

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: June 1, 2015

Cancellation No. 92056509

*Autodesk, Inc.*

v.

*3D Systems, Inc.*

**George C. Pologeorgis,  
Interlocutory Attorney:**

By order dated May 5, 2015, the Board, *inter alia*, required the parties to seek Board approval prior to filing any further unconsented motions in this proceeding. On May 26, 2015, counsel for each party requested a telephone conference, pursuant to the Board's May 5, 2015, order, seeking permission to file an unconsented motion in this matter. Petitioner sought permission to file a motion to quash the deposition notice of its CEO, as well as a motion for a protective order concerning new written discovery propounded by Respondent. In turn, Respondent sought permission to file a motion for leave to file an amended pleading to assert a counterclaim of functionality under Section 2(e)(5) of the Trademark Act.

On Wednesday, May 27, 2015 at 2 p.m. EDT, the Board held a telephone conference with counsel for the parties regarding each party's request to file an unconsented motion. The conference was held among John Slafsky, as counsel for

Petitioner, Jason M. Sneed and Sarah Hsia, as counsel for Respondent, and George C. Pologeorgis, as the Board attorney assigned to this case.

**Petitioner's Motions**

In support of its request to file a motion to quash, Petitioner argued that its CEO was not identified in Petitioner's initial disclosures or in response to discovery requests as a person who would have discoverable information in this case. Petitioner further maintained that Respondent has yet to take the 30(b)(6) discovery deposition of Petitioner and by noticing the discovery deposition of Petitioner's CEO, Respondent is merely attempting to harass Petitioner. Respondent confirmed that it has not yet taken the 30(b)(6) discovery deposition of Petitioner.

Based on the foregoing, Petitioner's request to file a motion to quash the deposition notice of its CEO is **GRANTED**.

With regard to Petitioner's request to file a motion for a protective order, Petitioner contends that it was implicit in the Board's April 12, 2014, October 30, 2014, and May 5, 2015 orders which, among other things, extended the close of discovery, that the parties were precluded from propounding any new discovery in this matter. The Board disagreed. The Board noted that none of its previous order precluded the parties from conducting additional discovery. The Board noted that these orders merely stated that the parties were required to complete discovery within the extension of time provided by the Board.

In view of the foregoing, Petitioner's request to file a motion for a protective order regarding Respondent's newly-propounded written discovery is **DENIED**.

**Respondent's Motion**

Respondent seeks permission to file a motion for leave to amend its answer to assert a counterclaim of functionality under Section 2(e)(5) of the Trademark Act. During the telephone conference, the Board noted that Petitioner's pleaded registered mark consists of a word mark in standard characters, namely, 3DS MAX, and that a claim of functionality typically concerns configuration marks or marks consisting of trade dress. In support of its request to file a motion for leave to amend its pleading, Respondent relies on two district court decisions from the Northern District of California, namely, *Autodesk, Inc. v. Dassault Sytemes SolidWorks Corp.*, 685 F. Supp. 1001 (N.D. Cal. December 8, 2009) and *Autodesk, Inc. v. Dassault Sytemes SolidWorks Corp.*, 685 F. Supp. 1023 (N.D. Cal. December 31, 2009). Respondent contends that the district court decisions found that the name of a file extension is functional and, therefore, cannot be trademarked. It appears that Respondent seeks to assert a counterclaim that Petitioner's registered 3DS MAX mark is functional because the mark consists of the name of the file extension for the goods identified in Petitioner's pleaded registration.

The Board notes that Petitioner's pleaded 3DS MAX registered mark is for the following identified goods: computer programs for animating, modeling and rendering images, for use in computer aided design, animation, graphics, game design and design modeling applications. While the Board acknowledges that the

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district court's December 31, 2009, decision held that the names of file extensions are functional and, therefore, cannot be trademarked, the goods identified in Petitioner's pleaded registration are not solely for file extensions but for a computer program as a whole. Furthermore, the Board noted that Petitioner's pleaded registered mark is 3DS MAX and not 3DS and that, if Respondent sought to assert a claim of functionality, the claim must be asserted against Petitioner's mark as a whole and not only in conjunction with the "3DS" portion of Petitioner's pleaded registered mark, which purportedly is the name of the file extension for the goods identified in Petitioner's pleaded registration.

In view of the foregoing, Respondent's request to file a motion for leave to amend its answer to assert a counterclaim of functionality is **DENIED**.

**Summary**

1. Petitioner's request to file a motion to quash the deposition notice of its CEO is **GRANTED**;
2. Petitioner's request to file a motion for a protective order regarding Respondent's newly-propounded discovery is **DENIED**;
3. Respondent's request to file a motion for leave to amend its pleading to assert a counterclaim of functionality under Section 2(e)(5) of the Trademark Act is **DENIED**.

**Trial Schedule**

Trial dates remain as reset by Board order dated May 5, 2015.