Cal. Dec 31, 2009) (“The primary function of a file extension to both a computer and its user is to identify a file or file type”, and “[e]ven if the function were solely to identify the format in which the contents are stored, that would still be a functional use.”).

The fact that the pleaded registration has become incontestable under 15 U.S.C. § 1065 does not mean that the pleaded mark has become immune to an analysis of its strength or weakness. A defendant still can raise issues regarding a mark’s strength or weakness in connection with determining likelihood of confusion. *See, e.g., Entrepreneur Media*, 279 F.3d 1135, at 1142 n.3 (9th Cir. 2001) (“[T]he incontestable status of EMI’s mark does *not* require a finding that the mark is strong”) (emphasis in original); *see also Coach/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, at *19 (TTAB 2014) (“[F]or purposes of determining inherent strength of a mark as a factor relevant to likelihood of confusion, incontestability does not preclude [the Board] from finding that, in terms of conceptual strength, [an incontestable mark] is descriptive.”)

Respondent therefore is entitled to discovery on the strength of Petitioner’s 3DS MAX designation – and specifically the term “3DS” – as this evidence is directly relevant to at least one of the many factors used in determining likelihood of confusion—“the nature of the mark itself.” *Coach/Braunsdorf Affinity*, 110 USPQ2d at *18 (TTAB 2014). This is particularly true when the strength of the element shared by the marks at issue in this proceeding is, at least as used by Petitioner, descriptive or functional or weakly suggestive. *See, e.g., Beiersdorf*, 1998 WL at *9 (“There are numerous cases in which this Board and the courts have found confusion to be unlikely where the only element in common was a descriptive or suggestive word.”).

Following the Eastern District of Virginia decision in the DWG case—which held that the mark “DWG” was descriptive, due to Autodesk’s use thereof as a file extension—Petitioner’s use of the term “3DS” as a file extension has weakened the “3DS” component of Petitioner’s mark. It will be important to the presentation of the trial evidence and the Board’s analysis that the only common element in the parties’ respective marks, “3DS,” cannot serve as a source identifier to Petitioner. *See Ziebart Int’l Corp. v. Z Tech Rustproofing*, 2009 WL 4073522, at * 1 (TTAB 2009) (“If the common element of conflicting marks is a word that is ‘weak’ then this reduces the likelihood of confusion.”) (*quoting* 4 J. Thomas McCarthy, McCarthy on Trademarks § 28:43 (2014)).

Respondent respectfully requests that the Board order Petitioner to produce documents and information in response to Respondent’s discovery requests regarding Petitioner’s use of the .3ds file extension on products sold under its 3DS MAX designation.

C. Respondent’s Discovery Period Was Not Closed by the Board’s October 30, 2014

Order

Petitioner's argument that the Discovery Period for Respondent was closed is without basis. The language of the Board's Order is unequivocal: "[d]iscovery closes for *both parties*" on December 30, 2014. TTABVUE 29 at p. 7 (emphasis added). But to the extent that the Board intended something other than what it wrote, Respondent can clearly show excusable neglect for not filing a motion to compel until December 13, 2014.

First, Respondent, who had 19 days left in the discovery period when the proceeding was suspended, was thus *precluded* from filing a Motion to Compel with respect to this issue, and thus could not file the instant motion until after the Board issued its Order on Petitioner's Motion to Compel and Respondent filed its Motion for Reconsideration in Part on November 29, 2014. TTABVUE 29, 30. Respondent, relying on the language in the Board's Order indicating that the close of discovery for both parties was not until December 30, 2014, did not believe that its discovery period had closed, and thus did not believe that it was required to move immediately on receipt of the Board's Order on October 30, 2014.

Secondly, Respondent filed this Motion *less than 48 hours* after Petitioner took the position that the discovery period had closed for Respondent – an interpretation of the Board's October 30, 2014 Order that Respondent did not agree with given the unequivocal language contained in the Order ("[d]iscovery closes for *both parties*" on December 30, 2014). TTABVUE 29 at p. 7 (emphasis added).

Additionally, there exists no measurable prejudice to Petitioner should the Board extend Respondent's discovery period for the purpose of allowing Respondent to review and follow up on Petitioner's late production. The only possible prejudice Petitioner can argue is a slightly extended discovery period—an extension that Petitioner acknowledges is required for Petitioner itself to be able to complete discovery. *See e.g. Old Nutfield Brewing Co. v. Hudson Valley*

Brewing Co., 65 USQP2d 1701, at *3 (TTAB 2002) (“[T]he mere passage of time is generally not considered prejudicial, absent the presence of other facts, such as the loss of potential witnesses.”) Further, it is due to Petitioner’s own delay in performing a supplement document collection and production that Respondent must request additional time to conduct discovery.

Fourth, a reopening of the discovery period would not cause substantial delay nor would the potential impact on the judicial proceedings be significant as the period for conducting discovery will most likely be extended as a result of the three motions to compel presently under Board review. Moreover, Respondent’s alleged failure to complete discovery by the prior deadline of August 27, 2014, was not within its reasonable control as Respondent was precluded from filing the instant motion until after the Board-ordered suspension was lifted.

Similarly, under the fourth *Pioneer* factor, Respondent’s reliance on the unequivocal language of the Board’s Order that the discovery period for both parties closed on December 30, 2014 was clearly made in good faith, and was such reliance was logical in view of the fact that there remained 19 days left in the discovery period when Petitioner prematurely moved to compel, resulting in suspension of the proceedings. Petitioner’s discussion of whether Respondent did or did not act promptly is a straw man argument in its purest form. The Board’s Suspension Order dated August 8, 2014 was clear: “Proceedings are suspended pending disposition of Petitioner’s motion to compel filed on August 7, 2014, except as discussed below. The parties should not file any paper which is not germane to the motion to compel.” TTABVUE 26 (emphasis in original); *see also* TBMP § 523.01(2) (“When a party files a motion for an order to compel...discovery, the case will be suspended by the Board with respect to all matters not germane to the motion.”). Once the Board suspended the proceeding, neither Respondent nor Petitioner had the burden of following the trial schedule as previously set by the

Board on April 12, 2014. *See e.g. Prakash Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, at * 2 (TTAB 2010) (“Both parties bear the responsibility for following the trial schedule as ordered unless and until the Board issues a suspension order or otherwise resets the trial dates.”)

D. Conclusion

For the foregoing reasons, Respondent respectfully requests that the Board grant Respondent’s Motion to Compel Discovery in its entirety and: (1) order Petitioner to respond to Respondent’s discovery requests and produce responsive documents concerning Petitioner’s use of “3DS” as a file extension; and (2) reset the discovery period to allow sufficient time for Respondent to complete discovery, including to and review Petitioner’s voluminous supplemental production and meet and confer with Petitioner’s Counsel regarding any remaining deficiencies.

Dated: January 22, 2015

Respectfully Submitted,

/s/ Jason Sneed
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Gina Iacona, Esq.
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Glacona@SneedLegal.com

Attorneys for Respondent 3D Systems, Inc.

Certificate of Filing / Certificate of Service

The undersigned hereby certifies that the foregoing *Respondent's Opposition to Petitioner's Motion to Compel* 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 22nd day of January, 2015.

/s/ Gina Iacona
An Attorney for Respondent